

O-413-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2561447
BY TALENT ACADEMY
TO REGISTER THE TRADE MARK**



IN CLASSES 16, 25, 35, 38 AND 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 101520 BY
ACADEMY MUSIC GROUP LIMITED**

BACKGROUND

1) On 14 October 2010 Talent Academy (hereinafter the applicant), applied to register the following trade mark:



2) In respect of the following goods and services:

In Class 16: Paper, printed matter; book binding material; photographs; stationery; printing blocks; printed publications;

In Class 25: Clothing, footwear, headgear.

In Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale of Items in class 16, and 25

In Class 38: Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.

In Class 41: Education; providing of training; entertainment; sporting and cultural activities.

3) The application was examined and accepted, and subsequently published for opposition purposes on 5 November 2010 in Trade Marks Journal No.6860.

4) On 4 February 2011 Academy Music Group Limited (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent states that it is a leading owner and operator of live music and club venues within the UK and has been operating venues under the ACADEMY name since the company acquired BRIXTON ACADEMY together with the goodwill in the name ACADEMY in 1996. The Brixton Academy has been trading since 1929 when it was operated as a cinema and theatre and then a music venue since 1983. Since 1996 the opponent has offered a wide


variety of goods and services relating to entertainment, live music and live music venues under the ACADEMY trade mark ranging from printed matter to organisation of live music events. In January 2009 a naming rights deal was entered into so that the opponent's venues carry the "O2" trade mark alongside the ACADEMY trade mark.

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

Number	Mark	Filing and Registration Date	Class	Relevant Specification
2500577	ACADEMY	21.10.08 / 19.08.11	9	Apparatus for recording, transmission or reproduction of sound, vision, or images; recording discs; computer software (including software downloadable from the Internet); computer programs; computer games; videos; DVDs; MP3s; MP4s; downloadable MP3 files, MP3 recordings, on-line discussion boards, webcasts and podcasts; CDs; audio and/or visual tapes; cassettes; discs; records; digital music (downloadable from the Internet); film, sound and video recordings; sound and video recordings and publications in electronic form supplied on-line, from databases or from facilities provided on the Internet; cinematographic, photographic and optical apparatus and instruments; digital music (downloadable) supplied from MP3 websites on the Internet; telephone ring tones (downloadable); podcasts; magnetic discs; magnetic data media; downloadable electronic publications; databases; magnetic data carriers; sunglasses.
			16	Printed publications; notepads, books, magazines, brochures and event programmes; posters, prints, photographs, postcards relating solely to live music and live music venues; flyers; leaflets; stationery; pens; tickets for concerts, shows and other events; decalcomanias.
			35	Advertising; dissemination of advertising matter; advertising by mail order; business management of performing artists; compilation of information into computer databases; organisation of exhibitions for commercial or advertising purposes; publicity; public relations; publication of publicity texts; radio advertising; sales promotion; distribution of samples; television advertising; radio and television commercials; business management; business administration; accounting and office functions in relation to the reservation, issue and sale of tickets; advertising services provided via the Internet; production of television and radio advertisements; provision of business information; hiring disc jockeys; organisation, operation and supervision of customer loyalty schemes; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.
			38	Streaming of audio and audio-visual material via the internet; telecommunication services, namely, transmission of podcasts; telecommunications; communications by computer terminals; cellular telephone communication; computer aided transmission of messages and images; television and radio broadcasting; electronic bulletin board services (telecommunications services); electronic mail; providing telecommunications connections to a global computer network; providing user access to a global computer network (service providers); providing access to computer databases; chat room services; portal services; providing user access to the Internet; information

				relating to all the foregoing provided on-line from a computer database or the Internet; consultancy, advisory and information services relating to the foregoing.
			41	Entertainment; organisation of competitions for entertainment; entertainment services, provided by means of podcasts; production of radio and television programmes; publication of texts (other than publicity texts); electronic games services provided by means of the Internet; the provision of on-line electronic publications and digital music (not downloadable) from the Internet; provision of recreational and entertainment facilities; live band performances; club entertainment services; organising nightclub events; recording of music onto a variety of media; production of sound recordings; production of musical recordings; production of audio recordings; hiring of audio and/or visual equipment; organising, arranging, managing and staging musical events, shows, concerts, festivals, gigs and live band performances; production of television, film, radio and music programmes and recordings; composition of music; video taping; digital music (not downloadable) supplied from MP3 websites on the Internet; providing digital music (not downloadable) from MP3 Internet websites; digital music (not downloadable) provided from the Internet; booking agencies; ticket reservation and ticket agency services for concerts and other events; ticket agency services provided online, by telephone, mobile telephone, and through ticket outlets; the provision of on-line electronic publications and digital music (not downloadable) from the Internet in the form of podcasts; management of theatres and music venues; provision of theatre facilities; theatre services; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.
			42	Creating and maintaining websites for others; compilation of websites; design of computer databases; design, drawing and commissioned writing for the compilation of websites; computer software design and development; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.
			43	Restaurant, cafe, fast food catering, snack-bar, pub and bar services; hiring of bar, catering and restaurant equipment and facilities; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.
CTM 7332539	ACADEMY	21.10.08 / 07.04.11	9	Apparatus for recording, transmission or reproduction of sound, vision, or images; recording discs; computer software (including software downloadable from the Internet); computer programs; computer games; videos; DVDs; mp3s; mp4s; downloadable mp3 files, mp3 recordings, on-line discussion boards; CDs; audio and/or visual tapes; cassettes; discs; records; digital music (downloadable from the Internet); film, sound and video recordings; sound and video recordings supplied on-line, from databases or from facilities provided on the Internet; cinematographic, photographic and optical apparatus and instruments; digital music (downloadable) supplied from mp3 websites on the Internet; telephone ring tones (downloadable); magnetic discs; magnetic data media; databases; magnetic data carriers; sunglasses; webcasts and podcasts relating to live music and live music venues; publications in electronic form supplied on-line from databases or from facilities provided on the Internet relating to live music and live music venues; podcasts and downloadable electronic publications relating to live music

				and live music venues ; all of the aforesaid relating to live music, live music venues and events.
			16	Paper, cardboard and goods made from these materials; printed matter and printed publications; notepads, books, magazines, brochures and event programmes; posters; flyers; leaflets; prints; photographs; postcards; stationery; pens; tickets for concerts, shows and other events; decalcomanias; all of the aforesaid relating to live music, live music venues and events.
			35	Advertising; dissemination of advertising matter; advertising by mail order; business management of performing artists; compilation of information into computer databases; organisation of exhibitions for commercial or advertising purposes; publicity; public relations; publication of publicity texts; radio advertising; sales promotion; distribution of samples; television advertising; radio and television commercials; business management; business administration; accounting and office functions in relation to the reservation, issue and sale of tickets; advertising services provided via the Internet; production of television and radio advertisements; provision of business information; hiring disc jockeys; organisation, operation and supervision of customer loyalty schemes; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing; all of the aforesaid relating to live music, live music venues and events.
			38	Streaming of audio and audio-visual material via the Internet; telecommunication services, namely, transmission of podcasts; telecommunications; communications by computer terminals; cellular telephone communication; computer aided transmission of messages and images; television and radio broadcasting; electronic bulletin board services (telecommunications services); electronic mail; providing telecommunications connections to a global computer network; providing user access to a global computer network (service providers); providing access to computer databases; chat room services; portal services; providing user access to the Internet; information relating to all the foregoing provided on-line from a computer database or the Internet; consultancy, advisory and information services relating to the foregoing.
			41	Entertainment; organisation of live music competitions; provision of recreational and entertainment facilities; live band performances; club entertainment services; organising nightclub events; organising, arranging, managing and staging musical events, shows, concerts, festivals, gigs and live band performances; production of television, film, radio and music programmes and recordings; management of theatres and music venues; provision of theatre facilities; theatre services; booking agencies relating to all of the foregoing; ticket agency services relating to all of the foregoing provided on-line, by telephone, mobile telephone, and through ticket outlets; entertainment services, namely, providing podcasts relating to live music and live music venues; production of radio and television programmes; publication of texts (other than publicity texts) about live music and live music venues; electronic games services provided by means of the Internet; the provision of on-line electronic publications relating to live music and live music venues and digital music (not downloadable) from the Internet; recording of music onto a variety of media; production of sound recordings; production of musical recordings; production of audio recordings; hiring of audio and/or visual equipment; composition of music; video taping; digital music (not downloadable) supplied from mp3 websites on the Internet; providing digital music (not downloadable) from

				mp3 Internet websites; digital music (not downloadable) provided from the Internet; ticket reservation and ticket agency services for concerts and other events; the provision of on-line electronic publications and digital music (not downloadable) from the Internet in the form of podcasts relating to live music and live music venues; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing; all of the aforesaid relating to live music, live music venues and events.
			42	Creating and maintaining websites for others; compilation of websites; design of computer databases; design, drawing and commissioned writing for the compilation of websites; computer software design and development; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.
			43	Restaurant, cafe, fast food catering, snack-bar, pub and bar services; reservation services for temporary accommodation; hiring of bar, catering and restaurant equipment and facilities; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.
2487541	ACADEMY	14.05.08 / 26.02.10	41	Entertainment; interactive entertainment services; electronic games services provided by means of any communications network; entertainment and entertainment information services provided by means of telecommunication networks; provision of news information; provision of entertainment by means of television and Internet protocol television; information and advisory services relating to the aforesaid.
2049175	ACADEMY	21.12.95 / 15.01.99	42	Public house services.
2243180	BIRMINGHAM ACADEMY	07.09.00 / 21.09.01	16	Posters, leaflets, advertising material.
			43	bar and pub services; provision of facilities for entertainment;.
2343728	LIVERPOOL ACADEMY	18.09.03 / 06.10.06	16	Posters, leaflets; advertising material.
			43	Catering for the provision of food and drink; provision of facilities for entertainment;
2343726	NEWCASTLE ACADEMY	18.09.03 / 25.02.05	16	Posters, leaflets, advertising material.
			43	Catering for the provision of food and drink; provision of facilities for entertainment;
2343721	LEEDS ACADEMY	18.09.03 / 25.02.05	16	Posters, leaflets, advertising material.
			43	Catering for the provision of food and drink; provision of facilities for entertainment;.
2253188		16.11.00 / 27.04.01	16	printed matter; posters, leaflets, publications, advertising material.
			25	Articles of clothing;
			41	entertainment services.
			42	bar and pub services; provision of facilities for entertainment;

c) The opponent contends that the mark in suit is similar to its family of marks, above, as they share the identical term ACADEMY. It also contends that the goods and services of the two parties are identical or similar. The mark in suit therefore offends against Section 5(2)(b) of the Act.

d) The opponent also contends that as a result of the extensive use of its “family” of four ACADEMY marks (2500577, 7332539, 2487541 and 2049175) in relation to entertainment, the arrangement of concerts, the arrangement of music performances and the arrangement of music shows, it has gained a reputation such that use of the mark in suit without due cause would take unfair advantage of, and be detrimental to, the distinctive character of its ACADEMY marks. The mark in suit therefore offends against Section 5(3) of the Act.

e) Because of the reputation of the opponent in the sign ACADEMY, use of the mark in suit would cause misrepresentation and therefore the mark in suit offends against Section 5(4)(a) of the Act.

5) On 23 May 2011, the applicant filed a counterstatement. They denied all the grounds and put the opponent to proof of use in relation to all goods and services under all the marks relied upon.

6) Both sides filed evidence and both sides request costs. Neither side wished to be heard in the matter although both provided written submissions.

OPPONENT’S EVIDENCE

7) The opponent filed a witness statement, dated 29 July 2011, by Toby Rolph, the opponent’s Finance Director, a position he has held since 2007. He states that the company changed its name from The McKenzie Group Ltd to Academy Music Group on 14 September 2004. The ACADEMY mark was first used by a predecessor in business when they renamed the Astoria in Brixton as ACADEMY BRIXTON in 1985. The opponent purchased the venue and the rights to the trade mark in 1998. The opponent currently owns and/or operates 24 venues throughout the UK although only 20 have the word ACADEMY in their title. He states that all the venues have a licence to serve alcohol and present live music, some also have catering facilities. He provides the following table:

Name	Location	Year first called Academy	Capacity
EMPIRE	London		1,100
ABC*	Glasgow		2,500
ABC2*	Glasgow		350
UNDERGROUND	Leeds		400
ACADEMY*	London	1985	4,950
ACADEMY*	Birmingham	2000	3,000
ACADEMY*	Bristol	2001	1,650
ACADEMY*	London	2003	800
ACADEMY2*	London	2003	250
ACADEMY*	Glasgow	2003	1,500
ACADEMY*	Liverpool	2003	1,250

ACADEMY2*	Liverpool	2003	500
ACADEMY*	Newcastle	2005	2,000
ACADEMY2*	Newcastle	2005	1,100
ACADEMY2*	Bristol	2006	1,650
ACADEMY*	Oxford	2007	1,600
ACADEMY2*	Oxford	2007	440
ACADEMY*	Sheffield	2008	2,150
ACADEMY2*	Sheffield	2008	2,150
ACADEMY*	Leeds	2008	2,300
ACADEMY2*	Birmingham	2009	600
ACADEMY2*	Glasgow	2009	250
ACADEMY3*	Birmingham	2009	250
ACADEMY*	Bournemouth	2010	2,000

*has "O2" and the name of location (Brixton, Bristol etc) in title e.g. "O2 ABC GLASGOW" or "O2 ACADEMY, Exhibits TR1 & TR8 refer.

8) Mr Rolph states that the opponent has entered into two naming rights deals. Firstly, between January 2003-2008 the naming rights partner was CARLING and since January 2008 has been O2. This deal gives the sponsor the right to use their brand name alongside the venue name for the period of the sponsorship deal. He provides the following turnover figures for the AMG Group:

Year	Turnover £ million
2004	16
2005	18.6
2006	21.4
2007	24.3
2008	28.2
2009	32.7
2010	36.7

9) However, Mr Rolph does not state what these figures relate to in terms of geographical area, goods or services, or under what trade mark. Nor does he provide any context for the figures, evidence of market share or evidence from others in the trade. He states that the venue in Brixton has won many awards as venue of the year from *NME* and *Music Week* magazines. He also states that the venue was chosen by a pop singer, Madonna, to launch an album and that the performance was broadcast on the internet to a global audience of approximately 9 million people. This event also generated some press coverage, mostly of other so-called celebrities, who attended the event. He provides examples of the press coverage at exhibit TR4, and at exhibit TR5 copies of tickets for various concerts which have taken place at Brixton over the years. I do not find either of assistance in my decision as they refer to the group performing rather than show use of the trade mark.

10) Mr Rolph states that the venues are promoted by means of flyers, posters, advertisements in magazines and newspapers as well as on its own website. He states

that the naming rights partners have also made a contribution to the promotion of the venues. At exhibit TR6 he provides copies of such items. Virtually all the items relate to sponsorship advertising by Carling. They show the words "CARLING ACADEMY" then underneath a letter "a" in a circle followed by the location e.g. Newcastle, Birmingham etc. Mr Rolph states that the device of the letter "a" in a circle is use of the opponent's mark 2253188. However, this is not the case as the examples provided were not a stylised "a" as in the mark nor did they have a piece of the letter missing as the trade mark does. The examples show use of a standard letter "a" in a circle, not the opponent's trade mark. There are also examples for the Shepherds Bush Empire, although I am not sure why. The exhibits all show use on concerts/shows and it is clear that they have a licence to sell alcohol and in some instances offer catering. Each venue also has its own website; all have the sponsor's name first, then the name of the venue and its location e.g. www.o2abcglasgow.co.uk; I also note that all e-mail addresses are along similar lines e.g. joe@o2academyglasgow.co.uk.

11) Mr Rolph states that local papers also provide coverage of concerts and provide free advertising as a result. At exhibit TR10 he provides examples. These mostly refer to the venues as "Carling Academy" or "O2Academy" and the location. There are a couple of examples where the term "Academy" is used *solus*. He states that in September 2000, 20,000 promotional CDs were produced to celebrate the 15th anniversary of the Brixton Academy. These were sent to music industry professionals and members of the public who were identified as potential or existing customers. They also distribute promotional lanyards and leaflets at target groups such as students. At exhibit TR12 he provides images of the lanyards which have the sponsor's name upon them e.g. "Carling Academy". He states that the venues also sell merchandise such as T-shirts bearing the legend "Carling Academy" with "Brixton" underneath.

APPLICANT'S EVIDENCE

12) The applicant filed a witness statement, dated 4 January 2012, by Naz Benamar, the applicant's Director of Operations. He states:

"2. The Talent Academy is an educational institute primarily specialising in entertainment and media. Its client group are those who wish to pursue a career in the performing arts including acting, singing, dancing, stage productions, musicals, camera work, script writing, film directing and many more. The Talent Academy provides practical workshops in these specialism's which go hand in hand with gaining traditional qualifications such as NVQ's and Diploma's.

3. Talent Academy is a member of an organisation who has been education (sic) and training for the last 18 years and support young people around the local communities. The purpose of the Academy is to encourage primarily young people who may have dropped out of main stream education back into an opportunity whereby they can gain a valuable qualification and encouraging them to do this through pursuing their creative interests."

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

DECISION

14) The first ground of opposition is 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.”

15) 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.”

16) The opponent is relying upon its trade marks listed in paragraph 4 above, all of which are clearly earlier trade marks. Of the marks relied upon five (2049175, 2243180, 2343726, 2343721 and 2253188) have been put to strict proof of use by the applicant and are subject proof of use. Section six of the Act 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).”

17) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the marks has been made. In the instant case the publication date of the application was 5 November 2010, therefore the relevant period for the proof of use is 6 November 2005 – 5 November 2010. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles

established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed person O-371-09 *SANT AMBROEUS*:

“(a) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(b) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(c) The 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 by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].


(i) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(f) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

18) The marks concerned are registered for the following goods and services:

2049175: ACADEMY	Class 42: Public house services.
2243180: BIRMINGHAM ACADEMY	Class 16: Posters, leaflets, advertising material. Class 43: bar and pub services; provision of facilities for entertainment.
2343726: NEWCASTLE ACADEMY	Class 16: Posters, leaflets, advertising material. Class 43: Catering for the provision of food and drink; provision of facilities for entertainment.
2343721: LEEDS ACADEMY	Class 16: Posters, leaflets, advertising material. Class 43: Catering for the provision of food and drink; provision of facilities for entertainment.
2253188: 	Class 16: printed matter; posters, leaflets, publications, advertising material. Class 25: Articles of clothing. Class 41: entertainment services. Class 42: bar and pub services; provision of facilities for entertainment.

19) As part of its evidence the opponent provided a number of items of printed matter. However, this does not mean that it is using its trade marks in relation to the provision of printed matter merely that it uses printed matter to promote its nightclub/concert hall venues, and cannot be regarded as genuine use in relation to class 16 goods. Similarly, whilst there is a small amount of evidence regarding clothing, the same contention holds that the use of any of the opponent's marks upon clothing is merely for promotion of its clubs. The opponent refers to it as merchandise which is sold in the venues. I now turn to consider the evidence provided in relation to use of the marks above. There is no use of trade mark no. 2253188 in the evidence. There is use of a letter "a" in a circle but it is not stylised in the manner of the mark registered, and in particular it does not have a gap in the letter. With regard to the rest of the evidence, this shows use of the terms "Carling Academy" and "O2 Academy" together with the device of a letter "a" in a circle and a location e.g. Leeds/ Newcastle.

20) The marks that have been used are not registered trade marks. I must determine whether these marks can be considered as variants. In considering this issue I look to the guidance set out on whether a mark used is in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. In considering this question I look to the judgement of the Court of Appeal in *BUD / BUDWEISER BUDBRAU* [2003] RPC 24. In particular, I refer to the comments of Lord Walker at paragraphs 43-45 where he stated:

"43. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences

have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

21) I also take into account the comments of Ms Carboni acting as the Appointed Person in *Orient Express* (BL O/299/08) where she said:

“66. It is unnecessary for me to give any further details here of the various underlying decisions. Their full case references are set out in *NIRVANA* [BL O/262/06] and *REMUS* [BL O/061/08]. But I do set out below the guidance that Richard Arnold QC derived from his review, which he set out in *NIRVANA* and reiterated in *REMUS*, as follows:

33. The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period....

34. The second question is whether the sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all....

67. There have been no decisions in the ECJ or CFI since *REMUS* that would give any reason to change this guidance. It seems to me that it is fully consistent with the approach laid down in *BUD*, effectively being a step-by-step version of the process that Lord Walker described in the extract that I have set out at paragraph 19 above. I would not expect a different result to come out of a comparison between a logo and a word mark depending on which guidance was being followed.”

22) I have to determine, in the light of the above authorities, whether the opponent’s use can be deemed use of its marks. It has used the device element contained in the mark below in three different ways. The first two have been with the sponsor’s name and the location e.g “Carling Academy” plus a device of the letter “a” in a circle and a location; “O2 ACADEMY” plus device of the letter “a” in a circle and a location; thirdly, simply the device element of the letter “a” in a circle. Below is an example of the device element in the form actually used.



23) I shall first consider the first two marks. The only difference between them is the sponsor's name so I shall simply deal with one mark and apply the logic to both. Clearly the mark contains the word ACADEMY which is the sole word in trade mark 2049175. However, to my mind the placing of the sponsor's name as the first word has a considerable effect on the way that the mark will be viewed by the average consumer. The word ACADEMY is a well-known word which has a simple and widely known meaning of a training place/college/school or an institution for the advancement of the arts or sciences. There are exhibits which show the two words of 2243180, 2343726 and 2343721. However, the words are in a different order and the marks also contain the words CARLING or O2 and the device element. To my mind the device element of the letter "a" in a circle will put the average consumer in mind of the sign "@". So most consumers would, I believe, view the above marks as simply referring to where the Carling venue is located. The average consumer will be aware that breweries own public houses which often feature live music, it is in no way a stretch to therefore assume that a brewery such as CARLING could own a nightclub. Similarly, I take judicial notice that O2 although a mobile telephone company have distinct links to music, not least as their phones offer applications which allow music to be downloaded and played via the phone speaker or headphones. O2 also have well publicised links to what was originally the Millennium Dome and were widely credited with "saving" the venue and it was renamed the O2 Dome. Consumers are well used to companies diversifying e.g. Virgin which has an airline, trains, music, phones and finances. It is accepted that the first word in a mark assumes greater importance in the mind of the average consumer, combined with the relative lack of distinctiveness of the word "ACADEMY" and the fact that the two words in the order that they are presented form an immediate image of a school or training place owned by Carling/O2, means, in my opinion, that the mark above does not equate to use of the registered marks in a form differing in elements which do not alter the distinctive character. The clear conclusion of the above is that the opponent has not shown use of its trade marks 2049175, 2243180, 2343726 and 2343721.

24) I now turn to consider the trade mark 2253188 which is a device mark. There is no evidence which shows use of this mark. The only evidence is use of the letter "a" in a circle. As I said in the paragraph above, the average consumer will view the device used in the evidence as the sign "@". In my opinion, the mark above does not equate

to use of the registered mark in a form differing in elements which do not alter the distinctive character.

25) Overall, I therefore find that there is no use of any of the above marks in the opponent's evidence and so they will not be considered in the comparison of marks. The comparison of marks and specifications will therefore be restricted to the opponent's trade marks which did not fall within the proof of use requirement, namely 2500577, CTM 7332539, 2487541 and 2343728.

26) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of European Justice (CJEU) 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.

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

28) 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.”

29) To my mind, as the opponent has failed to show use of its marks it cannot claim that it has a significant reputation in any of the marks at paragraph 18 above. The opponent refers to its marks as “a family of ACADEMY marks” and seeks to attach the figures for turnover and its promotional activities to this single word. However, I note that, as shown in paragraph 7 above, the opponent uses the marks “Empire”, “ABC” and “UNDERGROUND”. There is also the issue of the use of sponsor’s names as the first word in the mark e.g. CARLING ACADEMY which I have dealt with in paragraph 23 above. Even if these issues could be resolved, the opponent failed to put the figures it provided into any context as I outlined in paragraph 9 above. The word ACADEMY is a well-known word which has a simple and widely known meaning of a training place/college/school or an institution for the advancement of the arts or sciences. Despite this I regard it as having a reasonable degree of inherent distinctiveness for the goods and services for which it is registered.

30) I must now determine the average consumer for the goods and services of the parties. Both parties have very lengthy specifications which cover vast swathes of goods and services. To my mind the average consumer must be considered to be the general public or businesses. Given the range of goods and services concerned I believe that the level of attention paid will vary enormously.

31) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant’s Trade Mark	Opponent’s Trade Marks
	2500577: ACADEMY
	CTM 7332539: ACADEMY
	2487541: ACADEMY
	2343728: LIVERPOOL ACADEMY

32) The opponent claims that it has a “family” of marks and that because they all share the word “ACADEMY” differing only in that some show a location, the applicant’s mark will be seen as simply an addition to the “family” or economically linked to the opponent. However I note that in the case of *The Infamous Nut Company v Percy Dalton (Holdings) Ltd [2003] RPC 7* , Professor Annand sitting as the Appointed Person said:

“It is impermissible for Section 5(2) (b) collectively to group together several earlier trade marks in the proprietorship of the opponents.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by Section 6). This where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant’s mark must be considered against each of the opponent’s earlier trade marks separately (ENER-CAP trade mark [1999]RPC 362).

In some circumstances it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the opponent (AMOR, Decision No 189/1999 of the Opposition Division, OHIM OJ 2/2000 p235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31.”

33) I take into account the views expressed by the CJEU in C-552/09 *Ferrero SpA v OHIM* (KINDERYOGHURT) where they said:

“90 By the fifth part of the sole ground of appeal, Ferrero submits that the General Court erred in law by not taking proper account of the existence in the present case of a family of trade marks, on the ground that this is irrelevant for the purposes of assessing similarity.

91 In so doing, the General Court misinterpreted the case-law in that, although, in the context of Article 8(1)(b) of Regulation No 40/94, the existence of a family of trade marks increases the likelihood of confusion by leading the consumer to believe that the challenged trade mark is part of that family, that is precisely because of the similarity between the challenged trade mark and the family of marks, or, more specifically, on account of the element common to them (Case C-234/06 P *Il Ponte Finanziara v OHIM* [2007] ECR I-7333, paragraph 63).

92 Ferrero further submits that the very existence of a family of trade marks increases the likelihood that the trade mark of a third party containing the element shared by that family will automatically be perceived by the relevant consumer as similar to that common element.

93 According to Ferrero, that applies fully to the situation where the challenged trade mark contains the word ‘KINDER’, which enjoys a considerable reputation and is compared with a family of 36 trade marks, all of which contain the same word, either alone or in combination with other words.

94 OHIM contends that the fifth part of the sole ground of appeal is both inadmissible and clearly unfounded. First, the challenge to the General Court's finding that Ferrero could not rely on the existence of a 'family' of similar trade marks would involve a new factual assessment, which cannot be made in the context of an appeal. Secondly, OHIM argues that the possible existence of a family of marks is relevant only in the context of Article 8(1)(b) of Regulation No 40/94, in so far as it can create indirect confusion, by leading the public to believe that the later mark is yet another mark in that family. As regards Article 8(5) of Regulation 40/94, however, that argument is not legally sound because confusion itself is not relevant. Likewise, the lack of similarity between, on the one hand, all the marks in the series and, on the other, the challenged sign is enough to rule out definitively the possibility both of a likelihood of confusion and of detriment or unfair advantage.

– Findings of the Court

95 First of all, OHIM's argument relating to the inadmissibility of the fifth part of the sole ground of appeal must be rejected. It is apparent from its arguments that Ferrero is seeking to claim that, in taking the view that the existence of a family of trade marks is not relevant for the purposes of assessing similarity, the General Court failed to have regard to the scope of Article 8(1)(b) of Regulation No 40/94.

96 A part of a plea which is submitted to that effect thus relates to a matter of law and must therefore be declared admissible.

97 As to the substance, it should be borne in mind that it is settled law that the existence of a 'family' or a 'series' of trade marks is an element which must be taken into account for the purposes of assessing the likelihood of confusion. In those circumstances, the likelihood of confusion results from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for and may consider, erroneously, that that trade mark is part of that family or series of marks (*Il Ponte Finanziaria v OHIM*, paragraph 63).

98 However, as is apparent from paragraph 52 above, that element is irrelevant for the purposes of assessing the existence of a similarity between the earlier mark and the challenged mark.

99 Consequently, as is apparent from paragraph 66 above, it is only if there is some similarity between the marks at issue that the General Court must take into account, in the global assessment of a likelihood of confusion or of a link being made between those marks, the existence of a 'family' or 'series' of trade marks."

34) In considering the marks I take into account the following paragraphs of the *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* [C-120/04] case which read:

“[30] However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

[31] In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.”

35) And also Case T-6/01 *Matratzen Concord GmbH v OHIM* where the GC stated:

“A complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.”

36) As the opponent has not shown use of any of its marks it does not have a family of trade marks. To my mind, the applicant’s mark has as its dominant element the word “ACADEMY”. The large device element of the letter “A” would clearly be noticed by the average consumer; however as the letter A is the first letter of the word element this reduces the impact of the device element. Only one of the opponent’s marks consists of more than the word ACADEMY. As the additional element is a geographical location, even though this aspect is first in the mark it would be relegated into less significance by the average consumer. The opponent’s three marks 2500577, 7332539 and 2487541 are all identical and so one comparison can be made for all three. The opponent’s mark is contained within the applicant’s mark with the only additional element being the device of a large letter “A”. The applicant sought to differentiate the marks as it claims that the letter “M” in its mark is stylised. Until I read the applicant’s submissions I had not realised that this was the case. This could have been due to the size of the mark in this decision, but even if the average consumer noticed the stylisation, it is, to my mind, quite slight and unlikely to affect the way that the mark is viewed. The marks are visually reasonably similar; aurally they are effectively identical if not highly similar, as I do not envisage any consumer actually referring to the applicant as “A ACADEMY”. Conceptually they are also identical. Overall, the opponent’s three marks 2500577, CTM 7332539 and 2487541 are highly similar to the mark in suit.

37) Turning to compare the opponent's 2343728 mark with that of the applicant there are more visual differences, and also aural differences. Conceptually they are similar, as the only conceptual difference is the locational element in the opponent's mark. Overall the marks are quite similar.

38) I now turn to consider the specifications of both parties. 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.

39) 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.”

40) The question of complementary goods/services has been considered by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 the GC stated:

“It is true 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 those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraNAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

41) For ease of reference I reproduce below the specifications of both parties. The opponent's specification for its CTM 7332539 encompasses the whole of its specification under 2500577 with the exception of the words in italics under Class 9 as follows "sound and video recordings *and publications in electronic form* supplied on-line". I have therefore used the CTM specification in my deliberations, taking into account the opponent's submissions where it submitted which goods and services it regarded as similar. I have also considered the opponent's specification for its trade marks 2487541 and 2343728. I consider the services in Class 41 of the former and the goods and services in Classes 16 and 43 of the latter mark to be wholly encompassed within the specification of CTM 7332539. Therefore, CTM 7332539 provides the opponent with its strongest case and so I shall only use it for my comparison.

Applicant's Specification	Opponent's specification
<p>Class 16: <u>Paper, printed matter</u>; book binding material; <u>photographs</u>; <u>stationery</u>; printing blocks; <u>printed publications</u>;</p>	<p>Class 16: <u>Paper</u>, cardboard and goods made from these materials; <u>printed matter</u> and <u>printed publications</u>; notepads, books, magazines, brochures and event programmes; posters; flyers; leaflets; prints; <u>photographs</u>; postcards; <u>stationery</u>; pens; tickets for concerts, shows and other events; decalcomanias; all of the aforesaid relating to live music, live music venues and events.</p> <p>The opponent contended that goods in class 16 are complimentary to its Class 41 "entertainment" services.</p>
<p>Class 25: Clothing, footwear, headgear.</p>	<p>The opponent contended that goods in class 25 are complimentary to its Class 41 "entertainment" services with consumers expecting an association with the origin of the goods when provided together or separately it being well established that merchandise is a key part of entertainment services.</p>
<p>Class 35: <u>Advertising</u>; <u>business management</u>; <u>business administration</u>; <u>office functions</u>; <u>organisation, operation and supervision of loyalty and incentive schemes</u>; <u>advertising services provided via the Internet</u>; <u>production of television and radio advertisements</u>; trade fairs; opinion polling; <u>data processing</u>; <u>provision of business information</u>; retail services connected with the sale of Items in class 16, and 25.</p>	<p>Class 35: <u>Advertising</u>; dissemination of advertising matter; advertising by mail order; business management of performing artists; <u>compilation of information into computer databases</u>; organisation of exhibitions for commercial or advertising purposes; publicity; public relations; publication of publicity texts; radio advertising; sales promotion; distribution of samples; television advertising; radio and television commercials; <u>business management</u>; <u>business administration</u>; accounting and <u>office functions</u> in relation to the reservation, issue and sale of tickets; <u>advertising services provided via the Internet</u>; <u>production of television and radio advertisements</u>; <u>provision of business information</u>; hiring disc jockeys; <u>organisation, operation and supervision of customer loyalty schemes</u>; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services</p>

	<p>relating to the foregoing; all of the aforesaid relating to live music, live music venues and events.</p> <p>The opponent contended that services in class 35 are complimentary to its Class 41 “entertainment” services and references the “high profile sponsorship campaign with O2”, claimed to have been shown in its evidence, to back up this contention.</p>
<p>Class 38: <u>Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.</u></p>	<p>Class 38: Streaming of audio and audio-visual material via the Internet; <u>telecommunication services</u>, namely, transmission of podcasts; telecommunications; communications by computer terminals; cellular telephone communication; computer aided transmission of messages and images; <u>television and radio broadcasting</u>; electronic bulletin board services (telecommunications services); <u>electronic mail</u>; providing telecommunications connections to a global computer network; providing user access to a global computer network (service providers); providing access to computer databases; <u>chat room services; portal services; providing user access to the Internet</u>; information relating to all the foregoing provided on-line from a computer database or the Internet; consultancy, advisory and information services relating to the foregoing.</p> <p>The opponent also seeks to rely upon the whole of its Class 41 services.</p>
<p>Class 41: Education; providing of training; <u>entertainment</u>; sporting and cultural activities.</p>	<p>Class 41: <u>Entertainment</u>; organisation of live music competitions; provision of recreational and entertainment facilities; live band performances; club entertainment services; organising nightclub events; organising, arranging, managing and staging musical events, shows, concerts, festivals, gigs and live band performances; production of television, film, radio and music programmes and recordings; management of theatres and music venues; provision of theatre facilities; theatre services; booking agencies relating to all of the foregoing; ticket agency services relating to all of the foregoing provided on-line, by telephone, mobile telephone, and through ticket outlets; entertainment services, namely, providing podcasts relating to live music and live music venues; production of radio and television programmes; publication of texts (other than publicity texts) about live music and live music venues; electronic games services provided by means of the Internet; the provision of on-line electronic publications relating to live music and live music venues and digital music (not downloadable) from the Internet;</p>

	<p>recording of music onto a variety of media; production of sound recordings; production of musical recordings; production of audio recordings; hiring of audio and/or visual equipment; composition of music; video taping; digital music (not downloadable) supplied from mp3 websites on the Internet; providing digital music (not downloadable) from mp3 Internet websites; digital music (not downloadable) provided from the Internet; ticket reservation and ticket agency services for concerts and other events; the provision of on-line electronic publications and digital music (not downloadable) from the Internet in the form of podcasts relating to live music and live music venues; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing; all of the aforesaid relating to live music, live music venues and events.</p> <p>Class 42: Creating and maintaining websites for others; compilation of websites; design of computer databases; design, drawing and commissioned writing for the compilation of websites; computer software design and development; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.</p> <p>Class 43: Restaurant, cafe, fast food catering, snack-bar, pub and bar services; reservation services for temporary accommodation; hiring of bar, catering and restaurant equipment and facilities; information relating to all the foregoing provided by telephone, mobile telephone, on-line from a computer database or via the Internet; consultancy, advisory and information services relating to the foregoing.</p>
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**Underlining referred to at paragraph 44*

42) The opponent in its submissions has not provided any explanation as to why the goods and services set out above are similar. The applicant in its submissions states:

“16. Again, since one logo is not in use we do not see how AMG [the opponent] will be damaged in any way. Our goods and services, in the main relate to education and training purposes.

Merchandise is key part [sic] of any educational services and since The Academy Music Group logo has currently changed there will be no similarity in this area. The

other opponent [Academy Clothing] was clearly using the Academy logo for clothes and garments.

Advertising and class 35 services in the main will relate to education and training services. Most education organisations organise events and entertainment services and currently there are many Performing Art academies that use the word Academy in the promotion of events.

Class 35 – These services will relate to our current and prospective members/learners and it would be clear that we do not have any affiliation to the Academy Music Group (getting into the territory of disclaimers would be a sad state of affairs as a collaboration must be to our mutual advantages).

Class 41- all of the activities mentioned are currently been [sic] produced by many organisations that are education providers all throughout the country. This has in no way had any effect on the business of Academy Music Group.”

43) Unfortunately for the applicant these contentions are misguided. If the applicant wished to restrict its specification to education and training then it could easily have done so. Without such a restriction the services incorporate all services, including nightclub and musical services.

44) In the above specifications at paragraph 41 I have underlined the parts of the applicant’s and opponent’s specification where they are identical in terms of wording. An overall proviso in my comparison is that whilst the opponent has restrictions in its specification there is no restriction in the applicant’s specification. Therefore, the applicant’s goods and services would include the restricted goods and services of the opponent. I make the following findings regarding the applicant’s specification:

- In Class 16 “Paper, printed matter; photographs; stationery; printed publications.” are identical to the opponent’s goods in Class 16. The remaining goods “book binding material; printing blocks;” are highly similar to “printed matter and printed publications”.
- In Class 25: “Clothing, footwear, headgear.” are to my mind not similar to any of the opponent’s goods or services. The opponent contended these goods are complimentary to its Class 41 “entertainment” services with consumers expecting an association with the origin of the goods when provided together or separately it being well established that merchandise is a key part of entertainment services. I do not accept this contention. To my mind clothing and entertainment services do not have such 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 those goods lies with the same undertaking.
- In Class 35: “Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive

schemes; production of television and radio advertisements; data processing; provision of business information; advertising services provided via the Internet” are identical to the opponent’s specification. The applicant’s “trade fairs” are highly similar if not identical to the opponent’s “organisation of exhibitions for commercial or advertising purposes”. In accordance with the findings in *Oakley Inc. v Ohim T-116/06* “retail services connected with the sale of items in class 16” must be similar to the opponent’s class 16 goods. However, the applicant’s specification “opinion polling; retail services connected with the sale of items in class 25” does not appear to me to be similar in any way to the opponent’s specification in this class. To my mind these services are not complementary to the opponent’s Class 41 “entertainment” services as it claimed, and the opponent has not provided any reasons why I should find in its favour.

- In Class 38: The whole of the applicant’s specification is encompassed within the opponent’s specification and must be regarded as identical.
- In Class 41: “entertainment” is clearly identical to the opponent’s specification. To my mind “cultural activities” is identical to “provision of recreational and entertainment facilities” and “organising, arranging, managing and staging musical events, shows, concerts, festivals, gigs and live band performances”. In my opinion the applicant’s services “Education; providing of training; sporting activities” are dissimilar to any of the opponent’s Class 41, 42 or 43 services.

45) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services and vice versa. I also factor in that the opponent has a number of “ACADEMY” trade marks. To my mind, whilst there are minor differences in the marks, they are such that when used on identical or similar goods and services there is a likelihood of consumers being confused into believing that the goods and services provided by the applicant are those of the opponent or provided by some undertaking linked to them.

46) The opposition under Section 5(2) (b) therefore succeeds in relation to the following goods and services:

In Class 16: Paper, printed matter; book binding material; photographs; stationery; printing blocks; printed publications.

In Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; trade fairs; data processing; provision of business information; retail services connected with the sale of items in class 16.

In Class 38: Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.

In Class 41: Entertainment; cultural activities.

47) However, despite the similarities in the marks the opposition under Section 5(2)(b) fails in relation to the following:

In Class 25: Clothing, footwear, headgear.

In Class 35: Opinion polling; retail services connected with the sale of Items in class 25.

In Class 41: Education; providing of training; sporting activities.

48) I shall now turn to consider the ground of opposition under Section 5(3) of the Act which states:

“(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 3 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.

49) The relevant principles can be gleaned from the case law of the CJEU. In particular, cases *General Motors Corp v Yplon SA* [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 and *L’Oreal SA and others v Bellure NV and others* - Case C-487/07. These cases show that:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel*, paragraph 51.

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the

public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; *Intel*, paragraph 57.

(f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68: whether this is the case must also be assessed globally, taking account of all the relevant factors; *Intel*, paragraph 79.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel*, paragraphs 76 and 77.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal*, paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; *L'Oreal*, paragraph 41.

50) The onus is upon an opponent to prove that its earlier trade marks enjoy a reputation and it needs to furnish the evidence to support this claim. In the instant case the opponent filed evidence which it contended showed that it had reputation in the term "ACADEMY" for an array of goods and services but most notably for entertainment

venues. At paragraphs 23 & 24 above I set out my issues with the evidence provided and came to the conclusion that the opponent had not shown reputation in any of its marks for any goods or services. Thus the opponent fails at the first hurdle. **The ground of opposition based upon Section 5(3) fails.**

51) However, in case I am wrong regarding the matter of reputation, the opponent must also show how the earlier trade marks would be affected by the registration of the later trade mark. The opponent contends that its mark is highly distinctive and that use of the mark in suit could take advantage of, or be detrimental to, the distinctive character of the ACADEMY brand's uniqueness in relation to entertainment and music shows. 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)."

52) 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."

53) Earlier in this decision I determined that certain goods and services of the two parties were identical or very similar, but that some were dissimilar. I also found that the word ACADEMY has a reasonable degree of inherent distinctiveness for the goods and services for which the opponent's marks are registered. The opponent's strongest case under this section lies in its CTM 7332539 and earlier I found that when compared to the mark in suit they are highly similar.

54) Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there is an advantage for the applicant to derive when it uses the mark in suit on goods and services which are similar or identical to those for which the opponent has a reputation. To my mind, this advantage would only accrue when the mark in suit is used upon “entertainment; cultural activities” in Class 41. None of the other goods and services can be regarded as being in any way in close proximity to the opponent’s services in which it has reputation.

55) As far as detriment is concerned it is suggested that this would subsist in a reduction in the distinctiveness of the opponent’s marks and presumably lead to a loss of sales. I do not consider that registration of the applicant’s mark could have an impact in this respect other than in regard to its Class 41 registration for “entertainment; cultural activities”. The opposition under Section 5(3) therefore succeeds in relation to these services but fails in relation to the following goods and services:

In Class 16: Paper, printed matter; book binding material; photographs; stationery; printing blocks; printed publications.

In Class 25: Clothing, footwear, headgear.

In Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale of Items in class 16, and 25.

In Class 38: Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.

In Class 41: Education; providing of training; sporting activities.

56) I now turn to consider the ground of opposition under Section 5(4)(a) which reads:

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

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

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

57) In deciding whether the mark in question offend 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.

58) Earlier in this decision I found that the opponent did not have reputation in the word ACADEMY as it has not used this mark, other than as part of marks in which the word ACADEMY is not a distinct element. To my mind, the opponent has not shown that any goodwill it has in its business will be associated with the word ACADEMY, therefore the opponent fails to get past the first very low hurdle of having goodwill in its marks. **The opposition under Section 5(4)(a) therefore fails.**

59) However, in case I am wrong with regard to this I shall consider the matter on the basis that the opponent does indeed have goodwill in the word ACADEMY in respect of entertainment and music shows.

60) 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.”

61) In its evidence the opponent claims that its predecessors in business first used the ACADEMY mark in 1985 however no evidence of the acquisition of goodwill was provided. The applicant stated that it had been in business for eighteen years as of 2012, but the applicant also stated that it traded as “THE TALENT ACADEMY” but provided no evidence to support even this contention. I shall therefore regard the application date, 14 October 2010 as the relevant date.

62) It is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade. The point can be supported by reference to the following passage from Millet L.J.’s judgment in *Harrods Ltd v Harroddian School Ltd* [1996] RPC 697:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by Wynn-Parry J. in *McCulloch v May* [1948] 65 RPC 58 when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* (1902) 2 Ch. 282 (The Times Newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing-off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing-off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

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

63) Also:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

64) And:

“Passing off is a wrongful invasion of a right of property vested in the plaintiff, but the property which is protected in an action for passing off is not the plaintiff’s proprietary right in the name or get-up which the defendant has misappropriated but the goodwill and reputation of the business which is likely to be harmed by the defendant’s misrepresentations.”

65) Taking the above into consideration I do not believe that the average consumer will be deceived into believing that the opponent has diversified into any of the goods and services which the applicant seeks to register except for the following in Class 41 “entertainment; cultural activities”. The opposition under Section 5(4)(a) of the Act succeeds in relation to these services but fails in respect of all other goods and services must fail.

CONCLUSION

66) The opponent is successful under Section 5(2)(b) in relation to the following goods and services:

In Class 16: Paper, printed matter; book binding material; photographs; stationery; printing blocks; printed publications.

In Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; trade fairs; data processing; provision of business information; retail services connected with the sale of Items in class 16.

In Class 38: Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.

In Class 41: Entertainment; cultural activities.

67) However, the opposition under Section 5(2)(b) fails in relation to the following:

In Class 25: Clothing, footwear, headgear.

In Class 35: opinion polling; retail services connected with the sale of Items in class 25.

In Class 41: Education; providing of training; sporting activities.

68) The grounds of opposition under Section 5(3) and 5(4) failed in full.

COSTS

69) As the opponent has been partially successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£100
Submissions	£100
Expenses	£200
TOTAL	£600

70) I order Talent Academy to pay Academy Music Group Limited the sum of £600. 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 22nd day of October 2012

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