

O/1073/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3623180

BY POHL, URSULA ELISABETH

TO REGISTER THE FOLLOWING TRADE MARK:

+resonance.

IN CLASSES 35, 38 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427951

BY GROUPE CANAL+ SA

Background and pleadings

1. On 8 April 2021, POHL, Ursula Elisabeth (“the applicant”) applied to register **+resonance.** as a trade mark in the United Kingdom in respect of the following services:

Class 35: *Advertising, marketing, promotion.*

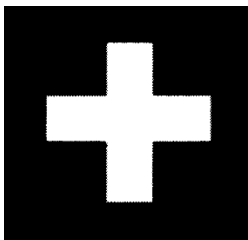
Class 38: *Access to content, websites and portals.*

Class 41: *Publishing; Training, instruction and further training; Coaching; Providing of training and education; Planning, arranging and conducting of seminars, training, training courses, courses, workshops; Publication of books and texts, other than publicity texts, including in electronic form; Dissemination of educational material; Production of training films.*

The mark was published for opposition purposes on 10 September 2021. The application takes its priority from an international trade mark registration protected in the EU under the Madrid Protocol, with the EU filing date being 24 January 2020.

2. On 4 November 2021, the application was opposed in its entirety by Groupe Canal+ SA (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). For the purpose of the opposition, the opponent relies upon the following comparable trade mark and the services laid out later in this decision.

United Kingdom Trade Mark (“UKTM”) 801025864
(Comparable mark derived from an IR(EU))



Filing date: 15 September 2009

Registration date: 2 December 2010

3. On 1 January 2021, international trade mark registrations protected in the EU under the Madrid Protocol ceased to be valid in the UK. To address this, on 1 January 2021 comparable trade marks (IR) were created in relation to each international (EU) trade mark designation which has protected status immediately before 1 January 2021. Each new UK right is to be treated as if applied for and registered under UK law, and may be challenged, assigned, licensed or renewed separately from the original international registration. In light of the above, and given the dates in play, the earlier mark is subject to the proof of use requirements specified within section 6A of the Act.

4. In its Notice of Opposition, the opponent contends that the parties' respective trade marks are similar and the competing services are identical or similar, such that it would be "entirely possible" that consumers would be confused as to the marks' origin. It submits that the "small differences" between the marks are likely to go unnoticed by the relevant consumers. The opponent also made a statement of use in respect of the services it identified.

5. In its counterstatement, the applicant denies that the marks are similar visually, phonetically or conceptually. It also denies that all of the services in the application are identical or similar to those relied upon and that there exists a likelihood of confusion or association. It further indicated that it required the opponent to provide proof of the use made of its earlier mark.

6. The opponent is represented by D Young & Co LLP and the applicant by Stevens Hewlett & Perkins. The opponent filed evidence and the applicant filed written submissions during the course of the evidential rounds. The parties were given the opportunity to request a hearing or file written submissions in lieu and both parties declined to do either.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon

in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

Proof of use

8. The opponent claims to have used its earlier mark in respect of the following services:

Commercial advice intended for consumers (namely consumer information) related to choice of computer and telecommunication equipment; arranging of audio visual program, audio programme subscriptions for others; services of subscription to video grams, to all audio and audiovisual media; arranging subscriptions to all kinds of information media, texts, sound and/or images and especially in the form of publications electronic or not, digital, multimedia products; subscription services to a television channel (class 35)

Television broadcasting; teletransmission; television broadcasts; TV programme broadcasting by satellite, cable, via computer networks (especially via the Internet), via wireless networks; broadcasting audio, audio visual, cinematographic and multimedia TV programmes (texts and/or images (still or moving) and/or sounds musical or not, ringtones) for interactive or other use; rental of access devices (apparatus) to interactive audio visual programmes; online downloading services for films and other audio and audio visual programmes; services transmitting television programmes and selections of channels; services for transmitting and receiving video images via the Internet by means of a computer or a mobile telephone; providing access to Web sites on the Internet containing any audio visual work; Programme broadcasting by satellite, cable, via computer networks (especially via the Internet), via wireless networks; broadcasting audio, audio-visual, cinema to graphic and multimedia programmes (texts and/or images); Rental of aerials and parabolic aerials (class 38)

Entertainment by means of television and the Internet; television entertainment on any media namely television set, computer, personal stereo, portable video player, PDA, mobile telephone, computer networks, the Internet; production of TV shows, films, television films, televised broadcasts, reports, debates, video recordings; rental of set-top boxes; production of TV shows, films, audio visual and multimedia programmes; Rental of video grams, films; rental of motion pictures (class 41)

9. The relevant statutory provisions are as follows:

“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), (aa) 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.

[...]

(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.

10. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union.”

11. Section 100 of the Act is also relevant, which states:

“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.”

12. The relevant territory for a proof of use assessment is the European Union and, pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the EU filing date of the contested mark, i.e. 24 January 2020.

13. 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 Bundervsvereinigung 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].”

14. 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 and services protected by the mark” is not, therefore, genuine use.¹

¹ *Intermar Simanto Nahmias v Nike Innovate C.V.*, Case BL O/222/16

15. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, in which Mr Daniel Alexander K.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.”

[...]

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

16. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs K.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.”

17. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice (“CJEU”) of the European Union noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

18. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. (as he then was) reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in

relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

19. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark

opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

20. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

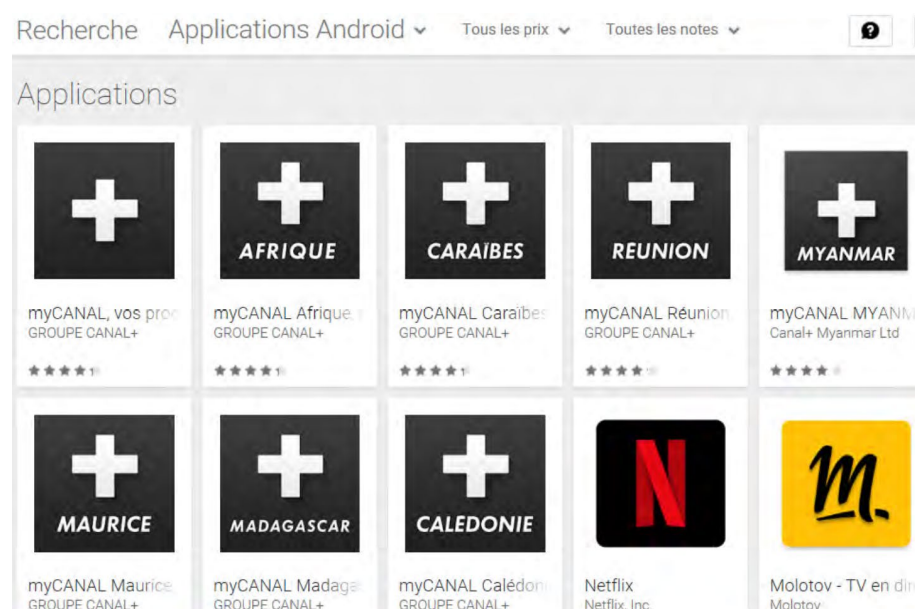
- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

21. The opponent's evidence comprises a witness statement from Mr Clement Hellich Praquin, Corporate General Counsel of Canal+, and supporting exhibits CH1 to CH19. Mr Praquin's statement is dated 10 March 2022. At the request of the registry, an additional witness statement was filed by Ms Emma Broxholme alongside (partial) English translations of Exhibits CH1 to CH18.

22. Mr Praquin explains that Canal+ is a leading French audiovisual media group, operating in premium content production, thematic and free-to-air channels and the bundling and distribution of pay-TV services in France and other "major markets" around the globe. It was launched in 1984 for French pay internet services for broadcasting videos to the public and providing packages to enable access on devices such as smartphones, tablets and PCs. Canal+ operates various websites including www.canalplus-caraibes.com; www.pluslecube.fr and www.canal-plus.co.uk which serve to advertise and sell products and services under the earlier mark.

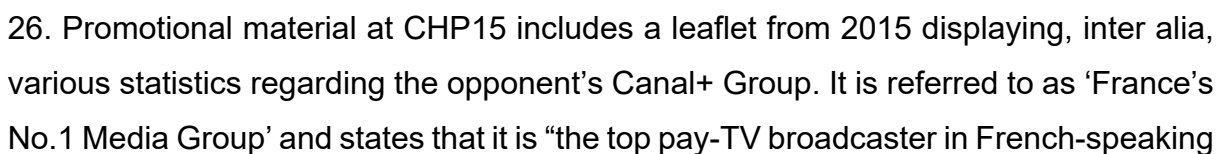
23. The opponent owns a range of trade marks incorporating a plus symbol, corresponding with a number of associated channels such as Cine+, Rugby+ and Infosport+. A Wikipedia extract² concerning Canal+, and its programmes, provides a list of British TV shows, namely, Skins, Merlin, Wire in the Blood, The Office and Spooks [MI-5]. Much of the opponent's evidence concerns television listings associated with the opponent's channels, the equipment and devices it provides to enable its customers to view its programmes (the CANAL+ decoder or the Cube S, for example), and the monthly costs for subscription. The costs associated with such subscriptions are displayed in Euros and its exhibits, for the most part, are presented in the French language.

24. The opponent offers a variety of mobile applications, for which the earlier mark is used as a display icon. On a webpage dated 9/5/2016, users are offered access to an iPhone app titled 'Canal Touch'. The description explains that the application 'provides a weekly guide where users can find the best programmes on more than 150 channels.' The site advises that the application 'only works in metropolitan France'. A 'Canal Touch – Android' application also uses the earlier mark as its icon and the page providing a link to the application is displayed in French.

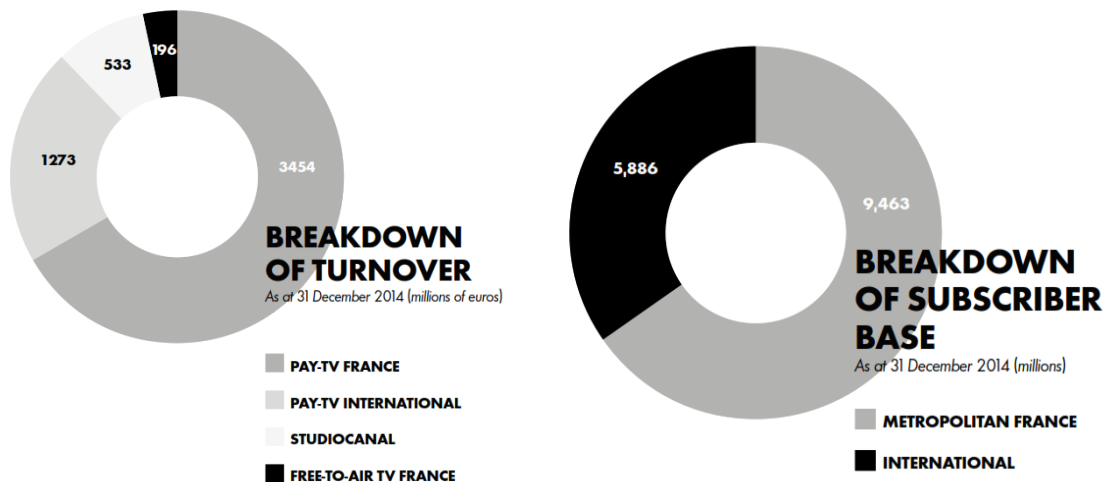


25. Pictures of the earlier mark used on storefronts associated with the opponent's services are provided, albeit undated, but the stores appear to be either in France or

² CHP2



countries worldwide, notably in Africa. It is also a leader in pay-TV in Poland and Vietnam. With STUDIOCANAL, CANAL+ Group is also a European leader in production and distribution of films and TV series.”



Europe's leading
film and TV
production
company

STUDIOCANAL

STUDIOCANAL is a European leader in film production, rights acquisition, distribution and international sales. STUDIOCANAL operates directly in all three major European markets - the UK, France and Germany - as well as in Australia and New Zealand. STUDIOCANAL carries forward an ambitious production policy premised on a slate financing approach that is unique in Europe.

Alongside its film business, STUDIOCANAL has also expanded its role as a producer of TV drama, with the acquisition of Tandem Communications, the German-based European leader in production and sales of international TV series, and of the UK's Red Production Company, a specialist in quality English-language TV series. STUDIOCANAL is also joining with Danish partners to create the Scandinavian production venture SAM.

5,000
films in one of the
world's biggest
libraries, featuring an
outstanding collection
of titles from France,
Britain and the USA.

As at 31 December 2014

27. In a Wikipedia screenshot concerning the Canal+ Group, StudioCanal is referred to as a 'corporate division', under which *StudioCanal Home Entertainment* and *Red Production Company* are listed against the United Kingdom. The Groupe Canal+ Wikipedia page states that "StudioCanal is a production company created in 1999, associated with NBC Universal until 2011. Nowadays, StudioCanal is operating in several countries such as Germany, Japan, or Australia. For the movie industry, it is a major player at the European level."

28. Leaflets promoting the opponent's subscription services and providing contractual details are dated between 2015 and 2019. The information displayed is presented in French and the subscription costs are given in Euros.

29. Mr Praquin encloses a number of third party press reviews, with dates between 2013 and 2018, concerning its LE CUBE product particularly, of which he states "a number" are in English and were published outside of France (though it is not clear where). An article of 15 June 2018, for example, published by DmEurope (DME Limited) explains that BeIN Sports has teamed up with Canal Plus and Orange to launch an event channel showing live action from the FIFA World Cup in 4K quality.

30. Various accolades earned by the opponent, and specifically by its LE CUBE decoder, are detailed in the opponent's evidence. At the 2016 Social Media Awards (SMA), the opponent was awarded the Best Digital Communication Device, Best 360 Degree Device and Best Interface. Its decoder was awarded the Red Dot Products Design Award (2016), the International Design Award (Gold, 2016) and the Spark Awards Gold (2016).

31. With regards the opponent's various social media platforms, Mr Praquin submits that the opponent boasts an "extensive European social media presence". In 2019 it had 2.9 million subscribers to its Twitter account and over 200,000 Instagram followers. Attached as exhibits are extracts from various Facebook accounts operated by the opponent (Cine+; Cuisine+, for example), with the entries' text displayed in French.

32. In its latter exhibits, the opponent focuses on its subscription services. Mr Praquin submits that, in 2015, Canal+ had 11.2 million subscribers which had increased to a total of 20.3 million subscribers by 2020. Its exhibits comprising contractual and subscription information and details of the available tariffs are displayed in French with the associated costs presented in Euros. Mr Praquin encloses the tables, reproduced below, to show the number of subscriptions to the opponent's Canal+ decoder LE CUBE in 2015.

The number of subscription to LE CUBE as a main decoder (all figures in excess off)

Platform	Material	2015/01	2015/02	2015/03	2015/04
Satellite	Le Cube	60,000	50,000	40,000	40,000
	G5	2,000,000	2,000,000	2,000,000	2,000,000
TNT	G5T	400,000	400,000	400,000	400,000

The number of subscriptions to LE CIBE as a secondary decoder (all figures in excess off)

Secondary Platform	Material	2015
Satellite	G4 Le Cube	3,000,000
	G5	300,000,000
	G5T	5,000,000
TNT	G5T	20,000,000

33. Mr Praquin also draws my attention to a partnership established in 2015 between the opponent and third party online music streaming service Deezer, with the opponent's Cube+ consequently featuring a number of times in Deezer's catalogue.

34. At the outset I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³ As already explained, the relevant territory for assessing use is the EU, and the relevant period 25 January 2015 to 24 January 2020⁴.

35. I acknowledge here that, in some of the exhibits filed by the opponent, the earlier mark is presented alongside additional wording; CANAL, for example.

36. 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, 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

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

⁴ The opponent noted the relevant period as 24 January 2015 to 23 January 2020. I should make clear that I do not consider such a small difference to have any material impact on my assessment of the opponent's evidence.

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 Nestlé, 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 by 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)

37. On the basis of the above, I find the use made of the earlier mark alongside company or product names is acceptable use. Consumers are generally accustomed

to seeing a house mark in conjunction with a brand mark, for example, both of which may work as trade marks on the same product to denote trade origin.

38. I return now to the matter of genuine use. To begin, I must acknowledge that some of the exhibits within the opponent's evidence are undated, though I note Mr Praquin's submission that "some of the evidence is not individually dated as it is not general practice, in the television industry, to mention the date a program is to be first broadcast on promotional materials." The evidence is also absent of any indication of turnover figures pertaining to the relevant period specifically and details of its advertising or marketing expenditure, nor do I have any insight with regards to the opponent's market share. Still, the evidence makes clear that the opponent maintains a significant position on the market, particularly in France. The opponent offers a range of products or various channels each incorporating the earlier mark or at least a 'plus symbol'. The mark is displayed on the opponent's websites, storefronts and packaging of its products such as 'Le Cube' which enables the user to stream content. The opponent offers a number of mobile applications or software allowing the user to access a range of programmes or channels streamed by the opponent, with the earlier mark utilised as the display image. Of the 'Canal Touch' application for iPhones, I note a disadvantage is recorded, specifically that the application only works in metropolitan France, though I cannot assume such a restriction applies to all of the applications featured in the evidence. In a promotional publication from 2015, CANAL+ Group is described as 'France's No. 1 media group' and shows that, as of 31 December 2014, its turnover stood at EUR 5.456 billion and it boasted 15.3 million subscribers. In regards its international subscribers, the same leaflet states that, at the same date, 2.1 of the opponent's international subscribers were based in Poland, which is said to be the second most important market for the CANAL+ Group, after France. The opponent's turnover stood at EUR533 million, with 25% attributable to France and 75% 'international'. In regards the opponent's STUDIOCANAL, referred to as 'Europe's leading film and TV production company', operating in the UK, France and Germany, the opponent has further ventured out into the production of TV drama (with an earlier Wikipedia extract listing *Skins*, *The Office* and *Wire in the Blood* as programmes for which it is responsible). The opponent has achieved a number of accolades, particularly for its LE CUBE decoder device and it has accrued a significant social media following (2.9 million Twitter followers and over 200,000 on Instagram in 2019),

though I keep in mind that there is no geographical breakdown as to where these followers originate. Notwithstanding the deficiencies with the opponent's evidence and that some of the information within its exhibits pre-dates the relevant period, I must look at the whole picture. In doing so, I am satisfied that the opponent has shown genuine use of its mark within the relevant territory, predominantly in France, during the relevant period.

39. That said, it falls to me now to consider a fair specification on which the opponent may rely. In that regard, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC (as he then was) 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."

40. 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 (at [47]):

"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."

41. Weighing the above case law against what I have said regarding the opponent's evidence, I am satisfied that the opponent has shown use in regards to the majority of the services it has identified, with the exception of a limited number of terms in classes 35, 38 and 41. On reflection of the evidence as a whole, I will proceed to assess the opposition under section 5(2)(b) based on the following fair specification:

Arranging of audio visual program, audio programme subscriptions for others; services of subscription to video grams, to all audio and audiovisual media; arranging subscriptions to all kinds of information media, texts, sound and/or images and especially in the form of

publications electronic or not, digital, multimedia products; subscription services to a television channel (class 35)

Television broadcasting; teletransmission; television broadcasts; TV programme broadcasting by satellite, cable, via computer networks (especially via the Internet), via wireless networks; broadcasting audio, audio visual, cinematographic and multimedia TV programmes (texts and/or images (still or moving) and/or sounds musical or not, ringtones) for interactive or other use; rental of access devices (apparatus) to interactive audio visual programmes; online downloading services for films and other audio and audio visual programmes; services transmitting television programmes and selections of channels; services for transmitting and receiving video images via the Internet by means of a computer or a mobile telephone; Programme broadcasting by satellite, cable, via computer networks (especially via the Internet), via wireless networks; broadcasting audio, audio-visual, cinema to graphic and multimedia programmes (texts and/or images) (class 38)

Entertainment by means of television and the Internet; television entertainment on any media namely television set, computer, personal stereo, portable video player, PDA, mobile telephone, computer networks, the Internet; production of TV shows, films, television films; rental of set-top boxes; production of TV shows, films, audio visual and multimedia programmes (class 41)

Decision

Section 5(2)(b)

42. Section 5(2)(b) of the Act 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”.

43. Section 5A of the Act reads:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Section 5(2)(b) – Case law

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

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 great degree of similarity between the marks, and vice versa;

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of services

45. Further to my above assessment, I compare the applied-for services to the services specified in paragraph 41 to my decision.

46. 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.

47. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

48. For the purpose of a comparison, it is appropriate to group related goods together, where they are sufficiently comparable to do so.

49. Of the parties' respective services, the opponent contends in its Notice of Opposition that they are identical or similar and "likely to be sold through the same trade channels and marketed in the same manner". In its submissions, the applicant denies that the services relied upon by the opponent do not directly relate to advertising, marketing and/or promotion services or advertising, marketing and/or promotion services, nor do they relate to publishing services, provision of training and education, the arranging of seminars, etc. or any of the other services recited in the subject application, concluding that "accordingly, they are neither identical nor similar to a high or medium degree".

Advertising, marketing, promotion. (class 35)

50. To my mind, none of the services remaining in the opponent's specification are used for the same purpose as those above, for which registration is sought. There may be some broad correlation in the services' users, though I attribute little weight to that. The applicant's services will generally appeal to professional bodies looking to promote their goods or services and the opponent's by a member of the general public seeking audiovisual entertainment (generally, at least) or an entity looking for their work to be produced. I cannot see any likelihood for similarity in the nature of the services, as delivered, and the trade channels are likely to be distinct. The services are not competitive and, whilst the services may be used alongside one another, broadly speaking, with advertisements streamed or incorporated via various programmes or channels, for example, the services are not directly complementary insofar as they are indispensable for one another, nor are they typically provided by a single entity, applying their core meaning. I find the respective services dissimilar.

Access to content, websites and portals. (class 38)

51. When considered against the opponent's class 38 services (*services transmitting television programmes and selection of channels*, for example), there could be some

element of similarity in the services' use, which will both generally be sought for entertainment purposes, though not exclusively in either case. There is likely some overlap in the services' respective users and there could be some opportunity for coincidence in trade channels. There could be some similarity in the services' nature, particularly in the case of the applicant's *access to content*, which seems fairly broad. Whilst the consumer will, for the most part, know whether it wishes to access a portal, for example, or stream a particular television programme, where the services are accessed for a similar purpose, it seems highly likely that there could be an element of competitiveness between the two; a consumer may simply choose how it wishes to be entertained, for example. The services may not always be indispensable, but the consumer may reasonably expect that they originate from a single or related entity. On balance, I find a high degree of similarity.

Publishing; Publication of books and texts, other than publicity texts, including in electronic form. (class 41)

52. The uses of the respective services are dissimilar; the applicant's for the publication of certain works and the opponent's for access to, or the production of, various televised or audiovisual pieces. Any overlap between the respective users would be fairly artificial and the nature of the services is dissimilar. The trade channels are unlikely to be shared and there is no competitive relationship to be found. The services are not generally provided by a single entity and I see little opportunity for an indispensable element. I find the services dissimilar.

Training, instruction and further training; Coaching; Providing of training and education; Planning, arranging and conducting of seminars, training, training courses, courses, workshops; Dissemination of educational material. (class 41)

53. The uses of the respective services are dissimilar and the users are unlikely to be shared to any meaningful degree. The services are not similar in their nature, neither do they typically occupy the same trade channels. The services are not complementary in any sense nor are they competitive. The services are dissimilar.

Production of training films. (class 41)

54. According to a principle laid out in *Gérard Meric v OHIM, Case T-133/05*, goods or services can be considered identical when the goods or services designated by the earlier mark are included in a more general category designated by the trade mark application, or vice versa. On that basis, I find the applicant's *production of training films* identical to the opponent's *production of... films*.

Comparison of marks

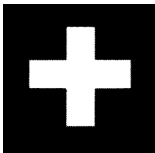
55. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

57. The respective trade marks are shown in the table below:

Opponent's trade mark	Applicant's trade mark
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	+resonance.
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58. The opponent's trade mark is a figurative depiction of a cross, or a plus sign, within a square. The square is coloured black and the cross which sits within is presented in white. The overall impression lies solely in the mark's figurative element.

59. The applicant's mark comprises a single word, preceded by a plus symbol and followed by a full stop. Its overall impression resides predominantly in its word element 'resonance'. A lesser weight is carried by the initial plus symbol, and a lesser weight still by the full stop which sits at the end of the mark.

60. Visually, the marks share an element reminiscent of a plus symbol. In the earlier mark, the symbol is the central point of the figurative mark and sits in the centre of a square, black background. In the later mark, it sits at the beginning of the mark and is followed by a word of nine letters and a full stop. Notwithstanding that the marks share an identical element, weighing what I have said regarding the marks' overall impression, I find the marks' visual similarity to be of a low degree.

61. The correct approach to conducting an aural comparison of figurative marks was clarified by the GC in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T-424/10, in which it stated:

"46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks."

62. Aurally, the earlier mark is unlikely to be articulated and the later mark will likely be articulated in three or four syllables; REH-SUN-UNCE or PLUS-REH-SUN-UNCE, though I find the latter more likely. In the absence of any aural impression pertaining to the earlier mark, as I cannot predict how it would likely be articulated or aurally expressed, I do not consider an aural comparison appropriate.

63. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁵ Conceptually, the earlier mark could be interpreted in a number of ways. In my view, the average consumer would most likely view it as a cross symbol which are generally associated with religion or health, for example. Should it be viewed as a plus, the average consumer will likely associate it with the mathematical symbol suggesting something to be added or increased. In the applicant's mark, resonance will likely be identified as a dictionary word, for which the applicant points to a number of possible meanings including "a physical phenomenon exhibited by a freely oscillating system in which the system's response has a large amplitude when driven by an externally applied oscillation at a frequency equal to the natural oscillation frequency of the system", "the quality of having a deep, clear, ringing sound" or "the quality of being suggestive of images, memories or emotions". I find the latter two likely to be most consistent with the understanding of the average consumer. The full stop is unlikely to contribute anything, conceptually, and the plus sign simply suggests something extra, or superior, and consequently is not, in my experience, an unusual element for a proprietor to elect to use in a trade mark. That said, I have found the mark's overall impression dominated by the word 'resonance', which evokes a concept absent to any which is likely to be evoked by the earlier mark. There will only be an element of conceptual similarity between the marks in circumstances whereby the average consumer views the earlier mark as a plus symbol representing an increase or addition, and it identifies the same concept in the later mark. Still, in the later mark it accompanies a word element, which I have found to be the mark's most dominant, and in the earlier mark the symbol is absent of any context. At most, I find the conceptual similarity to be fairly low. Where the earlier mark is viewed as a cross, as opposed to a plus, I find the marks conceptually dissimilar.

⁵ *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

Average consumer and the nature of the purchasing act

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

65. 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.”

66. The average consumer of services concerning the production of films (specifically training films in the applicant's case) is likely to comprise companies or individuals pitching various concepts in the hopes that a production company will elect to make use of them, and those looking to offer training in a specific field, likely a professional environment, and wish for the training to be expressed and delivered in the format of a film. The services are likely selected from an online resource or the pages of a relevant catalogue, though the average consumer could also seek the recommendation of peers or colleagues, for example. Both the visual and aural impressions of the marks are therefore significant. In approaching its selection, the average consumer will likely consider factors such as the quality of the provider's equipment, lead times and reputational standing. Depending on the circumstances of the consumer, the selection of the services is unlikely to be made with any meaningful

degree of frequency and the associated costs are likely to be considerable. Weighing all considerations, I find the average consumer will apply between a medium and high degree of attention to its selection of the relevant services.

67. When it comes to the remaining services in class 38, the average consumer is likely to be a member of the general public looking to access television programmes, for example, or other content, typically (though not exclusively) for entertainment purposes. The services are generally selected via an online platform, so the marks' visual impact carries the greatest weight in the selection process, though I do not overlook the opportunity for word-of-mouth recommendations. The consumer would likely consider the quality and variety of the provider's content and the services will likely be accessed fairly frequently and are often available for no cost, or a relatively small monthly subscription fee. On balance, I find it likely that the average consumer will apply a medium degree of attention.

Distinctive character of the earlier trade marks

68. 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).”

69. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

70. The relevant market for demonstrating an enhanced distinctiveness is the UK market. There is little within the opponent’s evidence concerning the UK market specifically. I do not have any turnover nor marketing expenditure pertaining to the UK, nor an indication of how many UK consumers have gained an awareness of the earlier mark via social media channels or otherwise. Reflecting on the evidence, I do not find the evidence to show that the opponent’s earlier mark has achieved an enhanced degree of distinctive character as a result of the use made of it in the UK and I am therefore able to consider only the inherent distinctiveness of the earlier mark. The mark essentially comprises two elements; a black background and a white cross or plus symbol. Whether it is recognised as a cross or a plus, any possible associated concept likely to be identified by the average consumer has, to my mind, no relationship or allusive connotation to the services relied upon. If it is viewed as a plus, signifying something additional or extra, it could be seen as a laudatory indication, though I have found this the less likely interpretation and that the consumer would identify it predominantly as a cross symbol. Whilst it may have no apparent association to the relevant services, its use is not particularly unusual, it is a fairly standard shape

and the mark is not particularly elaborate. I find its inherent distinctiveness to be of a medium degree.

Likelihood of confusion

71. For those services where I have failed to find any similarity, the opposition fails at this juncture. If there is no similarity, there is no likelihood of confusion to be considered.⁶

72. 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.

73. 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 realizes that the trade marks are not the same but puts the similarity that exists between the marks and the respective goods or services down to the responsible undertakings being the same or related.

74. 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

⁶ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA; *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

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.””

75. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

76. I begin by considering a likelihood of direct confusion and keep in mind that I have found the respective services either identical or similar to a high degree. I have found the marks visually similar to a low degree and failed to identify any aural similarity, or compare the marks aurally, given that the earlier mark is purely figurative. Even where the average consumer applies only a medium degree of attention to its purchase, I do not consider it likely that the marks’ common element would be sufficient to give rise to a likelihood of direct confusion. The most dominant element in the applicant’s mark is its word element, resonance, which has no counterpart in the earlier mark. The differences between the marks are simply too great to leave the average consumer susceptible to mistaking one for the other.

77. I move now to consider a likelihood of indirect confusion and, in doing so, I am reminded that I have found the respective marks, at most, conceptually similar to a fairly low degree. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

78. In *Nokia Oyj v OHIM*, Case T-460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 *P Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

79. Having identified that the competing trade marks are not the same, I cannot foresee any circumstances under which the average consumer would reasonably conclude that the marks must originate from a shared or related entity on the basis of the marks’ common element. I keep in mind the interdependency principle and that I have found some of the services at issue identical yet, to my mind, the marks’ differences are made out sufficiently to steer the average consumer from erroneously concluding that they are related. Such differences, including the marks’ contrasting conceptual positions, in my experience, are not consistent with what the average consumer would likely misconstrue as a sub-brand or brand extension, for example. The marks’ shared element is not particularly distinctive and plays a subservient role in the distinctiveness of the later mark, where the overall impression resides predominantly in the word ‘resonance’. I do not take the view that the similarities between the marks are such that one mark would call the other to mind but if that were to occur, it is a matter of mere association; not indirect confusion. The consumer would consider the use of a ‘plus’ symbol in both marks simply coincidental.

80. Having dismissed a likelihood of both direct and indirect confusion in respect of the opponent’s services which I have found to be identical and highly similar, it seems likely that even if I were to have found that the opponent had successfully demonstrated use of its mark for the full extent of the services relied upon and had gone on to found further similarity between the parties’ respective terms I would have likely reached the same conclusion and the opposition would nonetheless have failed. For clarity, given my findings on the marks themselves, had I found that only a low degree of attention would be applied to the consumer’s purchase (and there may be some services in the earlier specification to which this applies), this would still not be

sufficient, in my view, to engage confusion, and I would reach the same view had I awarded an enhanced degree of distinctiveness to the earlier mark.

Conclusion

81. The opposition has failed in its entirety and, subject to any successful appeal, the application will proceed to registration.

Costs

82. The applicant has been successful and is entitled to a contribution toward its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. In accordance with that TPN, I award costs as follows:

Considering the Notice of Opposition and preparing a counterstatement:	£200
Considering the opponent’s evidence and preparing written submissions:	£500
Total:	£700

83. I order Groupe Canal+ SA to pay Pohl, Ursula Elisabeth the sum of £700. This sum is to be paid within twenty-one days 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 7th day of December 2022

Laura Stephens
For the Registrar