

O-136-15

TRADE MARKS ACT 1994
IN THE MATTER OF
REGISTRATION NO 3012714
IN THE NAME OF FASHION TELEVISION MEDIA, S.De R.L. De C.V.
IN RESPECT OF THE TRADE MARK



IN CLASS 38
AND
THE APPLICATION FOR CANCELLATION THERETO
(UNDER NO 500415) BY FASHIONTV.COM GMBH

BACKGROUND

1) Trade mark Registration No. 3012714, shown on the cover page of this decision, stands registered in the name of Fashion Television Media, S.De R.L. De C.V. ('the proprietor'). It was applied for on 04 July 2013 and completed its registration procedure on 13 December 2013. It is registered in respect of the following services:

Class 38: Broadcasting (cable television-); Broadcasting (television-); Wireless transmission and broadcasting of television programmes.

2) On 22 May 2014, fashiontv.com GmbH ('the applicant') filed an application to cancel the trade mark registration, by declaring it invalid under the provisions of sections 47(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In its statement of grounds, the applicant claims that it has been using the sign FASHION TV throughout the UK since 2001 in relation to television broadcasting services and that use of the proprietor's mark in the UK is liable to be prevented by virtue of the law of passing off.

4) The proprietor filed a counterstatement in which it put the applicant to strict proof that it had a right of passing off at the material time.

5) During the evidential rounds, the applicant filed evidence and the proprietor filed written submissions only. Neither party requested to be heard; nor did they file submissions in lieu. I now make this decision after carefully considering all of the papers before me.

EVIDENCE

6) The applicant's evidence comes from Gabriel Lisowski, Chief Executive Officer of fashiontv.com GmbH. The points emerging from Mr Lisowski's evidence are:

- The applicant is the global multimedia network leader in fashion and lifestyle content, broadcasting to over 60 satellites, 530 TV platforms, mobile IPTV and with over 20 million monthly views on YouTube.
- FASHION TV broadcasts in 193 countries, to over 400 million households and 7 million public locations across five continents.
- FASHION TV is the only 24 hour fashion, beauty and lifestyle television station worldwide.
- FASHION TV has been used in the UK since 2001 through British Telecommunications Public Ltd, Sky Broadcasting Ltd and is still being used through operators such as INAA Ltd (organizing the upcoming Fashion Party in Glasgow), Everest Marketing UK Ltd (operating FASHION TV branded retail stores in England) and distribution operators such as Jet Virtual.
- FASHION TV has been registered as a trade mark in various countries throughout the world (but not in the UK). **Exhibit 1** consists of a list of these registrations and **Exhibit 2** consists of registration certificates.
- **Exhibit 3** consists of, what Mr Lisowski states is, samples of "advertising and promotional material of products bearing the trademark". The exhibit shows 6 similar screen snap-shots from www.youtube.com ('YouTube') (printed from

the website in May 2014). One of these snap-shots is shown below (the words 'Fashion TV' can be seen at the end of the video title, appearing just below the main picture):

<http://www.youtube.com/watch?v=-hEv8Qddrpw>



The video shown above states it was published on 2 May 2013. The five other videos appear to have been published on YouTube on 09 April 2010, 30 June 2010, 29 November 2012, 28 April 2013 and 15 June 2013. The latter video states that Fashion TV has a total of 33,669 videos on YouTube. The titles of the videos indicate that they all relate to various fashion events/launches in London or UK based competitions such as “Miss Top Model UK”.

- **Exhibit 4** consists of, what Mr Lisowski states is, information about “market research studies regarding the trademark in the UK”. He provides no further narrative in relation to the content of the exhibit and what it is intended to show. The exhibit consists of a bundle of 145 pages, the vast majority of which appears to be in the form of a promotional power point presentation entitled “FASHIONTV CHANNEL PRESENTATION”, detailing the applicant’s history, viewing figures in countries across the world, the number of ‘likes’ on Facebook in various countries, lists of Fashion TV operators in various countries, demographic statistics (e.g. % men viewers v women viewers), advertising/sponsorship opportunities (e.g. through Fashion TV’s facebook page, YouTube videos, Goggle Plus and Twitter etc). Much of the information relates to use in countries other than the UK. In terms of information which makes specific mention of the UK, I note the following:
 - Pages 1-3 appear to show viewing figures for FASHION TV in the UK on www.youtube.com in Sept - Dec 2009 (361,302 views), Jan – Dec 2010 (2,680,593 views), Jan – Dec 2011 (6, 606,847 views), Jan – Dec 2012 (9,271,499 views), Jan – Dec 2013 (7,152,162 views) and Jan – May 2014 (853,717 views).
 - Page 15 states, under the heading ‘**United Kingdom**’, “British viewers were able to watch the channel via Sky until November 18, 2004. The

channel had been carrying trailers warning that it would soon be available in the UK as a standalone subscription channel. The channel returned to its original Sky channel in April 2005 as part of Sky's Basic subscription package, apparently having dropped its original plans. Beginning in the autumn of 2005 the channel added several minutes of British commercials per hour on its UK service, apparently sold through Sky, in addition to its two international ad breaks per hour. The channel was FTA on Sky's EPG on channel number 261, in the Lifestyle and Culture block, until it was removed on 2 July 2010."

- Page 35 which is entitled "YouTube Demographics of Fashion TV, July 2012 – July 2013" indicates that Fashion TV had 3,450,120 video views on www.youtube.com in the UK in that period.
- Page 37 (and page 82 which is a duplicate of the same page) indicates that FashionTV's facebook page has had 33,915 'likes' from UK users.
- Page 136 (dated 20/12/3013) shows the following table and information:

United Kingdom

FashionTV channel distribution				
IPTV	DTH/Cable	Total	Market Size	Market share
47.213	8.805.053	8.852.266	24.100.000	36,73%

226.586 Views on YouTube in July 2013
 73.4% Male 26.6% Female in July 2013
 3.450.120 YouTube views (July 2012-July 2013)

That completes my summary of the applicant's evidence to the extent that I consider it necessary.

DECISION

7) The relevant provisions of the Act provide:

"47(2) The registration of a trade mark may be declared invalid on the ground—

(a) ...

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of the earlier trade mark or other earlier right has consented to the registration."

And:

"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

(b)...

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.”

8) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in 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. It is (with footnotes omitted) as follows:

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

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

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

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

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

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

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

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

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

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

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

10) In *SWORDERS Trade Mark* (BL O-212-06) Mr Allan James summarised the relevant date in relation to a claim to passing off as follows:

"Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made."

11) In the present case, the proprietor makes no claim to use of its mark prior to the date of application for registration. Accordingly, the relevant date at which the matter be assessed is that date i.e. 04 July 2013.

Goodwill

12) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) the court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates.”

13) In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

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

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

14) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

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

15) To qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature.¹ However, being a small player does not prevent the law of passing-off from being relied upon.² Further, it is clear that customers in the UK are required.³

16) At this point, I remind myself of the nature of the applicant's claim which is that it has used the mark FASHION TV throughout the UK, since 2001, in relation to television broadcasting services.

17) The evidence filed by the applicant is not well-marshalled. It has been assembled in an unfocused manner and there is very little supporting explanatory narrative in the witness statement. Unsurprisingly, the proprietor makes a number of, what are in my view, very valid criticisms of it. I agree with the proprietor that much of the evidence appears to relate to countries other than the UK, to goods/services other than television broadcasting or show use of a mark not relied upon in these proceedings (all such evidence is, of course, irrelevant and therefore has not formed part of my earlier evidence summary). I also agree with the proprietor that the provenance of a number of the documents in exhibit 4 is not made clear (although they appear to consist either of print outs from the website Wikipedia or of internal power-point documents containing information about the applicant). In this connection the proprietor submits that "the absence of any authoritative sources for the exhibits undermines the veracity and credibility of the evidence". Whilst I note this criticism, I nevertheless bear in mind that the documentation in the exhibits has been attached to a sworn statement provided by Mr Lisowski, who is the CEO of the applicant. As an individual in that position, Mr Lisowski is clearly in an appropriate position to attest to the truth of the information he has exhibited (whether or not it has been taken from the Wikipedia website or, indeed, elsewhere). I therefore see no reason to doubt the accuracy of the information provided about the applicant in those documents merely because their source is unclear (although, that is not to say that I will conduct an uncritical assessment of it).

18) Bearing in mind all of the above, and whilst much of the evidence does not assist the applicant, I am satisfied that the following relevant points can be gleaned from Mr Lisowski's evidence:

- The applicant's television channel Fashion TV was broadcast in the UK through Sky's basic subscription package between 2001 and November 2004 and again between Autumn 2005 and July 2010 on channel 261 in the Lifestyle and Culture block.
- Subsequently, the applicant's television channel Fashion TV has had a presence on the website YouTube since 2010 and has attracted the following viewing figures from the UK: Jan – Dec 2010 (2,680,593), Jan – Dec 2011(6, 606,847), Jan – Dec 2012 (9,271,499), Jan – Dec 2013 (7,152,162 views) (I bear in mind that not all of the latter figure falls within the relevant period).

¹ *Hart v Relentless Records* [2002] EWHC 1984

² See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49

³ *Hotel Cipriani SRL and Others v Cipriani (Grosvenor Street) Limited and Others*, 2010 EWCA Civ 110

- The screenshots from YouTube, bearing a range of dates from 2010 to June 2013, clearly show that the mark 'Fashion TV' has been used by the applicant in relation to content relating to various fashion events/launches in London or competitions based in the UK such as 'Miss Top Model UK'.
- 'Fashion TV' had over 33,669 videos on YouTube as of 15 June 2013.
- The applicant had a total of 8,805,053 UK viewers in 2013 through DTH/Cable and IPTV combined (I understand IPTV to be 'Internet Protocol Television'). Whilst it is not clear what proportion of that figure relates to prior to the relevant date in 2013 (i.e. 03 July 2013), it nevertheless has some relevance which I will bear in mind.

19) As regards the final bullet point above, I am mindful that the total number of UK viewers provided appears to be extremely high (equating to about 13-14% of the whole of the UK population). Given that the rest of the evidence illustrates that the applicant operates outside the mainstream broadcasting platforms, and in respect of a narrow field (i.e. fashion), in the absence of further corroborative evidence, I am somewhat sceptical of this particular figure. Nevertheless, when considering all of the above factors collectively, the picture that emerges is of a channel having been broadcast in the UK since 2001 (firstly through Sky and then through YouTube) under the name Fashion TV. All of the screenshots showing examples of the channel in use on YouTube are in the English language and appear to relate to various fashion related events, competitions or launches in the UK suggesting that they are targeted primarily at UK consumers. Further, although there are no viewing figures provided for the time the channel was broadcast on Sky from 2001 to 2010, the UK viewing figures on YouTube from 2010 to 2013 appear to me to have been consistently significant. Bearing all of this in mind, I come to the view that, whilst the evidence is far from compelling, when considered as a whole it is sufficient to satisfy me that the applicant had, on the balance of probabilities, the requisite goodwill in the UK, at the relevant date, attached to its business in the field of television broadcasting services with which the sign 'Fashion TV' was associated.

Misrepresentation and damage

20) The test for misrepresentation was addressed by Morritt L.J. in *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

"is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

Later in the same judgment he stated:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

In terms of proof, he went on to say:

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

He also identified who it is that needs to be deceived:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

21) In terms of the requirements for damage in passing off cases, in *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. stated:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

22) In the present case, the proprietor submits that “where a sign is descriptive, consumers are less likely to make assumptions as to origin. It follows that the use is less likely to form a misrepresentation...” In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

Whilst ‘Fashion TV’ is clearly not the most inventive of signs, I have already found that the evidence before me establishes that it was distinctive of the applicant's business in television broadcast services at the relevant date in the UK. The proprietor's mark, although containing a line drawing of a model in place of the letter ‘a’, is also likely to be instantly perceived and read through as ‘Fashion TV’; it is, overwhelmingly, a ‘Fashion TV’ mark. The respective marks are very similar; there are simply not enough differences between them, in my view, and in the light of the identity of the respective services, to avert confusion. I find that it is inevitable that there will be misrepresentation and that damage will follow.

The ground under section 5(4)(a) of the Act succeeds. The trade mark registration is invalid and will be cancelled.

COSTS

23) As the applicant has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice 4/2007 as a guide, I award costs to the applicant on the following basis:

Preparing the notice of cancellation and considering the counterstatement £300

Official fee	£200
Preparing and filing evidence	£500
Total:	£1000

24) I order Fashion Television Media, S.De R.L. De C.V. to pay fashiontv.com GmbH the sum of **£1000**. This sum is 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 27th day of March 2015

**Beverley Hedley
For the Registrar,
the Comptroller-General**