

O-155-13

TRADE MARKS ACT 1994

APPLICATIONS 2587152 & 2587390

BY NEWS GROUP NEWSPAPERS LIMITED

AND

CONSOLIDATED OPPOSITIONS

102998 & 103008

BY NCJ MEDIA LIMITED

THE ISSUES IN DISPUTE

1. On 8 July 2011 News Group Newspapers Limited made two applications to register the marks THE SUN ON SUNDAY and SUN ON SUNDAY. Application 2587152 ("152") is an application to register both marks as a series. Application 2587390 ("390") is for the mark THE SUN ON SUNDAY alone.

2. The applications cover virtually identical and equally long list of goods and services in classes 9, 16, 25, 35, 36, 38, 39, 41 and 43. The full lists are shown at Annex A. For present purposes it is sufficient to note that they include:

i) Newspapers and other publications in class 16, electronic publications in class 9, online publications in class 41.

ii) A range of goods and services that are said to be similar to these goods and services, such as books in class 16, news clipping services and retailing of printed publications in class 35, (financial) analysis, evaluation, advice, consultancy and information services in class 36, radio and TV broadcasting in class 38, distribution, transportation and delivery of newspapers and periodical publications in class 39, entertainment, publishing, news programme services for TV and radio and provision of information about entertainment, art, education, current events, politics etc. in class 41, and provision of information relating to travel and holidays in class 43.

iii) Other goods and services of the kinds sometimes sold through promotions in newspapers, such as video tapes, games and cassettes in class 9, calendars and posters in class 16, retailing of CDs and DVDs in class 35, travel arrangement in class 39, and arranging travel and holidays in class 43.

iv) Services of the kind offered by newspapers, such as providing space for advertising in class 35.

3. Application 152 was published for opposition purposes on 11 November 2011. Application 390 was published a little later on 25 November 2011.

4. Both applications are opposed in part by NCJ Media Limited. The grounds of opposition are, in summary, that:

i) The opponent has an established goodwill under the signs SUNDAY SUN/THE SUNDAY SUN as a result of the use of SUNDAY SUN in relation to a newspaper sold in the North East of England since 1919 and associated website activities started in 2000.

ii) The opponent's business has substantial reputation and goodwill in relation to:

Newspapers; photographs; advertising and publication services; newspaper publishing services; on-line news and information

services; directory services; retail services; provision of space on websites for advertising; provision of recordings, pictures, blogs and podcasts; provision of horoscopes; providing competitions and games; provision of information and news via emails and texts.

- iii) Use of the marks applied for would constitute a misrepresentation liable to cause consumers to mistake the applicant's products and services for those of the opponent, or to believe that the opponent endorses, licences or is otherwise connected to the applicant or its products or services. Such use is liable to damage the opponent's goodwill. As a result, use of the opposed marks would be contrary to the law of passing off.
- iv) Registration of the opposed marks, except for a small number of goods in classes 9,16 and 25, would therefore be contrary to s.5(4)(a) of the Act.
- v) The opponent is the proprietor of UK registration 1141360 ("360"), which consists of the mark SUNDAY SUN and is registered for newspapers for sale in the counties of Cleveland, Cumbria, Durham, Northumberland, North Yorkshire and Tyne and Wear.
- vi) The opponent's earlier mark has acquired an enhanced distinctive character as a result of the use of that mark since 1919.
- vi) The marks applied for are similar to the opponent's earlier trade mark and some of the goods/services covered by the applications are the same or similar to those for which the earlier mark is registered.
- vii) Registration of the marks, except for a small number of goods in classes 9,16 and 25, would therefore be contrary to s.5(2)(b) of the Act.

5. The applicant filed counterstatements denying the grounds of opposition and requiring the opponent to prove that the earlier mark had been used in the five year periods ending on the dates of publication of the opposed marks, and/or had acquired an enhanced level of distinctiveness through use, and that the opponent had established the claimed goodwill under the mark.

6. The applicant also pointed out that it was the proprietor of the mark THE SUN which had been used in the UK for many years, including before the date of filing of the opponent's earlier registered mark, and that it had built up a substantial reputation and goodwill under that mark in relation to a variety of goods and services including, but not limited to, newspapers in paper and electronic form and news information services.

7. Both sides ask for an award of costs.

8. The opposition proceedings were subsequently consolidated.

THE HEARING

9. The matter came to be heard on 28 January 2013 when the applicant was represented by Mr Simon Malynicz, instructed by the applicant's in-house lawyers, and the opponent was represented by Ms Anna Carboni instructed by Cleveland, trade mark attorneys.

THE FACTS

10. By the time of the hearing the basic facts were not in dispute. The opponent's SUN ON SUNDAY newspaper has been sold in the North East of England since 1919 and the opponent's THE SUN newspaper is well known and has been on sale throughout the UK since 1964. However, there is a dispute about the scope and/or extent of the parties' respective goodwill. There is also a factual dispute as to whether the extension of the opponent's mark to a Sunday edition of its newspaper in 2011 caused, or added to, confusion amongst the public. It is convenient to start with an overview of the parties' reputation and goodwill.

12. The opponent's evidence comes from Simon Edgley and Matthew McKenzie. Mr Edgley is Regional Managing Director of ncjMedia Limited. Mr McKenzie is the editor of the Sunday Sun and has worked for that paper since 1997. Much of Mr McKenzie's evidence is hearsay based on information provided to him by Janet Cook, the Customer Services Manager, Vikki Hawkins, the Regional Promotions Manager, Sue Coulson, Head of Regional Events, Aimee Rutter, a business accountant for the opponent, and Jill Hedley, the Regional Head of Management Accounting. According to this evidence:

- i) The Sunday Sun is a weekly (i.e. Sunday), regional newspaper sold in an area in the North East of England taking in Newcastle, Carlisle, Durham, Darlington and Middlesbrough and extending from Whitby in the south, to Berwick upon Tweed in the North, and extending as far west as Workington and Whitehaven in Cumbria.
- ii) The SUNDAY SUN has three editions for the Tyne & North, Weir and Durham and Teeside areas. The content is largely the same, but the front and back pages are tailored to these specific areas.
- iii) The paper is distributed through traditional newspaper channels. The opponent uses multiple wholesalers and distributes some papers itself in urban areas. The paper is sold through the usual mix of newsagents, supermarkets and petrol stations.

- iv) The newspaper has been presented in a tabloid format since 1980. The masthead has looked like this since 2003.



- v) The paper covers local, national and world news “*as well as some more entertaining stories*”. The newspaper has a strong focus on sport with extensive coverage of regional football and cricket teams. The paper comes with motoring and entertainment supplements.
- v) The newspaper had a circulation of around 100,000 in 2000 with over 240,000 readers, but as with many papers, that has declined in recent years: the current circulation is around 60,000 with around 170,000 readers.
- vi) The retail price of the paper at the time of the opposed application was £1. The paper also raises revenue from selling advertising space and various promotional activities. Since 2001 the annual revenue generated by the SUNDAY SUN has been consistently in excess of £3m, peaking at £4.5m in 2004.
- vii) In 2001 the paper spent around £160k on advertising and promotion. However, as sales declined so did the amount spent on promotion. By 2005, the advertising spend had halved to around £80k, and by 2010 it was less than £4k.
- viii) Advertising takes the form of advertising on local radio, sponsorship of agricultural shows and sporting competitions, advertising on billboards at football grounds in the North East region, branded giveaways, such as football fixture cards and vouchers offering discounted entry to theme parks, museums etc., social media, and deals through which features by radio DJs and TV presenters are placed in the SUNDAY SUN in return for ‘plugs’ on their shows.
- xi) The SUNDAY SUN website went live in 1997, but in 2001 it was moved to an aggregate website covering a number of the opponent’s regional titles. Thereafter the opponent’s sundaysun.co.uk website redirected traffic to the aggregate website called icnewcastle.co.uk. From 2004 onwards, the icnewcastle website had a branded SUNDAY SUN channel containing weekly news uploads plus additional content such as consumer advice, a food guide and a feature on ‘unsung heroes’. In March 2008, sundaysun.co.uk website was re-launched as a standalone site. Since the re-launch the website has included audio

and video content allowing users to listen and watch interviews and events.

- x) The sundaysun.co.uk website has hundreds of thousands of visitors. In June 2011 (the month before the filing of the opposed applications) the website had 730k visits from around 200k unique users. 60% of these were based in the North East of England, 20% from the rest of the UK and 20% from overseas.

13. The applicant's evidence comes from David Dinsmore, Robert Painter and Richard Caseby. Mr Dinsmore has worked for the applicant since 1994 and is currently the Acting Managing Editor of The Sun. Mr Painter has worked for the applicant since 1998 and is currently Marketing Director for The Sun. Mr Caseby is Group Managing Editor for News Group Newspapers Limited. He has over 20 years experience in the newspaper business and has worked for national and local newspapers. The evidence shows that:

- i) The Sun was launched in the UK in 1964, initially as a broadsheet. It changed to a tabloid in 1969. The masthead for the tabloid edition of the paper looked like this.



- ii) The masthead for the Monday-Saturday version of the paper sold in England, Wales and Northern Ireland has not changed since 1969.
- iii) The headline for the first tabloid edition was 'Horse Dope Sensation', a story about a race horse trainer apparently admitting to doping his horses, which is said to be characteristic of the newspaper's journalistic style. Other notable headlines include 'Up Yours Delors' in 1990, a story about the EU trying to "force" the euro onto the UK, 'It's The Sun Wot Won It', a story about The Sun helping the Conservative Party to victory in the 1992 general election, 'Goodnight Sweet Princess', a story about the death of Princess Diana in 1997, and in more recent years 'Sling Your Hook', a story about the Muslim cleric Abu Hamza, 'Harry The Nazi', a story about the outfit worn by Prince Harry at a fancy dress party, and 'Help Our Heroes', a story about The Sun's campaign to help members of the armed forces.
- iv) After converting to a tabloid in 1969 The Sun increased its focus on sports coverage and a year later introduced the first picture of a topless female in

mainstream newspapers, later to give rise to the term 'Page 3 girls'. The tabloid format proved very successful. Prior to the change the newspaper's circulation was less than 1 million. Within 2 years of the change this had risen to over 2 million, and by 1978 the circulation had reached over 4 million making The Sun the best selling UK newspaper by some distance. By 2001, the circulation had dipped a little to 3.3 million, since when it has gradually declined to the current figure of 2.5 million. Even with this reduction in circulation, The Sun is estimated to be still read by 7.5 million readers each day.

v) A version of The Sun is sold in Scotland where since 1998 it has been called The Scottish Sun. It is the highest selling daily newspaper in Scotland. The Sun is also sold in a number of other countries, typically those where large numbers of Britons live or go on holidays.

vi) The Sun is distributed from 55k outlets across the UK, including newsagents, supermarkets, outdoor street vendors, and book stores.

vii) A website was established in 1997 to partner The Sun, initially under the name and address CurrantBun.com. This later became Bun.com before being sold in 2000 to a Dutch company. The Sun has retained its own separate website presence since then. According to Mr Dinsmore, it is "*now found at www.thesun.co.uk*". The Sun also operates a number of other sites including www.page3.com, www.dreamteamfc.com and www.sunbingo.co.uk. According to figures provide by a research company called ABC, in early 2010 these sites had an average of over 20 million unique 'browsers' each month. The Sun website permits users to access news and information videos online.

viii) Substantial sums have been spent promoting The Sun, including television advertising. The figure for 2010 was in the region of £15m¹.

xi) The Sun is also promoted via mobile phones and tablets, Facebook and Twitter accounts.

The opponent's business extension activities

14. Mr McKenzie claims that the Sunday Sun provides an email alert service through which subscribers receive daily emails with news stories as they are uploaded to the website. At the time of the opposed applications, the opponent had 2k subscribers to this service. Since 2008, a syndication service has been available via the website

15. Classified advertisements have run in the newspaper since 2005, and online since 2006. The online classified advertisements are organised into four categories: jobs, motors, homes and everything else. Each category is hosted by a dedicated

¹ See exhibit DD53

website accessed from the sundaysun site². Classified advertisements can also be accessed via another site owned by the opponent called easyads123. Since 2007, users looking for products in the North East who have landed on this website have been shown this strapline: “powered by the Evening Chronicle, The Journal and the Sunday Sun”³. Income from classified advertisements was over £1.5m in 2007, but has since declined to around £500k per annum.

16. According to Mr McKenzie, bingo was offered through the Sunday Sun website, at least in the years 2008-2011. Users were directed to the bingo page on the opponent’s aggregate website, which displayed the Sunday Sun masthead⁴. The extent of such use is not clear, but it appears to have been a paid-for service.

17. Mr McKenzie also claims that the opponent provided directory services by providing a link from its website to that of localmole.co.uk, which permits users to find, rate and review local businesses. Mr McKenzie provides a copy of a page from the sundaysun website from September 2010 which he says shows co-branding of these ‘directory’ services⁵. However, my assessment of the evidence is that the Sunday Sun was there being used in relation to the opponent’s website, not the ‘directory’ services provided by localmole.co.uk.

18. Exhibit MAM-32 to Mr McKenzie’s statement is a sample of a screenshot from the sundaysun website showing the video, image and audio content available on 22 May 2011. This shows that video and audio content were available from the website prior to the date of filing the opposed applications. Counsel for the opponent submitted that this page also showed that a music video was available for download in the form of a video of a Radio 1 concert in Carlisle. However, that event is listed under the heading ‘Gallery’ indicating that only picture content was available for viewing. None of the content appears to have been downloadable.

19. Mr McKenzie says that Sunday Sun provides reader offers, typically comprising books, CDs/DVDs, calendars, jigsaws, pottery & crystal, tea towels, posters, prints & cards and t-shirts. According to Mr McKenzie, the offers were hosted on the aggregate icnewcastle site until 2008 and then on the sundaysun website. Exhibit MAM-14 consists of historical pages from the icnewcastle website dated between 2008 and 2010. The Sunday Sun masthead is one of the marks used to identify the undertaking responsible for the website. These pages show offers of books, DVDs, pottery (mugs), prints and cards, t-shirts and photographs (but not calendars, jigsaws, tea towels or posters). Mr McKenzie also provides an example of a reader offer made via the sundaysun website⁶, but this is dated May 2012, i.e. after the dates of filing and publication of the opposed applications. Mr McKenzie says that sales

² See exhibit MAM-21

³ See exhibit MAM-24

⁴ See exhibit MAM-5.

⁵ See exhibit MAM-28.

⁶ See exhibit MAM-15

through reader offers in 2010 and 2011 were just short of £20k and £15k, respectively.

20. Mr McKenzie also provides information about the opponent's photosales service through which members of the public can purchase photographs taken by Sunday Sun photographers and published in the newspaper or on the website. The service has operated since 2003. An example of a story run in the Sunday Sun promoting the service is in evidence⁷. The combined income from such sales between 2003 and 2012 through the Sunday Sun and two of the opponent's sister publications in the North East, The Journal and the Evening Chronicle, amounted to over £80k. Since 2007, the opponent has also offered customers the opportunity to purchase a customised version of the Sunday Sun with the content of the front or back page created by the customer. These are sold as gifts. No information is provided as to the extent of any such sales.

21. Mr McKenzie says that Sunday Sun has been used to brand various events and competitions between 2004 -2011 including a regular mystery picture competition called 'Where in the North?', a competition to find those most deserving of public recognition entitled 'Champions of the North', a Miss Sunday Sun modelling competition, and the Sunday Sun Pub of the Year'. Mr McKenzie says that these competitions have brought in significant income. For example, the Champions of the North event made £65k profit.

22. The opponent has also operated a Reader Travel scheme since 1991 with Sunday Sun branding⁸. The offers are co-branded with the name of the travel operator. The scheme has generated over £4m worth of holiday sales since 1991, although this figure covers all three of the opponent's titles in the North East and it is likely that the proportion attributable to the Sunday Sun is the smallest because it is a weekly paper whereas the other two are daily papers.

23. The opponent also claims to have offered 'dating services' for at least the last 10 years under the mark Sunday Sun, mainly through a page in the newspaper. Exhibit MAM-12 shows what the opponent means by this. It offers space for people to place personal details and indications of the sort of person they would like to date. Placing such advertisements is free, but responding to one means calling or sending a SMS message to a premium rate phone line. This generates income of around £5k per annum.

24. Like most newspapers, the Sunday Sun includes a weather forecast. So does the sundaysun website. The Sunday Sun also provides TV and entertainment listings. Up until 2008, the What's On section of the sundaysun website provided showbiz news and information on arts, theatre, games, cinema, music and gigs. The paper also provides horoscopes. Mr McKenzie says that from 2005 readers could

⁷ See exhibit MAM-16

⁸ See exhibit MAM-12

call a premium rate number to get a more detailed horoscope, but no further information is provided about the take up of this service.

25. Since 1992 the Sunday Sun has featured regular food reviews under the title 'Eddie Eats'. Between 2008 and 2010 the paper also hosted an online forum. It has run a popular blog since 2007.

26. I find that the business known as the SUNDAY SUN provided as money raising activities:

- i) Sale of advertising space in the newspaper and online;
 - ii) Bingo games;
 - iii) Sale of books, DVDs, pottery (mugs), prints and cards, t-shirts, photographs and customised newspapers;
 - iv) Competitions;
 - v) Retail of holidays;
 - vi) Dating advertisements.
- and provided as free services:
- i) Email news alerts;
 - ii) Audio and video news content from a website;
 - iii) Weather forecasts;
 - iv) Horoscopes;
 - v) TV and entertainment guides in paper and online format;
 - vi) Food reviews.

The applicant's business extension activities

27. The Sun has produced a number of supplements. In 1989 there was a supplement called Video Magazine. There were only 6 issues. A TV Guide was provided between 1991 and 2010. A football supplement called Supergoals and a fantasy football supplement called Dream Team were launched in 1996. A holiday supplement called Sun Holidays was launched in 1997. A racing and betting supplement called Favourite was launched in 2002. A motoring supplement called Motors was launched in 2004, and a supplement offering financial tips and advice was launched in May 2011.

28. Like most papers, including the opponent's Sunday Sun, The Sun sells advertising space in the paper itself, in the supplements, and on its website.

According to figures provided by Mr Dinsmore⁹, income from such activity is massive: in the region of £200m per annum.

29. Mr Dinsmore says that The Sun launched its first travel offer in 1986 when it offered trips to France for £1. This was followed in 1991 when The Sun in partnership with a holiday park offered readers the chance to collect vouchers that could be used to purchase accommodation at the holiday park.

30. In 1988, The Sun launched a lotto game which attracted over 4 million entries, the largest number of entries ever recorded for a newspaper competition. The paper has featured a long running 'agony aunt' called Dear Deirdre, which now has an associated telephone advice line

31. In 2002, The Sun started an SMS text messaging service for mobile phone users through which readers could obtain tips about dieting, moving on in 2005 to a WAP service through which mobile phone users could access some of The Sun internet content as well as download ringtones, wallpapers and games. In 2007, The Sun launched a website called thesun.mobi specifically for mobile phone users. The site was a simplified version of the papers main website and offered access to the top 10 stories, horoscopes and Page 3 girls. In return for payment, the website allowed readers to download videos, ringtones and other material for use on mobile phones. There was also a paid for text alert service for news, results, racing tips, and a dating information service.

32. The content of The Sun is syndicated and licensed.

33. The Scottish Sun ran a Miss Scotland competition for 11 years up to 2012. The paper also gives away free rewards to its readers, including DVDs and calendars

34. Sun bingo was launched in 1981 and became a fully fledged online site at sunbingo.co.uk in 2005. At the date of filing the opposed applications, sunbingo had 400k registrants.

35. An online live game show called Sun Quiz Live ran between October 2009 and April 2010. Each game cost 15p to enter.

36. The Dream Team fantasy football supplement also evolved into an online competition in which participants could win prizes if their 'team' performed well.

37. The Sun has an employment section called Sunemployment for readers seeking work.

38. The Sun also sells a range of products. The Sun's Page Three Calendar was first published in 1975 and has been on sale every year since. A number of books, including 'The Sun Guide to the 2010 World Cup' and 'Real Heroes' have been

⁹ See exhibit DD39

published under The Sun branding. The latter reached No.4 in the Sunday Times bestseller chart. Sun Christmas cards were offered for sale in 2007 and Mr Dinsmore says that a range of Sun clothing has been offered for sale “for a number of years”.

39. I find that the business known as THE SUN provided as money raising activities:

- i) Sale of advertising space in the newspaper and online;
 - ii) Travel offers;
 - iii) Games, such as lotto and bingo, and quizzes;
 - iv) Downloadable videos, ringtones and other material for use on mobile phones;
 - v) A text alert service for news, results, racing tips
 - vi) Dating information;
 - vii) Calendars and books;
 - viii) Christmas cards;
 - ix) Clothing.
- and included, at least as free products/services:
- i) TV, football, racing and betting, motoring, holidays and financial supplements;
 - ii) Beauty competitions;
 - iii) DVDs and calendars;
 - iv) Employment and ‘agony aunt’ advice.

The launch of The Sun as a Sunday paper

40. Richard Caseby exhibits various news articles published on or around 8 July 2011¹⁰ which show that the announcement that the News of the World would close prompted speculation that the applicant’s parent company, News International, would launch a Sunday edition of The Sun entitled The Sun on Sunday.

41. The opponent’s lawyers sent the applicant a letter on 15 July 2011. Mr Caseby says that although the letter expressed concern that the applicant’s new paper might be referred to as the Sunday Sun, the opponent expressed no specific concern about the marks applied for. Mr McKenzie says that the letter written on behalf of the opponent sought “*comfort that its rights in SUNDAY SUN would be respected and informing News International to take great care to avoid confusion arising in the*

¹⁰ See RC9

market place.” A copy of the letter is in evidence¹¹. It is true that the focus of the opponent’s concern was on the applicant’s paper being called the Sunday Sun, but opponent did not then know which name was going to be used, so no significance can be attached to the lack of concern about any other potential names. In any event, a subsequent letter from the opponent’s lawyers written on 22 February 2012 made it clear that the opponent was concerned about the Sunday edition of The Sun being called The Sun on Sunday.

42. Mr Painter’s evidence is that following the announcement by Rupert Murdoch on 17 February 2012 that a Sunday edition of The Sun was to be launched, there was a substantial campaign to raise public awareness of the product, which cost several million pounds. The campaign consisted of 300 advertisements. These adverts appeared, inter alia, on national and Scottish TV, radio, the London Underground, at major sporting events, Facebook and in-paper¹². Mr Painter says that Mindshare Media agency estimated that 93.7% of adults had seen the adverts on average 10 times.

43. According to Mr Painter, the Sunday edition of The Sun has a circulation of over 2 million copies per issue, including over 100,000 in the counties of Cumbria, Durham, Northumberland, Teeside, North Yorkshire and Tyne and Wear where the opponent’s Sunday Sun is sold.

Confusion arising from the launch

44. The mark that the applicant has used for the Sunday edition of its newspaper looks like this.



45. Both sides provided evidence about the media’s reaction to the launch of the Sunday edition of The Sun. Mr McKenzie gives evidence on behalf of the opponent¹³ that the media has sometimes referred to the applicant’s paper as the Sunday Sun and the Sun on Sunday. However, the mark shown above is not (The) Sun on Sunday. It is The Sun with the purely descriptive and non-trade mark addition ‘Sunday’. Therefore, the applicant has not yet used the marks applied for. It follows that there cannot have been any public reaction to the use of those marks. The initial widespread reports that the applicant was going to use the title ‘The Sun on Sunday’ for its new Sunday paper is likely to have increased the tendency for journalists to sometimes approximate the mark actually used to ‘The Sun on Sunday’. I will take this into account when I come to weigh such evidence as part of my assessment of the likelihood of confusion and deception.

¹¹ See exhibit RC10

¹² See exhibits RP1-RP5

¹³ See McKenzie 2 and exhibit MAM 36

46. Mr McKenzie gives evidence about an informal telephone survey of retailers that the opponent conducted around the time of the launch of the Sunday edition of the Sun in order to “*establish what trends were emerging*”. It is not clear who made the telephone calls, how many calls were made, or who was called, but the results were set out in an email sent by John Swanson, the opponent’s Regional Retail Sales Development Manager. According to Mr Swanson’s email, there was “*..alot of confusion with customers and retailers/agents*”. In particular, a promotional offer made by the opponent through which customers could purchase the Sunday Sun and the Mirror¹⁴ for a discounted combined price was being misused so as to permit customers to purchase The Sun and the Mirror at the discounted price. However, Mr McKenzie’s evidence is obviously hearsay (probably multiple hearsay) and is also so lacking in detail that no weight can be attached to it. Further, even if the survey had been properly conducted and recorded, it could only measure the level of confusion arising from the applicant’s use of The Sun for the Sunday edition of that paper, which is not one of the opposed marks.

47. Similarly, Mr McKenzie’s evidence that following the launch of the Sunday edition of The Sun, he and his paper’s news desk received many more letters/calls than usual from members of the public outside the Sunday Sun’s circulation area, tells me nothing that is relevant because The Sun is not one of the marks at issue in these proceedings. In any event, the sole example in evidence showing that someone in South Wales sent a communication to the Sunday Sun¹⁵ offers no clue as to why it was sent it to the opponent’s paper when it is not circulated in that area.

48. There is also some evidence that following the launch of the Sunday edition of The Sun, Mr McKenzie was chided on Twitter by someone who thought that he worked for the applicant. This is plainly just a case of mistaken identity and probably has as much to do with Mr McKenzie’s own name as the use of The Sun¹⁶.

49. Mr McKenzie gives evidence that in the 8 weeks following the closure of the News of the World on 7 July 2011 the sales figures for the Sunday Sun increased by 28% and that in the 7 week period following the launch of the Sunday edition of The Sun the average circulation of the Sunday Sun declined by 20% compared to the 7 weeks period prior to the launch. This is offered as evidence that the papers compete for readers rather than evidence of confusion¹⁷. I therefore conclude that there is no evidence of actual confusion or deception as a result of the use of the marks applied for. Indeed there could not be any such evidence because they have not been used.

¹⁴ The Daily Mirror is owned by the opponent’s parent company, Trinity Mirror Group.

¹⁵ A hand written note about an advertisement containing racist jokes, for a local shop in South Wales: see exhibit MAM 36.

¹⁶ Kelvin McKenzie having been one of The Sun’s most famous editors.

¹⁷ See the second statement of Mr McKenzie.

The evolution of the opponent's masthead

50. Part of the applicant's response to the opponent's oppositions is to accuse the opponent of having increased the likelihood of confusion itself by changing its masthead over the years to more closely resemble that of The Sun. I have already noted that the opponent has been using its current masthead since 2003, however, except in one respect, it is substantially the same as the masthead used since 1990¹⁸. The exception is that the words 'Champion of the North' were omitted from the opponent's masthead in 2003. However, the strap line was always secondary to the masthead itself and I therefore doubt that its omission had any significant effect on the likelihood of confusion/deception.

51. Mr McKenzie's evidence is that white-letters-on-a-red-background mastheads are very common in the newspaper industry, particularly for tabloid newspapers like the Sunday Sun. He points out that such use has led to tabloids becoming widely referred to as 'red tops'. However, Mr McKenzie acknowledges that the changes were made before he started working for the opponent, so he cannot give first hand evidence as to why they were made beyond speculating about probabilities.

52. I find that between 1980 and 2003 the opponent's masthead grew closer to the style used by the applicant, but that it has not become materially closer since the changes made in 1990.

THE PASSING OFF CASE

53. As the opponent claims that its goodwill goes wider than the single product for which its earlier mark is registered, I will start with s.5(4)(a) ground of opposition. Section 5(4)(a) of the Act states that 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”.

54. The requirements to succeed in a passing-off action are well established and are summarised in *Halbury's Laws of England* 4th Ed. Vol. 48 (2007 reissue), para 304, drawing on the guidance given by the House of Lords in *Jif Lemon*. Adapting the guidance to the facts in this case the opponent must establish that:

(1) the goods and services it provides have acquired a goodwill in the market and are known by reference to the name SUNDAY SUN;

¹⁸ This can be seen on the front page of the Sunday Sun of September 20, 1992, which is included in exhibit SE1 to Mr Edgley's statement.

(2) use of the contested marks in relation to the goods and services in the specification would give rise to a misrepresentation (whether or not intentional) leading or likely to lead the public to believe that such goods or services are connected in the course of trade to the Opponent; and

(3) it would be likely to suffer damage as a result of the erroneous belief engendered by that misrepresentation.

55. The following further guidance is provided about the assessment of whether the defendant's use of the sign complained about constitutes a misrepresentation.

"The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the claimant;

(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 deception is likely, the court attaches importance to the question of 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."

56. I described the nature and extent of the opponent's goodwill and reputation at paragraphs 12 and 14-26 above. There is no doubt that it was sufficient, in principle, to found a passing off action at the date of the opposed applications. Mr Malynicz submitted that the opponent's reputation was as a regional newspaper. It was therefore not in the same field of activity as the applicant's national paper. In support of this point he drew my attention to the following:

i) There are references in Mr Edgley's evidence to the industry distinguishing between the circulation of regional and national newspapers;

ii) A number of the people mentioned in the opponent's evidence have 'Regional' in their job title, including Mr Edgley;

- iii) In his first statement, Mr Edgley described the opponent's paper as a "*weekly regional newspaper*", and Mr McKenzie said something similar;
- iv) The Sunday Sun is tailored to three particular areas even within its regional coverage;
- v) The opponent's parent, Trinity Mirror, differentiates between its national and regional newspapers¹⁹;
- vi) Mr Caseby for the applicant gives evidence that regional newspapers can be distinguished from national newspapers because regional papers tend to focus on local news and human interest stories.

57. Ms Carboni submitted that the difference between a regional paper and a national paper was immaterial. My attention was drawn to Mr McKenzie's evidence that:

- i) Sunday Sun is distributed across a wider geographical area than most regional papers;
- ii) It includes national and international news as well as local stories;
- iii) It has celebrity news and a strong focus on sport;
- iv) The opponent's circulation increased following the closure of the applicant's paper The News of the World, and decreased following the launch of the Sunday edition of The Sun, indicating that the papers are to some extent in competition.

58. Ms Carboni also drew my attention to *Associated Newspapers Limited and Another v Express Newspapers*²⁰. This was a case of trade mark infringement and passing off. The defendant intended to launch a new free newspaper in London called the London Evening Mail. The claimant owned trade marks and common law rights in the titles, inter alia, The Daily Mail and The Mail on Sunday. The defendant sought to distinguish its business from that of the claimant by pointing to differences between free regional newspapers and national paid-for newspapers. Laddie J. noted that there was some evidence of confusion between one of the claimant's titles, The Mail on Sunday, and a third party local newspaper called Sunday Mail. He went on to say:

"The different geographical spread of the two newspapers was insufficient to prevent that [confusion]. It is difficult to see how the titles used would allow a customer to assume one way or another whether The Mail, The Mail on Sunday or The Daily Mail are regional or not."

¹⁹ See exhibit RC4 to Mr Caseby's statement.

²⁰ [2003] EWHC 1322 (Ch)

59. The judge went on to find that:

“...there is little in the local/national, free/paid and daily/evening argument. None of these differences, even if appreciated by the consumer would be sufficient of themselves or together to deter him from believing, if he were otherwise inclined to do so, that the defendant’s publication is from the same stable as the claimant’s.”

60. Having carefully examined the examples of the respective front pages of the parties’ newspapers in evidence, I also find that the regional/national newspaper distinction is not a material difference. As in the *Associated Newspapers* case, the marks at issue will not assist consumers to distinguish between the national and regional content of the papers. Further, although the applicant’s paper focuses on national news, it may include news with a regional context, and although the opponent’s paper has a regional focus it also includes some national and international stories. Moreover, the regional flavour of the opponent’s paper is more obvious in some weeks than others. For example, the edition from February 4th 2007 had the headline *“Anger as sex offender gets away with slap on wrist”*, which could equally be a headline for a regional or national tabloid. The same applies to the edition from October 12th 2008, which had the headline *“Burglar, 76, vows to go straight”*.

61. My finding is consistent with Mr McKenzie’s evidence that there was some drop off in sales of the Sunday Sun after The Sunday edition of The Sun was launched, suggesting that the papers are to some extent in competition. Mr Malynicz criticised this evidence because it did not show the pattern of sales over a longer period and the apparent drop in sales of the Sunday Sun might therefore have been no more than a seasonal sales pattern. Although no request was made to cross examine Mr McKenzie on his evidence, I accept that his evidence could have provided a more complete picture of the sales figures for the Sunday Sun during the relevant period. Nevertheless, the circulation figures tend to confirm the conclusion that I would have reached even without Mr McKenzie’s evidence on this point.

62. My assessment of the likelihood of confusion under s.5(2) of the Act must cover all the circumstances in which the marks applied for might be used if they were to be registered²¹. The same must also apply to the assessment made under s.5(4). As they stand the applications cover local, regional and national newspapers, so even if the opponent’s newspapers are considered as regional papers, this would do nothing to overcome the oppositions. Recognising this, the applicant offered to amend its list of goods and services, if necessary, so as to exclude regional newspapers and electronic publications: ‘regional’ in this context means the geographical content and

²¹ See *O2 Holdings Ltd v Hutchison 3G Ltd* Case, C-533/06, ECJ, at paragraph 66 (in relation to the corresponding provision of the underlying Trade Mark Directive).

context of the publications (as opposed to the area in which the paper is circulated). I do not consider that such an amendment would assist because i) any differences between the goods would not be sufficiently apparent at the point of selection to reduce the risk of deception, and ii) the goods overlap to such an extent that attempting to distinguish the products on the basis of the geographical context of their respective news content would result in unclear and imprecise specifications lacking the necessary legal certainty²².

63. (The) Sun on Sunday and Sunday Sun are plainly very similar marks. The only two words of note in the marks are the distinctive word Sun and the non-distinctive word (at least for newspapers) Sunday. It is true that the order of the words in the marks differs, so they do not look or sound exactly the same. Nevertheless, the level of visual, conceptual and, to a slightly lesser degree, aural similarity is so high that, all other things being equal, I would not usually hesitate to find that these marks are very likely to be confused through imperfect recollection and/or customers simply mistaking one mark for the other. My assessment of whether the applicant's use would actually constitute a misrepresentation must take account of all the surrounding circumstances. In this case that includes the potentially significant fact that consumers are familiar with the applicant's longstanding and extensive use of The Sun for daily newspapers and related goods and services, which might mitigate the likelihood of deception from use of the opposed marks.

64. The applicant says that I should also consider the effect of its own publicity campaign in 2012 to educate the public about the launch of the Sunday edition of The Sun. I reject that submission for these reasons. Firstly, as the marks applied for had not been used at the date of the applications the relevant date for assessing the s.5(4)(a) objection is the filing date in July 2011²³. Something that happened in 2012 is therefore irrelevant. Secondly, the publicity campaign was about the launch of the Sunday edition of The Sun. As I have already noted, that is not one of the marks applied for.

65. It is necessary to take into account the ways in which the goods and services are sold and the degree of care likely to be exercised when selecting the goods and services. So far as the newspaper itself is concerned, consumers are likely to show a certain loyalty to their usual newspaper, but they are unlikely to pay as close attention when selecting a newspaper as they might do when selecting a more expensive item, such as a watch. Like most products, the practice of ordering newspapers by word of mouth has declined over the years, although no doubt a minority of orders are still placed that way. Deception is less likely in that event because newsagents can be expected to be careful to supply the title requested

²² See Postkantoor CJEU, Case C-363/99 at paragraph 115 of the judgment, and IP Translator CJEU, Case C- 307/10 at paragraph 49.

²³ See, for example, *Advanced Perimeter Systems Limited v Multisys Computers Limited* BL O/410/11 at paragraphs 37-43 of the judgment.

(provided they hear the right name). In any event, newspapers are now more often selected by eye by the consumer himself (or herself) from amongst the publications arranged on a shelf or a stand. In my judgment, there is a *prima facie* likelihood of confusion and deception.

66. Does the applicant's concurrent goodwill under The Sun justify a different conclusion? It is well established that goodwill can be shared by two or more parties²⁴. At the relevant date in 2011 both parties had an established goodwill and reputation. In the opponent's case that was a result of the use of the distinctive word SUN as part of the title Sunday Sun. In the applicant's case it was the result of extensive use of The Sun. The opponent is the senior user, but it would have been far too late in 2011 for the opponent to start complaining about the applicant's use of The Sun, which started in 1964. It would also have been too late for the applicant to start complaining about the get-up of the opponent's masthead, which the opponent has been using in substantially the same form since 1990. By contrast, the applicant's decision to use (The) Sun on Sunday for a Sunday newspaper and associated goods and services materially altered the status quo. In these circumstances the applicant's existing goodwill under The Sun does not, in my view, preclude the opponent's complaint that the proposed use of (The) Sun on Sunday trespasses on its common law rights under the name Sunday Sun.

67. In *Sir Robert McAlpine Limited v Alfred McAlpine plc*²⁵ the parties shared goodwill in the name McAlpine, but had generally distinguished their businesses by the use of the first names Robert and Alfred. Both had rights in McAlpine, which could be asserted against third parties, but neither party could sue the other for using McAlpine as part of its trading name. The Alfred McAlpine business decided to omit the name Alfred. This increased the likelihood of deception and damage to the goodwill of the other McAlpine business. Mr Justice Mann held that in using McAlpine without Alfred, the Alfred McAlpine business would be misrepresenting itself and causing damage to other McAlpine business. Such use was therefore actionable as passing off.

68. In this case, the complaint is that by adding the words "...on Sunday" to its existing trade mark 'The Sun', the applicant has created new marks with new opportunities for confusion and deception.

69. The word Sunday is starkly lacking in distinctive character for Sunday newspapers. However, the opposed marks include 'on Sunday' as part of the trade marks and not just as a description. If that were not so there would be no benefit from registering the (The) Sun on Sunday over the existing registration of The Sun. In my judgment, the opposed marks present a new and greater likelihood of confusion and deception than previously existed as a result of the longstanding use of The Sun alone for a paper sold from Monday to Saturday.

²⁴ See, for example, *Dent v Turpin* 1861 J & H 139 and the *Associated Newspapers* case cited above.

²⁵ [2004] EWHC 630 (Ch)

70. I accept that there is evidence that one or two others, such as the Daily Mail, use the designation 'on Sunday' as part of the title of the Sunday editions of papers known by related names during the rest of the week. The high point of the applicant's case is therefore that the public will recognise this and consequently expect (The) Sun on Sunday to be the Sunday edition of The Sun, rather than anything to do with Sunday Sun. I agree that many of the opponent's customers and potential customers will probably see things this way and will not be confused or deceived. But this will not prevent confusion and deception amongst those customers who fail to notice the difference between (The) Sun on Sunday and Sunday Sun, and/or connect (The) Sun on Sunday with the Sunday Sun rather than with The Sun.

71. As a matter of law it is not necessary to show that a majority of the opponent's customers or potential customers will be confused and deceived. It is sufficient to show confusion and deception, or a likelihood of this, amongst a substantial number of the relevant public²⁶. In my view, the opponent has established this so far as newspapers is concerned.

72. The risk of confusion and deception in relation to electronic publications is similar to newspapers. In this connection, I note that websites are often accessed from the 'hits' delivered by internet browsers. It is a notorious fact that these are designed to match the term searched with similar terms. When presented with hits including 'sundaysun' and 'sunonsunday', it is very easy to see consumers accessing the website of (The) Sun on Sunday when they meant to access the website of the Sunday Sun, and the confusion extending to the downloading of the former publication. I therefore find that the applicant's use of (The) Sun on Sunday in relation to newspapers and electronic publications would have constituted a misrepresentation at the relevant date in July 2011.

73. Substitution of business is a classic head of damage. Loss of control of the opponent's mark and goodwill (to the extent that the applicant's mark is wrongly connected with the opponent) is another. I therefore find that the misrepresentation was likely to cause damage to the opponent's goodwill through diversion of sales and/or loss of control of the goodwill and reputation associated with Sunday Sun.

74. I have reached this conclusion without attaching any weight to the mock-up shown to me at the hearing by Ms Carboni on behalf of the opponent, which purported to represent how the applicant's mark might look in use. That mock-up showed a red masthead with a blue insert identical to that shown at paragraph 12(iv) above, except that where the opponent's mark includes the words 'Sunday' the version attributed to the applicant showed the words 'on Sunday'. In my view, the suggested arrangement of the words would not represent fair and normal use of the opposed marks. The opponent's mark is Sunday Sun (in that order). Therefore if the words in the applicant's mark were arranged in the same manner (as per the mock-

²⁶ See the judgment of the Court of Appeal in *Neutrogena Corp v Golden Ltd* [1996] RPC 473 and *Marks and Spencer plc v Interflora Inc.* [2012] EWCA Civ 1501, at paragraph 30.

up) its mark would logically be 'on Sunday Sun', rather than (The) Sun on Sunday. That is plainly wrong. I therefore regard the mock-up as irrelevant and unhelpful. Nevertheless, for the reasons given above, I find that registration of the opposed marks for newspapers and other printed publications would be contrary to s.5(4)(a).

75. The opponent's reputation is largely focussed in the North East of England, although its website is used by people elsewhere in the UK. Further, although the circulation of the newspaper is regional, it is not a local newspaper known in only a small area. Further, the evidence shows that the opponent's website has carried its reputation to other parts of the UK. In these circumstances, I believe that the opponent would have been entitled to prevent use of the marks applied for throughout the UK²⁷. In any event, although the applicant has offered to exclude newspapers with regional content from the scope of its applications, it has not offered to geographically limit its rights so as to exclude the registration of its marks in the areas where the opponent's goodwill exists.

76. The risk of confusion and deception from the use of (The) Sun on Sunday in relationship to newspapers and electronic publications extends, in my view, to similar printed publications, such as magazines, which are likely to be wrongly connected to the opponent's business.

77. The opponent's goods and services are newspapers, or sold through newspapers or the associated website. Mr Malynicz, for the applicant, accepted that normal and fair use of the applicant's marks in relation to the other goods and services listed in the applications would include the sale of those goods/services through the applicant's newspaper and its associated website. This appears to me to represent the opponent's best case under this head, although I also take account of the possibility of sales of the goods/services unconnected with a newspaper business. The risk of deception is a little lower in these circumstances than it is in relation to the publication itself. This is because, firstly, even if the consumer picks up (or downloads) the wrong publication, he or she may realise the error before selecting from amongst the offers included (although this will not help if the closeness of the names is taken as indicating a commercial connection between the parties). Secondly, the opponent's principal reputation under Sunday Sun is for its newspaper: it has only a limited (although not negligible) and connected goodwill for the goods and services provided through the newspaper and its associated website. Offers for sale of goods/services made outside the context of a newspaper business are therefore relatively less likely to confuse or deceive the public.

78. Ms Carboni helpfully supplied me with a list setting out the goods/services the opponent objects to under s.5(4)(a). The list below is based on that list and includes my conclusions.

²⁷ See *Chelsea Man v Chelsea Girl*, [1987] RPC 189 (CoA)

Class and goods/services	Factual basis for opponent's objection	Outcome	Reason
<p>Class 9: Downloadable electronic publications. Publications supplied by electronic means, telecommunications and communications networks. Publications in electronic form. electronic magazines, reports, and newsletters. Articles, columns and written/published articles contained and/or supplied in or by electronic media; downloadable on-line publications; downloadable electronic publications; publications in electronically, magnetically or optically recorded and recordable forms.</p>	<p><i>Sunday Sun</i> website – news, sports & entertainment online content (para 12 Edgley)</p>	<p>Upheld</p>	<p>See above.</p>
<p>Web pages. Podcasts.</p>	<p>Sunday Sun website (para 12 Edgley); Audio content (para 74 McKenzie 1).</p>	<p>Upheld</p>	<p>If web pages and podcasts are goods then they are too close to the opponent's website services: if they are not goods, then they should not have been accepted in class 9.</p>
<p>Electronic games; games and quizzes supplied by or played on the internet.</p>	<p>Bingo (para 20 McKenzie 1)</p>	<p>Upheld</p>	<p>Likelihood of deception through on-line games provided via applicant's website.</p>
<p>Downloadable music provided on-line from a database or from the Internet. downloadable videos supplied on-line from a database or from the</p>	<p>Audio and video content of opponent's website (MAM 32 – e.g. video of Radio 1 gig).</p>	<p>Rejected</p>	<p>No evidence that the opponent's goodwill extends to downloadable music or videos.</p>

<p>Internet (including websites) containing music, entertainment and instructional material.</p> <p>CD-Roms, DVDs and pre-recorded compact discs containing music, entertainment and instructional material (but not including CD Roms, DVDs and pre-recorded compact discs containing computer software other than that used for opening media applications.</p> <p>Class 16: Paper, cardboard and goods made from these materials, not included in other classes;</p> <p>Printed matter; printed publications; newspapers; newsletters; articles, columns and written/published articles contained and/or supplied in or by print media; magazines; periodicals; books; reference books; supplements.</p> <p>Manuals, catalogues, puzzle books</p> <p>Calendars.</p> <p>Photographs; posters; Drawings; stickers.</p>	<p>Opponent's sale of DVDs, (para 37(b) McKenzie 1, MAM14, p3).</p> <p>Football fixture cards & Lucky Numbers Lottery cards (para 18 McKenzie 1).</p> <p>Opponent's principal goods plus Reader travel brochures (para 33 McKenzie 1 & MAM14); Sale of books (para 37a McKenzie 1). "Motorsnortheast" and "7DAYS" supplements (para 5 Edgley).</p> <p>As above.</p> <p>Sale of calendars (para 37c McKenzie 1).</p> <p>Buy a Photo (para 41 to 44 McKenzie 1); sale of prints, (para 37c McKenzie 1).</p>	<p>Upheld for DVDs</p> <p>Rejected</p> <p>Upheld</p> <p>Rejected</p> <p>Upheld</p> <p>Upheld</p>	<p>Sales of DVDs containing music and entertainment from a website likely to cause deception.</p> <p>No evidence that the opponent's business trades in these goods under the Sunday Sun (although it may have given them away as promotional items).</p> <p>All similar to newspapers and/or the extension goods associated with the opponent's goodwill.</p> <p>Not covered by the opponent's goodwill</p> <p>Same/similar to goods sold by opponent's business.</p> <p>As above.</p>
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<p>Instructional and teaching material (except apparatus).</p> <p>Plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed awards; gift certificates; gift bags; decalcomanias.</p> <p>Parts and fittings for all the aforesaid goods.</p> <p>Class 35: Provision of space on websites for advertising goods and services.</p> <p>Advertising, marketing, public relations, publicity and/or promotional services.</p> <p>Compilation of directories for publishing on the Internet.</p> <p>News clipping services.</p> <p>Organisation, operation and supervision of sales and promotional incentive schemes.</p>	<p>Gift bags (p. 4 MAM4), Make the Front Page (para 45, McKenzie 1).</p> <p>Advertising on the Sunday Sun website (para 84 McKenzie 1, MAM11, MAM14, MAM22, MAM33).</p> <p>Sale of advertising space (para 11 McKenzie 1)</p> <p>Directories (para 66 & 67 McKenzie 1), Archives of reviews (para 69 McKenzie 1).</p> <p>Closely related to opponent's core business</p> <p>Reader Offers (paras 34 to 40 McKenzie 1).</p>	<p>Rejected</p> <p>Rejected</p> <p>Follows outcome for main goods.</p> <p>Upheld</p> <p>Upheld for advertising, rejected for other services.</p> <p>Rejected</p> <p>Upheld</p> <p>Rejected</p>	<p>No evidence opponent's goodwill extends to these goods.</p> <p>No evidence opponent's goodwill extends to these goods.</p> <p>Likelihood of deception.</p> <p>No evidence opponent's goodwill extends to other services offered to third parties.</p> <p>No evidence opponent's goodwill extends to such services offered to third parties.</p> <p>Likelihood of deception.</p> <p>No evidence that the opponent provides these services for others.</p>
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<p>The bringing together, for the benefit of others, of a variety of goods namely beauty products, toiletries, personal care products, cosmetics, perfumery, candles, pharmaceutical and veterinary goods, machines for household use, building, home improvement and gardening goods, home decorating equipment, paints and varnishes, hand tools, CD-Roms, DVDs and pre-recorded compact discs containing music, entertainment and instructional material (but not including CD Roms and pre-recorded compact discs containing computer software other than that used for opening media applications), sunglasses, spectacles, contact lenses, agricultural and horticultural goods, fresh fruits and vegetables, natural plants and flowers, meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice,</p>	<p>Reader Offers (paras 34 to 40 McKenzie 1); sale of and DVDs (para 37b McKenzie 1).</p> <p>Eddy Eats pub/food reviews (para 68 to70 McKenzie 1).</p> <p>What's On (para 64 McKenzie 1).</p> <p>Sale of prints (para 37c McKenzie 1).</p> <p>Sale of teatowels (para 37c McKenzie 1).</p> <p>Sunday Sun online shopping channel (para 34 McKenzie 1).</p>	<p>Upheld for the goods opposite, rejected for the rest because insufficient nexus between retailing of these products and opponent's goodwill.</p>	<p>The bringing together, for the benefit of others, of DVDs containing music and entertainment, printed publications, books, newspapers, magazines, comics, journals, television listings, printed materials, greeting cards, stickers for collecting and collating in albums, clothing, china, art, paintings, posters, postcards, prints, photographs, crockery.</p>
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<p>beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), musical instruments, medical equipment, jewellery, clocks, watches, stationery, printed publications, books, newspapers, magazines comics, journals, quiz books, shopping guides listing products for purchase, television listings magazines, printed materials, diaries, organizers, greeting cards, gift wrap, writing paper, writing sets, stickers for collecting and collating in albums, leather goods, luggage, footwear, headgear, clothing and accessories, hair accessories, lighting, kitchenware, glassware, china, porcelain, ornaments, furniture kitchens, sanitary ware, art, paintings, posters, postcards, prints, photographs, household containers and utensils, crockery, cutlery, furnishings, carpets, textiles, table linen, bed linen, haberdashery, sewing machines and equipment, toys, games and playthings, playing cards, sports equipment, fitness equipment, camping equipment, pets goods, food and drink, apparatus for use in relaxation, motor vehicles and their parts, enabling</p>			
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<p>customers to conveniently view and purchase those goods including via an Internet website, an interactive television shopping channel, a digital television shopping channel, an Internet walled garden or by means of interactive television and/or telecommunications (including voice, telephony and/or transfer of digital information or data) and/or interactive digital media.</p> <p>Information relating to all the aforementioned services provided on-line from a computer database or via the Internet.</p> <p>Class 36 Real estate agency services.</p> <p>Financial affairs; monetary affairs; financial services relating to bank cards, credit cards, debit cards, cash disbursement, cheque verification and cheque cashing, issuing and redemption of travellers' cheques and travel vouchers and advisory services relating thereto.</p> <p>Money saving advice; provision of financial information; wealth information; information services relating to insurance and financial matter.</p>	<p>Sunday Sun website</p> <p>Homes North East (para 55 to 57 McKenzie 1)</p> <p>Mr Justice column (para 13 Edgley & MAM1)</p> <p>Mr Justice (para 13 Edgley & MAM1).</p>	<p>Will follow conclusions on principal services</p> <p>Rejected</p> <p>Rejected</p> <p>Rejected</p>	<p>Likelihood of deception.</p> <p>Issuing a property supplement does not mean that the opponent's goodwill extends to real estate services.</p> <p>Offering consumer advice does not mean that the opponent has goodwill as a financial services provider.</p> <p>The opponent provides consumer advice through its paper but it does not have goodwill for financial information services.</p>
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<p>Analysis, evaluation, advice, consultancy and information services relating to all the aforesaid services;</p> <p>Providing the aforesaid services using the Internet and other electronic communications networks; information supplied on the Internet or other electronic communications networks relating to the aforesaid services.</p> <p>Issuing of tokens of value in relation to bonus and loyalty schemes.</p> <p>Class 38 Radio and television broadcasting; webcasting [‘390 application only]; providing online forums, chat rooms, journals and blogs.</p> <p>Class 39 transportation and delivery of newspapers and periodical publications; transport services relating to the distribution of newspapers and periodicals; distribution (transport) of newspapers and periodicals by road; distribution (transport) of newspapers and periodicals for retail sale; services for arranging the distribution of newspapers and periodicals.</p>	<p>Prize draws and giveaways, e.g. Grab a Grand, Next Vouchers (para 17 McKenzie 1)</p> <p>Sun website; audio and video content (para 74 McKenzie 1).</p>	<p>Will follow the outcome of the above services.</p> <p>As above.</p> <p>Rejected</p> <p>Rejected except for webcasting and proving online journals</p> <p>Upheld</p>	<p>No evidence that the opponent provides these services for others.</p> <p>There is insufficient connection between radio and TV broadcasting and operating a news website connected to a newspaper to cause deception in the circumstances of this case.</p> <p>The opponent’s evidence indicates that it distributes some of its own newspapers, but there is no evidence that delivery services are provided as such to external parties. Nevertheless, the services are closely connected to the opponent’s core business and the use of a very similar mark for such services is likely to cause confusion and deception.</p>
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<p>Travel arrangement.</p> <p>Class 41 Entertainment; sporting and cultural activities;</p> <p>Publishing services; publication of printed matter and printed publications; electronic publishing services; providing on-line electronic publications; publishing printed and electronic periodicals, magazines, directories, catalogues, books, journals, magazines, newsletters, guides, reports, bulletins and other materials. publication of materials for access from databases, the Internet or other electronic communication networks; organising and providing electronic publications; and databases on-line and/or on electronic media; publishing general interest newspapers and general interest magazines and on-line versions of them (other than for third parties).</p> <p>literary agency services.</p> <p>Publication of calendars of events.</p>	<p>Reader Travel (para 28 to 33 McKenzie 1).</p> <p>What's On (para 64 and 65 McKenzie 1).</p> <p>Opponent's core goods and website.</p> <p>What's On (para 74 McKenzie 1), sale of calendars (para 37c McKenzie 1).</p>	<p>Upheld</p> <p>Rejected</p> <p>Upheld, except for publishing of catalogues, and directories.</p> <p>Rejected</p> <p>Upheld</p>	<p>The opponent's business includes selling holidays.</p> <p>The provision of a entertainment supplement does not mean that the opponent's goodwill extends to entertainment services.</p> <p>Complementary connection between opponent's core goods/applicant's services except for those listed in next column, for which the opponent has no reputation.</p> <p>No evidence</p> <p>Included in opponent's goodwill.</p>
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<p>Arranging, conducting and organisation of exhibitions, seminars, conferences and shows; hosting and organising awards.</p>	<p>Miss Sunday Sun (para 24 McKenzie 1), sponsorship of agricultural shows (para 16b McKenzie 1))</p> <p>Champions of the North (para 23 McKenzie 1).</p>	<p>Upheld, except for arranging etc. of exhibitions, seminars, and conference</p>	<p>Opponent's goodwill covers organising of shows but does not extend to other services.</p>
<p>Web content creation and search services relating to entertainment, art education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing.</p>	<p>Sunday Sun website</p>	<p>Rejected</p>	<p>Opponent's goodwill does not extend to these services, even though it may create its own web content.</p>
<p>Organisation of competitions, quizzes, games and recreational and cultural facilities. organisation of lottery competitions; organisation of competitions, quizzes and games provided by means of a general interest newspaper, a general interest magazine or an on-line version; organisation of sports, competitions.</p>	<p>Five-a-side Legends (para 25 Mackenzie 1), Miss Sunday Sun (para 24 McKenzie 1).</p> <p>Lucky Numbers (para 18 McKenzie 1)</p>	<p>Upheld</p>	<p>The opponent's goodwill includes the organisation of competitions.</p>
<p>News programme services for radio or television.</p>	<p>Audio and video content of website (para 74 McKenzie 1).</p>	<p>Rejected</p>	<p>The opponent's goodwill does not include radio or TV broadcasting.</p>
<p>Reservation of tickets. Booking of seats for shows.</p>	<p>Ticket giveaways (para 17 McKenzie 1), What's On (para 64 & 65 McKenzie 1), Reader Travel (para 28 to 33 McKenzie 1).</p>	<p>Rejected</p>	<p>It is artificial to consider that any of the opponent's services extend its goodwill to the services of a ticket agent.</p>

<p>Provision of information relating to entertainment, art education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing. Providing information in databases and information online relating to news, sport, sports events, fitness, leisure and fitness activities, entertainment, art education, current events, politics and political events, amusements, sporting and cultural activities. Information relating to motor racing and motor sports. Sports and fitness information services. providing information in interactive database services relating to entertainment, education, games, activities, gambling, contests and events. Travel and [152 application only] sports information services.</p>	<p>Core goods and associated website.</p>	<p>Upheld</p>	<p>This is what the opponent provides via its website and makes up part of its goodwill.</p>
<p>Production of fashion shows.</p>	<p>Miss Sunday Sun (para 24 McKenzie 1)</p>	<p>Rejected</p>	<p>Miss Sunday Sun is not a fashion show and the opponent would not be expected to organise such events.</p>
<p>Games, gaming, gambling and casino services. Electronic game services provided by means of the Internet; Lottery operating services;</p>	<p>Bingo (para 20 McKenzie 1). Games, competitions, prize draws and giveaways (para 17 to 19 McKenzie 1). Lucky Numbers (para 18 McKenzie 1)</p>	<p>Upheld, except for casino services.</p>	<p>The services fall within the opponent's goodwill, except for casino services. No one would expect a newspaper to operate a casino.</p>

<p>Amusements.</p> <p>Creation, production and distribution of programmes and events for distribution over the Internet and other electronic communications networks.</p> <p>Production of shows and radio and television programmes; cable television, television and radio entertainment services; providing non downloadable digital music from the Internet. Providing non downloadable digital music from Internet web sites.</p> <p>All the aforesaid services also provided on-line or by means of short message services (SMS), multimedia messaging services (MMS), wireless application protocol (WAP) services, and telephone services. information services relating to all the aforesaid services; providing the aforesaid services using the Internet and other electronic communications networks; information supplied on the Internet or other electronic communications networks relating to the aforesaid services; analysis, evaluation, advice, consultancy and information services</p>	<p>Online audio and video content on website (para 74 McKenzie 1).</p>	<p>Rejected</p> <p>Rejected</p> <p>Will follow the listed services.</p>	<p>No evidence.</p> <p>The opponent may create its own content but it does not provide any such services to others. Nor does the opponent's goodwill extend to TV, radio or music.</p>
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<p>relating to all the aforesaid services.</p> <p>Class 43 Provision of information relating to travel and holidays [‘152 application only]. Arrangement of travel and holidays; arrangement and reservation of hotels and accommodation; travel agency services.</p> <p>Temporary accommodation. Travel [‘152 application only].</p> <p>Services for providing food and drink.</p>	<p>Reader Travel (para 28 to 33 McKenzie 1).</p> <p>Reader Travel (para 28 to 33 McKenzie 1).</p> <p>Eddy Eats</p>	<p>Upheld</p> <p>Rejected</p> <p>Rejected</p>	<p>Within the opponent’s goodwill.</p> <p>The opponent’s goodwill does not extend to the provision of accommodation or travel as such.</p> <p>Providing a food review does not mean that the opponent’s goodwill extends to providing food and drink.</p>
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THE OPPONENT'S EARLIER TRADE MARK

79. The opponent relies upon UK registration 1141360 to support its s.5(2)(b) objection. The trade mark is SUNDAY SUN which (as I noted above) is registered for:

Newspapers for sale in the counties of Cleveland, Cumbria, Durham, Northumberland, North Yorkshire and Tyne and Wear.

80. Section 5(2)(b) is as follows:

“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.”

81. The opponent's trade mark was filed in 1980 so it is plainly an earlier trade mark. Because the registration procedures were completed more than five years before the dates of publication of the opposed marks, the earlier mark is subject to the proof of use requirements set out in s.6A of the Act.

Limitation to, and exclusion of, 'regional' newspapers

82. In a similar vein to his submissions about the nature of the opponent's goodwill for the purposes of the s.5(4)(a) assessment, Mr Malynicz submitted that the opponent had only shown use of its mark in relation to regional newspapers for sale in the counties of Cleveland, Cumbria, Durham, Northumberland, North Yorkshire and Tyne and Wear and that the comparison of goods and services should be limited accordingly. For this purpose, Mr Malynicz relied on the facts already covered in paragraph 56 above. He also drew my attention to a number of authorities on partial revocation, both at national level and in the General Court of the European Union²⁸. I do not consider it necessary to review these authorities in detail because this case does not call into question the basic legal principles to be applied in arriving at a fair specification. These were summed up by Mr Geoffrey Hobbs Q.C. as The Appointed Person in *Euro Gida Samayi Ve Ticaret v Gima (UK) Limited* as follows:

“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

²⁸ Including *Reckitt Benckiser (Espana) SL v OHIM (ALADDIN)* Cast T-126/03, *Munipharma v OHIM*, Case T-256/04, *Thomson Holidays Ltd v Norwegian Cruise Line Limited* [2003] R.P.C. 32, *West v Fuller Smith & Turner* [2003] F.S.R. 44, *Euro Gida Samayi Ve Ticaret v Gima (UK) Limited*, BL O/345/10 and *Pan World Brands v Tripp* (Extreme Trade Mark) [2008] R.P.C. 2.

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

83. In essence Mr Malynicz submitted that the average consumer of newspapers would call the opponent’s product a regional newspaper and so that should be the extent of the protection to which the opponent is entitled under s.5(2). I disagree. In my judgment the regional circulation of the opponent’s newspaper is already reflected in the geographical limitation in the specification of UK registration No.1141360. I accept that regional newspapers are a definable sub-category of newspapers if this means that they are circulated only in a particular area or areas of the UK. That is largely what the consumer would have in mind when describing a newspaper as a regional paper. I also accept that such consumers might expect papers circulated in a limited geographical area to have more local or regional news content compared to a national paper. However, the geographical bias of the news coverage is likely to vary from week to week and whether some stories are national, regional or local is partly subjective. Further, the geographical focus of the news content would not necessarily be apparent to a consumer in the ordinary course of selecting the goods. I note that in the *Associated Newspapers* case, Laddie J. rejected a request to limit the specification of the claimant’s trade mark to ‘Sunday newspapers’ because he considered that was not a sufficiently distinct sub-category of newspapers. In my view, it is no easier to define the difference between a regional paper and a national paper (other by means of the areas in which they are circulated) than it is to define the difference between a daily paper and a Sunday paper.

84. Mr Malynicz sought to draw an analogy with the case of *West v Fuller Smith & Turner* in which the judge at first instance held that the registration of a trade mark for ‘beers’ should be restricted to ‘bitter beers’. The appellant contested the restriction pointing to the ill-defined boundaries between bitter beers, lagers and other types of beer. However, the Court of Appeal upheld the judge’s finding. I note that this case was decided before the judgment of the CJEU in *Koninklijke KPN Nederland NV v. Benelux-Merkenbureau* on 12 February 2004²⁹, which held that trade mark specifications should not be burdened with exclusions of goods or services which undermine the requirement for legal uncertainty as to the scope of the protected goods. Further, it is apparent from the Court of Appeal’s reasoning³⁰ in the *West* case that it attached weight to the judge’s finding that, in the main, beer drinkers drink either bitter or lager, but not both. I do not consider that the same can be said of local, regional and national newspapers. And as the Court of Appeal expressly acknowledged in *West*, every case depends on its own facts³¹. I do not accept that the regional news content of the opponent’s newspaper represents a discernible sub-category of newspapers that requires or permits further restriction of

²⁹ Case C-363/99 at paragraph 115 of the judgment.

³⁰ See paragraph 58 of the judgment.

³¹ See paragraph 57 of the judgment.

the specification under s.6A for the purposes of the comparison of goods/services under s.5(2).

85. In any event, the proposed restriction of the opponent's specification will not assist the applicant unless I also accept the proposed exclusion of regional news content from the specifications of the applications. As I have already indicated, I consider that the difficulty of defining local/regional/national/international news means that an exclusion of the kind proposed would breach the requirement for legal certainty about what is/is not covered.

Concurrent use of Sunday Sun and The Sun

86. In another echo of the arguments around the s.5(4)(a) ground, Mr Malynicz submitted that I should attach weight to the long co-existence of the Sunday Sun and The Sun without evidence of confusion. In this respect, my attention was drawn to the judgment of the CJEU in *Budejovicky Budvar v Anheuser-Busch*³² as a result of which the Court of Appeal held that the parties Budweiser marks should continue to co-exist on the register as they had done both on the register and in the market for many years before.

87. Ms Carboni submitted that:

- i) The reputation of the *later* trade mark is irrelevant to the assessment of the likelihood of confusion³³;
- ii) The use made of The Sun is immaterial because that is not one of the marks applied for.

88. I am doubtful that the first point means that concurrent use is necessarily irrelevant to the assessment of the likelihood of confusion³⁴. After all, long established concurrent use one was of the main factors which led the CJEU to answer as it did in *Budweiser*. However, I accept that the use of The Sun cannot be taken to an accurate predictor of the likelihood of confusion (or lack of it) from the use of (The) Sun on Sunday. This is consistent with the judgement of the Court of Appeal in *Reed Executive Plc v Reed Business Information Ltd*³⁵ that Reed was a different mark to Reed Business Information (even for business information services). It also accords with the judgment of the General Court in *Grupo Sada, pa, SA v OHIM*³⁶. I therefore find that the applicant's longstanding use of The Sun is not sufficient to exclude the likelihood of confusion for the purposes of s.5(2)(b). As a

³² Case C-482/09, reported at [2012] R.P.C. 11.

³³ Per paragraph 84 of the judgment of the CJEU in *Aceites del Sure-Coosur v OHIM* (La Espanola) Case C-498/07.

³⁴ In paragraph 82 of the same judgment, the CJEU appeared to accept that peaceful co-existence might be relevant.

³⁵ See paragraphs 37-41 of the judgment reported at [2004] RPC 40.

³⁶ Case T-31/03 at paragraph 86.

likelihood of confusion between the marks is liable to damage the essential function of the earlier mark, this is not an exceptional case like *Budweiser*.

89. Turning then to consideration of whether there is a likelihood of confusion, I take into account the guidance from the settled case law of the 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] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v 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 (and ears) of the average consumer of the 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 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) 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: *Limoncello*.

(f) beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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: *Medion*.

(g) 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*.

(h) 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*.

(i) 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*.

(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: *Marca Mode CV v Adidas AG & Adidas Benelux BV*.

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Comparison of marks

90. The marks (The) Sun on Sunday and Sunday Sun are self evidently similar to a high degree. This is because i) the words “the” and “on” make only a minimal contribution to the overall impression created by the applicant’s marks, and ii) although the order of the words Sun and Sunday is different, they are the same words. The words (The) Sun on Sunday and Sunday Sun have the same meaning (Sunday qualifying Sun). Therefore there is a high level of visual and conceptual similarity. The change to the order of these words and the addition of “the” and “on” to the applicant’s marks means that the level of aural similarity is perhaps a bit lower than under the other heads, but it is still fairly high.

Distinctive character of earlier mark

91. The Sunday Sun mark is inherently distinctive for newspapers because although the word Sunday is non-distinctive on its own, the word Sun is not descriptive, allusive or commonplace for such goods. It is not as highly distinctive as a wholly invented word, like Jif, but the word Sun appears to have an above average level of distinctiveness for newspapers (notwithstanding that there are two users of it). Further, the earlier mark as a whole has been used in relation to a Sunday newspaper in the North East of England since 1919, so at least within this area it was likely to have had an above average level of distinctiveness at the date of filing of the opposed applications.

Average consumer

92. The average consumer of the goods and services covered by the application is likely to be an ordinary member of the general public, although in the case of certain services, such as the sale of advertising space, it will also include other businesses. The average consumer is deemed to be reasonably careful and circumspect. Selecting a newspaper or posting an advertisement is an ordinary commercial transaction. Therefore relevant consumers in this case are likely to pay an average level of attention when selecting the goods/services at issue.

Comparison of goods and services

93. In comparing the respective services, I take account of the judgment of the CJEU in *Canon* where the court stated at paragraph 23 of its judgment that:

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

94. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*⁴⁴, the General Court restated 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”.

95. The applications include in class 16:

Printed publications; newspapers; newsletters; articles, columns and written/published articles contained and/or supplied in or by print media; magazines; periodicals; books; reference books; supplements.

96. Newspapers are clearly identical to the goods for which the opponent’s mark is registered. These are included in the broader term ‘printed publications’. These goods are therefore also identical to newspapers. The other goods are either parts of newspapers (articles, columns and written/published articles contained and/or supplied in or by print media, supplements) or other types of printed publications. Some, such as ‘newsletters’, are more similar to newspapers than others, e.g. books. However, they are all similar in nature and purpose and in competition to a greater or lesser extent. For example ‘reference books’ includes travel guides, which may compete with the travel section of a newspaper and/or its supplement.

97. The applications also include in class 9:

Downloadable electronic publications; publications in electronically, magnetically or optically recorded and recordable forms.

98. These descriptions include electronic versions of newspapers, which are self evidently highly similar to newspapers.

99. The applications also include in class 35:

The bringing together, for the benefit of others, of a variety of goods namely printed publications, newspapers, journals, television listings, magazines, printed materials.

100. These services are different in nature to newspapers, but are complementary to such goods and therefore similar to a reasonable degree.

101. The applications also include in class 36:

Provision of financial information; wealth information; information services relating to insurance and financial matters; providing the aforesaid services using the Internet and other electronic communications networks.

102. There is some similarity between these services and the sort of financial information provided in some newspapers (although not shown to be something for which the opponent's paper is known). The goods and services are therefore in competition to some extent, e.g. one might obtain similar information from buying a financial newspaper or via the internet. There is therefore a reasonable degree of similarity between these services and 'newspapers' *per se*.

103. The applications also include in class 39:

Transport; transportation and delivery of newspapers and periodical publications; transport services relating to the distribution of newspapers and periodicals; distribution (transport) of newspapers and periodicals by road; distribution (transport) of newspapers and periodicals for retail sale; services for arranging the distribution of newspapers and periodicals.

104. These services are different in nature and purpose to newspapers, but are complementary to such goods and therefore similar to a reasonable degree.

105. The applications also include in class 41:

Publishing services; publication of printed matter and printed publications; electronic publishing services; providing on-line electronic publications; publishing printed and electronic periodicals, magazines, journals, newsletters, guides, reports, bulletins and other materials; publication of materials for access from databases, the Internet or other electronic communication networks; organising and providing electronic publications and databases on-line and/or on electronic media; publishing general interest newspapers and general interest magazines and on-line versions of them (other than for third parties); provision of information relating to entertainment, art, education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing; provision of news relating to

entertainment, art, education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing; providing information in databases and information online relating to news, sport, sports events, fitness, leisure and fitness activities, entertainment, art education, current events, politics and political events, amusements, sporting and cultural activities; information relating to motor racing and motor sports; sports and fitness information services; travel and sports information services; organisation of competitions, quizzes and games provided by means of a general interest newspaper, a general interest magazine or an on-line version of either.

106. These services are about publishing newspapers or closely similar goods or providing information usually found in newspapers and/or their supplements. There is therefore some similarity of purpose. Publishing services are complementary to newspapers (particularly as the applicant has indicated that this is meant to include publishing its own material). The information services are to some extent in competition with newspapers. There is therefore a reasonable degree of similarity between all the above services and newspapers.

107. The applications also include in class 43:

Provision of information relating to travel and holidays.

108. I consider that this service is also reasonably similar to newspapers for similar reasons to those given above.

109. Ms Carboni contended that a number of other goods/services included in the opposed applications were also similar to newspapers. However, as I found that all of these goods/services are caught by the s.5(4)(a) ground of opposition, there is no need for me to extend this decision further by explaining why I disagree.

Likelihood of confusion

110. In my view, the high level of similarity between the marks coupled with the above average level of distinctiveness of the earlier mark and the identity of the goods so far as 'newspapers' is concerned, means that there was a likelihood of confusion at the date of the applications amongst average consumers of the goods/services at issue, particularly in the area where the opponent's trade mark is protected. I do not consider that the relevant public's familiarity with The Sun as a trade mark for daily newspapers avoids this result. The likelihood of confusion includes direct confusion through such consumers selecting one mark/product believing it to be the other, and indirect confusion, in the sense that consumers would believe that the close similarity of the marks indicates an economic connection between their users, e.g. that the applicant's paper is from 'the same stable' as the opponent's product.

111. It is sufficient to show that the applicant's mark and goods/services are likely to be mistakenly believed to be economically connected to the opponent. However, it is also sufficient if the opponent's earlier mark (and the goods sold under it) are likely to be mistakenly connected to the applicant's mark and goods/services³⁷. Both scenarios are likely here.

112. Confusion was somewhat less likely where the respective goods/services are only similar. However, given the applicant's acceptance that normal and fair use of its mark includes the provision of the contested goods/services through a newspaper and its associated website, I consider that the objection also succeeds for the similar goods/services listed above.

113. In the expectation that this case may go further, Mr Malynicz asked me to cover the scenario that the opponent's goods had been restricted further to 'regional newspapers for sale in the counties of Cleveland...' etc. I have considered the nature and extent of the opponent's goodwill in the process of assessing the s.5(4)(a) ground. The outcome of the opposition on that ground indicates what the conclusion would have been under s.5(2) if I had compared the actual product sold by the opponent with the goods/services covered by the application.

Opponent's submissions to OHIM

114. Subsequent to the hearing the applicant drew my attention to various submissions made by the opponent in opposition proceedings at OHIM, where the parties' roles are reversed. These are not consistent in all respects with the opponent's submissions in these proceedings. I have taken this into account but decided to give more weight to the submissions received in these proceedings than to the submissions made elsewhere.

Conclusion

115. The opposition succeeds for all the underlined services in Annex A. The trade marks should be registered for all the other goods/services.

Costs

116. Both sides have achieved a measure of success. The opponent has successfully made out grounds under s.5(2) and s.5(4) that the applicant resisted. On the other hand, measured in terms of the number of opposed goods/services proceeding and refused, the applicant has been equally successful. Overall, I judge that the opponent has been more successful. I will therefore order the applicant to make a contribution towards the opponent's costs.

117. There is no suggestion that costs should be awarded on anything other than the usual scale.

³⁷ See *Omega S.A. v OHIM*, Case T-90/05 at paragraph 43 of the judgment of the General Court.

118. If the oppositions had succeeded against all the opposed goods and services, I would have ordered the applicant to pay the opponent £3650 made up of:

£1000 for filing two notices of opposition (including official fees of £400) and considering the applicant's counterstatements.

£1500 for filing evidence and considering the applicant's evidence.

£1000 for the hearing, including skeleton argument.

£150 towards the cost of the case management conference on 21 August 2012.

119. Recognising that the opponent was less than 100% successful, I reduce this to £2000.

120. This sum should be paid within 14 days of the end of the period allowed for appeal.

Dated this 16th day of April 2013

**Allan James
For the Registrar**

ANNEX A

2587152

Class 9

Automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, fire-extinguishing apparatus; downloadable electronic publications; mouse mats; contact lenses, spectacles and sunglasses; clothing for protection against injury, accident, irradiation or fire; furniture adapted for laboratory use; publications supplied by electronic means, telecommunications and communications networks; publications in electronic form: Web pages; electronic magazines, reports, [electronic] directories and newsletters; electronic games; games and quizzes supplied by or played on the Internet; podcasts; articles, columns and written/published articles contained and/or supplied in or by electronic media; downloadable on-line publications; downloadable electronic publications; publications in electronically, magnetically or optically recorded and recordable forms; downloadable music provided on-line from a database or from the Internet; downloadable videos supplied on-line from a database or from the Internet (including websites) containing music, entertainment and instructional material, but excluding videos containing material relating wholly or primarily to computers, computer software, computer and communications technologies, services relating to the design, use or deployment of any of the foregoing, those industries concerned with computing, communications technologies and information technologies, the development of such technologies or the supply of goods and services relating to them; video tapes, games and cassettes; protective clothing, headgear and footwear; video tapes, games and cassettes; CD-Roms, DVDs and pre-recorded compact discs containing music, entertainment and instructional material (but not including CD Roms, DVDs and pre-recorded compact discs containing computer software other than that used for opening media applications); all the aforesaid goods provided through or in association with a newspaper or a news media company; the aforesaid goods also provided on or via an Internet website or other communications network or means; none of the aforesaid goods relating wholly or primarily to computers, computer software, computer and communications technologies, services relating to the design, use or deployment of any of the foregoing, those industries concerned with computing, communications technologies and information technologies, the development of such technologies, or the supply of goods and services relating to them.

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; printed publications; newspapers; newsletters; manuals; catalogues; articles, columns and written/published articles contained and/or supplied in or by print media; magazines; periodicals; books; reference books; supplements; puzzle books, calendars; bookbinding material; photographs; posters; drawings; stickers; conference folders; folders; stationery; packaging materials; adhesives for stationery or household purposes; artists' materials; paint brushes; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed awards; gift certificates; gift bags; decalcomanias; disposable nappies of paper for babies; printed publications; paint boxes for children; cheque book holders; parts and fittings for all the aforesaid goods.

Class 25

Clothing; footwear; headgear.

Class 35

Advertising, marketing, public relations, publicity and/or promotional services; none of the aforesaid services relating wholly or primarily to computer hardware or software (or services which relate to the design, use or deployment thereof); compilation of directories for publishing on the Internet; provision of space on websites for advertising goods and services; news clipping services; organisation, operation and supervision of sales and promotional incentive schemes, none of the aforesaid services relating wholly or primarily to computer hardware or software (or services which relate to the design, use or deployment thereof); loyalty card services; marketing studies; the bringing together, for the benefit of others, of a variety of goods namely beauty products, toiletries, personal care products, cosmetics, perfumery, candles, pharmaceutical and veterinary goods, machines for household use, building, home improvement and gardening goods, home decorating equipment, paints and varnishes, hand tools, CD-Roms, DVDs and pre-recorded compact discs containing music, entertainment and instructional material (but not including CD Roms and pre-recorded compact discs containing computer software other than that used for opening media applications), sunglasses, spectacles, contact lenses, agricultural and horticultural goods, fresh fruits and vegetables, natural plants and flowers, meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), musical instruments, medical equipment, jewellery, clocks, watches, stationery, printed publications, books, newspapers, magazines comics, journals, quiz books, shopping guides listing products for purchase, television listings magazines, printed materials, diaries, organizers, greeting cards, gift wrap, writing paper, writing sets, stickers for collecting and collating in albums, leather goods, luggage, footwear, headgear, clothing and accessories, hair accessories, lighting, kitchenware, glassware, china, porcelain, ornaments, furniture kitchens, sanitary ware, art, paintings, posters, postcards, prints, photographs, household containers and utensils, crockery, cutlery, furnishings, carpets, textiles, table linen, bed linen, haberdashery, sewing machines and equipment, toys, games and playthings, playing cards, sports equipment, fitness equipment, camping equipment, pets goods, food and drink, apparatus for use in relaxation, motor vehicles and their parts, enabling customers to conveniently view and purchase those goods including via an Internet website, an interactive television shopping channel, a digital television shopping channel, an Internet walled garden or by means of interactive television and/or

telecommunications (including voice, telephony and/or transfer of digital information or data) and/or interactive digital media; information relating to all the aforementioned services provided on-line from a computer database or via the Internet.

Class 36

Insurance; financial services; real estate agency services; building society services; banking; stockbroking; financial services provided via the Internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information; financial affairs; monetary affairs; money saving advice; real estate affairs; wealth information; information services relating to insurance and financial matters; financial services relating to bank cards, credit cards, debit cards, cash disbursement, cheque verification and cheque cashing, issuing and redemption of travellers' cheques and travel vouchers and advisory services relating thereto; analysis, evaluation, advice, consultancy and information services relating to all the aforesaid services; providing the aforesaid services using the Internet and other electronic communications networks; information supplied on the Internet or other electronic communications networks relating to the aforesaid services.

Class 38

Radio and television broadcasting; providing online forums, chat rooms, journals and blogs.

Class 39

Transport; transportation and delivery of newspapers and periodical publications; transport services relating to the distribution of newspapers and periodicals; distribution (transport) of newspapers and periodicals by road; distribution (transport) of newspapers and periodicals for retail sale; services for arranging the distribution of newspapers and periodicals; travel arrangement.

Class 41

Entertainment; providing of training; entertainment; sporting and cultural activities; education; publishing services; publication of printed matter and printed publications; electronic publishing services; providing on-line electronic publications; publishing printed and electronic periodicals, magazines, directories, catalogues, directories, books, journals, magazines, newsletters, guides, reports, books, bulletins and other materials; literary agency services; publication of materials for access from databases, the Internet or other electronic communication networks; publication of calendars of events; organising and providing electronic publications and databases on-line and/or on electronic media; publishing general interest newspapers and general interest magazines and on-line versions of them (other than for third parties); provision, organisation and promotion of courses, training instruction and education; arranging, conducting and organisation of exhibitions, seminars, conferences and shows; hosting and organising awards; none of the aforesaid services relating wholly or primarily to computer hardware, software computer or communications technologies, (or services which relate to the design, use or deployment thereof or those industries concerned with computing, communications and information technologies or products (or their development); Web content creation and search services relating to entertainment, art education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing; organisation of competitions, quizzes, games and recreational and cultural facilities; news programme services for radio or television; reservation of tickets; provision of information relating to entertainment, art education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing; education services relating to fashion; fashion show services; organisation of fashion shows; instruction in fashion; production of fashion shows; hosting and organising awards; provision of news relating to entertainment, art education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing; providing information in databases and information online relating to news, sport, sports events, fitness, leisure and fitness activities, entertainment, art education, current events, politics and political events, amusements, sporting and cultural activities; production of radio and television programmes; information relating to motor racing and motor sports; sports and fitness information services; games, gaming, gambling and casino services; film production services; amusements; creation, production and distribution of programmes and events for distribution over the Internet and other electronic communications networks; providing information in interactive database services relating to entertainment, education, games, activities, gambling, contests and events; electronic game services provided by means of the Internet; production of shows and radio and television programmes; cable television, television and radio entertainment services; providing non downloadable digital music from the Internet; providing non downloadable digital music from Internet web sites; travel and sports information services; booking of seats for shows; gaming and gambling services; lottery operating services; organisation of lottery competitions; organisation of competitions, quizzes and games provided by means of a general interest newspaper, a general interest magazine or an on-line version either; organisation of sports, competitions; news programme services for radio or television; all the aforesaid services also provided on-line or by means of short message services (SMS), multimedia messaging services (MMS), wireless application protocol (WAP) services, and telephone services; information services relating to all the aforesaid services; providing the aforesaid services using the Internet and other electronic communications networks; information supplied on the Internet or other electronic communications networks relating to the aforesaid services; analysis, evaluation, advice, consultancy and information services relating to all the aforesaid services.

Class 43

Travel; provision of information relating to travel and holidays; arrangement of travel and holidays; arrangement and reservation of hotels and accommodation; temporary accommodation; travel agency services; services for providing food and drink.

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Class 9

Automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, fire-extinguishing apparatus; downloadable electronic publications; mouse mats; contact lenses, spectacles and sunglasses; clothing for protection against injury, accident, irradiation or fire; furniture adapted for laboratory use; publications supplied by electronic means, telecommunications and communications networks; publications in electronic form; Web pages; electronic magazines, reports, [electronic] directories and newsletters; electronic games; games and quizzes supplied by or played on the Internet; podcasts; articles, columns and written/published articles contained and/or supplied in or by electronic media; downloadable on-line publications; downloadable electronic publications; publications in electronically, magnetically or optically recorded and recordable forms; downloadable music provided on-line from a database or from the Internet; downloadable videos supplied on-line from a database or from the Internet (including websites) containing music, entertainment and instructional material, but excluding videos containing material relating wholly or primarily to computers, computer software, computer and communications technologies, services relating to the design, use or deployment of any of the foregoing, those industries concerned with computing, communications technologies and information technologies, the development of such technologies or the supply of goods and services relating to them; video tapes, games and cassettes; protective clothing, headgear and footwear; video tapes, games and cassettes; CD-Roms, DVDs and pre-recorded compact discs containing music, entertainment and instructional material (but not including CD Roms, DVDs and pre-recorded compact discs containing computer software other than that used for opening media applications); all the aforesaid goods provided through or in association with a newspaper or a news media company; the aforesaid goods also provided on or via an Internet website or other communications network or means; none of the aforesaid goods relating wholly or primarily to computers, computer software, computer and communications technologies, services relating to the design, use or deployment of any of the foregoing, those industries concerned with computing, communications technologies and information technologies, the development of such technologies, or the supply of goods and services relating to them.

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; printed publications; newspapers; newsletters; manuals; catalogues; articles, columns and written/published articles contained and/or supplied in or by print media; magazines; periodicals; books; reference books; supplements; puzzle books, calendars; bookbinding material; photographs; posters; drawings; stickers; conference folders; folders; stationery; packaging materials; adhesives for stationery or household purposes; artists' materials; paint brushes; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed awards; gift certificates; gift bags; decalcomanias; disposable nappies of paper for babies; printed publications; paint boxes for children; cheque book holders; parts and fittings for all the aforesaid goods.

Class 25

Clothing; footwear; headgear.

Class 35

Advertising, marketing, public relations, publicity and/or promotional services; none of the aforesaid services relating wholly or primarily to computer hardware or software (or services which relate to the design, use or deployment thereof); compilation of directories for publishing on the Internet; provision of space on websites for advertising goods and services; news clipping services; organisation, operation and supervision of sales and promotional incentive schemes, none of the aforesaid services relating wholly or primarily to computer hardware or software (or services which relate to the design, use or deployment thereof); loyalty card services; marketing studies; the bringing together, for the benefit of others, of a variety of goods namely beauty products, toiletries, personal care products, cosmetics, perfumery, candles, pharmaceutical and veterinary goods, machines for household use, building, home improvement and gardening goods, home decorating equipment, paints and varnishes, hand tools, CD-Roms, DVDs and pre-recorded compact discs containing music, entertainment and instructional material (but not including CD Roms and pre-recorded compact discs containing computer software other than that used for opening media applications), sunglasses, spectacles, contact lenses, agricultural and horticultural goods, fresh fruits and vegetables, natural plants and flowers, meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), musical instruments, medical equipment, jewellery, clocks, watches, stationery, printed publications, books, newspapers, magazines, comics, journals, quiz books, shopping guides listing products for purchase, television listings magazines, printed materials, diaries, organizers, greeting cards, gift wrap, writing paper, writing sets, stickers for collecting and collating in albums, leather goods, luggage, footwear, headgear, clothing and accessories, hair accessories, lighting, kitchenware, glassware, china, porcelain, ornaments, furniture, kitchens, sanitary ware, art, paintings, posters, postcards, prints, photographs, household containers and utensils, crockery, cutlery, furnishings, carpets, textiles, table linen, bed linen, haberdashery, sewing machines and equipment, toys, games and playthings, playing cards, sports equipment, fitness equipment, camping equipment, pets goods, food and drink, apparatus for use in relaxation, motor vehicles and their parts, enabling customers to conveniently view and purchase those goods including via an Internet website, an interactive television shopping channel, a digital television shopping channel, an Internet walled garden or by means of interactive television and/or telecommunications (including voice, telephony and/or transfer of digital information or data) and/or interactive

digital media; information relating to all the aforementioned services provided on-line from a computer database or via the Internet.

Class 36

Insurance; financial services; real estate agency services; building society services; banking; stockbroking; financial services provided via the Internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information; financial affairs; monetary affairs; money saving advice; real estate affairs; wealth information; information services relating to insurance and financial matters; financial services relating to bank cards, credit cards, debit cards, cash disbursement, cheque verification and cheque cashing, issuing and redemption of travellers' cheques and travel vouchers and advisory services relating thereto; analysis, evaluation, advice, consultancy and information services relating to all the aforesaid services; providing the aforesaid services using the Internet and other electronic communications networks; information supplied on the Internet or other electronic communications networks relating to the aforesaid services.

Class 38

Radio and television broadcasting; webcasting services; providing online forums, chat rooms, journals and blogs.

Class 39

Transport; transportation and delivery of newspapers and periodical publications; transport services relating to the distribution of newspapers and periodicals; distribution (transport) of newspapers and periodicals by road; distribution (transport) of newspapers and periodicals for retail sale; services for arranging the distribution of newspapers and periodicals; travel arrangement;

Class 41

Entertainment; providing of training; entertainment; sporting and cultural activities; education; publishing services; publication of printed matter and printed publications; electronic publishing services; providing on-line electronic publications; publishing printed and electronic periodicals, magazines, directories, catalogues, directories, books, journals, magazines, newsletters, guides, reports, books, bulletins and other materials; literary agency services; publication of materials for access from databases, the Internet or other electronic communication networks; publication of calendars of events; organising and providing electronic publications and databases on-line and/or on electronic media; publishing general interest newspapers and general interest magazines and on-line versions of them (other than for third parties); provision, organisation and promotion of courses, training, instruction and education; arranging, conducting and organisation of exhibitions, seminars, conferences and shows; hosting and organising awards; none of the aforesaid services relating wholly or primarily to computer hardware or software computer or communications technologies, (or services which relate to the design, use or deployment thereof or those industries concerned with computing, communications and information technologies or products (or their development)); Web content creation and search services relating to entertainment, art education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing; organisation of competitions, quizzes, games and recreational and cultural facilities; news programme services for radio or television; reservation of tickets; provision of information relating to entertainment, art education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing; education services relating to fashion; fashion show services; organisation of fashion shows; instruction in fashion; production of fashion shows; hosting and organising awards; provision of news relating to entertainment, art education, current events, politics and political events, amusements, fitness, leisure fitness sporting and cultural activities, recreation, theatre, television, music, news, and publishing; providing information in databases and information online relating to news, sport, sports events, fitness, leisure and fitness activities, entertainment, art education, current events, politics and political events, amusements, sporting and cultural activities; production of radio and television programmes; information relating to motor racing and motor sports; sports and fitness information services; games, gaming, gambling and casino services; film production services; amusements; creation, production and distribution of programmes and events for distribution over the Internet and other electronic communications networks; providing information in interactive database services relating to entertainment, education, games, activities, gambling, contests and events; electronic game services provided by means of the Internet; production of shows and radio and television programmes; cable television, television and radio entertainment services; providing non downloadable digital music from the Internet; providing non downloadable digital music from Internet web sites; sports information services; booking of seats for shows; gaming and gambling services; lottery operating services; organisation of lottery competitions; organisation of competitions, quizzes and games provided by means of a general interest newspaper, a general interest magazine or an on-line version of either; organisation of sports, competitions; news programme services for radio or television; all the aforesaid services also provided on-line or by means of short message services (SMS), multimedia messaging services (MMS), wireless application protocol (WAP) services, and telephone services; information services relating to all the aforesaid services; providing the aforesaid services using the Internet and other electronic communications networks; information supplied on the Internet or other electronic communications networks relating to the aforesaid services; analysis, evaluation, advice, consultancy and information services relating to all the aforesaid services.

Class 43

Arrangement and reservation of hotels and accommodation; temporary accommodation; travel agency services; services for providing food and drink.