

O-241-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2233378

BY ASSOCIATED NEWSPAPERS LIMITED

TO REGISTER THE TRADE MARKS:

metro.co.uk

AND

metro.com

(A SERIES)

IN CLASSES 9, 16, 35, 36, 38, 39, 41 AND 42

AND THE OPPOSITION THERETO

UNDER NO 97043

BY BAUER RADIO LIMITED

AND

IN THE MATTER OF REGISTRATION NO 2147054B

IN THE NAME OF BAUER RADIO LIMITED

OF THE TRADE MARK:

METRO RADIO

AND THE APPLICATION FOR REVOCATION THERETO

UNDER NO 83917

BY ASSOCIATED NEWSPAPERS LIMITED

1) On 22 May 2000 Associated Newspapers Limited (Associated) filed an application to register a series of three trade marks. One of the series of trade marks was deleted. On 8 February 2008 the application was published for opposition purposes for the trade marks: **metro.co.uk** and **metro.com**. The application is for eight classes of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) Bauer Radio Limited (Bauer) filed an opposition to the registration. The opposition only concerns four of the classes of the application and in relation to two of these classes, only parts of the specifications, to wit:

digital music (downloadable) provided from the internet; digital music (downloadable) provided from MP3 internet web sites;

advertising, promotion and business services; advertising and business services provided on-line from a computer database or from the internet; compilation of advertisements for use as web pages on the internet; classified advertising services; organisation of exhibitions and trade fairs for commercial and advertising purposes;

communication services and information services relating thereto; telecommunication of information including web pages, computer programs and any other data; communication services, all provided on-line from a computer database or from the internet; search engine services; electronic mail services; providing an on-line portal network site; provision of telecommunications access and links to computer databases and the internet; providing user access to the internet; provision of web pages; computer bulletin and message boards; telecommunications services provided in relation to the internet; providing access to digital music web sites on the internet; providing access to MP3 web sites on the internet; delivery of digital music by telecommunications; broadcasting services; television, cable television and radio broadcasting services; news agency services; telephone rental services; provision and rental of telephone chat lines; providing an on-line directory; information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the internet;

education and entertainment services; publishing services; publication of printed matter and printed publications; publishing and publication services; electronic publishing services; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; organisation of exhibitions and shows; provision of information relating to education, sporting events, national and local politics, current affairs, cultural activities and entertainment; sports information services; organisation of competitions, quizzes, games and recreational and recreational and cultural facilities; news programme services for radio or television; all the aforesaid services also provided on-line from a

computer database or from the internet; information services relating to all the aforesaid services; 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 digital music (not downloadable) from the internet; providing digital music (not downloadable) from MP3 internet web sites.

The above goods and services are in classes 9, 35, 38 and 41 respectively of the Nice Agreement.

3) Bauer relies upon section 5(2)(b) of the Trade Marks Act 1994 (the Act), which states:

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

.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

It relies upon a single trade mark registration, United Kingdom registration no 2147054B. The registration is for the trade mark **METRO RADIO**. The application for registration of the trade mark was filed on 3 October 1997 and the registration procedure was completed on 23 July 1999. The trade mark is registered for:

advertising, marketing and promotional services;

telecommunication services; communication services; broadcasting services; television programming; radio broadcasting services; radio programming, broadcasting and production services; wireless transmission and broadcasting of television programmes; cable, satellite and direct to home transmission and distribution of television programmes; cable television, video, subscription television and radio broadcasting and transmission; computer network communications; transmission and reception of data and information; satellite transmission; teletext services; pay per view television transmission services; video on demand transmissions; rental, leasing or hire of apparatus, installations or components for use in the provision of the aforementioned services; advisory and consultancy services relating to the aforementioned services;

radio entertainment services; production of radio programmes; entertainment, education and instruction by or relating to television or radio; production, presentation or rental of television or radio programmes and entertainment services; interactive information provided on-line from computer data bases or the Internet; information provided on-line from computer data bases or the

Internet; provision of information for accessing via communication and computer networks; arranging, organising, presentation and provision of entertainment services; arranging, organising, presentation and provision of concerts, live entertainment, musical performances; organisation of competitions and awards; arranging and conducting competitions; arranging and conducting award ceremonies; presentation of awards for achievement; education and training services relating to radio and television broadcasting; arranging and conducting courses, conferences, exhibitions, events and seminars; organising, conducting, production of shows, events, displays, parties; organisation of events for cultural, entertainment and sporting purposes; organisation of competitions; organisation of sporting competitions and sports events; publication of printed matter.

The above services are in classes 35, 38 and 41 respectively of the Nice Agreement. As the trade mark had been registered for five years or more at the date of publication of Associated's trade mark, it is subject to proof of use, as per section 6A of the Act¹. Bauer claims that its trade mark has been put to genuine use for all of the services it encompasses within the period of five years ending with the date of publication of the application, ie 8 February 2008.

4) Bauer claims that the respective trade marks are similar and that there is a good deal of overlap between the goods and services the subject of the opposition and the services of the earlier registration. Bauer claims that all of the class 38 and 41 services of the application are "identical and similar" to the services of its earlier registration.

5) On 15 May 2009 Associated filed a counterstatement. It required proof of use of Bauer's trade mark in respect of all of the services for which it is registered. Associated denies that registration of its trade marks would be contrary to section 5(2)(b) of the Act.

6) On 22 November 2010 Associated filed an application for the revocation of Bauer's trade mark registration. It seeks revocation of the registration under section 46(1)(a) and 46(1)(b) of the Act in respect of all of the services with the exception of:

radio broadcasting services; radio programming, broadcasting and production services; radio broadcasting and transmission [in for as this relates to radio broadcasting] – class 38;

radio entertainment services; production of radio programmes; entertainment by or relating to radio; production, presentation of radio programmes and entertainment services [in for as this relates to radio broadcasting] – class 41.

7) Section 46 the Act states:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from——

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

Section 100 of the Act states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequent upon section 100, in revocation for non-use proceedings the onus is upon the registered proprietor to prove that it has made genuine use of a trade mark, or that there are proper reasons for non-use.

8) Under section 46(1)(a) of the Act, Associated seeks revocation of the registration from 24 July 2004. Under section 46(1)(b) of the Act, Associated claims that the trade mark of Bauer was not put to genuine use for the periods 22 November 2005 to 21 November 2010 and 25 July 2004 to 24 July 2009; in relation to these periods Associated seeks revocation from 22 November 2010 and 25 July 2009.

9) Associated states that in relation to the opposition proceedings Bauer filed evidence to show proof of use. Associated claims that Bauer failed to file evidence in respect of a number of the services of the registration. Associated states that it is seeking revocation in respect of the services for which use has not been shown.

10) Bauer filed a counterstatement in which it claims that it has made genuine use of its trade mark in respect of the services the subject of the application for revocation.

11) Only Bauer filed evidence. However, Associated filed written submissions.

12) A hearing was held on 3 May 2013. Bauer was represented by Simon Malynicz of counsel, instructed by Urquhart-Dykes & Lord LLP. Associated was represented by Adrian Speck QC, instructed by Bird & Bird LLP.

Witness statement of Sally Aitchison of 20 October 2009

13) Ms Aitchison was, at the time of her witness statement, regional managing director of Bauer Radio North East and Magic Network North. Bauer Radio North East and Magic Network North was part of Emap Consumer Media until January 2008 when it was acquired by the Bauer Publishing Group.

14) Ms Aitchison states that METRO RADIO was first used in July 1974 when the radio station of the same name broadcast its first show. She states that the station broadcasts to North East England to an audience of over 1.4 million. Exhibited at SA1 is a report produced by Radio Joint Audience Research (RAJAR). At page 6 figures are given in relation to "Metro Radio/Magic 1152" for the quarter ending December 2007. The population of the area covered was 1,463,000, the reach 512,000, a reach percentage of 35% and a listening share in TSA (total survey area) of 17.3%.

15) Ms Aitchison states that James Whale, Mark Goodyear, Gabby Logan, Jenny Powell and Jeremy Vine have presented programmes on the station. She states that the *Night Owls* programme has won over 30 national and international awards, including, in 2005, the New York radio award for the world's best talk show. Ms Aitchison states that in 2004 the METRO RADIO breakfast show was promoted when a new presenter, Tony Horne, began presenting the show. Exhibited at SA2 is a flyer for the show. In 2005 a CD of "wind up calls" made by Horne was distributed. An example of the CD is exhibited at SA3. Exhibited at SA4 are examples of a compliments slip, headed letter paper, a car sticker, a business card, a balloon and a lanyard. Exhibited at SA5 are examples of promotions that have been run:

- A competition to win tickets to see Take That.
- A leaflet giving the timetable of programmes.
- A competition to win one of 3 Peugeot cars.
- A competition in relation to Alan Shearer.
- A competition in relation to Take That.
- A beer mat with fixtures for Sunderland AFC.
- A credit sized card with fixtures of Sunderland AFC.

16) The arena in Newcastle is now known as the METRO RADIO ARENA; The Who, Elton John, Beyonce, Tom Jones, Robbie Williams and Meatloaf have appeared at the venue. Exhibited at SA7 are examples of publicity in relation to the Sugababes and another group (the name is not given but by reference to exhibit SA5 it appears to be Take That). The publicity relates to events in June and July 2009.

17) Ms Aitchison states that METRO RADIO has been promoted in the North East of England. In relation to this, exhibited at SA8, is:

A promotion for the Port of Tyne Duck Race, which includes a number of sponsors including METRO RADIO.

A lorry in which there is a stage, the METRO RADIO name appears upon it.

A picture of an outdoor stage around which are large signs for METRO RADIO.

A picture of people at an event on which METRO RADIO appears on the barriers.

A table with various Sunderland AFC promotional items, behind which is a construction with METRO RADIO upon it.

A picture outside of the Stadium of Light, there is a banner celebrating Sunderland AFC being champions. In front of the banner is another banner bearing the name METRO RADIO.

A stretch limousine with the name METRO RADIO upon it.

A railway train upon which METRO RADIO appears upon the outside.

A picture of an office block with the name METRO RADIO upon it, it would appear to be the studios of the radio station.

A car promoting a METRO RADIO competition to win the car.

Taxis bearing METRO RADIO.

A power boat with METRO RADIO upon it.

18) Ms Aitchison states that advertising is a core service offered under the trade mark METRO RADIO. She states that a range of services have been offered to clients, including artwork design, website building, web search engine optimisation, on air and online advertising, on air sponsorship and promotions, events SMS campaigns, field marketing, pod casting, video casting and viral e-mail design and delivery. Ms Aitchison states that the companies that have used the services include: GNER, North Tyne Tourism, Virgin Holidays, Volvo and the NHS. Exhibited at SA9 is a page downloaded on 15 October 2009 from metroradio.co.uk with the heading "Our Creative Solutions for Your Business". The page refers to the services to which Ms Aitchison refers.

19) Exhibited at SA10 are pages downloaded from the website of METRO RADIO on 17 September 2009.

Witness statement of Mary Catherine Ellington of 16 January 2012

20) Ms Ellington is Regional Managing Director of Bauer Radio North East. Parts of the statement of Ms Ellington rehearse what Ms Aitchison has stated and are not repeated here.

21) Ms Ellington states that Bauer Radio North East is a division of Bauer Media Group. She states that METRO RADIO works with advertising agencies as well

as creating advertisements or devising campaigns for clients. Ms Ellington states that some promotion is effected by the sponsorship of features or shows and by competitions. The advertising client often provides a prize and the competition is promoted on air by reference to the client's business. Ms Ellington describes exhibit MCE1 as a representative list of advertising agencies and their clients who advertised with METRO RADIO from 2001 to 2010. (In fact the list stops at 2008.) Two advertising agencies are shown: Robson Brown Advertising and Osborne Jack Media, the vast bulk of the advertising was obtained from the former. Exhibited at MCE2 are copies of invoices from 31 October 2003, 23 October 2003, 11 August 2005 and 30 April 2007 for advertising/promotion services. The radio station is described as Metro FM/Magic 1152 of METRO. Ms Ellington describes exhibit MCE3 as being "a list of the type of promotional activities typically provided for a client". The exhibit consists of 3 pages downloaded from metroradio.co.uk on 21 January 2011. The various promotions shown are in the form of competitions offered by a variety of undertakings. Ms Ellington states that METRO RADIO also offers competitions and quizzes both on and off-air.

22) Exhibited at MCE4 is:

An announcement from *MediaWeek* of 1 October 2003 advising that METRO RADIO is running a "Celeb 4 a Weekend" competition; which is being run through the creative agency Different.

A page from *Campaign* of 1 October 2003 referring to the same competition.

A page from winterjargon.com downloaded on 21 January 2011. It refers to "Metro Radio Battle of The Bands 2004" competition. The following appears:

"By sheer accident and fluke, the band were then entered into the Metro Radio Battle of The Bands 2004 competition, replacing another band that pulled out last minute. Some - including Rachel - felt that the band wasn't ready to enter such a competition. Even after getting through to the final, it was clear from the professional standard of the other contestants, that Winter Jargon were the underdogs of the competition.

It came as a great shock then - to the band and many others - that Winter Jargon emerged as the winners of the competition - hosted and announced by Night Owl's Metro Radio Disc Jockey - Alan Robson. The prize money and musical equipment kindly donated by Sound Control musical instrument retailer, was exactly what Winter Jargon needed to further their sound. The judges described winter jargon as a crossover between 'Tori Amos' and 'Muse.'

Backstage, Alan Robson was happy to relate personal stories, such as how Tori Amos ended up staying over at his house once when her hotel reservations fell through. He described Tori Amos as a very sweet, down to earth sort of girl, and not quite as 'kooky' as some may believe. It would seem though, that he wasn't really sure what to make of Winter Jargon, as he could later only think to describe the band's style as 'plain weird.'"

An Alan Shearer face mask produced for his 2006 testimonial, which relates to a photographic competition run by METRO RADIO.

Two Take That face masks which relate to a photographic competition run by METRO RADIO; the closing date is 31 January 2008.

Articles from the *Evening Chronicle* of 23 May 2006 and 18 August 2006 relating to the Alan Shearer face mask competition.

23) Exhibited at MCE5 are the terms and conditions for a competition entitled Set for the Season, which ran from 23 July 2007 to 3 August 2007.

24) Ms Ellington states that METRO RADIO is used in relation to Internet radio broadcasting and has the associated website metroradio.co.uk. She states that the website was launched on 9 May 1999. Exhibited at MCE6 is a printout from Wayback Machine which gives details of the web pages on metroradio.co.uk from 2000 to 2008. Exhibited at MCE7 are pages downloaded from the Wayback Machine website. These pages emanate from 9 September 2004, 15 October 2004, 1 October 2005, 2 November 2005, 26 December 2005, 13 March 2006, 13 June 2006 and 23 April 2007. Topics included on the web pages include: a debate, details of a film and of a television programme, information about a radio programme, competitions, information about careers, news, and an offer in partnership with the DFDS shipping line.

25) Ms Ellington states that METRO RADIO has been used in relation to road shows. She states that the trade mark has also been used in relation to the hosting and provision of live entertainment such as the organisation and provision of under 18 club nights, community and charity events; including providing entertainment at events such as the Sunderland Young Achiever Awards. Exhibited at MCE8 are:

Pages from a website from 2008 relating to METRO RADIO running under 18 nights in the north east. The website relates to digital awards in the North East. The young clubbers nights are run under the trade mark Sweet. There is, however, reference to "Metro Radio Sweet galleries".

Pages referring to the METRO RADIO roadshow from 28 July 2004, 27 September 2007, 11 March 2005, 20 November 2003, 23 May 2003 and 5 October 2005.

26) Ms Ellington states that Bauer Radio North East sponsors “the regions premier sports and entertainment venue which bears the name METRO RADIO Arena”. At MCE9 there is a photograph of the arena. This sponsorship began in January 2004. Ms Ellington describes MCE10 as containing examples of publicity material distributed between 2005 and 2009 to promote events at the arena. There are three items; one of these relates to July 2005 and another to November 2006. The third item relates to a free event at Dalton Park on 29 September 2006; the tickets are available from METRO RADIO or Bar 55. In relation to the event METRO RADIO, Bar 55, Live @ 55 and daltonpark are mentioned.

27) Exhibited at MCE11 is material relating to events at METRO RADIO Arena.

28) Exhibit MCE12 contains matters relating to the Young Achievers Awards of 2007, which are organised by Sunderland City Council. Various undertakings are identified as supporting the awards; the *Sunderland Echo*, Nike UK, METRO RADIO, Nissan Motor Manufacturing Company and Northumbria Police.

Witness statement of Mary Catherine Ellington of 27 April 2012

28) Parts of this statement rehearse what Ms Ellington stated in her earlier statement. Parts of the statement also relate to the radio broadcasting service, which is not a matter in dispute.

29) Exhibit MCE1 reproduces the material under the same reference to Ms Ellington’s earlier statement with the addition of details of advertising supplied by Robson Brown Advertising Ltd from 2009 to 2010. Exhibit MCE2 reproduces the material under the same reference to Ms Ellington’s earlier statement with the addition of two invoices from 17 August 2008 and 14 November 2010. Exhibit MCE3 reproduces the material under the same reference to Ms Ellington’s earlier statement. Exhibit MCE4 reproduces the material under the same reference to Ms Ellington’s earlier statement with the addition of:

Pages from the *Evening Chronicle* of 19 April 2008 and 24 April 2008 showing a joint competition run by METRO RADIO and the *Evening Chronicle*.

An advertisement for a competition jointly run by METRO RADIO and the MetroCentre.

A printout from metroradio.bauerweb.co.uk relating to a joint competition between METRO RADIO and Beamish Hall which took place in 2009.

A page from the forums of MoneySavingExpert.com in which a message posted on 28 August 2010 refers to “Metro Radio’s Mystery Voices” competition.

30) Exhibit MCE5 includes material exhibited under the same reference to Ms Ellington’s first statement, material that is exhibited at both MCE3s and the terms and conditions of a competition called “McCain – Family of the Month”, which was promoted by Bauer on a number of its radio stations, including METRO RADIO. Dates are given in relation to the competition but not the year, however, a copyright year of 2009 appears. Exhibit MCE6 reproduces the material under the same reference to Ms Ellington’s earlier statement.

31) Exhibit MCE7 consists of various pages from Wayback Machine from the METRO RADIO website (these pages are all different to those exhibited at MCE7 to the earlier statement). The pages emanate from between 1 June 2002 and 5 June 2010. They display the same sort of content as the pages exhibited to Ms Ellington’s first statement. Ms Ellington states that the website allows for broadcasting over the Internet.

32) Exhibit MCE8 reproduces the material under the same reference to Ms Ellington’s earlier statement with the addition of:

Information about The Port of Tyne Duck Race which was to be held on 30 August 2009. The race was to be held on behalf of “Metro Radio’s/Magic 1152’s charity Cash For Kids”.

A copy of an article from the *Berwick Advertiser* of 6 March 2008 about a visit to a primary school by a METRO RADIO presenter to record members of the school singing a folk song.

Various material relating to a Halloween event to be held on 30 October 2010 at Newcastle Racecourse called “Spooky Firework Spectacular”. An extract from the *Chronicle Extra* of 27 October 2010 advises that tickets were available at the METRO RADIO website. An extract advises that the previous year’s event “attracted 13,000 people and raised £15,000 for Metro Radio’s Cash for Kids”. The names of various undertakings appear on the promotional material: METRO RADIO, Magic and the *Evening Chronicle*. One of the extracts from the *Chronicle Extra* of 27 October 2010 reads:

“Tracy Skinner, event and hire manager at Newcastle Racecourse, said: “ At Newcastle Racecourse the team does a huge amount of work behind the scenes preparing this venue for an action packed schedule of racing and major events.

“Although the staff work very hard, they’re not normally reduced to the state of zombies!

“But getting in the spirit for our Spooky Fireworks Spectacular next Saturday is great fun.

“With all the proceeds from the night going to Cash for Kids, it is a great event to host and I can’t think of a better reason to get into the party mood and enjoy an exciting evening out with the family.”

Tickets are available online at www.newcastle-racecourse.co.uk or can be purchased at the racecourse or your local Matalan store.”

A picture of the stage before the event is exhibited which shows the METRO RADIO logo prominently displayed. Parts of the material are illegible. There are various extracts from the *Sunday Sun* relating to this event (not the News International publication).

33) Exhibits MCE9 and 10 reproduce the material under the same references to Ms Ellington’s earlier statement with the addition of three items which show various individuals with the legend “I was there November 2009”. The METRO RADIO logo appears on the items.

34) Exhibit MCE11 reproduces the material under the same reference to Ms Ellington’s earlier statement with the addition of press cuttings relating to events at the METRO RADIO Arena from 6 November 2008 to 30 December 2010.

35) Exhibit MCE12 relates to the Sunderland Young Achievers Awards, organised by Sunderland City Council. The material, in addition to that produced under the same reference to Ms Ellington’s earlier statement, also covers the years 2010, 2011 and 2009. The exhibit also includes pages from an article in the *News Post Leader* of 21 January 2011 in relation to an award ceremony. An award for “Child of Courage” was sponsored by METRO RADIO.

Genuine Use

36) In relation to the proof of use there are a number of dates that have to be considered. However, the dates from which revocation is sought, and are possible, are all after the date of application for the registration of Associated’s trade mark. Consequently, as per the decision of Professor Ruth Annand, sitting as the appointed person, in BL O/220/12, the application for revocation cannot have an effect on the oppositionⁱⁱ; it is only the proof of use as per section 6A of the Act that is pertinent to the opposition.

37) The application for revocation was filed on 22 November 2010, consequently, under section 46(3) of the Act, in relation to the application under section 46(1)(a) of the Act, use from 24 July 2004 to 21 November 2010 must be considered. Under the same provision, in relation to the application under section 46(1)(b), where revocation is sought from 25 July 2009, use from 25 July 2009 to 21 November 2010 must be considered. (All subject to the proviso.)

38) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(3) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the

goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(4) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

It was not argued by Associated that the forms of use of METRO RADIO, eg with a device, were uses in forms altering the distinctive character of the trade mark in which it was registered.

39) If genuine use is established it will be necessary to decide upon a specification that represents fairly the use that has been proved. The description of the use shown must not be pernicketyⁱⁱⁱ. It is necessary to consider how the relevant public, would describe the goods and services^{iv}. The General Court (GC) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to

genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

40) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

41) In his submissions, Mr Speck characterised much of the use of METRO RADIO as being an adjunct to the business of Bauer as a radio station; as effectively being a promotional tool for the basic services of a radio station. Mr Speck submitted that promotional use does not count as use in relation to the promotional goods or services but it will count as use in respect of goods or services being promoted. He prayed in aid the judgment in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, in which the CJEU held:

“17 It is settled case-law that ‘genuine use’ within the meaning of the Directive must be understood to denote actual use, consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (Case C-40/01 *Ansul* [2003] ECR I-2439, paragraphs 35 and 36, and Case C-442/07 *Verein Radetzky-Orden* [2008] ECR I-0000, paragraph 13).

18 It follows from that concept of ‘genuine use’ that the protection that the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d’être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings (*Ansul*, paragraph 37, and *Verein Radetzky-Orden*, paragraph 14).

19 As the Commission submitted in its observations to the Court and as the Advocate General stated in points 45 and 55 of his Opinion, it is essential, in the light of the number of marks that are registered and the conflicts that are likely to arise between them, to maintain the rights conferred by a mark for a given class of goods or services only where that mark has been used on the market for goods or services belonging to that class.

20 For the reasons set out in points 48 and 56 of that Opinion, that condition is not fulfilled where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter.

21 In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings.

22 In the light of the foregoing considerations, the answer to the question referred is that Articles 10(1) and 12(1) of the directive must be interpreted as meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items.”

42) This judgment does not hold that there cannot be genuine use of a trade mark in relation to promotional goods per se but that there cannot be genuine use “where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods”. The judgment is very case specific. Use can

be both to maintain or create a market for goods or services and at the same time be promotional and also be an adjunct to the main business of an undertaking. The two types of use are not mutually exclusive. This was the case in *Daimler Chrysler AG v Alavi (t/a Merc)* [2001] ETMR 98, where Pumfrey J stated:

“73 In my judgment, DaimlerChrysler will be adequately protected in their sales of **promotional** garments if the mark is revoked in respect of all clothing except sweaters, anoraks, polo-shirts, scarves, T-shirts and baseball caps, and I would order accordingly. However, I consider that this raises a point of construction of and approach to Article 10 of the Directive, which is transposed into English law in section 46. It seems to me to be essential to know whether a registration is to be restricted to precisely the goods in respect of which use is shown or some other, wider class, and, if so, what are the criteria by which that class is established. Before the mark is revoked, I consider that a reference may be necessary, and I will hear submissions.”

(emphasis added). In that case there was a sale of garments, so it is not necessarily on all fours with this case, but is indicative that promotional use may also be use to maintain or create a market in goods or services.

Metro Radio Arena Use

43) In relation to use of the trade mark of Bauer in relation to the Metro Radio Arena, Mr Speck argued that Bauer had paid for naming rights. He made comparisons with the naming of sports stadia. Mr Speck distinguished this type of use and the type of use by a licensor of a trade mark; in this case Bauer would be paying the owners of the Arena to have its trade mark used and in the case of a licensor, it would be paid for the use of its trade mark. In terms of genuine use, and the judgment of the CJEU in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01, who pays and who is paid for use of a trade mark is not necessarily a pertinent factor:

“37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as

envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.”

The use in relation to Metro Radio Arena is external, it is used in relation to services provided at the arena and it is used to distinguish services provided at that particular venue as opposed to other venues and so distinguishes those services provided at other venues by other undertakings. It is used in relation to services for which there is payment. The requirement to use relates to use by the proprietor or with the consent of the proprietor. It is clear that the use is with the consent of Bauer (as per paragraph 8 of the statement of Ms Aitchison). METRO RADIO is not being used as indicating sponsorship of an event and so merely promoting a core service or product. The use can clearly be distinguished from the type of sponsorship use that can be seen in relation to The Young Achievers Awards organised by Sunderland City Council; where the award was clearly that of the council and there were a number of sponsors. Mr Speck did not challenge that use of Metro Radio Arena was use of the trade mark in a form which did not alter the distinctive character of the trade mark. His challenge was that it was not use as per *Ajax Brandbeveiliging BV v Ansul BV* and that it was the sort of use that was excluded by *Silberquelle GmbH v Maselli-Strickmode GmbH*. The use of Metro Radio Arena is use upon which Bauer can rely. The use has been since January 2004 (Ellington 2 paragraph 9). Any use after the date of the application for revocation, 22 November 2010, cannot be taken into account in relation to either the revocation or the proof of use period for the opposition. Any use after 8 February 2008 cannot be taken into account in relation to the proof of use period for the opposition. Neither Ms Aitchison nor Ms Ellington give much detail as to when and what actual events have taken place in the Metro Radio Arena. Ms Aitchison refers to several world wrestling events but without reference to date. Ms Ellington refers to other types of events at the arena but gives no specific details of these events. The exhibits show that in every year from 2004 to 2010 popular music acts performed at the Metro Radio Arena. There is evidence of a dance spectacular in April 2006 – MCE11 (first statement) page 74 and cage fighting - MCE11 (first statement) page 79 (although without a date as to when the fighting took place). Relevant to the revocation, but not the proof of use for the opposition, the following events can be seen as taking place at the Metro Radio Arena: Al Murray The Pub Landlords Beautiful British Tour and Torvill and Dean’s Dancing on Ice which took place in 2009 - MCE7 (second witness statement) page 90; Disney Live from 17 March 2010 – MCE7 (second witness statement) page 92; Disney on Ice, Gateshead Summer Flower Show and Cirque du Soleil from 5 June 2010 - MCE7 (second witness statement) page 94. The last two dates relate to pages from the website of METRO RADIO rather than the specific dates of the events but the use is creating or maintaining a market prior to the date of the application for revocation. Events will invariably be publicised and bookings sought prior to the date of the event.

44) Taking into account the class 41 specification of Bauer's trade mark, a fair specification in relation to the use in the METRO RADIO Arena is:

arranging, organising, presentation and provision of concerts, live entertainment, musical performances.

This specification is appropriate to both the opposition proof of use and the revocation action.

Competitions

45) Material exhibited at SA5 includes matter relating to competitions. In her statement Ms Aitchinson refers to these as "joint promotions that METRO RADIO have run with Peugeot, Sunderland AFC, Dalton Park Retail Outlets, Alan Shearer (in 2006) and "Take That on Tour" (in 2007)". In relation to the matter exhibited at SA8, she also puts this within the parameters of "promoting the mark METRO RADIO". In this exhibit there is material relating to a duck race; METRO RADIO was one of a number of sponsors of the race. Ms Ellington in her first statement refers to competitions as being run as a promotional tool. She states that in addition to these that METRO RADIO "also runs competitions and quizzes both on and off-air". Material exhibited at MCE4 (to the first witness statement) includes matter from two advertising trade magazines relating to a competition being run on behalf of METRO RADIO by a creative agency. The matter emanates from 1 October 2003. Both articles describe the competition as a promotion. The exhibit also includes material relating to "Metro Radio Battle of the Bands 2004". The prize money and musical equipment were donated by a musical instrument retailer. The exhibit also includes masks which are used in competitions. The closing date for one competition is 31 January 2008, the other relates to the Alan Shearer testimonial 2006. MCE5 (to the first witness statement) consists of the rules for a competition which ran from 23 July 2007 to 3 August 2007. MCE4 (to the second witness statement) has details of competitions run jointly by METRO RADIO and the *Evening Chronicle*, METRO RADIO and the MetroCentre (a shopping centre) and METRO RADIO and Beamish Hall. Exhibit MCE5 includes terms and conditions of another competition, which was promoted on a number of Bauer radio stations, including METRO RADIO.

46) There is no indication that there is any monetisation of the competitions. It is common for undertakings to monetise competitions by use eg of premium rate telephone numbers. If a market in the services is being created or maintained it is reasonable to assume that there will be monetisation of the services themselves. Monetisation can be accomplished even for services that are supplied free through the sale of advertising; this is the case with the likes of Google and free newspapers. There is not a hint of monetisation in any shape or form from Bauer. It is common for undertakings to promote their goods and services through competitions; the competition is, in effect, a means of

promotion/advertising the product or service; not maintaining or creating a market in competitions. The competitions of Bauer are considered to be only a promotion of the radio station and not the creation or maintenance of services in relation to competitions. **Bauer has not established genuine use of its trade mark in relation to competitions in any of the material periods.**

Awards

47) The Young Achievers Awards of 2007, 2009, 2010 and 2011 were organised by Sunderland City Council. METRO RADIO was one of a number of sponsors of the awards. The exhibit also includes pages from an article in the *News Post Leader* of 21 January 2011 in relation to an award ceremony. An award for "Child of Courage" was sponsored by METRO RADIO. The evidence in relation to this (MCE12 to the second witness statement of Ms Ellington) emanates from after all of the material periods. Sponsoring an award is not the same as creating or maintaining a market in services in relation to awards. The sponsorship shown in the material periods is promotion of the radio services of Bauer. **There has not been genuine use of the trade mark of Bauer in relation to services relating to awards in any of the material periods.**

Contrast with METRO RADIO Arena use

48) The context and nature of use in relation to competitions and awards, as shown in the evidence, is fundamentally different to the use of METRO RADIO Arena.

Advertising

49) Mr Speck submitted that "the mere provision of advertising space whether online or on air does not by itself amount to "advertising services"". He prayed in aid the judgment of HHJ Birss in *Yell Limited v Louis Giboin, Zagg Limited, Zagg Global Limited* [2011] EWPC 009:

"116 Mr Giboin explained that his system offers a service whereby users can buy enhanced forms of advertisement and are offered templates for the adverts. In my judgment that means the sites supply "advertising and publicity services" within the specification of the '391 registered trade mark and also "marketing, promotional and advertising services" within the '121 mark. The core of each definition seems to me to focus on a service whereby the client is helped in order to produce advertising or promotional material. I doubt, but do not have to decide, whether merely offering advertising space for sale amounts to the core of either definition but when that offer is combined with templates in order for the particular advertisement to be created as a result of a collaboration between the Zagg system and the advertiser, then it seems to me that those services are on offer."

HHJ Birss did not come to a conclusion as to whether merely offering advertising space amounted to providing advertising services in class 35.

50) In relation to services other than supplying the medium for the diffusion of advertisements, the evidence of Bauer is very limited. The evidence of Ms Ellington at MCE3 emanates from after all of the material dates. The evidence furnished at SA9 emanates from after the proof of use period in relation to the opposition and so cannot be relied upon by Bauer in relation to the opposition. Neither Ms Ellington nor Ms Aitchison give any dates for when the non-diffusion services were supplied. Robson Brown Advertising and Osborne Jack Media are using METRO RADIO simply to diffuse their advertisements.

51) Consequently, fundamental to the position of Bauer in relation to advertising related services, as far as the opposition is concerned, is whether supplying the medium for advertising services, either through the radio station or the website is supplying an advertising service. The idea of the “core” can be found in the judgment of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

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

However, in *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch) at paragraph 12 Floyd J stated:

“Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

Throughout the material periods Bauer has been supplying an outlet for advertisements through its radio output. The very purpose of a commercial radio station is to advertise; that is how the owners make their profits. Advertising runs through the warp and weft of a commercial radio station. Equally, in relation to websites, the commercial model is often based on advertising. It would no doubt surprise Google to discover that it is not providing advertising services. If the diffusion of advertisements were not an advertising service one would wonder what services are being supplied by those companies that supply outside advertising; whether on hoardings, bus stops, on the walls of tube stations, at sports arenas etc. Advertising is not just about creation of advertisements; it is also about the diffusion of the advertisements. The two are mutually dependent. The obiter dictum comments of HHJ Birss have been considered, however, in the context of the use shown by Bauer and the judgments of Floyd J and Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267^v, the diffusion of the advertising is an advertising

service. (For a commercial radio station or commercial website, advertising is the purpose of the services, as it creates the income for the owner.)

52) *Advertising, marketing and promotional services* are all part and parcel of the same service. The advertising that Bauer has undertaken is by means of the radio or the Internet. It is not considered that limiting the service to the use of these media would represent a genuine category or sub-category. **Consequently, the class 35 part of the specification is maintained in relation to both the revocation and the opposition.**

Internet

53) Exhibits MCE7 to the witness statements of Ms Ellington show pages from the website of METRO RADIO. The pages cover all of the material periods. The pages show, inter alia:

Information re the radio programmes of the station and their hosts.

Debates.

Competitions.

Information re events, tickets and gigs.

News and sport.

Links to music videos.

Listen again functions.

Listen to headlines function.

Polls.

Weather forecasts.

Jokes.

Webcams of the radio station.

Galleries.

Interactivity with the radio programmes.

Charitable fundraising.

Quizzes.

54) Advertisements appear on the pages; consequently, the pages are generating money for Bauer; they are not simply a promotion for the radio station. The website has its own stand-alone presence, despite its link with the radio station. The contents of the pages are quite extensive. Mr Speck distinguished the website of METRO RADIO from that of the BBC. Looking at the content it is not possible to see where the distinction lies. There is, indeed, possibly more of a case for Bauer, as the presence of the advertising means that the website is monetised. There has been genuine use of the trade mark of Bauer in relation to its website during all of the material periods.

55) Website services are a clear and well established category of service; consequently, a fair specification will limit the appropriate parts of the specification to the use of a website. On the basis of the use shown in relation to

the website, **Bauer has established genuine use of its trade mark for all material periods in respect of the following services:**

website services – class 38.

(Website services are included in the portmanteau term telecommunication services.)

interactive information provided from a website; information provided from a website - class 41.

Live events and entertainment (outwith METRO RADIO arena)

56) Exhibit SA8 shows a lorry upon which someone with a microphone is standing. No information as to provenance is given. In relation to this exhibit Ms Aitchison refers to Bauer's sponsorship of events. (She describes all of the material exhibited at SA8 as being sponsorship or advertising METRO RADIO.) In relation to the Spooky Fireworks Spectacular, METRO RADIO appears as one of the sponsors; they are not the organisers. The form of the sponsorship shown will be seen as a form of advertising the services of the sponsor rather than maintaining or creating a market in the service being sponsored. Ms Ellington states that METRO RADIO has been used in relation to road shows. There is a lack of detail as to what actually occurs at the road shows. Exhibit MCE8 to the first witness statement of Ms Ellington gives some basic details of when and where road shows took place. The material covers a period from 28 July 2004 to 27 September 2007. As Mr Speck submitted it is not unusual for radio stations to have road shows; in particular he referred to road shows organised by Radio 1. The existence of a road show is not per se an indication that a market is being created or maintained in such services. As submitted by Mr Speck the road show could be simply a promotion for the radio services of Bauer. There is no indication of any monetisation of the road shows and in the absence of such monetisation the road shows are more likely to be purely a promotional vehicle for the radio station rather than a trade in the undefined services that they provide (still bearing in mind the comments made in paragraphs 41 and 42 re promotional use).

57) Ms Ellington refers to the use of the trade mark in relation to the provision of entertainment at live events. However, she does not give details of these events. The young clubbers nights that have been run by Bauer have been marketed under the name Sweet rather than METRO RADIO. The website printouts give information about "Metro go LIVE from the Baja Beach Club every Friday". Printouts in relation to these events emanate from 3 August 2002 and 5 March 2005. There are also references to "Reef Sundays": "Metro are at Blu Bambu every Sunday night from 11pm" (page from the METRO RADIO website emanating from 5 March 2005. The use of METRO in both of these contexts is without RADIO. This is not use of METRO RADIO.)

58) Outwith the use of METRO RADIO in relation to the arena, Bauer has not established genuine use of its trade mark in relation to live events and entertainment.

Overall findings in relation to proof of use

59) In relation to the class 38 services of Bauer's registration, it was conceded that there had not been genuine use of the trade mark for all of the services. Mr Malynicz submitted that certain of the services could be struck through. However, he considered that the general term telecommunication services should be maintained owing to the use of Bauer. When it was noted that this would include terms which were to be struck out, he then considered that the general term could be qualified by an exclusion of the struck out terms. It is an inherent contradiction to submit that the general term is a fair specification but then have a list of terms that are to be excluded from the general term.

60) Telecommunication services is a very wide term; covering all sorts of services with which Bauer has not been involved eg Internet provider services and telephone services. Telecommunications services is far too wide a term to represent a fair reflection of the use made by Bauer. A fair specification for the class 38 services, taking into account Associated's acceptance of partial use, is

radio broadcasting services; radio programming, broadcasting and production services; radio broadcasting and radio transmission, website services.

61) It has been decided that the full class 35 specification can be maintained.

62) Based on the findings above, and the concession of use by Associated, the class 41 specification is to be limited to:

radio entertainment services; production of radio programmes; entertainment by or relating to radio; production, presentation of radio programmes and radio entertainment services; arranging, organising, presentation and provision of concerts, live entertainment, musical performances; interactive information provided from a website; information provided from a website.

63) These specifications are appropriate for both the revocation application and the proof of use in relation to the opposition. In relation to the revocation, Associated succeeds under section 46(1)(a) of the Act in relation to the services which are to be revoked. Consequently, the trade mark of Bauer is to be revoked with effect from 24 July 2004 in respect of all services other than those identified in paragraphs 60, 61 and 62.

64) Mr Malynicz submitted that if it were decided that the specification of the registration was to be limited beyond that which Bauer conceded, Bauer should be allowed to propose a revised specification. The specification that remains reflects the use shown within the parameters of the case law. Bauer is not allowed to propose a revised specification based on the findings of this decision.

Likelihood of confusion – section 5(2)(b) of the Act

Average consumer, nature of purchasing decision and standard for likelihood of confusion

65) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”^{vi}. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) Joined Cases T-117/03 to T-119/03 and T-171/03* the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (BUDMEN, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

66) The class 38 and the class 41 radio and website services upon which Bauer can rely have two different sets of users. There is the public at large who will listen to the services or access them via the Internet. This public is not purchasing the services and so will not necessarily be making a careful decision when using them. The other set of users are those who supply the revenue stream to maintain the services ie the advertisers. The nature of the services means that the advertising will be purchased as the result of a careful and educated purchasing decision. This decision must take into account either set of users. Consequently, it must take into account those who will represent the best case for Bauer, the public at large. In relation to this type of consumer the effects of imperfect recollection will be increased. In relation to the radio based services, owing to their nature, aural similarity will be of greater importance than visual similarity. In relation to the website services, these will be accessed and used from some form of device with computing facilities and visual similarity will be of greater importance than visual similarity.

67) The services of *arranging, organising, presentation and provision of concerts, live entertainment, musical performances* will be purchased by the public at large. The public will wish to be sure that they are purchasing the correct service and will be interested in such things as seating and the price ranges. The services will be purchased with a reasonable degree of care and so the effects of imperfect recollection will be limited. The services, nowadays, are normally purchased either using the Internet or by telephone. Consequently, aural and visual similarity are of equal importance.

68) The average consumers of the class 35 services of Bauer will be businesses. They are services that will be purchased after the consideration of cost and of content and so the purchase will be careful and considered. Consequently, the effects of imperfect recollection will be limited. The services will normally be purchased following perusal of documents and so visual similarity will be of greater importance than aural similarity. The class 35 services, the subject of the opposition, will be purchased on the same basis.

69) The class 9 goods, the subject of the opposition will be purchased by the public at large. They are goods that can be bought on impulse. The purchasing process will not be particularly careful and educated; increasing the effects of imperfect recollection. The nature of the goods is such that they be purchased by use of computer enabled devices and so visual similarity will be of greater importance than aural similarity.

70) The average consumer of the class 38 services of the application is the public at large. Some of the services are identical to the services upon which Bauer can rely in class 38 and so must be considered in the same manner. Many of the rest of the services will be accessed and funded in the same manner as the class 38 services of Bauer, eg search engine services and provision of web pages, and so must be considered in the same manner. However, services such as *providing user access to the internet*, which is the business of an ISP, will be purchased, by the public at large, following consideration of cost, download speeds and data usage limits. Such services will, therefore, be purchased as the result of a careful and considered purchasing decision, limiting the effects of imperfect recollection. The services, of their nature, will normally be purchased via the Internet and so visual similarity will be of greater importance than aural similarity. The nature of the purchasing decision and the relevant public will be further considered in the conclusion as to the likelihood of confusion.

71) The class 41 services of the application encompass a very wide spectrum of services. In the conclusion as to likelihood of confusion, consideration will be given as to whether the nature of the purchasing decision and the relevant public will have an effect on the likelihood of confusion.

Comparison of trade marks

72) The trade marks to be compared are:

metro.co.uk
metro.com

METRO RADIO

73) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{vii}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{viii}; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{ix}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^x.

74) Nothing turns upon the trade mark of Bauer being in upper case and the trade marks of Associated being in lower case. The trade marks share the word metro. This word comes at the beginning of all of the trade marks. In the case of Bauer's trade mark, metro will be seen as identifying services coming from a particular radio station; whether the services are directly related to radio or not. The public are well versed in seeing domain name suffixes. Consequently, the metro element of the trade marks of Associated will be seen as identifying particular domain names. The dominant and distinctive component of the trade marks is the word metro. (The GC considered the distinctiveness of .com as a suffix in *Getty Images (US), Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-338/11^{xi}.) Owing to the presence of metro in the trade marks, its position and the nature of the rest of the trade marks, there is a good degree of visual and aural similarity between the trade marks. There is no evidence as to whether metro will have any particular meaning to the public at large. Some might make an association with various public transport systems. The people of the north east may make this

association as there are indications in the website evidence that the term is used in relation to a public transport system on Tyneside. However, this evidence emanates from well after the date of application for registration so it cannot be assumed that this was the case then. Some may be aware of the use of metro in relation to the underground train systems in cities such as Madrid and Paris. In the absence of any conclusive evidence as to whether metro will have any meaning for the average consumer, the position in relation to conceptual similarity is neutral. **Overall it is considered that there is a reasonable degree of similarity between the respective trade marks.**

Comparison of goods and services

75) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”^{xii}. The judgments in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, *YouView TV Limited v Total Limited*, and *Avnet Incorporated v Isoact Ltd*, referred to in paragraph 50, have to borne in mind. Consideration should be given as to how the average consumer would view the goods and services^{xiii}. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods^{xiv}. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{xv}. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{xvi}.

76) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the General Court (GC) explained when goods are complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

Consideration is also taken into account of the decision of Mr Daniel Alexander QC, sitting as the appointed person, in *Sandra Amalia Mary Elliott v LRC Products Limited* BL O/214/13^{xvii}.

77) Bauer claims that its class 35 services are all similar or identical to the class 35 services of the application, its class 38 services are all similar or identical to the class 38 services of the application and its class 41 services are all similar or

identical to the class 41 services of the application. It submitted that the class 9 services of the application are similar to radio broadcasting via the Internet. The analysis of the identity and/or similarity will be made on this basis that Bauer has submitted.

78) The class 9 goods under attack are: *digital music (downloadable) provided from the internet; digital music (downloadable) provided from MP3 internet web sites*. The *radio broadcasting services* of the application will include broadcasting via the Internet. Mr Malynicz submitted that it is common practice for radio broadcasters to offer podcasts, which consist of downloadable material provided by the Internet. This is accepted on the basis of judicial notice. Podcasts can contain any audio content, including music. Music downloads will often be provided by means other than the radio eg from iTunes or Amazon. However, they can be provided from an Internet radio station in the form of a podcast. In such circumstances the purpose of the goods and services will be the same, to provide music in a downloadable form. The users will be persons wanting downloadable music, and so, the same end users. The nature of the goods and services are the same in that it is music supplied digitally. The goods and services can be provided by the same providers and so have the same channels of trade. **The class 9 goods of the application are highly similar to radio broadcasting (via the Internet).**

79) Advertising, promotion services; advertising services provided on-line from a computer database or from the internet; compilation of advertisements for use as web pages on the internet; classified advertising services; organisation of exhibitions and trade fairs for advertising purposes all fall within the ambit of Bauer's class 35 services and so are identical.

80) The remaining services in class 35 in the application are *business services; business services provided on-line from a computer database or from the internet; organisation of exhibitions and trade fairs for commercial purposes*.

81) *Business services*, whatever the method of provision, will involve assisting and effecting the running of businesses. The purposes of the services are not the same as advertising, promotion and marketing. The respective services will be supplied by different types of undertakings and will have different channels of trade. The respective services are not fungible, they are not in competition. They are not indispensable or important to each other. The respective services could all have the same ultimate consumers ie businesses. However, so could virtually all goods and services. This coincidence is at such a level of generality that it is without pertinence in relation to the similarity of the services. **Business services; business services provided on-line from a computer database or from the internet are not similar to the class 35 services of Bauer's registration.**

82) Organisation of exhibitions and trade fairs for commercial purposes are for the promotion and marketing of goods and services and so fall within the parameters of Bauer's class 35 services and are identical.

83) Goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application^{xviii}; taking this into account the following class 38 services of the application are identical to the services of Bauer's registration or have such a close connection to them that they are very similar:

communication services and information services relating thereto; telecommunication of information including web pages, computer programs and any other data; communication services, all provided on-line from a computer database or from the internet; providing an on-line portal network site; provision of web pages; computer bulletin and message boards; telecommunications services provided in relation to the internet; providing access to digital music web sites on the internet; providing access to MP3 web sites on the internet; delivery of digital music by telecommunications; broadcasting services; radio broadcasting services; news agency services.

84) Provision of telecommunications access and links to computer databases and the internet; providing user access to the internet are the services of an ISP. There is no meaningful coincidence between these services and the class 38 services of Bauer; they are not similar.

85) Search engine services are a discrete area of the Internet, supplied by the likes of Google. There is no meaningful coincidence between these services and the class 38 services of Bauer; they are not similar.

86) There is no relationship, within the parameters of the case law, between telephone rental services; provision and rental of telephone chat lines; electronic mail services; providing an on-line directory and the class 38 services of Bauer. The respective services are not similar.

87) Television, cable television broadcasting services are broadcasting services and so have the same general nature as the radio broadcasting services. The services could be provided through the same means ie through a television or the Internet. The respective services have the same end users; persons who wish to be entertained and/or educated. The consumer could choose one service instead of the other; they are in competition. **The respective services are similar to a high degree.**

88) *Information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the internet* stand or fall with the primary services to which they relate.

89) As goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application, the following class 41 services of the application are identical to the services of Bauer's registration or have such a close connection to them that they are very similar:

entertainment services; organisation of exhibitions and shows; provision of information relating to education, sporting events, national and local politics, current affairs, cultural activities and entertainment; sports information services; news programme services for radio; production of shows and radio programmes; radio entertainment services; organisation of recreational and cultural facilities.

90) *Publishing services; publication of printed matter and printed publications; publishing and publication services; electronic publishing services; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line* do not coincide with the class 41 services of Bauer's registration in any meaningful manner and, therefore, are not similar to the class 41 services.

91) *News programme services for television; production of television programmes; cable television and television entertainment services* can be supplied by the same means as the various class 41 radio services of the earlier registration eg through a television, a computer or a mobile device and so have the same channel of trade. The respective services would supply the same content, although one without pictures. The end users would be the same, those seeking news or entertainment or those seeking production services by means of electronic media; they, therefore, have the same end users. The respective services can be alternatives to each other, they are in competition. **The services of the application, considered in this paragraph, enjoy a good deal of similarity with the class 41 services of Bauer's registration.**

92) Taking into account the core meaning of the services, as per *Avnet*, *education; organisation of competitions, quizzes and games; electronic game services provided by means of the internet* do not have meaningful coincidences within the parameters of the case law and are, therefore, not similar to Bauer's class 41 services.

93) *Providing digital music (not downloadable) from the internet; providing digital music (not downloadable) from MP3 internet web sites* have a direct relationship with the class 9 goods that Bauer has attacked. The only difference is that the music is streamed rather than downloaded. **Although consideration is, herein,**

given in relation to the class 41 services; these include the radio content services and there is a high degree of similarity between the services rehearsed at the beginning of the paragraph and the class 41 radio services of Bauer.

94) All the aforesaid services also provided on-line from a computer database or from the internet; information services relating to all the aforesaid services stand or fall with the services to which they relate.

Conclusion

95) It is a requisite for likelihood of confusion that goods and services are similar. Consequently, there can only be a likelihood of confusion in respect of the goods and services which have been found to be similar.

96) Mr Speck referred to other Metro trade marks co-existing together. There is an absence of evidence to this point. Allusions to the MetroCentre shopping centre can be found on some of the web pages of METRO RADIO and there is an allusion to the Metro transport system. There is no evidence that these existed at the date of application, when the position has to be considered. Also a transport system and a shopping system are not on a par with the goods and services under consideration here. Trade marks in difference areas can co-exist; the issue here is where the goods and services are not in discrete areas. Polo can exist for cars, for mints and for a brand of clothing; this does not mean that others can, therefore, register Polo for similar goods or services to those of Volkswagen, Nestlé or Ralph Lauren.

97) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xx}. Certain of the services are identical. Where goods and services are similar, they are highly similar. There is a reasonable degree of similarity between the respective trade marks.

98) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xx}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xxi}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xxii}. The METRO element of METRO RADIO is neither descriptive nor allusive to the services for which use has been established. Taking into account the RADIO element, even in relation

to radio related services the trade mark has a reasonable degree of distinctiveness. Mr Malynicz submitted that the trade mark had enhanced distinctiveness through its use as a radio station. However, that use is in a part of the North East of England. Distinctiveness must be considered in relation to the United Kingdom as a whole as per *Bovemij Verzekeringen NV v Benelux-Merkenbureau* Case C-108/05 and the decision of Mr Richard Arnold QC, sitting as the appointed person, in *THE JOURNAL* BL/O/272/08^{xxiii}. Mr Malynicz submitted that persons from the broadcast area for METRO RADIO move to other parts of the United Kingdom. This does not mean that in those parts the station has a reputation. There are Spanish people dotted throughout the United Kingdom, this does not mean that Bimbo for bread has a reputation in the United Kingdom, however well-known it is in Spain. However, the METRO RADIO Arena has had national coverage. There are reviews of events taking place there in national newspapers. Advertisements for tours which include the METRO RADIO Arena, will also identify the venue. One doesn't have to live in the West Midlands to be aware of the NEC or in London to be aware of the Royal Albert Hall. There is enhanced distinctiveness in relation to the services supplied at the METRO RADIO Arena.

99) Owing to the degree of similarity of the trade marks, the degree of care in the purchase of goods and services and whether aural or visual similarity is more important, will not affect whether there is a likelihood of confusion.

100) Taking into account the identity or closeness of the goods and services, the degree of similarity of the trade marks and the degree of distinctiveness of the earlier trade mark, there is a likelihood of confusion in relation to all of the goods and services which are identical or similar.

Summary of results

101) The specification of the earlier trade mark of Bauer is to be limited from 24 July 2004 to:

advertising, marketing and promotional services;

radio broadcasting services; radio programming, broadcasting and production services; radio broadcasting and radio transmission, website services;

radio entertainment services; production of radio programmes; entertainment by or relating to radio; production, presentation of radio programmes and radio entertainment services; arranging, organising, presentation and provision of concerts, live entertainment, musical performances; interactive information provided from a website; information provided from a website.

The class 16, 36, 39 and 42 goods and services were not opposed.

The class 9 specification of the application is to be limited to:

Software, electronic publications, CD-Roms, computer software and hardware to enable searching of data and connection to databases and the internet; pre-recorded video tapes and cassettes; video tapes, games and cassettes; computer accessories, screen savers, mouse pads, keyboards, bank cards and debit cards (encoded or magnetic).

The class 35 specification of the application is to be limited to:

Retail services provided through a television shopping channel, general merchandise internet website, mail order catalogue and a newspaper publication, in connection with the sale of beauty products, toiletries, domestic cleaning products, machines for household use, hand tools, DIY products, gardening products, optical goods, cameras, domestic electrical and electronic equipment, including white goods, videos, CDs, DVDs, jewellery, clocks, watches, stationery, publications, leather goods, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headgear, haberdashery, toys and games, sports equipment, fireworks, oils and fuels, foodstuffs and drinks; on-line ordering services; providing an on-line directory; advice and assistance relating to the establishment of on-line retail stores; search and retrieval of information; business services; business services provided on-line from a computer database or from the internet; information services relating to all the aforesaid services; provision of a database; compilation and provision of business information, advice and statistics; business research; provision of commercial information; business information services; public relations services; recruitment, employment and personnel management services; information relating to all the aforesaid services; career information and advice; all the aforesaid services also provided on-line from a computer database or the internet.

The class 38 specification of the application is to be limited to:

search engine services; electronic mail services; provision of telecommunications access and links to computer databases and the internet; providing user access to the internet; telephone rental services; provision and rental of telephone chat lines; providing an on-line directory; information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the internet.

The class 41 specification of the application is to be limited to:

Education services; publishing services; publication of printed matter and printed publications; publishing and publication services; electronic publishing services; providing on-line electronic publications (not downloadable); publication of electronic books and journals on-line; organisation of competitions, quizzes and games; all the aforesaid services also provided on-line from a computer database or from the internet; information services relating to all the aforesaid services; electronic game services provided by means of the internet.

Costs

102) Both parties have achieved degrees of success, although Bauer has been more successful than Associated. Taking into account the degree of success, Bauer will receive a third of the costs that it would have received if it had been wholly or virtually wholly successful, plus the opposition fee.

Opposition fee:	£200
Preparing statements and considering the other side's statements (taking into account different statements for the opposition and revocation):	£400
Preparing evidence:	£400
Preparing for and attending a hearing	£400
Total:	£1,400

103) Associated Newspapers Limited is ordered to pay Bauer Radio Limited the sum of £1,400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of June 2013

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

ⁱⁱ “29. It is clear from this that in contrast to invalidation, a mark that is revoked pursuant to Section 46(1) (whether on grounds of non-use or one of the other grounds mentioned in that sub-section) continues to have effect up until that date of revocation.”

ⁱⁱⁱ *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is

not expected to think in a picky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

^{iv} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

^v "In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor."

^{vi} *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

^{vii} *Sabel BV v Puma AG* Case C-251/95.

^{viii} *Sabel BV v Puma AG* Case C-251/95.

^{ix} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^x *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xi} “22 As regards the element ‘.com’, it is important to note that this will immediately be recognised by the relevant public as referring to an internet site. In that respect, it should be pointed out that – as the Board of Appeal noted in its assessment – it is a technical and generic element, the use of which is required in the normal structure of the address of a commercial internet site. Furthermore, the element ‘.com’ may also indicate that the goods and services covered by the trade mark application can be obtained or viewed on-line, or are internet-related. Accordingly, the element in question must also be considered to be devoid of distinctive character in respect of the goods or services concerned.”

^{xii} *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{xiii} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^{xiv} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{xv} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xvi} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

(a) The respective uses of the respective goods or services;
(b) The respective users of the respective goods or services;
(c) The physical nature of the goods or acts of service;
(d) The respective trade channels through which the goods or services reach the market;
(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

^{xvii} “17. First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are “identical or similar” but they do not specify the criteria by reference to which similarity is to be

assessed. In the well-established guidance from the Court of Justice on this issue originating in *Canon*, to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services themselves should be taken into account, of which complementarity is but one (see e.g. in *Boston*).

18. Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.

19. Third, the Hearing Officer said at [32]:

As stated above, the legal definition of ‘complementary’, as per *Boston*, is that the goods must be “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”. It is not sufficient that the goods “can” be used together; nor is it sufficient that they are sold together.

20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.

21. Moreover, it is necessary to view the quotation from *Boston* in the context of the facts of that case where the dispute over similarity turned in part on whether the goods were used together for a rather specific medical procedure. The Court of First Instance said at [77]-[87]:

Similarity between the products

77 According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*Sunrider v OHIM*, paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM - Gómez Frías (euroMASTER)*, paragraph 31).

78 As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fiber oxygenators with detachable hard-shell reservoir, on the other hand, have a different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels

and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81 In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM - Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM - Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).

83 It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fiber oxygenators with detachable hard-shell reservoir.

84 However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85 It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.

86 Finally, the products at issue can in fact be found in the same distribution channels, such a criterion being relevant for the purposes of the assessment of the similarity of the goods (*PiraÑAM diseño original Juan Bolaños*, paragraph 82 above, paragraph 37; see also, to that effect, *SISSI ROSSI*, paragraph 82 above, paragraph 65; and *PAM PLUVIAL*, paragraph 82 above, paragraph 95).

87 Accordingly, given the close link between the products in question as regards their end users, the fact that they are to some extent complementary and the fact that they may be distributed via the same distribution channels, the Board of Appeal was right to find that the applicant's goods and those of the intervener were similar (see, to that effect, Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 56).

22. The Court of First Instance was not attributing decisive importance to the question of whether the goods in that case were complementary in determining the overall question of whether they were similar.

23. In the present case, because of the way in which the case was presented to the Hearing Officer, the issue of whether the goods were complementary assumed excessive importance which may have diverted the Hearing Officer's attention from other, no less important, considerations in the evaluation of similarity. That requires me on this appeal to scrutinize the approach taken by the Hearing Officer in considering the evidence by reference to the test of similarity more closely than would ordinarily be warranted by the REEF principles on an appeal of this kind.£

^{xviii} See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 29:

"In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

^{xix} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xx} *Sabel BV v Puma AG* Case C-251/95.

^{xxi} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xxii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.

^{xxiii} "22. Given the applicant's opposition to a reference, however, I shall give my own answer to the question. In absence of further guidance from the Court of Justice, I consider that it is not possible to overcome an objection under section 3(1)(b), (c) or (d) of the 1994 Act by demonstrating that the mark applied for has acquired a distinctive character within a particular locality or region. The Court of Justice's first ruling in *EUROPOLIS* appears to be quite unequivocal on this point: "registration of a trade mark can be allowed on the basis of [Article 3(3) of the Directive] only if it is proven that that trade mark has acquired distinctive character through use throughout the part of the territory of the Member State ... where there exists a ground for refusal". Moreover, its reasoning is that the mark must be free from objection throughout the Member State in question. At least in the case of goods, I do not think that it makes any difference if the market for the goods is confined to a particular locality or region, for the following reasons."