

O/147/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2556196
BY PASSION RADIO (OXFORD) LIMITED TO REGISTER THE TRADE MARK**

GLIDE FM

IN CLASSES 38 AND 41

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 101348
BY GLIDE UTILITIES LIMITED**

BACKGROUND

1) On 18 August 2010, Passion Radio (Oxford) Limited (“Passion”) applied under the Trade Marks Act 1994 for registration of the mark GLIDE FM in respect of the following services:

Class 38

Broadcasting; radio broadcasting; broadcasting via the Internet; digital radio broadcasting services; providing access to digital music websites on the Internet; providing access to websites for the downloading of MP3, audio, visual and data content; webstreaming namely the transmission of data, information and audio-visual data via the Internet, news agency services.

Class 41

Entertainment services; compilation, production, presentation, distribution, networking and rental of radio programmes, and sound recordings, recording services; presentation of live performances; provision of recording facilities; charitable fund-raising events; organisation of entertainment events; information, advice and assistance all relating to the aforesaid services.

2) The application was published in the Trade Marks Journal on 24 September 2010 and on 23 December 2010, Glide Utilities Limited (“Glide”) filed notice of opposition to the application. The single ground of opposition is that the application offends under Section 5(2)(b) of the Act because it is similar to two of Glide’s earlier marks and in respect of similar or identical services. In its statement of case, Glide only relied upon some of the goods and services listed in its earlier marks and this was further refined at the subsequent hearing. The goods and services relied upon and other relevant details of Glide’s two earlier marks are:

2302905 Glide	Filing date: 14 June 2002 Registration date: 14 November 2003
Class 9: [...] <i>instruments for conducting, switching, transforming [...], regulating or controlling electricity; apparatus for recording, transmission [...] of sound or images; [...] data processing equipment [...].</i>	
Class 14: [...].	
Class 36: [...] <i>financial affairs, monetary affairs; [...].</i>	
Class 38: <i>Telecommunications.</i>	

2455879 GLIDE	Filing date: 18 May 2007 Registration date: 11 April 2008
<p>Class 35: [...]</p> <p>Class 36: [...] <i>financial affairs; monetary affairs; [...] collection of payments; [...]; information, advice and consultancy in relation to the aforesaid services.</i></p> <p>Class 38: <i>Telecommunications; provision of Internet and broadband services; Internet service providers; [...] digital and electronic network telecommunications services; providing access to computer networks; data transmission services over telecommunications networks; television broadcasting services; dissemination of television programmes to television receivers; interactive services for facilitating the recordal of television programmes; [...] information, advisory and consultancy services in relation to the aforementioned services.</i></p> <p>Class 39: [...]</p> <p>Class 42: <i>Design and development of computer software and hardware; [...]</i></p>	

3) Both of Glide's registrations are earlier marks as defined by Section 6 of the Act because they both have a date of application for registration that is earlier than Passion's mark.

4) Passion subsequently filed a counterstatement denying Glide's claims and putting it to proof of use in respect of its earlier mark 2302905.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs in its favour. The matter came to be heard on 21 March 2011 when Glide was represented by Ms Anna Edwards-Stuart of Counsel, instructed by Forrester Ketley & Co. Passion was not represented and did not attend.

Opponent's Evidence

6) This takes the form of a witness statement by Sandeep Singh Krishan, director of Glide. Mr Krishan explains that the mark 2302905 was assigned to Glide on 1 August 2007 and he confirms it was used between that date and 24 September 2010.

7) Mr Krishan states that Glide is essentially a provider of utility and telecommunication related services but that it also supplies physical products and apparatus. These include wireless broadband routers. Two copies of completed customer sign up forms are provided at Exhibit SSK1, dated 9 April 2010 and 12 April 2010 respectively, illustrating that the customer had selected to receive Glide's broadband services (amongst other services). Mr Krishan states that Glide also supplies, direct to the customer, a suitable router. An

undated photograph of such a router is provided at Exhibit SSK2 and carries a label with the text “GLIDE3761, For support call: Glide Utilities on [telephone number] and it is also branded with a stylised GLIDE mark.

8) Mr Krishan states that Glide had about 900 customers in the year ending September 2007, 3,600 in 2008, 6,000 in 2009 and 9,000 in 2010. As customers are tenants in shared properties, he states these figures relate to around 150 properties in 2007, 600 in 2008, 1,000 in 2009 and 1,500 in 2010. About 50% of properties receive a router from Glide. Mr Krishen estimates that Glide have supplied about 1,400 routers between August 2007 and September 2010. He supports this, at Exhibit SSK3, with copies of invoices from Glide’s router provider, Net Lynk Group, for the same period and relating to around three hundred routers. He confirms that these represent a snapshot and also confirms that these routers will have had the GLIDE mark applied to them.

9) Mr Krishen also states that, over the years, GLIDE has provided other apparatus to its customers, including telephony equipment in the form of IP telephones, television sets and set top boxes. Whilst the supply of these has been scaled back in recent years, he states that Glide did supply a number of customers with these goods during the relevant period. To support this, he provides an invoice dated 1 April 2010 from Gamma Telecom Limited to Glide at Exhibit SSK4. The invoice includes four “2 Line IP Phones”. Mr Krishen confirms that these were subsequently supplied to customers. He states that, as part of previously provided broadband services, Glide also supplied to customers, wireless network cards between 2007 and 2008. Technological advances have resulted in a reduced demand for these.

10) Glide’s turnover was about £150,000 in 2007, £500,000 in 2008, £1.9 million in 2009 and £2.7 million in 2010 (all up to the end of September of the year indicated).

11) Promotion is through posters, literature and brochures. At Exhibit SSK5 is a copy of a brochure distributed to approximately a thousand landlords in 2007 promoting its services for tenants. Both the plain word GLIDE and a stylised form appears on the brochure. A student flyer, a poster, a further brochure and an advertisement are provided at Exhibits SSK6 – SSK9. All follow a similar theme, encouraging tenants to contact Glide to avoid falling out with co-tenants over shared bills. There is a handwritten year in respect of the first three of these, being 2007, 2007 and 2010 respectively. The final exhibit carries a date of “27/5/10”.

Applicant’s Evidence

12) This takes the form of a witness statement by Nicholas White, a solicitor with the firm Couchmans LLP, Passion’s representatives in these proceedings. He explains that Passion has operated a radio station in the Oxford area under the

GLIDE FM mark since 18 August 2010. A variety of promotional material relating to this radio station is provided at Exhibit NW1.

13) The remainder of Mr White's statement is submission that I will not detail here but I will keep in mind.

DECISION

Proof of use

14) Glide's earlier mark 2302905 completed its registration procedure on 14 November 2003. Being more than five years before the publication of Passion's mark (24 September 2010 - the relevant date) it is subject to the proof of use provisions. However, this earlier right does not advance Glide's case beyond that based upon its other earlier mark 2455879, at least in respect of the services listed in its Class 36 and Class 38 specifications. This is because these services are encompassed by the specifications in the same classes listed in mark 2455879 and this later mark is not subject to the proof of use provisions.

15) Further, the helpful comparison of goods and services provided by Ms Edwards-Stuart at the hearing indicated that it was Glide's position that none of the Class 9 goods listed in its 2302905 registration presented a better case than that presented by the services covered in Glide's other registration, 2455879. I concur with this assessment and, accordingly, there is nothing to be gained from considering the issue of proof of use in respect of 2302905.

16) In light of the above finding, I will not consider the issue of proof of use and will limit my remaining considerations so that Glide's case is based solely upon its registration 2455879.

Section 5(2)(b)

17) Section 5(2)(b) reads:

“(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.”

18) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. 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-Mayer 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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-Mayer Inc.*

(k) assessment of the similarity between two marks means more than taking just one component of a composite mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *LIMONCELLO*

Comparison of goods

19) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

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

20) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

21) Further, I am mindful of the guidance in *Avnet Inc v Isoact Ltd* [1998] FSR 16, where the court commented that specifications should be confined to the

substance, or core, of the possible meanings attributable to the words and phrases used.

22) Two further cases on the way that specifications ought to be interpreted should be borne in mind. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* (“*Thomson*”) [2003] RPC 32, at paragraph 31, Aldous LJ, says:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use.”

23) Although this was in the context of arriving at a fair specification consequent to an attack of revocation on the grounds of non-use, the principle that it is the public and circumstances of the relevant trade that should underpin consideration as to the terms used in a specification nonetheless holds good.

24) Secondly, there is the case of *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* (“*Beautimatic*”) [2000] FSR 267, in which the principle of giving words their ordinary (rather than an unnaturally narrow) meaning was enshrined. In summary, the *Beautimatic* case urges an approach that is not unnaturally narrow, whilst the *Thomson* case stresses that the exercise is not one of lexical analysis in a vacuum, but by reference to how the average consumer may perceive matters in the relevant trade.

25) Finally, I also keep in mind, the guidance of the General Court (GC), in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05 (“*MERIC*”), paragraph 29, that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category covered by the application or vice versa and in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-325/06 (“*Boston Scientific*”) that “goods are complementary if 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”.

Passion’s Class 38 services

26) For ease of reference *Passion’s Class 38 services* are:

Broadcasting; radio broadcasting; broadcasting via the Internet; digital radio broadcasting services; providing access to digital music websites on the Internet; providing access to websites for the downloading of MP3, audio, visual and data content; webstreaming namely the transmission of data, information and audio-visual data via the Internet, news agency services.

27) In respect of Passion's *broadcasting*, when applying the principle expressed in *MERIC*, it is self evident that as the broad term covers Glide's *television broadcasting services*. Consequently, the two terms must be considered as identical.

28) Regarding Passion's *radio broadcasting; broadcasting via the Internet; digital radio broadcasting services*, Ms Edwards-Stuart submitted that these, amongst other services, are identical to Glide's *data transmission services over telecommunications networks*. In support of this, Ms Edwards-Stuart directed me to Collins English Dictionary and Thesaurus: 21st Edition where *telecommunications* is defined as communications by telephony, radio, television etc. When taking this into account together with broadcasting being a form of transmission of data, I conclude that these respective services are identical. Even if I am wrong, there is also a very high level of similarity between Passion services and Glide's *television broadcasting services*. Even though one is directed at the radio listening public and the other at the TV watching public, the nature is very similar and there may also be overlap in the respective trade channels.

29) Next, I will consider Passion's *providing access to digital music websites on the Internet; providing access to websites for the downloading of MP3, audio, visual and data content; webstreaming namely the transmission of data, information and audio-visual data via the Internet*. Ms Edwards-Stuart submitted this is covered by Glide's broad terms *provision of Internet and broadband services, Internet service providers, data transmission services over telecommunication networks* as well as other terms. I agree with this analysis, both sets of terms essentially cover data transmission and therefore must be considered as identical when applying the guidance in *MERIC*.

30) Finally, Passion's specification also includes *news agency services*. On a normal reading of the specification, I do not take this term to be part of the webstreaming services listed in the preceding part of the specification, but rather a standalone term. Nevertheless, within the context of Class 38, this term relates to the transmission of news and, as such, is covered by Glide's broad term *data transmission services over telecommunication networks*. Applying the guidance from *MERIC*, these services are identical.

Passion's Class 41 services

31) Passion's Class 41 services are as follows:

Entertainment services; compilation, production, presentation, distribution, networking and rental of radio programmes, and sound recordings, recording services; presentation of live performances; provision of recording facilities; charitable fund-raising events; organisation of

entertainment events; information, advice and assistance all relating to the aforesaid services.

32) Ms Edwards-Stuart submitted that Passion's *entertainment services and presentation of live performances* were highly similar to Glide's *television broadcasting and dissemination of television programmes to television receivers* because Glide's services are also a form of entertainment. I do not agree. Class 38 covers the services relating to the technical aspects of delivery of broadcasted entertainment and is very different to an entertainment service itself. It is akin to claiming that the service of goods delivery is the same as the goods themselves. The average consumer will not normally expect a broadcaster to also be the originator of the entertainment, programme or show itself, whether it is broadcast live or not. Often these are produced by a different entity than the broadcaster. Whilst there are notable exceptions like the BBC who, for example, produce programmes and also provide broadcast services, this is not the normal trading model for broadcasters. They are clearly not in competition. Is entertainment important or essential to broadcasting services? If so, there will be a complementarity between the respective services within the meaning set out in *Boston Scientific*. There is an element of this. Many, if not most material broadcast could normally be described as entertainment, therefore, without such entertainment the broadcast industry, in the form that it is in, would not exist. Taking all of this into account, I conclude that there is some similarity, but that this is relatively low.

33) Similar arguments exist when considering Passion's *compilation, production, presentation, distribution, networking and rental of radio programmes and sound recordings, recording services*. These are services all involved with the creation of entertainment rather than the broadcasting of such. Further, Passion's services are likely to be targeted at specialist consumers, namely the radio station broadcasting the show rather than the general public, who are the likely average consumers of Glide's services. Once again, if there is any similarity, it is only on the low side.

34) Similar considerations also apply in respect of Passion's *charitable fund-raising events and organisation of entertainment events*. These services relate to the "organisation" of events rather than the "transmission" or "broadcast" of the same. Therefore, they are different in nature and use. The users are also likely to be different with broadcast services being provided to television viewers and radio listeners whereas the consumer of event organisation will be wide ranging from bodies such as charities and corporate bodies to individuals. They are clearly not in competition with each other and neither are they complementary as neither is important or essential to the existence of the other. Broadcast companies transmit a wide range of material and are not restricted to broadcasting "entertainment events" or "fund-raising events". Taking all of this into account, I reject the contention that these services are similar and I conclude that there is no similarity between these respective services.

35) In respect of Passion's *provision of recording facilities*, Ms Edwards-Stuart submitted that these are identical services to Glide's *interactive services for facilitating the recording of television programmes* as the latter is included in the former. I do not accept this. Passion's term will be understood as providing the physical premises where a customer can go to record material. On the other hand, Glide's term will be understood as the service of permitting customers to record television programmes (probably in their own home) with a view to watching them at a more convenient time. They differ in nature, purpose and trade channels. They are not in competition and neither are they complementary in the sense expressed in *Boston Scientific*. The relevant consumers would make no connection between the respective services and I find there is no similarity.

36) Finally, in respect of Passion's *information, advice and assistance all relating to the aforesaid services*, I would describe the level of similarity as being no better than attributed to the services that such information, advice and assistance relates.

The average consumer

37) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue.

38) At the hearing Ms Edwards-Stuart contended that the relevant services could be described as everyday services where the consumer does not pay any particular care and attention. Whilst I concede that services such as provision of broadband connections and telecommunication services are now services considered by nearly all households, nevertheless, the costs are such as to make consumers consider their options reasonably carefully taking account of costs, broadband speeds etc. Therefore, in respect of such services, I consider that the average consumer is the ordinary Internet-using general public but that the level of attention is slightly higher than that involved in everyday purchases.

39) In respect to the various broadcasting services covered by Passion's application, these are indeed, services where the consumer will pay an unremarkable level of attention to the provider and will be more concerned about the content of the broadcast. That said, with the advent of digital technology and subscription television broadcasting, these services will involve a heightened level of attention during the purchasing process that may involve tailoring a package of channels to view.

40) In respect of the various entertainment services and organisation of events, there will be a wide range of consumer depending upon the size of the event and whether it is provided to corporate customers or private individuals.

Comparison of marks

41) For ease of reference, the respective marks are:

Glide's mark	Passion's mark
GLIDE	Glide FM

42) When assessing the extent of similarity between the respective trade marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23).

43) The word GLIDE is the only element of Glide's mark and consequently it is the dominant and distinctive element. In respect of Passion's mark, it consists of the word GLIDE and the letters FM. The first element consists of five letters and the second element, two letters. Consequently, from a visual perspective, the word GLIDE makes up the largest proportion of the mark. The opposite is true from an aural perspective as the word GLIDE consists of a single syllable whereas FM is two syllables. As pointed out by Ms Edwards-Stuart, the letters FM are understood, at least in respect to some of the services as being an abbreviation for the descriptive words "frequency modulation". Taking this into account, together with the above points, I conclude that the dominant distinctive element of Passion's mark is also the word GLIDE, but that the letters FM are not negligible and form part of the mark for the purposes of considering similarity and likelihood of confusion.

44) From a visual perspective, Glide's mark consists of a single, five letter mark. The same five letter mark appears as the first element of Passion's mark and is an obvious point of similarity. Passion's mark also consists of the additional letters FM, being a point of difference between the marks. Taking this into account, I conclude that there is a great deal of visual similarity.

45) From an aural perspective, Glide's mark consists of the single syllable word GLIDE. Passion's mark consists of the three syllables GLIDE-F-M. Whilst they share the first syllable, they differ by virtue of the additional two syllables in Passion's mark. Taking this into account, I conclude that the common presence of the word GLIDE results in a moderately high level of aural similarity.

46) Conceptually, the word GLIDE means "move with a smooth, quiet, continuous motion"¹. It is a common word in the English language and will be widely understood by the relevant consumer as meaning this. Passion's mark also contains the additional letters "FM" and the parties are in agreement that this

¹ "glide". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 23 March 2012 <<http://oxforddictionaries.com/definition/glide>>.

will be understood, by the relevant consumer, as an abbreviation for “frequency modulation” being a term commonly used in radio broadcasting to indicate the radio band on which a radio station broadcasts.

47) It is submitted on behalf of Glide that as the letters “FM” are descriptive, in respect of radio broadcasting, then it should be disregarded for radio related services. The result being that when comparing the marks, they must be considered to be identical. I reject this argument because, as the guidance provided in *LIMONCELLO* makes clear, it is only when an element of a mark is considered to be negligible is it permissible to ignore it for the purposes of considering similarity. The letters “FM” are clearly not negligible. The fact that they may be of low, or no, distinctive character does not impact upon the level of similarity between the marks. Nevertheless, I note the descriptive nature of the letters “FM” in respect of radio broadcasting and I will keep this in mind when considering the likelihood of confusion.

48) Taking account of the above and that both marks contain the word GLIDE and Passion’s mark has the additional conceptual hook provided by the letters FM, I conclude that the respective marks share a high level of conceptual similarity.

49) To summarise, I have found that the respective marks share a great deal of visual similarity, a moderately level of aural similarity and a high level of conceptual similarity. These combine so that the marks share a high level of similarity overall.

Distinctive character of the earlier trade mark

50) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). The meaning of GLIDE has no obvious reference to the relevant services other than to possibly allude, in a very loose fashion, to some sort of ease of use. Therefore, the distinctive character of the word may not be of the highest order such as might be afforded to a made-up word but it, nevertheless, is endowed with a reasonably high level of distinctive character.

51) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act (David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04)). Glide’s evidence illustrates that it has supplied what is essentially utility and telecommunication services since August 2007 and has grown to about 9,000 customers in the final year before the relevant date (18 August 2010). Mr Krishan

explains that this equates to services being provided to 1,500 properties in 2010. When taking account of the size of the industry (which is self evidently massive) and the number of households in the UK, such use must be considered as relatively small and with a relevant proportion of the average UK consumer not being educated to recognise the mark. I therefore conclude that the use is not such as to lead to an enhanced level of distinctive character.

Likelihood of confusion

52) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

53) Passion submits that it is a “policy issue” that the parties operate in different fields and it is, therefore, wrong to make a finding of likelihood of confusion. I dismiss this argument. The consideration required by Section 5(2) of the Act should be a notional one based on the services listed in the respective specifications rather than an analysis based on what the parties are actually doing in the market place. In taking this view, I am mindful of the comments of the CJEU in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 when commenting on the same issue within the context of the Directive 89/104 to approximate the laws of the Member States relating to trade marks:

“66 Article 4(1)(b) of Directive 89/104, however, concerns the application for registration of a mark. Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.”

54) A trade mark registration can be sold and a new or subsequent proprietor may decide to use it in an altogether different market. In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03 (Devinlec)*, the GC said:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the

prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.”

55) Glide currently occupies a particular field of business but this may not always be the case, nor may Glide always be the owners of its mark. Consequently, I dismiss Passion’s submissions on the importance of the parties currently being involved in different fields of activity.

56) Mr White submitted, on behalf of Passion, that the addition of the letters “FM” to the word GLIDE are significant (and he cites *Devinlec* and *MANGO HOUSE*, BL O-257-08) when contending that conceptual differences may counter aural and visual similarities. Whilst I accept the general principle that conceptual differences may counter visual similarity, such an assessment must be carried out on a case by case basis. In the current case, the addition of the letters “FM” provides some descriptive context in respect to radio related services, but the impact this has upon the assessment of likelihood of confusion must be factored into the global assessment, taking account of all the relevant factors. I do this in the analysis that follows.

57) The guidance provided by the CJEU in *Waterford Wedgwood plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-398/07, paragraph 34, is that a finding of likelihood of confusion presupposes that the goods or services covered are identical or similar. It follows, as a natural consequence of this, that where I have found that there is no similarity between the respective services, there is no likelihood of confusion. This is the case in respect of Passion’s *charitable fund-raising events, organisation of entertainment events* and, insofar as it relates to these services, *information, advice and assistance all relating to the aforesaid services*. It follows that there is no likelihood of confusion in respect of these services.

58) I will apply the global approach when considering likelihood of confusion in respect of the remainder of Passion’s services. I have found that the respective marks share a great deal of visual similarity, a moderately level of aural similarity and a high level of conceptual similarity and that there is a wide variation in both the relevant consumer and the nature of the purchasing act.

59) I also found that, in respect of Passion’s Class 38 services, they are identical or share a very high level of similarity to Glide’s services in the same class. I factor this into the global assessment together with the fact that consumers rely upon imperfect recollection and that Glide’s mark has reasonably high degree of distinctive character. In doing so, I find that, in respect of Passion’s terms that are or can cover radio related services, the difference between the respective marks

is insufficient to outweigh their similarities and I find that the consumer would confuse the origin of the respective services. Whilst Passion's mark contains the additional element "FM", this will have minimal or no trade origin impact upon the consumer as it will merely be perceived as denoting the channel on which the radio station broadcasts. Upon seeing GLIDE alone in respect of the same services or in respect of other forms of broadcasting, such as television broadcasting, the consumer will assume that the services are provided by the same or a linked undertaking.

60) In respect of Passion's terms, insofar as they cover services not relating to radio services, I find that there is also a likelihood of confusion. For these terms, there remains at least a high level of similarity regarding the respective services. In respect of these services, the role of the letters "FM" may be perceived differently by the consumer because it is less likely to be immediately associated with the term "frequency modulation". Nonetheless, the common presence of the word GLIDE is likely to lead the consumer to believe there is a trade connection between the providers of these highly similar or identical services.

61) In respect of Passion's Class 41 services not commented upon in paragraph 57, above, I found that if the respective services share any similarity, this is only on the low side. I find that such a low level of similarity places sufficient distance between them that the consumer is not likely to assume that the respective services are provided by the same or linked undertakings. Consequently, there is no likelihood of confusion.

62) In summary, the opposition succeeds against Passion's application in respect of all of its Class 38 services but fails in respect of all of its Class 41 services.

63) Finally, I must comment upon Passion's offer, in its counterstatement, that it is prepared to consider deletions or amendments to its specifications, if I was so minded to find against it. As Ms Edwards-Stuart pointed out, such an offer will not improve its case because, when applying the principle set out in *MERIC* its terms listed in Class 38 are included in the broader terms of Glide's earlier mark. This is mostly true. The exception is Passion's term *broadcasting* which is wider than Glide's terms that also relate to broadcasting. However, even if Passion restricted this term to "radio broadcasting", there will still be a high level of similarity between the respective services (as I found in paragraph 28, above) and likelihood of confusion would still exist. Consequently, the offer cannot assist Passion.

COSTS

64) As the opposition has been only partially successful with Passion's application surviving the proceedings in respect of one of its two specifications, the outcome can be described as a "score draw". In such circumstances, each party should bear its own costs and I decline to make an award.

Dated this 3rd day of April 2012

**Mark Bryant
For the Registrar,
the Comptroller-General**