

**O-625-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3398117 BY ALSHOROQ LIMITED  
TO REGISTER:**

**Social Idol**

**AS A TRADE MARK IN CLASS 41**

**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS. 417441 AND 417442  
BY FREMANTLE MEDIA LIMITED, FREMANTLE MEDIA NORTH AMERICA INC  
AND 19 TV LIMITED**

## Background & Pleadings

1. On 9 May 2019, ALSHOROOQ Limited (“the applicant”) applied to register the trade mark “Social Idol” for the following services in class 41:

*Entertainment Show; Entertainment in the nature of a social show.*

The application was published for opposition purposes on 24 May 2019.

2. On 23 August 2019, the application was opposed in full by FremantleMedia Limited and FremantleMedia North America Inc. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the aforementioned opponents rely upon the following mark and all services in class 41 for which it is registered:

European Union Trade Mark (“EUTM”) 8376857

AMERICAN IDOL

*Education and entertainment services in the form of television programme, radio, cable, satellite and Internet programmes; production and presentation of radio and television programmes, cinematographic films, shows, videos, DVDs, cable programmes, satellite programmes and/or Internet programmes; entertainment by means of theatre productions; organization of competitions (education or entertainment); interactive telephone competitions; publishing; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the Internet; organization of shows; rental of sound recordings and of pre-recorded shows, films, radio and television performances; production of video tapes and video discs; radio entertainment; television entertainment; cinema entertainment; theatre entertainment; game shows; television entertainment services involving telephonic audience participation; interactive entertainment for use with a mobile phone; internet based games; operation of lottery and games of chance; amusement game services; gaming services; gambling services; betting services; casino services; card game and casino tournaments, competitions, contests, games and/or events; lotteries; the provision of any of the aforesaid services to mobile phones, via a mobile network, by communications satellite, by microwave or other electronic, digital and analogue media, live, electronically, via computer*

*network, via the internet, online and through the medium of television; organisation, production and presentation of events for educational, cultural or entertainment purposes; organisation, production, promotion, management and presentation of competitions, contests, games, game shows, quizzes, fun days, exhibitions, shows, roadshows, staged events, raves, theatrical performances, concerts, live performances and participation events; organisation and production provision of video clips via mobile or computer networks for entertainment and/or educational purposes. (Class 41)*

3. On 23 August 2019, a further opposition was filed by 19 TV Limited and FremantleMedia Limited. The application was opposed, again, in full under section 5(2)(b) of the Act, with the opponents relying on the following trade marks and the services laid out respectively below:

United Kingdom Trade Mark (“UKTM”) 2298224D

IDOLS

*Education and entertainment services all relating to television, cinema, radio and theatre; production and presentation of radio and television programmes, films and shows; education by or relating to television and radio; entertainment by or relating to television and radio; organization of competitions (education or entertainment); interactive telephone competitions; publishing; production of cinematographic films, shows, radio programmes and television programmes; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the World Wide Web and the Internet; organization of shows; rental of sound recordings and of pre-recorded shows, films, radio and television performances; production of video tapes and video discs; radio entertainment; television entertainment; cinema entertainment; theatre entertainment; game shows; television entertainment services involving telephonic audience participation (Class 41)*

UKTM 3130417

NEPAL IDOL

*Entertainment services; entertainment services in the nature of production and distribution of television programmes and audio and/or video recordings provided through cable television,*

*Internet , video on-demand, mobile devices and other distribution platforms; electronic games services provided by means of the Internet; interactive entertainment for use with a mobile phone; Internet based games; operation of lottery and games of chance; amusement game services; gaming services; gambling services; betting services; casino services; card game and casino tournaments, competitions, contests, games and/or events; lottery services ; the provision of any of the aforesaid services to mobile phones, via a mobile network, by communications satellite, by microwave or other electronic, digital and analogue media, live, electronically, via computer network, via the Internet, online and through the medium of television; organisation, production and presentation of events for entertainment purposes; organisation, production and provision of video clips via mobile or computer networks for entertainment purposes; entertainment services namely editing, posting, displaying, tagging, blogging, sharing or otherwise providing data including images, graphics, sound, text or audio-visual information via the Internet or other communications network for entertainment purposes. (Class 41)*

EUTM 15739196

POP IDOL

*Entertainment and education services; educational services relating to entertainment; information relating to entertainment or education, provided on-line from a computer database or the Internet or by communications satellite, microwave or other electronic, digital or analogue media; entertainment services in the nature of production and distribution of television programmes and audio and/or video recordings provided through cable television, Internet, video on-demand, mobile devices and other distribution platforms; publishing services; entertainment; online entertainment; sporting and cultural activities; electronic games services provided by means of the Internet; the provision of online electronic publications; rental of audio and or video recordings, radio and television programmes and films; theatrical, musical, television and film entertainment services; publication of books, texts and journals online; providing digital video and or audio recordings (not downloadable) via a computer network such as the Internet; providing online electronic publications (not downloadable) online from databases or the Internet; providing electronic images and artwork (not downloadable) on-line from databases or the Internet; theatre entertainment; game shows; television entertainment services involving telephonic audience participation; interactive entertainment for use with a mobile phone; Internet based games; operation of lottery and games of chance; amusement game services; gaming services; gambling services; betting services; casino services; card game and casino tournaments, competitions, contests,*

*games and/or events; lottery services; the provision of any of the aforesaid services to mobile phones, via a mobile network, by communications satellite, by microwave or other electronic, digital and analogue media, live, electronically, via computer network, via the Internet, online and through the medium of television; organisation, production and presentation of events for educational, cultural or entertainment purposes; organisation, production and presentation of competitions, contests, games, game shows, quizzes, fun days, exhibitions, shows, roadshows, staged events, theatrical performances, concerts, live performances and participation events; organisation, production and provision of video clips via mobile or computer networks for entertainment and/or educational purposes; education and entertainment services namely editing, posting, displaying, tagging, blogging, sharing or otherwise providing data including images, graphics, sound, text or audio-visual information via the Internet or other communications network for educational and entertainment purposes.*  
(Class 41)

4. The proceedings were consolidated on 6 February 2020. As such, hereafter, “the opponent” will be used to refer to the opponents collectively; FremantleMedia Limited, FremantleMedia North America Inc and 19 TV Limited.

5. In its Notice(s) of Opposition, the opponent submits that the applied for services are encompassed by and/or closely allied to those for which the opponent’s marks are registered. Describing the “IDOL” element within the applied for mark as “prominent and distinctive”, it claims that the conceptual, visual and phonetic similarities render the competing marks overall confusingly similar.

6. In response, the applicant filed a counterstatement in which it contends that “Idol” is a common word and, to support its claim, it encloses an extract from the trade mark register, stating that 283 trade marks containing the word ‘Idol’ have been registered, all of which consequently share some degree of similarity, and co-exist, with the opponent’s marks. Based on what it therefore considers ‘a legal precedent’, it asks that its application for “Social Idol” is registered.

7. The opponent is represented by Marks & Clerk LLP, whilst the applicant is not legally represented. During the evidence rounds, the opponent elected to file evidence and the applicant written submissions. Neither party requested a hearing and only the

opponent filed written submissions in lieu. This decision will be taken following a careful reading of all the papers which I will refer to, as necessary.

### **State of the register evidence**

8. As mentioned above, to support the arguments made in its counterstatement, the applicant filed an excerpt from the trade mark register displaying the results generated by a search for trade marks containing the word “IDOL”, though I note the statuses of those marks vary. In the absence of evidence to show that any of these marks have been used in the UK, this is to be regarded as “state of the register” evidence. In the *Torremar* case, BL O/207/02, Mr G Hobbs Q.C., acting as the Appointed Person, stated that whether a consumer deems a mark to be origin specific or origin neutral:

“may be supported by evidence directed to the way in which the mode or element of expression has been used by traders and consumers more generally. In neither case can the proposition in contention be substantiated simply by evidence of entries in the register of trade marks; entries in the register do not in themselves affect the way in which marks are perceived and remembered.”

9. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and

Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71).”

10. In *British Sugar Plc v James Robertson & Sons Ltd* [1996], RPC 281, Mr Justice Jacob said:

“Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is on principle irrelevant when considering a particular mark tendered for registration, see eg *Madam Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

11. In summary, when assessing the likelihood of confusion under Section 5(2), it is necessary that I consider the potential for conflict between the applied for mark and the earlier trade marks in light of all relevant circumstances. As the above case law indicates, the existence of other trade marks on the register is not pertinent to the matter before me. Consequently, this line of defence must be dismissed.



### **The parties’ respective trading styles**

12. In its written submissions, the applicant maintains that its mark should be registered on account of the following differences in the parties’ trading styles, the majority of which specifically concern the formatting of the respective services. The applicant states:

The Trade Mark "SOCIAL IDOL" application should be approved because of the following differences:

- 1- The content will not include singing. Social Idol will be for social leaders in charity, humanitarian workers, refugee's aide, educators, environmental activists, influencers in social media, etc.
- 2- Individuals and Entities may apply.
- 3- There will be no auditions.
- 4- Applications are online only. No theater activities.
- 5- No voting. A global committee will select the Social Idol.
- 6- This is not be a TV show. Applicants apply online, shortlisted, and nomination. Winners will be notified by emails or phone calls.
- 7- It will have its own unique name and logo which will not resemble Pop Idol.
- 8- Different geographic location

13. I also note the below comparison of the marks which the applicant has included in its submissions:

7.	Name and Logo	Different 	Clearly Different 
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14. For clarity, it is worth noting here that all of the marks at issue in these proceedings are word only marks; the above representations of the marks should not therefore, be taken into account when making an assessment as to a likelihood of confusion. I refer to the following case law which explains why the above reasoning can have no bearing on the outcome of the opposition.



15. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*<sup>3</sup>, the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Differences between the services currently provided by (or intended to be provided by) the respective parties are irrelevant to the assessment I am required to make, except to the extent that those differences are apparent from the lists of services they have tendered for the purpose of the registration of their marks. My decision as to whether there is a likelihood of confusion must be based on an objective assessment of the relevant factors.

16. Moreover, in *Oakley v OHIM*, Case T-116/06, it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current trading patterns of the parties. Though it refers specifically to goods, it is also relevant when assessing competing services:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks... cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors...”

17. Further, marketing strategies are temporal and may change with the passage of time. See for instance, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

18. In light of the above, it follows that I am required to make the assessment of the likelihood of confusion notionally and objectively solely on the basis of the services, and indeed the marks, as they appear on the register. The *actual* market each party may target or what may be a contrast in the services' current format is irrelevant to that assessment.

## Decision

19. The opposition is based upon section 5(2)(b) of the Act which 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.”

20. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

21. Under the provisions outlined above, the opponent's trade marks clearly qualify as earlier marks. Of the marks relied upon by the opponent, only EUTM 8376857

("AMERICAN IDOL") and UKTM 2298224D ("IDOLS") had completed their registration procedure more than five years prior to the filing date of the applicant's mark. Consequently, in accordance with section 6A of the Act, each is subject to the proof of use provisions. In its counterstatement(s), the applicant requested that the opponent provide proof of use in respect of both marks and all services relied upon.

22. Under section 6A of the Act, the relevant period for assessing proof of use is the five-year period ending on the date that the opposed mark was applied for. For the purposes of the current opposition, the relevant period is, therefore, 10 May 2014 until 9 May 2019.

### **The opponent's evidence**

23. The opponent's evidence comprises a total of four witness statements which are supported by exhibits IB1 to IB11 and 2IB1 to 2IB13. Two of the witness statements are from Isabelle Brender, the Vice President in Brand Protection for FremantleMedia Limited and two are from Elena Nicholas, an attorney at Marks & Clerk LLP (the opponent's representatives). Ms Brender explains that the information contained within her witness statements is a combination of that which is personally known to her, some which is gleaned from the internet or general media and some which has been extracted directly from the opponent's records. Ms Nicholas explains that her witness statements should be read in conjunction with those filed by Ms Brender and are submitted to provide information in relation to Ms Brender's statements and in connection with the proof of use requests made by the applicant.

24. In her first witness statement, Ms Brender provides a history of the opponent's 'American Idol' brand, describing it as a "singing competition television series... in which aspiring singers compete for a recording contract and a shot at wealth and fame". American Idol originally aired in the United States on 11 June 2002. It ran for 15 seasons until April 2016, returning to television in March 2018 after a year-long hiatus. For eight consecutive years between 2004 and 2011, it was the highest rated show in the US. It is broadcast to over 100 nations across the world including the UK. Ms Brender explains that on account of its "immense popularity and fame", the brand

became a recognised springboard for catapulting its contestants to stardom and international fame.

25. Ms Brender includes in her witness statement an overview of where the show was broadcast and/or available in the UK each year:

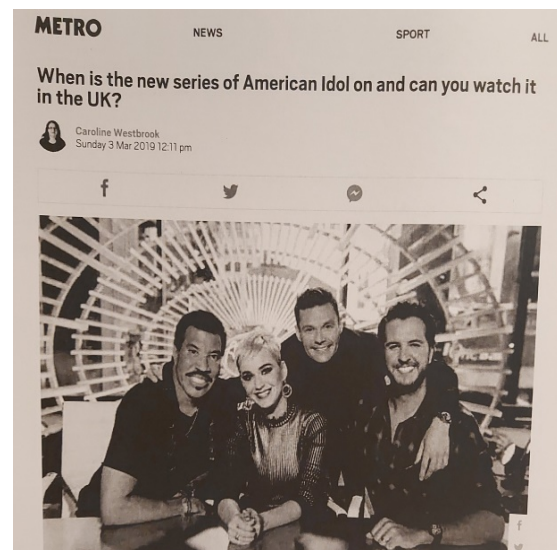
Season	Broadcast Channel	Year
1	ITV2	2002
2	ITV2	2003
3	ITV2	2004
4	ITV2	2005
5	ITV2	2006
6	ITV2	2007
7	ITV2	2008
8	ITV2	2009
9	ITV2	2010
10	ITV2	2011
11	ITV2	2012
12	5STAR	2013
13	5STAR	2014
14	Not broadcast on television in the United Kingdom	2015
15	4Music	2016
16	Amazon	2018
17	Netflix	2019
18	Netflix (to be released)	2020

26. She also provides the associated viewing figures<sup>1</sup>, though she explains that viewing figures are not available for the years where the show was available on the Netflix or Amazon Prime platforms (2018 onwards).

Season	Channel	Dates	Average audience ('000s)
Season 2	ITV2	January - May 2003	262
Season 3	ITV2	January - May 2004	436
Season 4	ITV2	January - May 2005	581
Season 5	ITV2	January - May 2006	613
Season 6	ITV2	January - May 2007	654
Season 7	ITV2	January - May 2008	586
Season 8	ITV2	January - May 2009	517
Season 9	ITV2	January - May 2010	574
Season 10	ITV2	January - May 2011	565
Season 11	ITV2	January - May 2012	516
Season 12	5STAR	January - May 2013	211
Season 13	5STAR	February - June 2014	51
Season 15	4Music	January - April 2016	58

<sup>1</sup> Enclosed at Exhibit IB2 is a spreadsheet attesting to the ratings of season 15 which aired on 4Music in 2016

27. At Exhibits IB1, IB3, IB4, IB5 and IB6 Ms Brender encloses various media articles attesting to the broadcasting of Seasons 12, 15, 16, 17 and 18 respectively and detailing various milestones enjoyed by the show. Such articles were available to view in national publications including *The Guardian*, *Evening Standard* and *Radio Times*. Exhibit IB7 comprises a variety of articles which appeared in publications circulated across the UK, with dates ranging from 2012 to 2019, and focus on the American Idol brand. Examples of the headlines attributed to such articles are provided below:



28. Exhibit IB8 concentrates on the American Idol brand's social media presence. Of the 819,000 followers of the opponent's American Idol and Idols Global Facebook pages, 1,700 are based in the UK. The American Idol Twitter page currently has just under two million followers and its Instagram profile has 1.1 million followers though, whilst both are available to UK consumers, it is not possible to assess how many are based in the United Kingdom. The American Idol Youtube channel has 29,000 subscribers based in the UK and has received 43 million views from UK consumers.

29. At Exhibit IB9 are extracts from various websites detailing nominations and awards won by American Idol during its time on air. According to the Emmys website<sup>2</sup>, the show earned 67 nominations, 8 Emmys and 1 Honor up to 2016. Also enclosed is an extract from what appears to be the official Grammy Awards website which shows how many awards and nominations have been earned amongst a selection of ten American Idol contestants featuring from seasons 1 to 6 and season 8. At IB10 are examples of the merchandise associated with the show (clothing and prints, for example), available for UK consumers to purchase from retailers such as Amazon, eBay and Etsy.

30. Exhibit IB11 comprises an extensive selection of articles published between 2013 and 2019 in media outlets circulated specifically in Ireland. The content of the articles includes changes to the American Idol judging panel, details of high profile performances and noteworthy events from the shows themselves.

31. Ms Brender states that it is the policy of FremantleMedia Limited not to publicise turnover figures for any of its television shows, American Idol included. She also advises that the opponent does not have the permission of its broadcasters to disclose how much it spends on advertising. She does, however, state that the turnover for American Idol was estimated at \$900 million for 2004 and that its total television revenue for the first eight seasons is estimated at \$6.4 billion. She also refers to, and encloses, articles which refer to product placement and sponsorships enjoyed by the American Idol brand, with global companies including *Coca-Cola* and *Ford*. One

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<sup>2</sup> <https://www.emmys.com/shows/american-idol>

article<sup>3</sup> shows that during the 2011-12 season, the average cost for a 30-second advert during the Wednesday night American Idol showing cost \$502,000. By the 2015-16 season, the cost had dropped to \$151,245. Despite these omissions in the opponent's evidence, Ms Brender submits that "the long standing and undisputed ratings figures, audience numbers, publicity materials, the over 250 million digital downloads sold, the sponsorship deals, awards and associated merchandise, demonstrate extensive and continuous use of the AMERICAN IDOL brand in the United Kingdom...and prove that there has been real commercial exploitation of the AMERICAN IDOL brand in the United Kingdom market".

32. Ms Brender's second witness statement serves to provide further information and introduces additional exhibits 2IB1 to 2IB13 focusing predominantly on the use made of the opponent's remaining marks; IDOLS, NEPAL IDOL and POP IDOL.

33. Ms Brender refers to the following definition of a TV format: "a programme or programme concept with distinct elements that can be exported and licensed to production companies and broadcasters outside its country of origin for local adaptation."<sup>4</sup> Ms Brender submits that the opponent is one of the largest TV format production companies in the world and one such format is its IDOLS brand. The IDOLS format first premiered in the UK in October 2001 with British television show POP IDOL which ran from 2001 to 2003 and, at its peak, attracted an audience of 13.3 million viewers. Since then, Ms Brender states that IDOLS has become a worldwide phenomenon, with 281 series produced and adapted in over 54 territories worldwide and its various versions broadcast to over 150 countries. The brand has been carefully nurtured via a consistency of names, graphics, music, programme, structure etc to ensure that viewers worldwide can readily identify the IDOLS brand.

34. At Exhibit 2IB1 is an article titled *Format Creation*<sup>5</sup>, which offers readers a guide on how to create a game show. At Exhibit 2IB2 are two articles which refer specifically

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<sup>3</sup> *Variety*, 30 June 2017

<sup>4</sup> *Schmitt, Bisson, and Fey, (2005)*

<sup>5</sup> [www.tvformats.com/formats.html](http://www.tvformats.com/formats.html)

to the opponent's IDOLS brand within the context of TV formats at large<sup>6</sup>, with the second article describing IDOLS as a "super-format".

35. Exhibit 2IB3 encloses several articles referencing the aforementioned TV show POP IDOL, the first of which is headed "Nestle agrees £6m ITV Pop Idol sponsorship deal" and dated 29 January 2003<sup>7</sup>. The remaining articles are more recent (2016, 2017 and 2018) and offer readers an update on the contestants from the show, bearing headlines such as "Pop Idol ended 15 years ago – but where are they now?"<sup>8</sup>. Also enclosed are screenshots from a YouTube video entitled 'Pop Idol series theme', which feature a variety of logos representative of different 'Idol' shows from around the world and serve to illustrate the visual consistency of the IDOLS brand across all its derivative television shows.



36. Exhibit 2IB4 shows results generated by a YouTube search for "pop idol theme", with videos uploaded as recently as 2016, 2017, 2018 and 2019, and all relating to the opponent's IDOLS brand.

37. At Exhibit 2IB5, Ms Brender encloses a promotional presentation used by the opponent centred on the global success achieved by the IDOLS brand, with specific reference made to countries including America, Germany, France and China. Exhibit 2IB6 is headed 'Idols Around the World' and lists the region of the world, the original title of the 'Idols' show(s) broadcast within that region, the network it was broadcast to and the winners of each season. The list shows that, in some countries, nationality is used as a prefix to 'IDOL'; "Australian IDOL", "Singapore IDOL" and more recently "Nepal IDOL", to name a few. Where this format was not considered commercially or

<sup>6</sup> <https://www.thedrum.com/opinion/2018/07/09/ideas-scale-how-create-global-tv-format> and <https://scriptmag.com/features/evolution-of-televiaion-formats-where-we-at>

<sup>7</sup> <https://www.campaignlive.co.uk/article/nestle-agrees-6m-itv-pop-idol-sponsorship-deal/169259>

<sup>8</sup> *Buzzfeed*



culturally appropriate, alternatives were adopted. In countries such as Belgium and Brazil, the regional translation of IDOLS was chosen (IDOOL and IDOLOS) and in countries such as Poland and Norway, the singular version of IDOLS was used (IDOL). Other variations include SUPER IDOL in Greece, MUSIC IDOL in Bulgaria and POP IDOL in the UK. In countries where the show's title deviates from the inclusion of IDOL or IDOLS (NOUVELLE STAR in France or TURKSTAR in Turkey, for example), Ms Brender maintains that the IDOLS brand could still be identified as the TV format responsible, on account of the consistent elements such as graphics, music and programme structure.

38. Exhibits 2IB7 to 2IB10 focus on the marketing efforts made by the opponent in respect of its IDOLS brand. Exhibit 2IB7 comprises extracts from a 2020 catalogue promoting the opponent's various shows and formats, including those under the IDOLS brand, and extracts from the magazine 'The Formats COLLECTION', published in 2017 and 2018 in anticipation of MIPTV and MIPCOM, which are annual trade shows targeting companies producing, buying, selling, financing and distributing entertainment content. Ms Brender informs me that a thousand copies of the magazine are distributed at the trade shows and that further copies are distributed to clients worldwide.

39. At Exhibit 2IB8<sup>9</sup>, Ms Brender refers me to the opponent's website where the IDOLS brand can be found under the website's 'Shows' section. It reads:

"Idols has become the defining entertainment show of our time revolutionising and pioneering the reality competition genre."

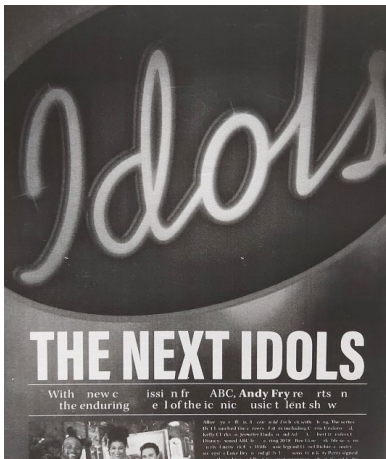
40. At Exhibit 2IB9 are extracts from another of the opponent's websites<sup>10</sup> which is aimed more so at buyers and commissioners as it offers access to more in-depth information relating to the opponent's formats or shows.

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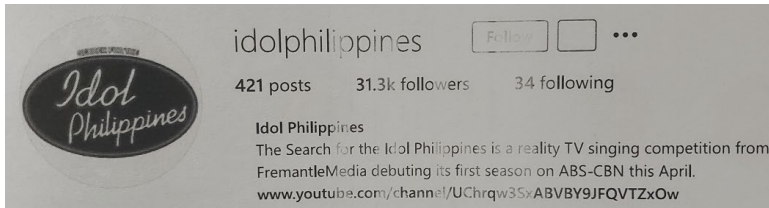
<sup>9</sup> [www.Fremantle.com](http://www.Fremantle.com)

<sup>10</sup> [www.fmscreenings.com](http://www.fmscreenings.com)

41. The promotional materials displayed by the opponent at MIPCOM in 2017 and MIPTV in 2018 as well as a feature dated 2018 which appeared in 'The Formats COLLECTION' are enclosed at 2IB10. Extracts can be seen below:



42. Of the 819,000 followers to the dedicated Idols Global Facebook page, 1,700 are based in the United Kingdom. At Exhibit 2IB11 are extracts from the local Facebook pages of the television shows broadcast under the IDOL brand in Cambodia, Finland, Spain, Sweden and the Netherlands. The dedicated Idols Global YouTube channel has 12,300 subscribers from the United Kingdom, with its videos attracting 19.8million views from within the UK. For Exhibit 2IB12, Ms Brender encloses the results generated by a YouTube search for "Idols" followed by consecutive years from 2012 to 2019; "Idols 2014", for example. Ms Brender states that all of the videos shown relate to shows offered under the opponent's Idols brand. At Exhibit 2IB13 is a sample of the respective Instagram accounts attached to different television shows broadcast under the brand in various countries. A selection is shown below:



43. Ms Brender concludes that “the extensive use and commercialisation of the brand IDOLS... has resulted in IDOLS being a well-known medial brand amongst the UK protection industry and professionals, as well as being instantly recognisable to the public.”

### Proof of use

44. The relevant statutory provisions are 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 relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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) [...]

(5A) [...]

(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.”

45. Section 100 of the Act is also relevant, which reads:

“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.”

46. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the First Earlier Registration is the 5-year period ending with the date of the application in issue i.e. 10 May 2014 to 9 May 2019.

47. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

48. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C., as the Appointed Person, stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

49. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person, stated that:

“22. The burden lies on the registered proprietor to prove use... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the



tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

50. When making an assessment as to whether genuine use of the opponent’s marks has been shown, I must also consider the way in which the marks have been used. Section 6A(4)(a) of the Act provides for use of trade marks in a form differing in elements which do not alter the distinctive character of the mark as registered. In *Nirvana Trade Mark*, Case BL O/262/06, Richard Arnold Q.C. (as he then was), as the Appointed Person, considered the law in relation to the use of marks in different forms and summarised the test (albeit in relation to the analogous principle when dealing with revocation claims) as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

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

51. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

"31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article

15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

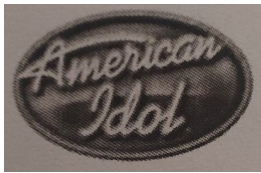
33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

52. Whilst there is substantial evidence showing the opponent's marks presented in the plain word, as registered, I acknowledge that in many of the exhibits, the

AMERICAN IDOL mark in particular, is presented alongside additional stylistic elements, as shown below:



As seen, the words 'American Idol' are presented in a handwritten-style typeface and encased within an oval shape adorned by a border. Applying the guidance set out by Arnold J., I find the stylised mark to be an acceptable variant as, in my view, the stylisation has no bearing on the mark's distinctive character, which continues to reside within the words themselves. It is also clear from *Colloseum* that use of a mark in conjunction with other matter can constitute genuine use and I find that to apply here. The words within the mark are essentially unaltered and, consequently, the mark continues to serve as an indicator of trade origin.

53. The opponent's IDOLS mark is predominantly presented in word-only format, though there is evidence showing it presented using the same stylisation as the AMERICAN IDOL mark. Applying the same reasoning given above, I find the stylised adaptation of IDOLS an acceptable variant of the registered mark.

54. I turn now to consider the sufficiency of the evidence. I bear in mind that proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" does not constitute genuine use.

55. Although, as the opponent admits, the evidence fails to provide any tangible information relating to either brand's turnover or advertising expenditure (within the relevant period, at least), an assessment of genuine use is a global assessment, which requires looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself. In my view, it is apparent from the evidence that, during the relevant period, the opponent has made great efforts to promote both its

AMERICAN IDOL and IDOLS brand and nurture a longstanding position within the entertainment arena. Though the promotional materials enclosed were displayed at international trade shows which did not, to my knowledge, target UK consumers specifically, it demonstrates an intention on the part of the opponent to generate a wider interest and global awareness in its IDOLS brands. Whilst there is a clear decline in the viewing figures for AMERICAN IDOL in the UK, and indeed I note that some articles refer to a drop in the show's ratings, AMERICAN IDOL, and the wider IDOLS brand, maintained a presence by garnering various headlines in national publications which I understand to have a wide readership in the UK. Moreover, even where the ratings were at their lowest, they were by no means insignificant and, presumably, showed a high enough level of interest amongst UK consumers for streaming services including Netflix and Amazon Prime to ensure the show's continued availability on their behalf. The social media following earned by the opponent also demonstrates a significant degree of interest, or certainly awareness, of its television shows amongst UK consumers.

56. I refer to the below passage from Ms Sam Glynne, global Vice President of branded entertainment at Fremantle Media<sup>11</sup>:

“...TV formats are conceived with great care, designed to have a long lifespan and international appeal. They are nurtured to keep them evergreen. They attract huge, highly engaged audiences who actively choose to spend time with them... their lifeblood is their Intellectual Property, or IP.”

In my view, the application of care and nurturing Ms Glynne refers to is apparent throughout the opponent's evidence. The consistency in the structure and presentation of the opponent's marks shows a deliberate effort to create a recognisable brand within the entertainment industry in respect of its IDOLS format and all derivatives which followed. I keep in mind when considering genuine use that American Idol experienced a hiatus of one year in 2017, during the relevant period. Ms Nicholas states, however, that activities continued under the mark via publicity of the contestants, award ceremonies and publicity in the press. The evidence shows continued promotion of

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<sup>11</sup> Enclosed at Exhibit 2IB2

the American Idol brand and the articles are indicative of a continued UK media interest. Nevertheless, the show resumed in 2018 and was available for broadcast to a UK audience. Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated genuine use of both its AMERICAN IDOL and IDOLS marks during the relevant period.

57. I must now consider whether, or to what extent, the evidence shows use of the opponent's AMERICAN IDOL and IDOLS marks in relation to the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C., as the Appointed Person, summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

58. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

59. In its Notice of Opposition, the opponent claims to have used its AMERICAN IDOL mark in respect of all class 41 services for which it is registered. In its submissions, the opponent submits that its evidence shows use of the mark in respect of *at least*:

*Education and entertainment services in the form of television programme, radio, cable, satellite and Internet programmes; production and presentation of radio and television programmes, cinematographic films, shows, videos, DVDs, cable programmes, satellite programmes and/or Internet programmes; entertainment by means of theatre productions; organization of competitions (education or entertainment); interactive telephone competitions; publishing; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the Internet; organization of shows; rental of sound recordings and of pre-recorded shows, films, radio and television performances; production of*

*video tapes and video discs; radio entertainment; television entertainment; cinema entertainment; theatre entertainment; game shows; television entertainment services involving telephonic audience participation; interactive entertainment for use with a mobile phone; the provision of any of the aforesaid services to mobile phones, via a mobile network, by communications satellite, by microwave or other electronic, digital and analogue media, live, electronically, via computer network, via the internet, online and through the medium of television; organisation, production and presentation of events for educational, cultural or entertainment purposes; organisation, production, promotion, management and presentation of competitions, contests, games, game shows, quizzes, fun days, exhibitions, shows, roadshows, staged events, raves, theatrical performances, concerts, live performances and participation events; organisation and production provision of video clips via mobile or computer networks for entertainment and/or educational purposes.*

60. The opponent claims use of its IDOLS mark in respect of:

*Education and entertainment services all relating to television, cinema, radio and theatre; production and presentation of radio and television programmes, films and shows; education by or relating to television and radio; entertainment by or relating to television and radio; organization of competitions (education or entertainment); interactive telephone competitions; publishing; production of cinematographic films, shows, radio programmes and television programmes; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the World Wide Web and the Internet; organization of shows; rental of sound recordings and of pre-recorded shows, films, radio and television performances; production of video tapes and video discs; radio entertainment; television entertainment; cinema entertainment; theatre entertainment; game shows; television entertainment services involving telephonic audience participation (Class 41)*

61. In the second witness statement of Elena Nicholas, she asserts that the evidence presented shows use of the IDOLS mark as:

“a) the name of the TV Format and concept and b) part of the titles of various television shows in the UK and beyond, available to viewers in the UK...

These materials demonstrate, use of the earlier mark IDOLS in relation to *education and entertainment services* at large and the *provision of such services relating to television and to shows*. They also demonstrate use of the

mark IDOLS in connection with *the production and presentation of shows and television programmes, organisation of competitions, rental of pre-recorded shows, television performances, game shows and television entertainment services involving telephonic audience participation.*”

62. For the avoidance of doubt, it seems worth stating here that the use made of the word IDOLS as part of the titles of various television shows is not relevant to the matter before me. I must consider the deliberate use made of the IDOLS mark itself which, as Ms Nicholas identifies, is as a television format and concept.

63. In determining a fair specification for each of the opponent’s marks, I am mindful of the different ways in which they have been used. I must also consider how the average consumer is likely to describe the services for which use has been shown. The opponent’s IDOLS mark has acted almost as a ‘house brand’, being used essentially as an umbrella term for the TV format which captures within it many derivatives of ‘IDOLS’ television shows interpreted by multiple territories worldwide, including in the UK. This is in contrast to the opponent’s AMERICAN IDOL mark which has been used explicitly as the title of one such show. Still, whilst I acknowledge that ‘IDOLS’ has acted as somewhat of a background mark, and AMERICAN IDOL at the forefront, the evidence shows that the opponent has utilised IDOLS to promote entertainment services via the medium of its various derivative television shows. Furthermore, I have found that the genuine use requirements are met by each mark. That being so, I consider a fair specification for both marks to be:

*Entertainment services in the form of a television programme; organisation, production and presentation of shows.*

### **Section 5(2)(b) - Case law**

64. The following principles are gleaned from the decisions of the courts of the European Union 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 Office for Harmonization in the*



*Internal Market (Trade Marks and Designs) (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.*

**The principles:**

(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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

**Comparison of services**

65. The competing services are laid out in the table below:

Opponent’s services	Applicant’s services
<p>EUTM 8376857 “AMERICAN IDOL” and UKTM 2298224D “IDOLS” <i>Entertainment services in the form of a television programme; organisation, production and presentation of shows.</i></p> <p>UKTM 3130417 “NEPAL IDOL” <i>Entertainment services; entertainment services in the nature of production and distribution of television programmes and audio and/or video recordings provided through cable television, Internet , video on-demand, mobile devices and other distribution platforms; electronic games services provided by means of the Internet; interactive entertainment for use with a mobile phone; Internet based games; operation of lottery and games of chance; amusement game services; gaming services; gambling services; betting services; casino</i></p>	<p><i>Entertainment Show;</i> <i>Entertainment in the nature of a social show.</i></p>

*services; card game and casino tournaments, competitions, contests, games and/or events; lottery services ; the provision of any of the aforesaid services to mobile phones, via a mobile network, by communications satellite, by microwave or other electronic, digital and analogue media, live, electronically, via computer network, via the Internet, online and through the medium of television; organisation, production and presentation of events for entertainment purposes; organisation, production and provision of video clips via mobile or computer networks for entertainment purposes; entertainment services namely editing, posting, displaying, tagging, blogging, sharing or otherwise providing data including images, graphics, sound, text or audio-visual information via the Internet or other communications network for entertainment purposes.*

EUTM 15739196 “POP IDOL”

*Entertainment and education services; educational services relating to entertainment; information relating to entertainment or education, provided on-line from a computer database or the Internet or by communications satellite, microwave or other electronic, digital or analogue media; entertainment services in the nature of production and distribution of television programmes and audio and/or video recordings provided through cable television, Internet, video on-demand, mobile devices and other distribution platforms; publishing services; entertainment; online entertainment; sporting and cultural activities; electronic games services provided by means of the Internet; the provision of online electronic publications; rental of audio and or video recordings, radio and television programmes and films; theatrical, musical, television and film entertainment services; publication of books, texts and journals online; providing digital video and or audio recordings (not downloadable) via a computer network such as the Internet; providing online electronic publications (not downloadable) online from databases or the Internet; providing*

*electronic images and artwork (not downloadable) on-line from databases or the Internet; theatre entertainment; game shows; television entertainment services involving telephonic audience participation; interactive entertainment for use with a mobile phone; Internet based games; operation of lottery and games of chance; amusement game services; gaming services; gambling services; betting services; casino services; card game and casino tournaments, competitions, contests, games and/or events; lottery services; the provision of any of the aforesaid services to mobile phones, via a mobile network, by communications satellite, by microwave or other electronic, digital and analogue media, live, electronically, via computer network, via the Internet, online and through the medium of television; organisation, production and presentation of events for educational, cultural or entertainment purposes; organisation, production and presentation of competitions, contests, games, game shows, quizzes, fun days, exhibitions, shows, roadshows, staged events, theatrical performances, concerts, live performances and participation events; organisation, production and provision of video clips via mobile or computer networks for entertainment and/or educational purposes; education and entertainment services namely editing, posting, displaying, tagging, blogging, sharing or otherwise providing data including images, graphics, sound, text or audio-visual information via the Internet or other communications network for educational and entertainment purposes.*

66. The General Court (“GC”) provided guidance as to when goods (though it equally applies to services) can be considered identical, where they are not literally so, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05. It stated:

“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 trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

67. To my mind, the services for which the applicant seeks registration are encompassed by, and therefore identical to, *entertainment services*, which the opponent’s POP IDOL and NEPAL IDOL marks are registered for.

68. When considering the similarity between the applied-for services and those for which I have found use in respect of the opponent’s AMERICAN IDOL and IDOLS marks, 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods 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.

### **Entertainment show**

69. The nature of the 'show' is not clear from the above term, for which the applicant seeks registration. I have found the opponent's AMERICAN IDOL and IDOLS marks to have shown use for *entertainment services in the form of a television show and organisation, production and presentation of shows*. Given that an 'entertainment show' could comprise a television show, I find it to encompass the opponent's *entertainment services in the form of a television show* and to therefore be identical. However, if I am wrong in that approach, I would submit that the respective services are at least highly similar on account of their shared use, insofar as each is provided for entertainment purposes, shared consumers, what is likely to be a coincidence in trade channels and an opportunity for competitiveness. Whilst I accept that there may be a difference in the services' nature, I maintain that the services are at least highly similar.

#### **Entertainment in the nature of a social show**

70. I am not aware of a precise definition for 'social show'. Whilst I keep in mind the applicant's explanation that "*Social Idol will be for social leaders in charity, humanitarian workers, refugee's aide, educators, environmental activists, influencers in social media, etc*", I must allow for all services the term is likely to encapsulate. Given that the services are intended to provide entertainment, they are selected essentially for the same purpose as the opponent's *entertainment services in the form of a television show*. There is likely to be a shared user group, similar trade channels and an opportunity for competitiveness insofar as consumers will consider their preferred medium of entertainment. Although, as I said, I am unaware of precisely what a 'social show' entails, it could allow for a distinction in the services' nature. Weighing all factors, I find the similarity to be of a high degree.

#### **The average consumer and the nature of the purchasing act**

71. As indicated in the above case law, it is necessary for me to determine who the average consumer is for the services at issue. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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.”

72. The average consumer of the services at issue here is likely to be a member of the general public who is seeking out entertainment, though based on the evidence before me, the immediate consumer could also be a broadcaster, for example, looking to adapt or interpret the ‘IDOLS’ format. The means of selection is likely to be primarily visual, with the services mostly advertised via online outlets, traditional advertisements in magazines or on television, or in trade catalogues. However, as it is not unusual for consumers to exchange recommendations in this field, I do not discount the significance of aural considerations. The services are unlikely to be selected with a high degree of frequency, though there could be a measure of regularity for the end consumer, who is invited to engage with the services on a weekly basis, for example. When approaching the selection, consumers are likely to consider the content of the services, their quality and general compatibility. Weighing all factors, it seems likely that the general public will apply a medium degree of attention, but for consumers approaching the selection as a professional transaction, a high level of attention is likely to be applied.

### **Comparison of trade marks**

73. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall

impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. ...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.”

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

75. The trade marks to be compared are displayed in the table below:

<b>Opponent's trade marks</b>	<b>Applicant's trade mark</b>
AMERICAN IDOL  IDOLS  POP IDOL  NEPAL IDOL	Social Idol

76. The applicant's mark is comprised only of the words 'Social Idol'. In the absence of any stylisation or figurative elements, the mark's overall impression resides within



the words themselves. 'Idol' is likely to be viewed as the mark's subject, with 'Social' serving as a descriptor (of the Idol). On that basis, I would attribute a greater degree of distinctiveness to 'Idol'.

77. When it comes to the overall impression of the opponent's AMERICAN IDOL, POP IDOL and NEPAL IDOL marks, 'IDOL' is likely to be seen as the subject, with the marks' first word acting either as a descriptor or indication of the 'idol's' specialism. On account of the roles played by the words within each mark, I find IDOL to be the more distinctive of the two in each.

78. The opponent's IDOLS mark comprises only one word. The mark's overall impression lies solely in the word 'IDOLS'.

79. I will assess the visual, aural and conceptual similarity between the applicant's mark and each of the opponent's marks in turn. When assessing the marks' similarity, particularly the visual and aural, I will bear in mind that, at least generally, the beginnings of marks have more of an impact on consumers than their endings<sup>12</sup>.

### **The opponent's AMERICAN IDOL mark**

80. Visually, the respective marks coincide insofar as they each comprise only two words; the second of which is 'IDOL/Idol'. Nothing turns on the variation in capitalisation given that fair and notional use allows the opponent to present its mark in any casing and/or standard typeface. There are eight letters in the first word of the opponent's mark and six in the applicant's. Weighing all factors and keeping in mind where the identical element is positioned within the marks, I find the visual similarity to be fairly low.

81. The opponent's mark is likely to be articulated in six syllables; AM-ER-IC-AN-I-DOL and the applicant's mark in four; SO-CIAL-I-DOL. Whilst the latter two syllables of each mark are identical, there is no similarity in the syllables which precede them. Again, keeping in mind where the identity lies, the aural similarity is of a low degree.

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<sup>12</sup> *El Corte Inglés, SA v OHIM*.

82. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

83. Both marks are likely to offer the consumer a readily identifiable concept, given that each combines two relatively standard dictionary words. In both, 'IDOL' will be understood to be a person or object of excessive devotion or admiration<sup>13</sup>. With the preceding words acting as descriptors, consumers are likely to conceptually interpret the opponent's mark as referring to an idol who is American, or at least represents America, and the applicant's mark as an idol in a social field, with 'social' understood to be a descriptive word either for things relating to society, status or the nature of interactions or activities between individuals<sup>14</sup>. Alternatively, it could be a reference to social media channels or platforms. Whilst the fields are different, both marks refer to an idol. On balance, I find the conceptual similarity to be of no more than a medium degree.

### **The opponent's IDOLS mark**

84. The opponent's mark consists of one five-letter word; the applicant's mark of two words of six letters and four letters, respectively. The only common visual element shared between the marks is the inclusion of letters I-D-O-L, though of course in the opponent's mark an 'S' has been added. I find the visual similarity to be low.

85. The opponent's mark will be vocalised in two syllables; I-DOLS. Comparing this to the applicant's SO-CIAL-I-DOL, I consider the aural similarity to be of a low degree.

86. Given what I have said above regarding consumers' understanding of the word 'idol', the opponent's mark will simply be seen as its plural form, meaning more than one idol. Although I accept that 'idol' remains in the singular tense within the applicant's

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<sup>13</sup> <https://www.collinsdictionary.com/dictionary/english-thesaurus/idol>

<sup>14</sup> <https://www.collinsdictionary.com/dictionary/english/social>

mark, the conceptual message evoked is highly similar. That said, in the opponent's mark, 'IDOLS' is unparticularised and, consequently, remains a broad term, whereas the applicant's mark refers specifically to a *social* idol. All things considered, I find the conceptual similarity to be of at least a medium degree.

### **The opponent's POP IDOL mark**

87. Visually, both marks see the word IDOL preceded by a different word; consisting of three letters in the opponent's and six in the applicant's. Despite both preceding words having an O as their second letter, that represents the extent of the marks' visual similarity, which I would pitch at no more than a medium degree.

88. Aurally, the opponent's mark is likely to be articulated in three syllables; POP-I-DOL. As said, the applicant's mark comprises four syllables; SO-CIAL-I-DOL. On that basis, the aural similarity between the marks is fairly low.

89. Conceptually, the marks share an identical element insofar as each refers to an idol. Whilst I accept there are a number of possible definitions, in my view, given the context, 'POP' is likely to be seen conceptually as a reference to a specific genre of music and a POP *IDOL*, therefore, as an individual to be admired within that field. Whilst the respective fields are distinct, both Social and POP offer some degree of contextual insight. On balance, the marks' conceptual similarity is of a medium degree.

### **The opponent's NEPAL IDOL mark**

90. The respective marks consist of two words, the second of which is IDOL. The first word in the opponent's mark comprises six letters and the first word in the applicant's comprises five; the final two letters of each are A-L. Keeping in mind where the similarities are positioned within the marks, I consider the visual similarity between the marks is of a medium degree.

91. Both marks are likely to be articulated in four syllables; NE-PAL-I-DOL and SO-CIAL-I-DOL. Whilst the number of syllables is identical and the latter two the same in

each mark, I see little aural similarity in the marks' first two syllables. On balance, I find the aural similarity is of no more than a medium degree.

92. Conceptually, consumers will identify the opponent's mark as an idol originating from or representing the country of Nepal and the applicant's as an idol based on its social superiority or standing. Both marks bring to mind a representation of an idol, but that is where the conceptual similarity ends. The marks' conceptual similarity is of no more than a medium degree.

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

93. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. 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).”

94. When it comes to assessing marks’ *inherent* distinctiveness, it is widely accepted, though only a guideline, that words which are invented often possess the highest degree of distinctive character, whilst words which are suggestive or allusive of the goods or services relied upon generally possess the lowest. The distinctiveness of a mark can be enhanced by virtue of the use made of it, with the relevant date for assessing enhanced distinctiveness being the date of the application at issue i.e. 9 May 2019.

#### **The opponent’s AMERICAN IDOL mark**

95. When considered in respect of the services relied upon, inherently, AMERICAN IDOL is likely to give consumers an indication of the type of content they can expect from the entertainment against which the mark is used, insofar as it seeks to find an ‘idol’ to represent America, though it is not clear in which field or specialism. On that basis, I would place the mark’s inherent distinctiveness at a fairly low level. However, the use made of the mark awards it an enhanced degree of distinctiveness in respect of *entertainment services in the form of a television programme and the organisation, production, promotion, management and presentation of shows*.

#### **The opponent’s POP IDOL mark**

96. The opponent’s mark is comprised of two ordinary words, the meanings of which will be easily understood by the average consumer. When considered in respect of some services for which the mark is registered, the words paired together may be suggestive of an entertainment format whereby a single person is identified on account of their talent, specifically in pop music. That said, the term is not directly descriptive nor consistently allusive towards all of the registered services. On balance, I would attribute a fairly low degree of inherent distinctiveness to the mark.

#### **The opponent’s IDOLS mark**

97. Inherently, the mark is not descriptive nor allusive of the services at issue, though for some, could be an indication of content which focuses on individuals who excel in a specific field and may therefore be considered 'idols'. As this is where the allusion ends, I find the mark to possess a medium degree of inherent distinctiveness. In relation to the services where the opponent has shown extensive use of its IDOLS brand, it has acquired an enhanced degree of distinctiveness.

### **The opponent's NEPAL IDOL mark**

98. Both words within the mark are likely to be easily and readily understood by the average consumer. Consequently, in this mark, consumers are likely to identify an idol who represents the Asian country of Nepal. Inherently, this is likely to be considered an insight into the show's content, albeit of a limited degree. The mark is not directly descriptive nor allusive toward the services for which it is registered. I find the inherent distinctiveness of the mark to be fairly low.

### **Likelihood of confusion**

99. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

100. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

101. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.””

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

102. In *Kurt Geiger v A-List Corporate Limited*<sup>15</sup>, Mr Purvis, as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

103. Earlier in this decision I reached the following conclusions in respect of the opponent’s marks:

- The competing services are at least highly similar, if not identical;
- The average consumer is a member of the general public or a professional user. Visual considerations are likely to play the predominant role in the selection process, though aural considerations are also relevant;
- Consumers are likely to pay at least a medium degree of attention when selecting the services, or a high degree where approached professionally;
- The marks’ visual similarities are of either a low, fairly low, no more than medium or medium degree; the aural similarities of a low, fairly low or no more than medium degree and the conceptual similarities of a medium or at least medium degree.
- The opponent’s AMERICAN IDOL mark and IDOLS marks possess a fairly low or medium degree of inherent distinctiveness, respectively, however they enjoy

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<sup>15</sup> BL O-075-13



an enhanced degree of distinctiveness in respect of the services for which they have shown use. The opponent's POP IDOL and NEPAL IDOL marks are inherently distinctive to a fairly low degree.

104. To make the assessment as to a likelihood of confusion, I must adopt the global approach advocated by the case law and take account of my earlier conclusions. I keep in mind the average consumer for the services at issue, the nature of the purchasing process and the fact that the average consumer rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them retained in their mind.

105. Based on my findings regarding the marks' similarity and my conclusions concerning the distinctiveness of the earlier marks, I plan to approach the assessment initially on the basis of the opponent's AMERICAN IDOL mark as this seems to present the best prospect of success.

106. I begin by considering a likelihood of direct confusion. Although the respective marks each comprise two words, the second of which is identical (IDOL/Idol), to my mind, there are too many differences in the marks' first words, which are likely to carry the greater weight, to engage direct confusion. The low degree of visual and aural similarity between the marks is likely to steer consumers from simply mistaking one mark for the other, even where identical services are in play.

107. As the above case law indicates, indirect confusion involves more of a thought process on the part of the average consumer. I keep in mind when considering a likelihood of such confusion that I have found the opponent's mark to possess an enhanced degree of distinctiveness in respect of services which are identical or highly similar to those for which the applicant seeks registration. Clearly, the common element between the respective marks is the word IDOL/Idol, which is the second of two words in each mark. Whilst I accept that the marks' first words introduce different concepts, each acts as a descriptive prefix serving to introduce the subject of the mark; the idol. This is a common conceptual tie between the marks, which consumers are likely to readily identify. Coupled with the distinctiveness of the earlier mark, on balance, I find it likely that this will lead consumers familiar with the opponent's mark

to conclude that the applicant's mark originates from a related, if not the same, entity as the opponent's. Both are used (or are intended to be used) in respect of entertainment services and both marks are suggestive toward a search for a single 'idol'. With regard to the differing descriptors (AMERICAN/Social), in this field, in my experience, it would not be unusual for television formats to be approached this way; with one common element running throughout different derivatives and only the descriptive elements amended or revised (be it geographical or content-based). This is something the average consumer would be accustomed to identifying and, consequently, would not be sufficient to steer them from blurring the marks' respective origin(s). Weighing all factors, I am of the view that indirect confusion would occur, with consumers concluding that the marks share the same, or at least an economically-linked origin based on the shared use of 'IDOL', preceded by a descriptive or informative element.

108. For completeness, I turn briefly to consider a likelihood of confusion between the applicant's mark and the opponent's POP IDOL mark, given that identical services are in play and that much of the above reasoning can be applied to my assessment. Given the visual and aural differences in play between the marks' first words (POP/Social), direct confusion is likely to be bypassed by the average consumer. Turning to consider indirect confusion, consumers are likely to identify that each mark comprises two words; the first of which being a descriptive element, or at least an element which is suggestive toward the services' context or content, and the second being the identical word 'IDOL/Idol'. When utilised in respect of identical services consumers are, in my view, likely to wrongly attribute this shared structure to the respective parties being the same, or at least related. In other words, indirect confusion will occur.

## **Conclusion**

**109. Given that I have found a likelihood of confusion in respect of the opponent's AMERICAN IDOL and POP IDOL marks, it would put the opponent in no more of a favourable position, and is therefore unnecessary, to assess such a likelihood in respect of its remaining marks, which I have found to be less similar to one degree or another.**

**110. The opposition has succeeded and, subject to any successful appeal, the application will be refused.**

**Costs**

111. As the opponent has been successful, it is entitled to a contribution toward its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the applicant on the following basis:

Filing form TM7 (official fee):	£100
Preparing a Notice of Opposition and reviewing the counterstatement:	£200
Preparing written submissions and considering the other side’s submissions:	£200
Preparing evidence	£600
<b>Total:</b>	<b>£1100</b>

**112. I order ALSHOROOQ Limited to pay FremantleMedia Limited, FremantleMedia North America Inc and 19 TV Limited the sum of £1100. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 14th day of December 2020**

**Laura Stephens  
For the Registrar**