

O-135-05

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION Nos 2269373 & 2269371
BY HELEN HYDE
TO REGISTER TRADE MARKS
IN CLASSES 16, 39, 41 & 42

AND IN THE MATTER OF CONSOLIDATED OPPOSITION
THERE TO UNDER NOS 80358 & 80360
BY REED MIDEM ORGANISATION S.A.

BACKGROUND

1) On 5 May 2001, Helen Hyde of The Wellhouse, 4 Stable Court, Herriard Park Industrial Estate, Herriard, Hampshire, RG25 2PL applied under the Trade Marks Act 1994 for registration of the following trade marks:

Number 2269373 : m.d.e.m. / mdem / M.D.E.M / MDEM

Number 2269371:



The applicant claims the colours dark blue and gold as an element of the first mark in the series.

2) Both marks were sought to be registered in respect of the following goods and services:

In Class 16: Paper, cardboard and goods made from these materials; printed matter; photographs; instructional and teaching materials; paper and documents for use at conferences; magazines; booklets; books; maps; brochures; leaflets; stationery; pens; notepaper; coasters made of paper or cardboard; folders; printed carrier bags.

In Class 39: Arranging travel; hiring of transport vehicles; provision of information about accommodation, journeys, timetables, tariffs and methods of transport.

In Class 41: Arranging and conducting conferences, seminars, meetings, lectures and events; organisation of exhibitions; provision of recreation services; liaising with presenters and speakers; information and consultancy relating to the aforesaid services.

In Class 42: Arranging accommodation; hiring of venues for conferences, meetings, seminars, lectures; hiring and leasing of furniture, equipment and facilities for conferences and events; provision of catering services; design of conference materials, fliers and invitations; research into venues for conferences; information and consultancy services in relation to the aforesaid.

3) On 8 November 2001 Reed Midem Organisation S.A of 9-13 rue du Colonel Pierre Avia, 75726, Paris, France filed notice of opposition to the applications. The grounds of opposition are in summary:

- a) The opponent is the proprietor of the following marks, following the assignment of UK 988733 to the opponent on 15 January 2002:

Mark	Number	Effective Date	Class	Specification
MIDEM	CTM 270587	15.05.96	35	Organization of showrooms and exhibitions for commercial or advertising purposes.
			38	Communications, among other, relations with the press; telecommunications, multimedia telecommunications; telecommunications by computer terminals, by data communication channels, by radio, by telegrams, by telephone; electronic mail; computer aided transmission of messages and images; transmission of data by data communication codes; transmission of data contained in data banks; electronic mail, transmission services, displaying information from a data bank stored on computers; communication services, electronic and by computers; electronic data exchange; news and information agencies; radio broadcasting, communications by telegrams, by telephone or data communications; telex services; radio and television broadcasting; satellite transmission of sounds and images; gathering and dissemination of information, data transmission by access code.
			41	Organization of showrooms and exhibitions for cultural or educational purpose, arranging and conducting of congresses, colloquiums, seminars, symposiums, conferences, publication of books and texts (other than publicity texts).
	988733	11.03.72	16	Paper, paper articles, cardboard and cardboard articles, all included in Class 16; printed matter, newspapers, periodical publications, books, photographs; instructional and teaching materials (other than apparatus).
Registration of this mark shall give no right to the exclusive use of a device of a musical note.				

b) The marks in suit are similar to the opponent's trade marks, and the goods and services applied for are identical or similar. The opponent has made substantial use of the marks for over thirty years, and have created a considerable reputation in the said trade marks. In particular MIDEM is the name of a famous International Music Market/Congress which takes place once a year in Cannes, France. The mark applied for therefore offends against Section 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent's claims. The applicant claims to have been trading under Managing Directions Event Management or the acronym MDEM since 1993.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 23 February 2005 when the opponent was represented by Mr Malynicz of Counsel instructed by Messrs Fry Heath Spence. The applicant was represented by Mr Engleman of Counsel instructed by Messrs Be.

OPPONENT'S EVIDENCE

6) The opponent filed three witness statements in each case prior to the proceedings being consolidated. Therefore, I have detailed only the contents of one set of statements in this decision. The first, dated 21 May 2003, is by Peter Alexander Rhodes the Managing Director of Reed Midem UK, which is owned by the opponent company. He states that; "the trade mark MIDEM denotes the products and services provided by my company's French owners, Reed Midem at the annual MIDEM event which takes place every January at Cannes France. This year's event in 2003 was the 37th, the first festival having been in 1967". He states that his evidence comes from his own knowledge and from the records of his company Reed Midem UK.

7) Mr Rhodes states that the festival is; "the most important musical event of the year and everyone connected with the UK music industry attends it". By everyone he includes composers, artists, agents, manufacturers, distribution and retail companies, all forms of media. In fact he lists any group which might be connected to the music industry including lawyers and accountants. He also mentions various official bodies connected to the industry. At exhibit PAR1 he provides a list of participating companies at MIDEM events from 1993-2001. He comments that the UK has more participants than the host country, Germany, Italy and the USA. At exhibit PAR2 he provides a similar list for the 1979 event. He states that UK participation at the event has gradually increased over the years. The documents provided at exhibits PAR 1 & 2 do not show use of the CTM trade mark. The 2000-2002 events have a different form of the word MIDEM with a very distinctive font and with the third down stroke of the first letter being as short as the middle down stroke and having a dot under it. The earlier years show use of a plain version of the mark similar to the UK registration albeit with a device element above the word.

8) Mr Rhodes provides figures of the number of participants at each event between 1996 and 2001. The total number has increased from just over 9,000 to approximately 10,500. Out of these totals the UK participants have accounted for between 14% in the earlier years to 18% at the 2001 event. On average each participant has paid between 500-740 euros to take part. He states that the event does not need to be publicised as everyone in the industry knows when it is just as they know when and where Royal Ascot takes place. Some advertising does take place, but it is on a barter system as periodicals provide advertising in return for "free" services from the opponent. At exhibit PAR4 he provides copies of various advertisements for the event. These cover the years 1994-2002.

9) Also at exhibits PAR4,5,6,7,8,9,10 he provides copies of event programmes for the years 1994-2001 which show that a large number of the moderators and lead speakers were from UK companies and also that a considerable number of concerts featured UK bands signed to UK companies.

10) At exhibit PAR11 Mr Rhodes provides a publication titled “Practical guide” which relates to the 2001 event. He states that this shows that various services are provided, however, what it actually shows is that hotel reservations are made for invited guests and a bus is laid on to transport guests to concerts at one of the locations. Within the centre where the event occurs there are various services on offer such as office services and car rental, but these appear to be offered by companies such as Europcar.

11) Mr Rhodes also refers to other trade marks owned by his company, however, full details are not provided nor were they part of the statement of grounds. He provides his view on the issue of confusability which I shall not detail as it does not assist in my decision. He offers his view that the mark in suit is easily pronounceable.

12) At exhibit PAR12 he provides a copy of a booklet “Focus on Business MIDEM 2003”. He states that the services mentioned in this booklet were also available in the year 2001. This offers a full booking service for hotels, flights and car rental at the same time as registering for the event. Assistance is also offered to those exhibiting in customising their stands and adding audio visual effects etc.

13) The second witness statement, dated 2 July 2003, is by Sarah Faulder the Chief Executive of the Music Publishers Association (MPA) a position she has held for six years. Prior to this she was a partner in a firm of solicitors and dealt with music copyright. She states that the MPA always attend the MIDEM event and that she has been aware of the event for twenty-two years and in her opinion it is the most important music trade fair in the world. She states that many UK record companies and UK music publishers have representation at the event. She states that these firms and other companies who service them such as solicitors and accountants and various others connected with the music industry such as media, manufacturers and technical companies would be aware of the opponent’s mark MIDEM. She also offers her views on the confusability issue, but I do not find her comments assist me in my decision.

14) The third witness statement, dated 19 August 2003, is by Nigel John Parnell the opponent’s Trade Mark Attorney. At exhibit NJP1 he provides a sample of the headed notepaper of the opponent and also a copy of a booklet issued by the applicant. He makes no comment on either document, but I assume these exhibits were provided to show that the opponent uses the colours blue and orange on its headed notepaper, the applicant’s brochure also has these colours. I note that the applicant uses the form “m.d.e.m.” or mark 2269371 which has a circle, a triangle and a square between the letters.

APPLICANT’S EVIDENCE

15) The applicant filed three witness statements. The first, dated 19 February 2004, is by Helen Hyde the applicant. She states that her company “offers a range of ‘behind-the-scenes’ event management services”. She states that her company is; “a venue research and event management company, not an event marketing company” a distinction which she states is important for the case in hand. She states that her company receives its revenue through commission revenue which is a percentage of the corporate client spend paid to her company by the venues into which her company

has placed business and secondly the direct payment of fees by corporate clients against event management services. She states that her company does not receive any fee revenue from delegates for attending events as her company does not produce events for their own purposes. She categorises her company's services into three broad categories: venue research, pre-event management and on-site management.

16) Ms Hyde states that clients contact her company with a 'brief' on their requirements which include dates, audience, size, duration, seating layout, equipment requirements, catering requirements and preferred location. Her company then find suitable locations, negotiate rates and inform the client of the possibilities. They book hotels etc for clients, but all communication and bills are thereafter dealt with directly by the client. She states that her company continue to assist and advise the client on issues regarding the conference i.e. dates by when confirmation of numbers and menus should be sent to the hotel. In the main, Ms Hyde states that most delegates are internal to the client and although her company may offer on site services such as registration it is often the case that no branding of m.d.e.m is visible and most delegates would be unaware of the company's involvement. This is what is meant by "behind the scenes organiser".

17) Ms Hyde states that:

"From 1994 until May 2001, m.d.e.m traded as 'Managing Directions Event Management', However, as a result of a dispute with a company called 'Managing Direction', I decided to change the name to its acronym, m.d.e.m. I had been advised by my solicitor that we were entitled to continue using the 'Managing Directions Event Management' name in light of acquired rights in the name but my opponent was aggressive and so as to avoid becoming embroiled in a potentially costly and unpleasant dispute, I chose to change the name. I chose to adopt the acronym of m.d.e.m, which was sufficiently different whilst still alluding to the original name in order to help my clients to identify me. At this time I redesigned the corporate image of the business, which remains the same today."

18) Ms Hyde points out that the name is always shown as an acronym and draws attention to the use of the circle, triangle and square between the letters. She states that the two companies are in different business sectors and do not appear in the same business directories.

19) The second witness statement, dated 7 May 2004, is by Bill Tansley a proprietor of a corporate marketing communications business Da Capo, a position he has held for twelve years. Previously he worked in the music industry for seventeen years and attended the Midem conference "three or four times". He states that he was aware of the Midem conference before becoming aware of m.d.e.m. He offers his view on the confusability of the marks which I do not find helpful. He also states that there is no overlap in the businesses of the two parties as he claims; "event management services are a very specialised niche service procured by professional purchasers, rather than private consumers. When engaging any event management company to assist us, I would generally choose a company on the basis of either my personal experience of the business or in reliance on a personal recommendation".

20) The third witness statement, dated 21 June 2004, is by Michiel J.A.J. Fortuin the Managing Director of the Vision Hotel Group & Services SARL, a French registered company. He states that his group consists of affiliated hotels for whom his company provide sales and marketing services. He states that the UK is a key market and that “in particular we target companies who specialise in the organisation of events for their corporate clients”.

21) He states that he has dealt with the applicant company for many years and since the change of name to the acronym, the telephone has always been answered by spelling out the letters never pronounced as a word. He also states that the opponent does not appear on his company’s database of 1500 contacts with whom his company would work. He knows that the opponent is involved in trade shows and so his group of hotels could be a client, but he is not aware of the opponent offering event management services.

22) That concludes my review of the evidence. I now turn to the decision.

DECISION

23) The first ground of opposition is under Section 5(2)(b) which reads:

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

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

24) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

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

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

25) The opponent has two earlier marks registered, UK mark 988733 and CTM 270587. These and their specifications are set out fully in paragraph 3 earlier in this decision. The marks are registered with effect from 11 March 1972 and 15 May 1996 respectively and are clearly “earlier trade marks”.

26) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd*

Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V. [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG*;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG*;
- (h) further, 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; *Marca Mode CV v Adidas AG*;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.*

27) In essence the test under Section 5(2)(b) is whether there are similarities in the marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion, I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the marks applied for and the opponent's registrations on the basis of their inherent

characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

28) The applicant contends that the opponent's marks both have at their core the word MIDEEM which they state is a "meaningful" word as it is the name of a music festival. The applicant also contends that the word MIDEEM is an acronym for "Marche International du Disuqe et de Ledition Musicale" the name of the festival in France. It is also stated that; "Any alleged inherent distinctiveness in the MIDEEM mark is completely destroyed by the descriptive use made of the mark by the opponent and its predecessors".

29) I do not accept any of these contentions. The word MIDEEM is not a dictionary word and to the average consumer would be meaningless unless they had been educated into viewing the word as a trade mark. I note that the applicant is silent on the words inherent distinctiveness with regard to the rest of the opponent's specification, attacking it only in relation to "music festivals". The fact that the word has become associated with a music festival does not reduce the words inherent distinctiveness. It has not been shown to have become a generic term for music festivals per se, but is used only on an annual festival organised by the opponent. With regard to the word being an acronym, whilst this might be the origin of the word, it does not diminish the inherent distinctiveness of the word even when used on music festivals. I regard the word MIDEEM as being inherently distinctive with regard to the whole of the opponent's specification. As the CTM comprises the word MIDEEM solus then the mark is inherently distinctive. The UK mark has at its core the word MIDEEM, but it is a very stylised version where the letter "d" has been replaced by a musical note. The font used is not standard with the two letter "M"s being capital letters and appearing to be in a different font to the letters "i" and "e". The UK mark has a high degree of inherent distinctiveness.

30) I must also consider the use of the mark and consider whether the mark has acquired distinctiveness as a result of use. The applicant contends that the opponent's mark has not been used in the UK, the mark actually used is REED MIDEEM, that the evidence provided is not from the opponent or with its authority, that the only evidence of use is in France and that there is no supporting trade evidence.

31) At the hearing Mr Engleman accepted that the mark MIDEEM is known by the UK music industry as the name of a famous music conference, which takes place in France. Whilst the evidence has been supplied by a UK company which itself is not the proprietor of the marks in suit, but is owned by the registered proprietor this does not mean that the evidence provided should be ignored. When assertions are made, but not backed by corroborative evidence it will be given less weight. From the various historic programmes it is clear that the UK music industry is very well represented at the festival, and that the UK company offers ancillary services such as travel and hotel services, and exhibiting services such as stands and visual effects to UK attendees of the festival under the Reed Midem name. I would also regard the evidence of Ms Faulder, the Chief Executive of the Music Publishers Association to be trade evidence that the music festival is famous amongst the UK music industry.

32) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchen Q.C.

sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those trade marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

33) The opponent has shown no use of the trade mark UK 988733. To my mind, this mark is so highly stylised that it cannot rely upon use of the word “midem” in capital letters or lower case in a normal font to show use as it has elements which are part of its distinctive character and the word “midem” does not have such dominance that these elements are reduced to insignificance. However, when considering the trade mark CTM 270587 I consider the evidence filed as sufficient to show that the mark has acquired distinctiveness in the UK in relation to the provision of a music festival.

34) I now turn to the comparison of the specifications of the two parties which I reproduce below for ease of reference.

Applicant’s specification		Opponent’s specifications	
Class 16	Paper, cardboard and goods made from these materials; printed matter; photographs; instructional and teaching materials; paper and documents for use at conferences; magazines; booklets; books; maps; brochures; leaflets; stationery; pens; notepaper; coasters made of paper or cardboard; folders; printed carrier bags.	UK 988733 Class 16	Paper, paper articles, cardboard and cardboard articles, all included in Class 16; printed matter, newspapers, periodical publications, books, photographs; instructional and teaching materials (other than apparatus).

Class 39	Arranging travel; hiring of transport vehicles; provision of information about accommodation, journeys, timetables, tariffs and methods of transport.	CTM 270587 Class 35	Organization of showrooms and exhibitions for commercial or advertising purposes.
Class 41	Arranging and conducting conferences, seminars, meetings, lectures and events; organisation of exhibitions; provision of recreation services; liaising with presenters and speakers; information and consultancy relating to the aforesaid services.	Class 38	Communications, among other, relations with the press; telecommunications, multimedia telecommunications; telecommunications by computer terminals, by data communication channels, by radio, by telegrams, by telephone; electronic mail; computer aided transmission of messages and images; transmission of data by data communication codes; transmission of data contained in data banks; electronic mail, transmission services, displaying information from a data bank stored on computers; communication services, electronic and by computers; electronic data exchange; news and information agencies; radio broadcasting, communications by telegrams, by telephone or data communications; telex services; radio and television broadcasting; satellite transmission of sounds and images; gathering and dissemination of information, data transmission by access code.
Class 42	Arranging accommodation; hiring of venues for conferences, meetings, seminars, lectures; hiring and leasing of furniture, equipment and facilities for conferences and events; provision of catering services; design of conference materials, fliers and invitations; research into venues for conferences; information and consultancy services in relation to the aforesaid.	Class 41	Organization of showrooms and exhibitions for cultural or educational purpose, arranging and conducting of congresses, colloquiums, seminars, symposiums, conferences, publication of books and texts (other than publicity texts).

35) The European Court of Justice held in *Canon* in relation to the assessment of the similarity of goods and/or services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

36) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

37) The applicant accepted that the goods in Class 16 of both parties are identical. Clearly, the “organisation of exhibitions” appears in both parties specifications whilst the applicant’s Class 41 services “Arranging and conducting conferences, seminars, meetings, lectures and events” must be considered identical to the opponent’s class 41 services of “Arranging and conducting of congresses, colloquiums, seminars, symposiums, conferences”.

38) I regard the applicant’s Class 41 specification of “provision of recreation services; liaising with presenters and speakers; information and consultancy relating to the aforesaid services” and Class 42 specification of “Arranging accommodation; hiring of venues for conferences, meetings, seminars, lectures; hiring and leasing of furniture, equipment and facilities for conferences and events; provision of catering services; design of conference materials, fliers and invitations; research into venues for conferences; information and consultancy services in relation to the aforesaid” to be quite similar to the opponent’s Class 35 services of “Organization of showrooms and exhibitions for commercial or advertising purposes” and its Class 41 services of “Organization of showrooms and exhibitions for cultural or educational purpose, arranging and conducting of congresses, colloquiums, seminars, symposiums, conferences, publication of books and texts (other than publicity texts)”.

39) With regard to the applicant’s services in Class 39 (see above) as such services may be ancillary or complementary to the organisation of conferences and seminars then I accept that there is a degree of similarity between these services and those of the opponent.

40) When considering the issue of confusion I have to take into account the relevant public. In this instance the applicant has sought registration on, to my mind, two distinct types of goods and services. Firstly, the goods in Class 16 and the services in Class 39 would be purchased by members of the general public. In contrast, the services in Classes 41 & 42 are far more specialised and likely to be purchased by companies. I do not believe that these two groups would view the marks in different ways and so will refer simply to the average consumer. However, when considering the issue of confusion I will return to these two groups as I believe that more care would be exercised in engaging a company to provide a conference or even choosing to go to a conference than when choosing paper goods.

41) I shall now compare the marks of the two parties. For ease of reference the marks of both parties are reproduced below:

Applicant's marks		Opponent's marks	
2269373 :	m.d.e.m. / mdem / M.D.E.M / MDEM	CTM 270587:	MIDEM
2269371:	 <p>The applicant claims the colours dark blue and gold as an element of the first mark in the series.</p>	988733	

42) I shall first compare the applicant's mark 2269373 to the opponent's mark CTM 270587. The applicant's mark consists of a series of four, with two marks shown in both upper and lower case as follows "mdem/MDEM" and "m.d.e.m/M.D.E.M". To my mind the first set without the punctuation between the letters is very similar visually to the opponent's mark "MIDEM". Whilst a single letter difference can, on occasions, alter a mark considerably I do not believe it does so in this instance. Aurally the marks are not very similar as, contrary to the claims made by the opponent, I do not believe that the average consumer will fill in the space between the first letter "m" and the three other letters "dem". If they try to pronounce it at all I believe that it will be as "em-dem". With the punctuation marks between the letters there is far less visual similarity whilst the applicant's mark would, in my opinion, be pronounced by the average consumer as a series of four letters "em-dee-ee-em". This compares to the opponent's mark which is easily pronounced as "my-dem" or "mid-em". Neither mark has a conceptual meaning. As the applicant's mark has been applied for as a series I have to come to a consensus view, which is that the applicant's mark 2269373 is visually and aurally similar to the opponent's mark 270587.

43) I shall now compare the applicant's mark 2269373 to the opponent's mark 988733. As stated earlier the applicant's mark consists of a series of four, with two marks shown in both upper and lower case as follows "mdem/MDEM" and "m.d.e.m/M.D.E.M". The opponent's mark is a very stylised mark with both letter "M"s being in capital letters whilst the letters "i" and "e" are lower case. Sitting in the middle of the mark is a musical note which has some visual similarity to a letter "d" and so the mark can be viewed as the word "MIDEM". I do not believe that the fact that the mark is in white letters against a black background is significant. Clearly, there is a degree of visual similarity as both marks start and end with a letter "M" and both have as their second to last letter, a letter "e". However, overall I believe that the visual differences outweigh any visual similarity. Aurally the applicant's mark will as stated earlier be pronounced "em-dem" or "em-dee-ee-em". The opponent's mark if it is pronounced will be "my-dem" or "mid-em". Neither mark has a conceptual

meaning. Overall there is, in my opinion, a degree of visual and aural similarity between the applicant's mark 2269373 and the opponent's mark 988733.

44) Moving onto the applicant's mark 2269371, I shall first compare this to the opponent's CTM 270587. Visually there are minor similarities in that each mark starts and ends with a letter "M" and both contain the letters "d" and "e". Both are very short marks, and it is accepted that even minor differences can make a significant impact. In this instance the opponent's mark is a single word whereas the applicant's mark because the letters are interspersed by punctuation would be clearly seen as a series of four letters and not as a word. The use of the circle, triangle and square devices between the letters would be noticed by the average consumer as they are unusual and are not standard punctuation devices. Whilst the first part of the series has a colour claim the second part of the series is in black and white. I do not believe that the colours blue and gold are particularly significant. As stated earlier the opponent's mark would be seen as a word and pronounced "my-dem" or "mid-em" although, unless educated otherwise, the average consumer would not know what the word meant. The applicant's mark would, because of the very unusual devices between the letters, be seen as a group of four letters. In my view they would be pronounced in this manner just as the UN and the CIA are always pronounced as a series of letters even though they could be seen as single words. Although there are some visual similarities I believe these are outweighed by the visual differences and the marks are very different aurally. Neither has any conceptual meaning. In my view the applicant's mark 2269371 and the opponent's mark CTM 270587 are not similar.

45) Lastly, I compare the applicant's mark 2269371 with the opponent's mark 988733. The opponent's mark is a very stylised mark with both letter "M"s being in capital letters whilst the letters "i" and "e" are lower case. Sitting in the middle of the mark is a musical note which has some visual similarity to a letter "d" and so the mark can be viewed as the word "MIDEM". I do not believe that the fact that the mark is in white letters against a black background is significant. Visually both marks have the letter "m" at the start and at the end, both also have a letter "e" as the last but one letter. The opponent's use of a musical note and the applicant's use of very unusual punctuation creates a significant visual difference which completely outweighs any similarity. The applicant's mark would, because of the very unusual devices between the letters, be seen as a group of four letters. In my view they would be pronounced in this manner just as the UN and the CIA are always pronounced as a series of letters even though they could be seen as single words. The opponent's mark if it is pronounced will be "my-dem" or "mid-em". Neither mark has a conceptual meaning. In my view the applicant's mark 2269371 and the opponent's mark 988733 are not similar.

46) When considering the question of whether there is a likelihood of confusion on the part of the public I have to take into account all of the factors set out above and make a global assessment. With regard to the applicant's mark 2269373 it was accepted that the goods in Class 16 were identical to the goods in Class 16 for which the opponent's mark 988733 is registered. I found earlier that the marks had a degree of similarity. The relevant public is the general public and would whilst reasonably well informed and reasonably circumspect and observant would not be particularly vigilant when purchasing such goods. In my opinion there is a likelihood of confusion on the part of the public. Earlier in this decision I found that the applicant's services

in Classes 39,41 & 42 were either identical or similar to the services for which the opponent's mark CTM 270587 is registered. I also found that these marks were similar. Whilst I believe that the average consumer for the services in Classes 41 & 42 would take considerable care in their selection, I still believe that there is a likelihood of confusion. The opposition under Section 5(2)(b) with regard to the whole of the specification of application 2269373 has been successful.

47) Applying the same global assessment with regard to the applicant's mark 2269371 it was accepted that the goods in Class 16 were identical to the goods in Class 16 for which the opponent's mark 988733 is registered. I found earlier that the differences between the marks was such that despite superficial similarities the marks could not be considered similar. Considering all of the aspects outlined in the decision, it is my view that the differences between the marks are such that, despite the goods being identical, there is no likelihood of confusion on the part of the relevant public.

48) Lastly, applying the global assessment to the applicant's mark 2269371 and the opponent's mark CTM 270587, earlier I found that the applicant's specification relating to services in Classes 39,41 & 42 were either identical and/or similar to the opponent's specification for services in Classes 35, 38 & 41. I also found that although there were some minor similarities visually these were far outweighed by the visual and aural differences. Considering all of the aspects outlined in the decision it is my view that the differences between the marks are such that despite some of the services being identical (the others being similar) there is no likelihood of confusion on the part of the relevant public. Consequently, the opposition under Section 5(2)(b) fails in relation to application 2269371.

49) As the opposition was successful with regard to application 2269373 I do not need to consider that application under the ground of opposition under Section 5(4)(a) which reads:

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

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

(b)

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

50) In deciding whether the mark in question (2269371) offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the

application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd - v - Borden Inc* [1990] RPC 341 and *Even Warnik BV - v - J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

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

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

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

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

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

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

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

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

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

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

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

51) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed....”. The relevant date is therefore 5 May 2001, the date of the application.

52) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision, and the arguments put forward at the hearing.

53) To succeed under this ground the opponent must show that it enjoyed goodwill at the relevant date. The opponent has not shown that it has any goodwill or reputation in its 988733 mark, nor has any evidence of use been filed.

54) With regard to its CTM 270587 the opponent has not filed turnover figures for the mark in the UK. The average cost per delegate to the annual conference in France was provided but it was not entirely clear to whom these fees were paid. Claims were also made about the provision of travel, accommodation and services to delegates as well as the provision of space and stands to exhibitors. These services were offered as is

clear from the programmes of previous events, but whether they are utilised by the participants is not certain. Again no specific turnover figures were provided.

55) Considered overall it seems clear that the opponent had some trade in the UK prior to the relevant date. However, the deficiencies in the evidence make it impossible to assess the extent of the opponent's goodwill in the businesses conducted under its "MIDEM" trade mark.

56) The applicant accepted at the hearing that the mark MIDEM is known by the UK music industry as the name of a famous music conference which takes place in France. For the opponent, Mr Malynicz tried to persuade me that the opponent's reputation and its goodwill would extend to the provision of ancillary services such as travel, accommodation and business services provided to those attending the conference, and also to the services provided to those exhibiting at the conference. However, I believe that I should be slow to extend the sphere of the opponent's reputation and goodwill in the absence of clear evidence such as turnover figures. It was accepted at the hearing that the opposition under Section 5(4)(a) added only two points to the Section 5(2)(b) opposition. The first point was that the specification of the opponent would encompass all the ancillary services which it claims are provided at the festival. The second point was in relation to the colour claim of the applicant's 2269371 mark as the opponent claims to have used identical colours.

57) I accept that this ground of opposition considers the actual use made of a mark and its reputation and goodwill. However, this requires the opponent to show that it has goodwill and reputation in such goods and services. It is not enough to rely upon reputation in one field and then seek cross over into ancillary activities. As to the question of the colour claim of the applicant I note that the opponent filed a single piece of evidence which consisted of a sample of headed notepaper which had the colours blue and orange upon it. No claims were made as to the extent of use of these colours or the date when such a colour scheme was first used. I also note that the extensive array of exhibits filed do not reflect widespread use of these colours.

58) Earlier in this decision I found use of the applicant's mark 2269371, actual or on a fair and notional basis would not result in confusion with the opponent's marks when used on the goods and services sought to be registered in Classes 16, 39, 41 & 42. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail with regard to the applicant's 2269371 application.

59) As the opponent was successful with regard to its opposition to one of the two applications it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1,000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of May 2005

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