

**O-082-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3116730  
BY LONDON ENTREPRENEURS NETWORK LIMITED TO REGISTER THE  
TRADE MARK**



**Dragons Investment Show**

**IN CLASSES 35, 36, 38, 41 AND 45**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 405491  
BY CPT HOLDINGS INC.**

## Background and pleadings

1) London Entrepreneurs Network Limited (“the applicant”) applied to register the following mark in the UK on 7 July 2015:



2) It was accepted and published in the Trade Marks Journal on 21 August 2015 in respect of the following list of services:

**Class 35:** *Business management; business development; consultancy on business management and business development; evaluation of business ideas, business plans, commercial enterprises; business appraisals; supplying, maintaining data bases on businesses, marketing and research; provision of commercial information; creation business plans; assisting others with the creation and development of business plans and presentations of business plans; analysis and research of business and services available to new enterprises and business ventures; services of introducing business to business; provision of information regarding all the aforesaid; Acquisition and merger consultation; Acquisition (business-) searches; Acquisition of business information relating to company activities; Acquisition of commercial information; Acquisitions (Advice relating to -); Acquisitions (business-) consulting services; Administration (Commercial -) of the licensing of the goods and services of others; Administration of business affairs; Administration of businesses; Administration of the business affairs of franchises; Administration of the business affairs of retail stores; Administration relating to business planning; Administration relating to marketing; Administration relating to sales methods; Advertising services*

*relating to financial investment; Advice in the field of business management and marketing; Assistance in franchised commercial business management; Assistance in management of business activities; Business advice and information; Business appraisals and evaluations in business matters; Business management planning; Business management supervision; Business merger consultation; Business organization advice; Business planning; Commercial assistance in business management; Commercial business management; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise; Information in business matters; Information or enquiries on business and marketing; Information services relating to business matters; Advertising and business services; Arranging and conducting of exhibitions for business purposes; Arranging business introductions; Arranging of business introductions; Business administration services; Business advice; Business advisory and consultancy services; Business advisory and information services; Business advisory services; Business advisory services relating to franchising; Business analysis; Business and management consultancy services; Business and market research; Business appraisal; Business appraisal services; Business consultancy; Business consultancy and advisory services; Business consultancy services; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise; Management of a retail enterprise for others; Business management and enterprise organization consultancy; Business acquisition and merger consultation; Business administration consultancy; Business advice and information; Commercial assistance in business management; Commercial business management; Expert evaluations and reports relating to business matters; Organizing of business competitions; Providing information about commercial business and commercial information via the global computer network; Business administration services; Business advice; Providing business information in the field of social media; Providing marketing consulting in the field of social media.*

**Class 36:** *Investment by electronic means; Capital investment brokerage; Capital investment consultation; Investment advisory services; Investment*

*analysis; Investment clubs; Investment consultation; Investment fund services; Investment information; Investment management services; Investment of funds for others; Investment trusteeship and advisory services; Investment trusteeship services; Venture capital and project capital investment services; Capital investment; Investment services; Investment of funds; Acquisition for financial investment; Administration of capital investment services; Administration of fund investment; Administration of investment funds; Advisory services relating to financial investment; Advisory services relating to investment finance; Capital fund investment; Capital investment advisory services; Consultancy services relating to investment; Consultations relating to investment; Industrial investment; Investment; Investment (capital-); Investment advice; Investment asset management; Investment consultancy; Investment management; Equity capital investment; Management of a capital investment fund; Arranging investments, in particular capital investments, financing services and insurance; Capital investment consultation; Private placement and venture capital investment services; Providing working capital; Venture capital and project capital investment services; Venture capital and venture capital management services; Venture capital financing; Venture capital funding services to emerging and start-up companies; Capital investment; Venture capital services; Administration of capital investment services; Capital (raising of -); Capital fund investment; Capital fund management; Capital investment advisory services; Investment of capital (services for-); Provision of investment capital; Raising of capital; Venture capital (services for the finding of-); Venture capital (services for the provision of-); Venture capital fund management; Venture capital management; Capital investment consulting; Capital investments; Investment (Capital -).*

**Class 38:** *Broadcast of information by means of television; Broadcast of television programmes; Broadcasting of financial information by television.*

**Class 41:** *Entertainment services; preparation of entertainment programs for broadcasting; television program production services; production, presentation, distribution and syndication of entertainment programs,*

*television programs, radio programs, films; production, presentation and syndication of shows, theatrical entertainment, stage entertainment, musical entertainment and live entertainment; education, recreation, instruction, tuition and training services; publishing services (including electronic publishing services); organisation, production and presentation of shows, competitions, contests, games, concerts and events; rental of sound and video recordings; provision of information and advisory services relating to any of the aforesaid services.*

**Class 45:** *On-line social networking services.*

3) CPT Holdings Inc. (“the opponent”) opposes the mark on the basis of section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The section 5(2)(b) and section 5(3) ground are on the basis of two earlier marks, the relevant details of which are:

Mark and relevant dates	List of goods and services
<p>European Union Trade Mark (EUTM) 13863634</p> <p>DRAGONS’ DEN</p> <p>Filing date: 23 March 2015</p> <p>Date of entry in the register: 12 August 2015</p>	<p><b>Class 9:</b> <i>computer software; pre-recorded dvds featuring reality entertainment programming; pre-recorded cds featuring reality entertainment programming; downloadable audio and video recordings featuring reality entertainment programming; downloadable television shows and video recordings featuring reality entertainment programming; downloadable ring tones, graphics, computer desktop wallpaper, games and music via a global computer network and wireless devices; computer screen saver software; computer game and video game software; mouse pads; decorative magnets; downloadable mobile software applications for mobile communication devices for use in distribution of digital video, video files, video games, and multimedia content.</i></p> <p><b>Class 28:</b> <i>toys, games and playthings, namely, toy action figures and accessories, toy action play sets (sold as a unit for creative play activities), toy environments for use with action figures; plush dolls, soft sculpture dolls, bendable figurines, puppets, board games, puzzles, rack toys, toy watches, toy</i></p>

	<p><i>calculators, role playing games, electronic hand-held games; christmas tree ornaments.</i></p> <p><b>Class 41:</b> <i>entertainment services in the nature of a television series streamed, downloaded or otherwise exhibited on wired or wireless devices; providing on-line computer games and information in the field of television.</i></p>
<p>2390934</p> <p>DRAGONS' DEN</p> <p>Filing date: 3 May 2005</p> <p>Registration date: 11 November 2005</p>	<p><b>Use is claimed in respect of the following goods and services:</b></p> <p><b>Class 9:</b> <i>Audio, video, still and moving images and data recordings in compressed and uncompressed form; computer software, including software for use in downloading audio, video, still and moving images and data in compressed and uncompressed form from a computer or communication network ...; downloadable electronic publications; ...</i></p> <p><b>Class 16:</b> <i>...; printed publications; magazines; books; pamphlets; printed guides; ...</i></p> <p><b>Class 41:</b> <i>Provision of entertainment, education, recreation, ... both interactive and non-interactive; production, presentation, distribution and syndication of audio, video, still and moving images and data whether in compressed or uncompressed form and whether downloadable or non downloadable; ...; production of educational and instructional materials; publishing services (including electronic publishing services); ...; organisation, production and presentation of shows, competitions, contests, ... and events; ...; provision of information and advisory services relating to any of the aforesaid services.</i></p>

4) In respect of the section 5(2)(b) grounds, the opponent claims that it's DRAGONS' DEN mark is well-known particularly in respect of the BBC television show of that name where investors (popularly known as "the Dragons") receive pitches from entrepreneurs seeking investments to further their businesses. The opponent submits that, as this can be described as a "Dragons' Investment Show", use of this descriptive designation by the applicant for identical and similar services would inevitably give rise to confusion.

5) In respect of the section 5(3) grounds, the opponent relies upon the reputation associated with the BBC television programme and claims that use of the applicant's mark:

- (i) will lead to confusion in the same way as stated in respect of the grounds based upon section 5(2)(b);
- (ii) would exploit the distinctive character and repute of the earlier mark by effectively using the opponent's mark as a springboard to generate additional consumer interest leading to advantage in that the applicant would not need to make such a substantial investment in promoting itself. It is claimed that such an advantage would be unfair because the reward for the opponent's efforts to promote its earlier mark should accrue to it and not the applicant;
- (iii) would result in the opponent having no quality control over the goods and services provided under the applicant's mark and consequently leading to a risk of damage to the repute of the opponent's mark;
- (iv) would risk devaluing and diluting the opponent's mark. It claims that the public would potentially be diverted or misled into taking up the applicant's services in the belief that there is an economic connection with the opponent. It further claims that if, and when, the public realise that there is no economic connection, then the distinctiveness of the earlier mark will have become blurred.

6) In respect of the section 5(4)(a) grounds, the opponent relies upon unregistered rights in the sign DRAGONS' DEN and a claimed first use in the UK of January 2005 in respect of a television series that is broadcast, provided online and also on recorded media. The opponent claims that the sign has been used in respect of board games, printed and online publications, including books. There is a claim to a significant goodwill in the UK and that use of the applicant's mark would result in misrepresentation because the mark DRAGONS INVESTMENT SHOW directly describes the nature of the opponent's TV show. For the reasons set out in respect to the grounds based upon section 5(3), the opponent will suffer economic and reputational damage.

7) The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier UK mark.

8) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

9) The opponent was represented by Page Hargrave and the applicant was unrepresented.

### **Opponent's Evidence**

10) This takes the form of a witness statement by Gregory K. Boone, Executive Vice President and Assistant Secretary of the opponent. Mr Boone states that the mark DRAGONS' DEN was first used in the UK in 2005 by the BBC under a licence agreement from the then proprietor of the mark, Sony Pictures Television UK Rights Limited. Mr Boone explains that this use was in respect of a television show "where budding entrepreneurs pitch for investment from wealthy "Dragons" being venture capitalists willing to make an investment in return for equity".

11) Mr Boone states that the show has now ran for 13 series from July 2005 to February 2016 and regularly achieves high ratings and attracts several million viewers weekly. At Exhibit A is a copy of the *Wikipedia* entry for DRAGONS' DEN and provides detailed information including the number of viewers per episode. These are reasonably consistent throughout all 13 series being in the range of 2.1 million to 4.3 million viewers. The only exception was the 2012 series where viewing figures dropped under 2 million on at least seven occasions.

12) Mr Boone details the ownership history of the two earlier marks, but it is sufficient that I record here that the current proprietor obtained the earlier EUTM in September 2015 and the earlier UK mark on 2 November 2015. Mr Boone states that the associated goodwill was also transferred with the UK mark (a copy of the assignment



was included with the Notice of Opposition). The opponent was, therefore, the proprietor of both marks when it brought the opposition proceedings on 20 November 2015.

13) Mr Boone provides the following in support of the use made of, and reputation in the earlier mark in respect of the television series and associated website, *YouTube*, *Facebook* and *Twitter* sites:

- At Exhibit B are undated example web pages (but carrying a 2016 copyright notice). These are taken from the BBC website but exclusively relate to the DRAGONS' DEN TV show;
- In the same exhibit are:
  - pages from *YouTube* relating to short video extracts from the television show. The particular video shown was uploaded on 23 December 2010;
  - copies of pages from the "BBC Dragons' Den" *Twitter* account. They are undated, but there is an indication that the user "[j]oined April 2010". The page has 167k followers;
  - pages from the "BBC Dragons' Den" *Facebook* page. Again, these are undated. The first page shows that the page has received 9330 "likes".
- At Exhibit C is a list of results obtained from an Internet search using the *Google* search engine. These show references to the DRAGONS' DEN television series on the websites of publications such as the *Telegraph*, *The Times*, *The Sun* and *The Guardian* newspapers. Some are dated and some are not. Of those that are, they cover the date range 2007 to 2016 with approximately half dated before the filing date of the application;
- At Exhibit D are further Internet pages referring to the DRAGONS' DEN television series and include extracts from the websites of the *RadioTimes* (providing links to episode guides from at least Series 7 to Series 13 and another providing information regarding Series 12, Episode 12), *Television Heaven* (a 2014 review of the history of the show), *UK Game Shows.com* (providing a synopsis of the show), the website *dragonsdeninvestors.com* (it is not clear if this is the opponent's website), the website of *Kent Invicta*

*Chamber of Commerce*, dated 4 August 2015, and the website of one of the “Dragons”, Deborah Meaden and states that “[f]ilming for series 13 will start in 2015” thus appearing to date it to 2014.

- Exhibit E consists of extracts from various online blogs discussing the show including the UKIPO’s own blog that began in 2011.

14) Mr Boone also provides evidence of product merchandising in association with the show. Whilst he states that having only recently acquired the earlier marks, the opponent does not have direct access to all the prior records but he understands that the BBC had at least three sub-licensees authorised to use the mark for associated products. Mr Boone states that these included books, board games, DVD/videos, an online educational programme and the facility to purchase video downloads of the show. Examples of these products and their marketing is provided at Exhibit F and consists of:

- What appears to be an online advertisement for a DRAGONS’ DEN online educational programme that claims users will “Develop an Entrepreneurial Skillset for Success”. The advertisement is undated;
- Copies of undated front covers of three different books entitled DRAGONS’ DEN™ GROW YOUR BUSINESS, DRAGONS’ DEN™ START YOUR OWN BUSINESS and DRAGONS’ DEN™ THE PERFECT PITCH;
- A photograph of the box of a board game named DRAGONS’ DEN. The get-up shows the set of the TV show. It is undated;
- A screen shot of a page from the *BBC* website showing online downloads of DRAGONS’ DEN episodes from series 12 and 13 for sale;
- A screen shot from the web site of *Classic Films Direct* illustrating a DVD for sale of DRAGONS’ DEN complete BBC series 1 and 2. The page carries a 2015 copyright notice;
- A screen shot from *boxsets.co.uk* showing the same DVD box set for sale. It is undated but a review dated 17 October 2009 is visible;
- Books, DVDs and the board game referred to above are also all shown for sale on the website of the Internet retailer *Amazon.co.uk*. The search was conducted on 23 February 2016.

15) Finally, at Exhibit G Mr Boone provides a copy of *Google* search results for the phrase “dragons investment show” where it is apparent that most of the results refer to DRAGONS’ DEN.

### **Applicant’s Evidence**

16) This is in the form of a witness statement by Reza Soheily, director and CEO of the applicant. He provides information regarding the history of the applicant and he states that the applicant has operates networking and learning events and has been active since 2008 and has over 30,000 members.

17) Mr Soheily refers to a reference obtained from *oxforddictionaries.com* where “dragon” is defined as fierce or intimidating persons (particularly women). He also states that “[t]he term could also be used, in the ordinary course of business, to describe high-net-worth investors that have a greater degree of self-interest, when compared to “Angel” investors”, but no reference is provided for this.

18) Mr Soheily identifies two other registrations both for the mark ANGELS DEN (2410107 and 2481793) that include business management and business development in Class 35, and entertainment in Class 41. At Exhibit A he provides extracts from the ANGELS DEN website illustrating that its business model involves “inspiring the UK to become a nation of angel investors”.

19) The remainder of Mr Soheily’s statement is in the form of submissions that I will keep in mind, but not detail here.

## **DECISION**

### **Section 5(3)**

20) I find it convenient to begin by considering the opponent’s grounds based upon section 5(3) of the Act.

21) Section 5(3) states:

“(3) A trade mark which-  
is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.”

22) The relevant case law can be found in the following judgments of the Court of Justice of the European Union (“the CJEU”): Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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.

(c) It is necessary 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 of all relevant factors, including the degree of similarity between the respective marks and between the 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) Where a link is established, the owner of the earlier mark must also establish 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 relevant factors; *Intel, paragraph 79*.

(f) 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 risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) 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*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark 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. This 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 coat-tails of the mark with a

reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

## Reputation

23) The opponent's evidence illustrates that it is the current proprietor of the mark DRAGONS' DEN that has been used as the name of a television series that has ran for 13 series between 2005 and 2016. No turnover figures have been provided but the evidence illustrates that the show regularly attracts several million viewers each episode. The evidence also shows that since at least 2010 the show has been aired on the BBC. It has also received coverage (shown between 2007 and 2016) in the Internet versions of national newspapers such as the *Telegraph*, *The Times*, *The Sun* and *The Guardian*. There is no doubt in my mind that the opponent enjoys a significant reputation in respect of this television series. Such a reputation maps onto the following of the opponent's services listed in its Class 41 specifications:

**Earlier EUTM:** *entertainment services in the nature of a television series streamed, downloaded or otherwise exhibited on wired or wireless devices;*

**Earlier UK mark:** *Provision of entertainment, [insofar as it is in the nature of a television series]; production, presentation, distribution and syndication of moving images [insofar as it is in the nature of a television series]; organisation, production and presentation of shows [insofar as it is in the nature of a television show],*

24) The opponent also claims that the mark enjoys a reputation in respect of product merchandising in association with the show, pointing to the *BBC* having at least three sub-licensees relating to use of the mark in respect of related products. Whilst there is some evidence showing the mark being used in respect of a number of books and a board game, there is nothing to indicate the scale of use in respect of these goods and whilst the evidence leads me to conclude that there has been some use in respect of these goods, it falls far short of demonstrating the reputation in the mark extends to these goods.

25) The opponent's evidence also refers to the availability of the DRAGONS' DEN series being available to download from the *BBC* website and to DVD box sets of the series being available to purchase from several online retailers including *Amazon.co.uk*. Whilst this may demonstrate use of the mark in respect to downloads and DVD's there is no indication regarding the volume of sales. That said, to the extent that these goods are recordings of the TV show, the reputation of the show must extend to such recordings.

26) There is some evidence that the opponent's provide an online educational programme under the mark, but the sole corroboratory evidence of this is an undated online advertisement. In the absence of further information, I find that the reputation does not extend to these services.

### **The Link**

27) The CJEU has stated that the existence of a link "must be assessed globally, taking into account all factors relevant to the circumstances of the case" (*Intel*, paragraph 41). These relevant factors include the degree of similarity between the marks, the nature of the respective goods and services and the degree of similarity between them, the closeness of the respective relevant publics, the strength of the reputation, the degree of the earlier mark's distinctive character and whether there is a likelihood of confusion on the part of the public.

28) In *Addidas-Salomon*, the CJEU held that:

"28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark

and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

29) In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

30) I have already found that the opponent’s mark enjoys a significant reputation in respect of the television series called DRAGONS’ DEN. Such a reputation will result in an enhanced level of distinctive character of the mark. There are submissions from the applicant that the word DRAGON describes a type of investor, but there is no corroboratory evidence before me to support this view. There is a statement from Mr Boone, for the opponent, describing the format of its show as “where budding entrepreneurs pitch for investment from wealthy “Dragons” being venture capitalists...”. I make a number of observations about the relevance of this statement. Firstly, being uncorroborated, I am unable to assess how well known such a term might be; secondly, the comment is somewhat ambiguous as to whether the opponent believed the word “Dragon” describes an investor, or whether it is a



fanciful way in which it uses it; thirdly, even if the word “Dragon” describes a type of investor, I do not know whether this has come about because of the use by the opponent, or whether it is a term that was in use prior to the opponent’s use in 2005. Therefore, it is not clear to me whether the relevant section of the public, being the general public, in respect to the television series is likely to be aware of such a meaning. To my mind, the likely perception is that of the mythical animal. My view is that it is this perception that will be uppermost in the mind of the relevant public when encountering both marks. There is therefore a degree of distinctive similarity between the respective marks because of the common element DRAGONS. Even if this is wrong, the word ‘dragon’ is, at most, allusive (as opposed to being descriptive) of investors with fierce or intimidating personalities

31) The presence of the words “INVESTMENT SHOW” appearing in the applicant’s mark will also assist in creating a link in the minds of the relevant public because they are likely to be familiar with the reputation of the DRAGONS’ DEN television show and also be aware that its format is (as described by Mr Boone) as one where “budding entrepreneurs pitch for investment from wealthy ... venture capitalists willing to make an investment in return for equity”.

32) Some of the Class 41 services are identical insofar as both include services related to television programmes. The applicant’s Class 35 and Class 36 services are not highly similar to the opponent’s services for which I have found a reputation. However, there is a connection between them insofar as the format of the opponent’s television programme is such that the “dragons” impart business advice and other business services to businesses that are seeking investment and they also chose to invest in certain businesses.

33) In respect to the applicant’s Class 38 services, there is some similarity, particularly because the television broadcasting industry is dominated by a small number of large providers such as the *ITV*, *BBC* and *SKY* and the relevant public will be familiar with these broadcasters involvement in producing television shows.

34) Similarly to my considerations in respect to Class 35 and Class 36, the applicant’s *on-line social networking services* in Class 45 do not share high similarity

with the opponent's television show. However, there is a connection between them insofar as the social networking services may have the purpose of allowing users to discuss business investment issues and network with like-minded individuals and businesses, then there is a connection with the format of the opponent's television show.

35) Keeping in mind my comments in the preceding paragraphs, I find that the relevant section of the public will perceive a link between the respective marks, even where there would be no likelihood of confusion. The word DRAGONS in the applicant's mark will bring to mind the opponent's DRAGONS DEN television series, especially as the words that follow it (namely, "INVESTMENT SHOW") are a description consistent with the format of the opponent's show.

36) Having established the existence of the required link, I go on to consider the issues of detriment and unfair advantage.

#### ***Detriment to distinctive character***

37) The opponent's claim is that use of the applicant's mark would devalue the opponent's mark and dilute its distinctive character. It claims that the public would potentially be diverted or misled into taking up the applicant's services in the belief that there is an economic connection with the opponent. It further claims that if, and when, the public realise that there is no economic connection, then the distinctiveness of the earlier mark will have become blurred.

38) The CJEU in *L'Oreal v Bellure*, has provided the following guidance:

"39. As regards detriment to the distinctive character of the mark, also referred to as 'dilution', 'whittling away' or 'blurring', such detriment is caused when that mark's ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is

registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).”

39) As referred to in paragraph 22 above, the same court commented in *Intel* that 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. It is my view that the applicant’s use of a mark that refers to DRAGONS within the context of an INVESTMENT SHOW will inevitably lead the relevant public to wonder whether the provider of the services applied for might be economically linked to an undertaking that is responsible for a well-known television show called DRAGONS DEN involving venture capitalists considering whether to invest in business ideas pitched to them. The presence of the device element fails to dispel such wondering on the part of the relevant public.

40) As a consequence of this, I find that use of the applicant’s mark is likely to lead to detriment to the distinctive character of the opponent’s mark. This finding extends not only to the applicant’s services directly related to television programmes, but also to all other of the services listed. In respect of the services in Class 35 or Class 36, this is because these are all either business services or investment services of the kind that may be offered by the venture capitalists who star in the opponent’s show. In respect of the various broadcasting services listed in the applicant’s Class 38 specification, there is similarity with the entertainment services of the opponent because, as I have already noted, the broadcasting industry is dominated by a small number of companies such as *ITV*, the *BBC* and *Sky* and it is common for such broadcasters to also be involved in the production of television shows. Therefore there will be a clear overlap of trade channels. Having regard to the nature and extent of the opponent’s mark’s reputation, the applicant’s business training services would be likely to be mentally linked with the opponent’s mark. Education, instruction etc. are merely alternative names for training services. Recreation may be different, but would cover things such as business themed recreational events which combine education with entertainment. These would also be linked with the opponent’s mark. Electronic publishing services includes publishing online blogs etc. where the purpose of the blog is to discuss television shows or business management issues. Consequently, these would also be linked with the opponent’s mark. Finally, in

respect of the applicants on-line social networking services in Class 45, because social networking is becoming an increasingly common way to promote services the link between the marks in this case will lead the relevant public to wonder whether the provider of a social networking service under the applicant's mark is economically linked to a business investment show called DRAGONS' DEN that promotes itself using the same social networking service.

41) There is a real risk of a change in the economic behaviour of consumers of the opponent's services, being the general public with an interest in business and entrepreneurs. This consumer group overlaps with the relevant public for the applicant's services. The risk that such a public may not be able to distinguish, or will be able to distinguish only with difficulty, between services offered under the applicant's mark and services offered under the opponent's mark, is liable to affect their economic behaviour. In particular, they will be diverted to the applicant's services, or at least, be less able to easily identify the opponent's services and therefore less likely to use them.

42) I find that the opponent's opposition, insofar as it relies upon a claim of detriment to the distinctive character, is successful in its entirety.

### ***Detriment to repute***

43) The opponent's claim that use of the applicant's mark would result in the opponent having no quality control over the goods and services provided under the applicant's mark and consequently leading to a risk of damage to the repute of the opponent's mark. The CJEU provided guidance as to what constitutes detriment to repute in *L'Oreal v Bellure*, C-487/07, paragraph 40 (see sub-paragraph (h), paragraph 22, above). This was interpreted, for example, in *Hollywood* [2002] ETMR 64, where a chewing gum maker succeeded in preventing a tobacco maker from using the same mark because of the negative associations associated with tobacco. The Registry has also considered the point in a number of earlier cases and found the opponent to be successful where use of the later mark would create negative associations. For example, the makers of Quorn vegetarian meat substitute successfully prevented the registration of QUORN HUNT because of the negative

connotations of a meat substitute being associated with a hunt (see BL O/319/04); in *KAPPA*, BL O/192/14, the opponent succeeded in preventing the registration of *KAPPA* in respect of tobacco because of the negative connotations of a sportswear maker being associated with tobacco; in *FRAUD*, BL O/504/13, where the word “Fraud” was presented in a blue roundel mimicking the Ford car badge, the opponent successfully prevented registration in respect of clothing because of the obvious negative connotations that the mark would create in respect of the reputation of the opponent.

44) The cases referred to above were all successful because it was deemed that either the goods in respect of which the later mark was intended to be used, or the mark itself communicated a message that led to a negative connotation associated with the opponent’s mark in each case. No such negative connotation exists in the present case. Rather, the opponent relies upon a hypothetical risk based upon the possibility that the applicant’s services will be of a lower quality. This is insufficient (see the comments of Ms Anna Carboni, sitting as the Appointed Person in *UNITE Trade Mark*, BL O/219/13, paragraphs 46 and 47). There is no inherent characteristic or quality attached to the applicant’s services that would lead to a negative impact being imparted upon the opponent or its services. Rather, the opponent relies upon a possible hypothetical situation. I find that this is insufficient for me to conclude that the opponent has established the existence of detriment to repute. I reject this limb of the grounds based upon section 5(3).

### ***Unfair advantage***

45) The opponent claims that use of the applicant’s mark would exploit the distinctive character and repute of the earlier mark by effectively using the opponent’s mark as a springboard to generate additional consumer interest leading to advantage in that the applicant would not need to make such a substantial investment in promoting itself. It is claimed that such an advantage would be unfair because the reward for the opponent’s efforts to promote its earlier mark should accrue to it and not the applicant.

46) Once again, I refer to the CJEU's guidance in *L'Oreal v Bellure*. It provides guidance as to what constitutes unfair advantage at paragraph 41, where it said:

“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 coat-tails of the mark with a reputation.”

47) In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

“34. According to the Court's case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words ‘[i]t follows that’, immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of

detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that 'the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark'.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'."

48) Therefore, I must be satisfied, beyond "mere suppositions", that following "an analysis of the probabilities" and taking account of "all the ...circumstances of the case", there real risk that use of the applicant's mark would take unfair advantage of the distinctive character or repute of the opponent's mark. Circumstances of particular importance in the current case are that:

- (i) that the opponent's mark enjoys a significant reputation in respect of television shows;
- (ii) the nature of this show is that entrepreneurs pitch business ideas to wealthy potential investors and offer a share in their company in exchange for their investment and business advice;
- (iii) the applicant's services include providing business advice, capital investment and preparation of entertainment programs for broadcasting;
- (iv) the applicant's mark includes the descriptive words INVESTMENT SHOW, and;
- (v) the word DRAGONS appears at the start of both parties' marks.

49) When taking all of these points into account, I have little hesitation in concluding that it is likely that the customers of the opponent will be attracted to the applicant's services because they will believe that they are provided by the same or linked undertaking. There is nothing before me that the applicant intended to benefit from the opponent's reputation, however, as Arnold J. noted in *Jack Wills Limited v House*



of *Fraser (Stores) Limited* [2014] EWHC 110 (Ch), paragraph 80, there is nothing in the case law to prevent the decision maker concluding that the objective effect of use of a given mark is that its proprietor benefits from the reputation of an similar earlier mark, whether or not that is the applicant's subjective intention. The business and investment services covered by classes 35 and 36 of the application are not included in the specifications of the earlier mark and they are not known to be provided by the opponent as standalone services, but they are known to be a feature of the opponent's TV show. The relevant public is likely to have knowledge of the format of the show and is likely to recognise a reference to the same or similar feature in the applicant's mark because of the presence of the words INVESTMENT SHOW. As a result, I conclude that use of the applicant's mark is likely to result in an unfair advantage being taken of the opponent's earlier mark because the connection between the marks and services makes it more likely that consumers will use the applicant's services because they think they are economically linked to the opponent, or because of the positive mental association they make with the opponent's mark and the services with which they associate it.

### ***Due Cause***

50) Finally, it is a defence if the applicant can rely upon "due cause". Earlier, I dismissed the applicant's claim that DRAGON describes a particular type of investor. The implication of such a claim is that the applicant had due cause to use the word in its mark and that the mark was adopted in good faith. There is nothing before me to indicate that the term is used, or would be recognised, as a description of a type of investor, or that if it is, such usage would be regarded as normal outside the context of the opponent's TV show. A due cause defence is, essentially, a balancing act between the interests of the respective parties. By way of example, in the judgment of the CJEU in Case C-65/12, *Leidseplein Beheer BV, Hendrikus de Vries v Red Bull GmbH, Red Bull Nederland BV*, it was stated:

"...but to strike a balance between the interests in question by taking account, in the specific context of Article 5(2) of Directive 89/104 and in the light of the enhanced protection enjoyed by that mark, of the interests of the third party using that sign. In so doing, the claim by a third party that there is due cause

for using a sign which is similar to a mark with a reputation cannot lead to the recognition, for the benefit of that third party, of the rights connected with a registered mark, but rather obliges the proprietor of the mark with a reputation to tolerate the use of the similar sign.”

51) In circumstances where I have found that the potential use of the mark would dilute the distinctive character of the earlier mark’s reputation and take unfair advantage of the earlier mark, merely pointing to the applicant’s innocent adoption of the mark (even if true) does not mean that such use should be tolerated. The due cause defence is dismissed.

52) In summary, the opponent’s section 5(3) grounds insofar as they are based on a claim to unfair advantage is successful in its entirety.

### **Section 5(2)(b)**

53) In case I am found to be wrong, or partially wrong in respect of my findings regarding the section 5(3) grounds, I will also consider the opponent’s opposition insofar as it relies upon section 5(2)(b) of the Act. This reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

54) For reasons of procedural economy, I intend to consider the grounds based upon section 5(2)(b) insofar as the opponent relies upon its earlier EUTM. I will only consider its case based upon its earlier UK mark (that is subject to proof of use), only to the degree that it materially improves the opponent’s case.

## Comparison of goods and services

55) In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

56) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services 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 or services in the same or different sectors.

57) In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of

similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

58) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

59) I am also mindful of the following guidance of the General Court (“the GC”) in *Gérard Meric v OHIM*, T-133/05 (*MERIC*):

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

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

### ***The applicant’s Class 35 services***

60) In respect of all these services, the opponent submits that these can all “be summarised as being in the nature of ‘business management, development and consultancy services’”. It goes on to argue that because of the subject matter of these services, they will be viewed as similar and related services to the opponent’s Class 41 services. It cites that the DRAGONS’ DEN programme and publications that can be seen as offering business management, development and consultancy advice. The applicant, in its submissions, merely states that the opponent’s goods and services do not overlap.

61) The first point to make is that no identical goods or services are involved. The opponent’s list of goods and services does not include Class 35, the only class where identical services could be classified. The second point is that, whilst the TV program may offer business management, development and consultancy advice to the contestants, such services are not covered by the scope of the opponent’s specifications. I keep in mind that I must conduct a notional analysis of similarity based upon the services identified in the specifications of the respective marks and not based upon how the marks may be actually used. This is because the nature of the use may change over time as marketing strategies change or because a mark is sold and the new proprietor decides to take the business in a different direction. In making these observations, I have been guided by the comments of the CJEU in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, paragraph 59.

62) However, I also need to consider whether the respective goods and services are similar and if so, to what extent. The opponent relies on its television show and by this, I understand it to mean its *entertainment services in the nature of a television series* as covered by its Class 41 specification. Regarding the nature of the respective services, there is a fundamental difference in that one is an entertainment service, the other various business services. It follows that their intended purpose also differs in that one is to entertain, the other is to support businesses. Further, the trade channels and methods of use in respect of television shows and business services are different, however, I recognise that the end users will overlap because users of business services also watchers of TV shows, including shows with a business theme. They are not in competition with each other and neither is one indispensable or important for the use of the other in such a way that customers would be liable to believe that responsibility for the services lies with the same undertaking. Such a finding is based on notional considerations and in isolation of factors such as the reputation of the opponent's mark or factors that are not evident from an ordinary reading of the specification of services, such as the format of the opponent's television show. This explains why I found that the consumer will assume an economic connection between the two marks when considering detriment and unfair advantage. In considering complementarity, I am considering how consumers normally perceive business and entertainment services. In this respect, the relevant public are not liable to believe that responsibility for the respective services lies with the same undertaking

63) Taking all of the above into account, I conclude that there is no similarity between the opponent's Class 41 services and any of the applicant's Class 35 services. In *Wedgwood plc v OHIM* – C-398/07 P, the CJEU makes it clear that some similarity of services is an essential requirement under the equivalent of the UK's section 5(2). Consequently, my finding puts an end to the opponent's grounds under section 5(2)(b) insofar as it relies upon its Class 41 services.

64) There is nothing further in the specifications of the opponent's earlier EUTM that appears to place it in a better position when considering similarity to the applicant's Class 35 services.

### ***The applicant's Class 36***

65) For analogous reasons as set out in respect of the applicant's Class 35 services, there is nothing in the specifications of the opponent's earlier EUTM that appears to be similar to the applicant's Class 36 services.

### ***The applicant's Class 38***

66) In respect of the comparison between the opponent's goods and services and the applicant's Class 38 services it is important to keep in mind the type of services that are proper to this class. The Explanatory Note on the class provided in the official WIPO guide on the Nice Classification of goods and services states:

“Class 38 includes mainly services allowing at least one person to communicate with another by a sensory means. Such services include those which: 1. allow one person to talk to another, 2. transmit messages from one person to another, and 3. place a person in oral or visual communication with another (radio and television).

This Class includes, in particular:

- services which consist essentially of the diffusion of radio or television programmes.

This Class does not include, in particular:

- radio advertising services (Cl. 35);
- telephone marketing (telemarketing) services (Cl. 35).”

67) The opponent's submission is that because of the subject matter of the applicant's services, they must be viewed as being similar to its services. The provision of broadcasting services and the provision of entertainment services are quite different. The first is the act of diffusion of, for example, a television programme whereas the programme itself is the act of providing amusement or enjoyment. One is a communication service, the other an entertainment service. Therefore, they are different in terms of nature and intended purpose. As I have already noted, television broadcasting services are dominated by a small number of providers such as the *ITV*, *BBC* and *Sky* and such providers are also involved in producing television

shows. Consequently, the consumer is familiar with providers of broadcasting services also providing entertainment services in the form of television shows. Therefore, some overlap of trade channels can be expected. In terms of methods of use, these can be similar in that both types of services may be accessed by the consumer by turning on a television (in the case where the entertainment is in the form of a TV show) or radio (in the case where the entertainment is in the form of a radio show). They are not, however, in competition with each other. In the sense expressed by the GC in *Boston Scientific*, some of the respective services are complementary. For example, television broadcasting is indispensable or important for the use of entertainment in the form of a television programme.

68) In summary, whilst there are differences between the respective services, there are also similarities and when taking all of these into account, I conclude that they share a medium level of similarity.

#### ***The applicant's Class 41***

69) The applicant's *Entertainment services* is a broad term that includes the opponent's *entertainment services in the nature of a television series...*, therefore, applying the guidance from *MERIC*, these services are identical.

70) The applicant's *television program production services; production, presentation, distribution and syndication of entertainment programs, television programs* are identical or, if not identical, highly similar. The provision of a television series will include the production, presentation, distribution and syndication of that series, or if it doesn't it is very closely aligned to the entertainment service itself, with the same businesses likely to be involved in providing all these services.

71) Similar considerations apply in respect of the applicant's *production, presentation and syndication of shows...*, *musical entertainment* as these can both include television shows. In respect of the applicant's *production, presentation, distribution and syndication of ..., films...*, films and TV shows are not identical products, however, they are highly similar and a production company may produce both. Consequently, I conclude that the respective services are highly similar.



72) In respect of the applicant's *production, presentation, distribution and syndication of entertainment radio programs*, these services are not identical to those of the opponent because one relates to radio programmes, the other to television programmes. That said the services involved in producing both are similar in terms of their nature and intended purpose. There may be some overlap of trade channels, but not necessarily so. I conclude that there is a medium degree of similarity.

73) Next, in respect to the applicant's *production, presentation and syndication of theatrical entertainment, ... stage entertainment, ...and live entertainment*, the nature of the entertainment itself is different to the opponent's television series, but the services remain similar in terms of nature and intended purpose. Generally speaking such services will not be in competition or complementary to the same services relating to television programmes. Taking all of this together, I find that the respective services share a medium level of similarity.

74) In respect to the applicant's *education, recreation, instruction, tuition and training services*, education, instruction etc. are just alternative names for training services and such training includes business themed training. Similarly, recreation services may also cover business themed recreational events which combine education with entertainment. As a result, there may be overlap of trade channels and the respective services may be complementary in the sense expressed in *Boston Scientific*. Nevertheless, they are different in terms of nature, intended purpose and I conclude that the respective services share only a low degree of similarity.

75) In respect of the applicant's *publishing services (including electronic publishing)*, these include publishing of online blogs etc. to promote or discuss issues in a particular field such as television shows or business services. With this in mind, the applicant's services share some similarity to the opponent's television show or subject matter of the show and it is possible that one provider could provide both services. Therefore, there may be some overlap in terms of trade channels, but in all other respects they are different. They are not in competition and neither is one important to the existence of the other. I conclude that they are similar only to a low degree.

76) The applicant's *organisation, production and presentation of shows, competitions, contests* insofar as they include television shows, competitions and contests produced for television then they are identical to the opponent's *entertainment services in the nature of a television series streamed, downloaded or otherwise exhibited on wired or wireless devices*.

77) The applicant's *organisation, production and presentation of ....., games, concerts and events* may have some similarity with the opponent's *entertainment services in the nature of a television series*, but it appears less obvious to me because an entity producing a television series is not likely to also be the producer of games, concerts and events and, therefore, the trade channels are not likely to be the same even though the end users are the same. Whilst their intended purpose (to entertain) is the same, their nature and method of use is different to that of a television series. They may be loosely in competition because a consumer may have a choice whether to stay at home and watch a television programme or to go out to a concert. Taking all of these similarities and differences into account, I conclude they share a medium level of similarity.

78) In respect of the applicant's *rental of ... video recordings*, where the video recordings are of a television series, there will be a close correlation in terms of the nature of the subject matter of the respective services, the intended purpose is very similar with both being screen entertainment. Methods of use are similar in that the products of these services are watched on a screen such as a television. However, I do not see that they are in competition because video recordings can be watched at any time within the rental window and as such, the consumer is not required to choose whether to watch the television programme or the video. Taking all of this together, I conclude that the respective services share a medium level of similarity.

79) In respect of the applicant's *rental of sound ... recordings*, there is not such a close correlation. The intended purpose is less similar, even though they may both be, at a general level, entertainment. The method of use is different with one be viewed, the other being listened to. It is also less likely that they will be in competition and they are not complementary in the sense set out in *Boston Scientific*. I conclude that there is a low level of similarity.

80) Finally, in respect of the applicant's *provision of information and advisory services relating to any of the aforesaid services* it is, at least in part, identical to the opponent's *providing ...information in the field of television*. Whilst the "advisory services" element of the applicant's term may not be identical to the opponent's term, there is a great deal of overlap between provision of advice and provision of information to the point that the former can be argued to be wholly included within the latter. They are similar in nature and method of use with advice being a form of imparting information, and both information and advice may be obtained from the same provider. Therefore, there is an overlap between, or even the same, trade channels. They share a high level of similarity.

### ***The applicant's Class 45***

81) In respect of the applicant's On-line social networking services, the opponent submits that considering the particular subject matter of its television shows, the applicant's Class 45 services will be viewed as similar. The term includes the operation of a social networking services to promote or discuss issues in a particular field. With this in mind the applicant's services share some similarity to the subject matter of the opponent's television shows and it is possible that one provider could provide both services. Therefore, there may be some overlap in terms of trade channels, but in all other respects they are different. They are not in competition and neither is one important to the existence of the other. I conclude that they are similar only to a very low degree.

82) In respect of the applicant's services in all its classes, the opponent has indicated it relies upon all of the goods and services covered by its earlier marks, but it is not obvious to me how reliance upon any of its other goods or services place it in any stronger position.

### **Comparison of marks**

83) It is clear from the judgment of Court of Justice of the European Union ("the CJEU") in *Sabel BV v Puma AG*, Case C-251/95 (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to

analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

84) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

85) The respective marks are shown below:

Earlier mark	Contested mark
<p style="text-align: center;">DRAGONS' DEN</p>	

86) The earlier mark consists of the possessive form of the plural of the word DRAGON together with a second word DEN. The two combine to make a conceptual whole with the word DRAGONS' qualifying the word DEN. The two words combine to create a conceptual whole and its distinctive character resides in this. The applicant's mark consists of two distinct elements: the words DRAGONS INVESTMENT SHOW, and the device element. The size and position of the device

within the mark ensures that it is a distinctive element that cannot be ignored. That said, it is my view that the three words are at least equally dominant and will lodge in the minds of the consumer.

87) Visually, both marks share the same word DRAGONS, but in all other respects, they are different. The opponent's mark also contains the word DEN, whereas the applicant's mark contains the words INVESTMENT SHOW and the device that appears above the words. Taking all of this into account, I can conclude that when viewing the marks as a whole, they share of low level of visual similarity.

88) Aurally, only the word elements of the respective marks will have an impact. The opponent's mark consists of three syllables DRAG-ONS-DEN whereas the applicant's mark consists of six syllables DRAG-ONS-IN-VEST-MENT-SHOW. They share the same first two syllables. In other respects the marks are different. Taking all of this into account I conclude that the marks share a medium level of aural similarity.

89) Conceptually, in its final written submissions, the applicant submits that the word DRAGON “is a well-known derogatory term used to describe fierce or intimidating persons (particularly women)” and that it “could also be used, in the ordinary course of business, to describe high-net-worth investors that have a greater degree of self-interest, when compared to “Angel” investors”. The opponent also suggests similar meanings as well as the obvious one of a mythical creature. The opponent, when describing its show, refers to it starring “Dragon” investors, but it is unclear whether this is a reference to its own fanciful name for the investors or whether it is a reference to what it believes is an ordinary descriptive word. It is my view that there is no evidence that establishes such a meaning and I do not regard the opponent’s submissions as having conceded the point.

90) I conclude that the average consumer is likely to perceive only the obvious meaning of a type of mythical monster when encountering both marks and it remains a point of conceptual similarity. Even if this is wrong, the word ‘dragon’ is, at most, allusive (as opposed to descriptive) of investors with fierce or intimidating personalities. In all other respects, the marks are dissimilar. Whilst the device

element of the applicant's mark does not add any conceptual impact, the words "Investment Show" has a different conceptual meaning to the word "Den" in the opponent's mark. I also keep in mind that the words INVESTMENT SHOW are descriptive of the nature of some of the applicant's services. Taking all of this into account, I conclude that the respective marks share a medium level of distinctive conceptual similarity.

### **Average consumer and the purchasing act**

91) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

92) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch)*, Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

93) Earlier, I found that the applicant's Class 35 and Class 36 services are not similar and, as a consequence, there can be no likelihood of confusion. Therefore, I do not need to consider the purchasing process for such services.

94) On one level, the applicant's Class 38 services may be provided to members of the public who receive broadcasts through their televisions, radios or other devices. On another level, broadcasting services may also be provided to businesses who

wish to have information, programmes etc. broadcast to their target audience. In both cases, whilst the purchasing process is different, they are likely to involve an enhanced level of consideration during the purchasing process. In the case of members of the public, in this digital age, choice of broadcast provider is generally involves a commitment to take the service for a period of time, or at least a commitment to purchase suitable equipment to access free-to-air services. There are generally different packages to choose from. In the case of business customers, choice of broadcaster will take into account of issues such as whether the service reaches the target audience of the programme of information and also cost will be an aspect that is likely to involve some negotiation.

95) Regarding both parties' similar Class 41 services, involving programmes, videos, audio and moving images, the access to such services can be rather casual, such as choosing to watch a programme on television, or more considered, such as procuring a video that may be used for a specific entertainment purpose. The average consumer is likely to be the general public.

96) Finally, in respect of the applicant's Class 45 services, these are used by both members of the public and businesses. The level of care and attention in deciding which platform to use involves some care, but not the highest because the consumer of such services is able to switch platform with relative ease.

### **Distinctive character of the earlier trade mark**

97) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

98) The opponent's mark consists of the two words DRAGONS' and DEN that combine to make a phrase that is evocative of the lair of some fierce individuals. Such an allusion does not detract from a reasonable level of distinctive character that reside in the phrase.

99) The opponent claims an enhanced level of distinctive character and I accept that this exists in respect of the services of providing a television series. As a consequence of this use in respect to these services, I conclude that the mark has distinctive character that is enhanced to a high level.

#### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

100) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:



(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 or 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;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

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

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

101) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

102) In respect of the applicant's Class 35 and Class 36 services, I have found no similarity with the opponent's goods or services. The CJEU in *Waterford Wedgwood plc v OHIM – C-398/07 P* stated that for there to be a likelihood of confusion some similarity between the respective goods and services is essential. Therefore, it is not necessary that I further consider likelihood of confusion in respect of these services.

103) With the exception of the above services and the applicant's *rental of sound recordings* and *publishing services (including electronic publishing services)* and *education, recreation, instruction, tuition and training services* in Class and *online social networking services* in Class 45 (where I have found a low level of similarity with the opponent's goods and services), I have found that the respective services share at least a medium level of similarity. I have also found that the respective marks share a low level of visual similarity and a medium level of aural and conceptual similarity. I have found that the purchasing process varies from the rather casual to involving protracted negotiations and that, dependent upon the services, the average consumer may be other businesses or the general public. Finally, I have

found that the opponent's mark is endowed with a reasonable level of inherent distinctive character and that, in respect of the television series, its distinctive character has been enhanced to a high level by the use made of it.

104) When comparing the respective marks as a whole, it is clear to me that the differences are such that they will not go unnoticed by the average consumer, even where there is the most casual of purchases. Therefore, I find that there is no direct confusion. However, when factoring all of my findings identified in the previous paragraph together with the role that the word DRAGONS plays in both the marks, it is my view that the average consumer, upon encountering the applicant's mark in respect of services with some similarity to the goods or services of the opponent, will believe that it is identifying services that originate from the same or linked undertaking. It is my view that because the words INVESTMENT SHOW present in the applicant's mark may be perceived by the average consumer as suggesting a show which deals with a similar subject matter to the opponent's show assists the average consumer in having such a perception. I find that there is a likelihood of, so called, indirect confusion.

105) Insofar as the opponent's case is based upon its earlier EUTM, I find a likelihood of confusion in respect of all the applicant's services except those in Class 35 and Class 36.

106) Next, I will turn to consider if the opponent's section 5(2)(b) case is improved by its reliance upon its earlier UK mark. This is subject to the proof of use requirements, and I consider this below insofar as the opponent may be able to rely upon a broader range of goods and services compared to those listed in its earlier EUTM.

### **Proof of use**

107) The relevant provision, Section 6A of the Act reads as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

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

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

108) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes *Case C-442/07 Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and *Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) 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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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.

Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

109) Section 100 of the Act states that:

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

110) The relevant period for showing genuine use is the five years ending with the date of publication of the application, in this case 22 August 2010 to 21 August 2015. Having considered the opponent’s evidence summarised earlier at paragraphs 9 to 14, it makes reference to the following goods:

**Class 9:** *Video recordings in uncompressed form:* the evidence shows DVD box sets of the television series for sale on three web sites, the first two from 2015 or later and the other from sometime in or after 2009 and records the release date of the video as being 26 September 2008. The third is from *Amazon.co.uk* and dated in February 2016, some 6 months after the relevant date. Despite this, it is clear from the other two websites that the DVD were available over a period of eight years. Whilst the scale of sales is unknown, the presence of such DVDs and DVD box sets on the websites of three Internet retailers over a period of 6 years prior to, and also just after the end of the five year period illustrates a presence on the market that is more than merely token. Taking all of this within the context of a successful television series running since 2005, I find that genuine use has been demonstrated in respect of *Video recordings in uncompressed form*.

**Class 16:** *books:* Front covers of three books are shown where the mark DRAGONS DEN appears prominently. A number of DRAGONS’ DEN books are also shown in extracts from the website of the Internet retailer

*amazon.co.uk*. Whilst the extract was obtained after the end of the five year period, I note that the books were published variously in 2009, 2010 and 2011.

111) There is also use shown in respect of *Downloadable TV shows* and *board games* but such goods are not included in the specifications of the opponent's earlier UK mark and therefore cannot improve on its position compared to when relying upon its earlier EUTM. There is no corroboratory evidence in respect of the remaining goods and services where genuine use is claimed (and not already covered by the earlier EUTM). In summary, the opponent's case may be improved insofar as it can also rely on its earlier UK mark in respect of *Video recordings in uncompressed form* in Class 9 and *books* in Class 16. However, it is not obvious to me how reliance upon these goods will materially improve the opponent's position over its reliance upon its *entertainment services in the nature of a television series...* listed in its EUTM.

112) I will, however, consider further the opponent's reliance upon the term *books* in its Class 16 specification. Of course *books* includes such goods that have business advice and consultancy as their subject matter, and it is this sub-category of these goods that appears to present the opponent with its strongest case and I will consider similarity from this starting point. The nature of *books* is that of printed and bound document that can be read at leisure. They are goods rather than services and, as such have a fundamentally different nature to the applicants various business services. The intended purpose of these goods is to provide information and advice to the reader. The opponent's services in this class that are either imparting advice, providing information or consultancy (which is, in essence, also imparting advice) shares similarity in that both are intended to impart business knowledge and/or advice. There may also be some overlap in trade channels because it is possible that the provider of business management and development services may also be the source of books on the same subject. There may also be competition between books relating to business management and the opponent's consultancy, advice and provision of information services because the potential consumer of both of these may choose to be provided with the advice/information by a provider of such services or alternatively to take the self-help approach and buy a



book that contains the same advice/information. However, the methods of use are different because one is used by reading its content, the other by procuring a service from a provider. Taking all of this into account, I conclude that there is a medium level of similarity between the opponent's *books* (insofar as these relate to business management and development and similar topics) and the following of the applicant's Class 35 services:

*...; consultancy on business management and business development; ...; provision of commercial information; ...; provision of information regarding all the aforesaid; Acquisition and merger consultation; ...; Acquisitions (Advice relating to -); Acquisitions (business-) consulting services; ...; Advice in the field of business management and marketing; ...; Business advice and information; ...; Business merger consultation; Business organization advice; ...; Information in business matters; Information or enquiries on business and marketing; Information services relating to business matters; ...; Business advice; Business advisory and consultancy services; Business advisory and information services; Business advisory services; Business advisory services relating to franchising; ...; Business and management consultancy services; ...; Business consultancy; Business consultancy and advisory services; Business consultancy services; ...; Business management and enterprise organization consultancy; Business acquisition and merger consultation; Business administration consultancy; Business advice and information; ...; Providing information about commercial business and commercial information via the global computer network; ...; Business advice; Providing business information in the field of social media; Providing marketing consulting in the field of social media.*

113) In respect to the remaining of the applicant's Class 35 services, the considerations are similar, with the opponent's best case resting with its *books*. However, unlike with the services considered in the previous paragraph, the link between the subject matter of a book and the services themselves is not so direct. To illustrate this, the applicant's specification includes *evaluation of business ideas*. Such a service suggests that there must be input of ideas to the service provider in order to receive an evaluation of them. Therefore, there is an element of interaction

that is missing when merely consulting a book. A consumer could not replace this service by purchasing a book on the subject. Therefore, unlike my considerations above, the respective goods and services are not in competition and the intended purpose is different. However, the respective goods and services may share trade channels with the provider of the services in issue also providing books on the subject. Consequently, whilst there may still be some similarity because the book may relate to the services, such publications only share a low level of similarity with the following of the opponent's services:

*Business management; business development; ...; evaluation of business ideas, business plans, commercial enterprises; business appraisals; supplying, maintaining data bases on businesses, marketing and research; ...; creation business plans; assisting others with the creation and development of business plans and presentations of business plans; analysis and research of business and services available to new enterprises and business ventures; services of introducing business to business; ...; Acquisition (business-) searches; Acquisition of business information relating to company activities; Acquisition of commercial information; ...; Administration (Commercial -) of the licensing of the goods and services of others; Administration of business affairs; Administration of businesses; Administration of the business affairs of franchises; Administration of the business affairs of retail stores; Administration relating to business planning; Administration relating to marketing; Administration relating to sales methods; Advertising services relating to financial investment; ...; Assistance in franchised commercial business management; Assistance in management of business activities; ...; Business appraisals and evaluations in business matters; Business management planning; Business management supervision; ...; Business planning; Commercial assistance in business management; Commercial business management; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise; ...; Advertising and business services; Arranging and conducting of exhibitions for business purposes; Arranging business introductions; Arranging of business introductions; Business administration services; ...; Business analysis; ...; Business and market research; Business appraisal; Business appraisal*

*services; ...; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise; Management of a retail enterprise for others; ...; Commercial assistance in business management; Commercial business management; Expert evaluations and reports relating to business matters; Organizing of business competitions; ...; Business administration services; ...*

114) In respect to the applicant's Class 36 services, I find that the services divide into two categories for analogous reasons to those discussed in respect to Class 35.

Where the applicant's services are the providing of information advice or consultancy, I find that there is a medium level of similarity to the opponent's *books*.

The services that fall into this category are:

*...; Capital investment consultation; Investment advisory services; ...; Investment consultation; ...; Investment information; ...; Investment ... advisory services; ...; Advisory services relating to financial investment; Advisory services relating to investment finance; ...; Capital investment advisory services; Consultancy services relating to investment; Consultations relating to investment; ...; Investment advice; ...; Investment consultancy; ...; Capital investment consultation; ...; Capital investment advisory services; ...; Capital investment consulting; ...*

115) Where the services require an interactive approach, I find there is a low level of similarity. The applicant's services that fall into category are:

*Investment by electronic means; Capital investment brokerage; ...; Investment analysis; Investment clubs; ...; Investment fund services; ...; Investment management services; Investment of funds for others; Investment trusteeship ... services; Investment trusteeship services; Venture capital and project capital investment services; Capital investment; Investment services; Investment of funds; Acquisition for financial investment; Administration of capital investment services; Administration of fund investment; Administration of investment funds; ...; Capital fund investment; ...; Industrial investment; Investment; Investment (capital-); ...; Investment asset management; ...;*

*Investment management; Equity capital investment; Management of a capital investment fund; Arranging investments, in particular capital investments, financing services and insurance; ...; Private placement and venture capital investment services; Providing working capital; Venture capital and project capital investment services; Venture capital and venture capital management services; Venture capital financing; Venture capital funding services to emerging and start-up companies; Capital investment; Venture capital services; Administration of capital investment services; Capital (raising of - );Capital fund investment; Capital fund management; ...; Investment of capital (services for-); Provision of investment capital; Raising of capital; Venture capital (services for the finding of-);Venture capital (services for the provision of-);Venture capital fund management; Venture capital management; ...; Capital investments; Investment (Capital -).*

116) I factor the above conclusions into my analysis of likelihood of confusion discussed in paragraphs 103 and 104. In addition, I also find that in respect of *books*, the opponent's mark has a reasonable level of inherent distinctiveness, but given that the extent of the proven use of the mark for *books* is no more than average, that the mark has not been shown to have acquired a highly distinctive character in respect of these goods (unlike TV show services). Taking all of this into account, I conclude that the opponent's case based upon section 5(2)(b) is also successful in respect of the Class 35 and Class 36 services.

### **Section 5(4)(a)**

117) Section 5(4)(a) states:

“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.”

### **Goodwill**

118) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of Section 5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....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.’

119) Therefore, the relevant date for the purposes of this opposition is the filing date of the application, namely 7 July 2015. Whilst other dates may be relevant, there is no such claim in this case.

120) Guidance on the meaning of goodwill was provided in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), where it was 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.”

121) 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.”

122) 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.”

123) The opponent claims that its goodwill is identified by the sign DRAGONS' DEN and claims first use in January 2005 in respect of “an investment show – television series programmes broadcast, provided online ...and on recorded media; board games; printed and online publications, including books”.

124) When considering the opponent's evidence I have already identified use of the DRAGONS' DEN mark that has resulted in a substantial reputation in respect of a television series. I find that the same evidence also illustrates that the opponent's goodwill is identified by this mark in respect of the same services.

### ***Misrepresentation and damage***

125) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“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.”

And later in the same judgment:

“... 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.”

126) I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here and the opponent’s case insofar as it is based upon section 5(4)(a) is wholly successful.

## **Summary**

127) The opponent is wholly successful in respect and the application is refused in respect of all the services claimed.

## **COSTS**

128) The opponent has been wholly successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice



4/2007. I take account that both sides filed evidence and provided written submissions in lieu of a hearing. I award costs as follows:

Preparing statement and considering counterstatement	£300
Opposition fee	£200
Evidence	£600
Submissions in lieu of a hearing	£500
<b>Total:</b>	<b>£1600</b>

129) I order London Entrepreneurs Network Limited to pay CPT Holdings Inc. the sum of £1600 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 21<sup>st</sup> day of February 2017**



**Mark Bryant**  
**Principal Hearing Officer**  
**For the Registrar,**