

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO 2233378  
IN THE NAME OF ASSOCIATED NEWSPAPERS LIMITED  
AND IN THE MATTER OF OPPOSITION NO 97043 BY BAUER RADIO LIMITED**

**-and-**

**IN THE MATTER OF TRADE MARK REGISTRATION NO 2147054B  
IN THE NAME OF BAUER RADIO LIMITED  
AND IN THE MATTER OF REVOCATION NO 83917 BY ASSOCIATED NEWSPAPERS LIMITED**

**APPEAL BY ASSOCIATED NEWSPAPERS LIMITED  
FROM THE DECISION OF  
MR DAVID LANDAU DATED 5 JUNE 2013**

**AND**

**IN THE MATTER OF TRADE MARK REGISTRATION NO 2147054B  
IN THE NAME OF BAUER RADIO LIMITED  
AND IN THE MATTER OF INVALIDITY NO 84649 BY ASSOCIATED NEWSPAPERS LIMITED**

**APPEAL BY BAUER RADIO LIMITED  
FROM THE DECISION OF  
MR DAVID LANDAU DATED 14 FEBRUARY 2014**

**DECISION**

1. This is the decision in two appeals from two separate but related decisions of Mr David Landau in which the opposing parties are Associated Newspapers Limited (“ANL”) on the one hand and Bauer Radio Limited (“Bauer”) on the other.
2. The first decision was dated 5 June 2013 (BL O/241/13). It related to a trade mark opposition brought by Bauer against a trade mark application by ANL for a series of marks (metro.co.uk and metro.com), and a revocation application brought by ANL against Bauer’s METRO RADIO mark. ANL appeals that decision. The second decision was dated 14 February 2014 (BL O/078/14) and related to a separate invalidity application brought by ANL against the same METRO RADIO mark. Bauer appeals that decision.

3. The parties to the appeals (and, I believe, associated companies) have been locked in a variety of proceedings against each other for some years, as each side claims rights in marks having in common the word METRO. There have been other decisions about their marks in the past and I understand that there are further disputes yet to be resolved. The hearing of these appeals was adjourned for a lengthy period whilst the parties endeavoured to settle their differences. Sadly, they could not do so.

### **Background**

4. Bauer Radio Ltd has since 2008 owned a radio station called Metro Radio, which has been broadcasting in the North East of England since 1974. ANL operates the Metro “free to consumer” newspaper which it first published in London in March 1999.
5. These appeals relate to two registered trade marks and one trade mark application. On 28 September 1994 ANL applied to register a UK trade mark no 1586405 METRO (“the 1994 Mark”). The registration procedure was completed on 24 January 1997. The trade mark is registered for books, magazines, printed publications, all included in Class 16. There are some exclusions to the scope of the specification but those are irrelevant to this appeal.
6. Secondly, on 3 October 1997 Bauer applied to register the mark METRO RADIO for a range of services. On 23 July 1999 the registration procedure was completed and the mark (“the Metro Radio Mark”) was registered for services in Classes 35, 38 and 41.
7. Thirdly, on 22 May 2000, ANL filed an application to register a series of three trade marks which proceeded to publication in February 2008 in relation to the two marks metro.co.uk and metro.com (“ANL’s 2000 Application”). Registration was sought for a wide range of goods and services. I do not know why there was such a significant delay before publication of the application.

*The proceedings leading to the first decision*

8. On 7 May 2008, Bauer filed a TM7 opposing ANL's 2000 Application for goods and services in Class 9 (digital music etc), Class 35 (advertising and promotion of business services, etc), Class 38 (telecommunications services etc) and Class 41 (publishing services, organisation of exhibitions shows, etc), on the basis of its earlier rights in the Metro Radio Mark in Classes 35, 38 and 41. This opposition was given number 97043.
  
9. In its TM8, in May 2009, ANL put Bauer to proof of use of the Metro Radio Mark in relation to all of the services relied upon and the relevant period for proof of use was 7 February 2003 to 7 February 2008. In October 2009, Bauer filed evidence of use in the form of a witness statement of Sally Aitchison. ANL did not file evidence in answer but filed submissions on 20 January 2010 challenging parts of Bauer's evidence. In particular, ANL challenged the relevance of Ms Aitchison's exhibit SA9, first because it consisted of a print-out dated after the end of the relevant period and secondly saying it did not evidence genuine use of the Metro Radio Mark for advertising services. Bauer did not then take the opportunity to file further evidence in reply.
  
10. On 22 November 2010, ANL filed an application to revoke the Metro Radio Mark for non-use in respect of all of the services for which it was registered, with the exception of services relating broadly to radio broadcasting in Classes 38 and 41. The revocation application was given number 83917. Revocation was sought from 24 July 2004 pursuant to s 46(1)(a), or 25 July 2009 or 22 November 2010 pursuant to s 46(1)(b). The Hearing Officer pointed out at paragraph 36 of his decision that the dates from which revocation were sought all post-dated ANL's 2000 Application, so only the proof of use within the period relevant to section 6A affected the opposition.
  
11. Opposition 97043 and revocation 83917 were consolidated. Following consolidation, Bauer took the opportunity to file further evidence in reply in the opposition in the form of a witness statement from Mary Ellington, in January 2012. A second witness

## O-249-15

statement from her dated 27 April 2012 was filed in relation to the revocation application. The consolidated proceedings were heard together on 3 May 2013. Mr Simon Malynicz represented Bauer, Mr Adrian Speck QC represented ANL. In his decision of 5 June 2013, the Hearing Officer decided that:

- a. there was satisfactory proof of use in relation to certain parts of Bauer's Metro Radio Mark specification and most particularly in respect of advertising, marketing and promotional services in Class 35, website services in Class 38 and a range of services within Class 41, not limited to radio broadcasting, etc but also including arranging and organising concerts, live entertainment and musical performances;
  - b. as a result, the revocation application was only partially successful;
  - c. there was a reasonable degree of similarity between the trade marks;
  - d. the similarity of goods/services varied from Class to Class, some were identical, some highly similar, some dissimilar;
  - e. there was a likelihood of confusion in relation to all of the goods and services which were identical or similar;
  - f. the opposition succeeded in part, such that ANL's 2000 Application should proceed to registration on a limited basis in Classes 9, 35, 38 and 41.
12. ANL appeals that decision. The Grounds of Appeal dated 3 July 2013 claim that Bauer's opposition ought to have succeeded only in relation to a narrow range of services all connected with radio broadcasting and that Bauer's mark should have been revoked in relation to other services. ANL challenges the Hearing Officer's findings as to use in relation to concerts, live entertainment and musical entertainment, advertising services and website services etc.
13. On 27 January 2014, that is to say, several months out of time, Bauer filed a Respondent's Notice which stated merely that it wished to uphold the decision of Mr Landau "for the different or additional reason that he ought to have held that the evidence referred to at paragraph 50 of his decision was sufficient to show genuine use in relation to advertising services." Mr Landau had said in paragraph 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 gave 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."

14. The Respondent's Notice exhibited a few pages of the transcript from the hearing before Mr Landau, recording counsel for Bauer's submissions about the meaning of advertising services and parts of Ms Aitchison's evidence, which I discuss further below. Bauer seeks permission to file the Respondent's Notice out of time. ANL objects to that application.
15. The Respondent's Notice was filed in late January 2014, yet it was not until March 2014 that Bauer produced a second witness statement of Ms Aitchison dated 19 March 2014, seeking to clarify and supplement her first witness statement, by describing Bauer's activities and by exhibiting additional documents. Bauer seeks permission to adduce that very late evidence on the appeal. ANL objects to that application too.

*The proceedings leading to the second decision*

16. In the meantime, on 15 January 2013, ANL had filed an application for the invalidation of the Metro Radio Mark in respect of advertising services in Class 35. It relied upon its earlier rights in the 1994 Mark. Bauer put ANL to proof of use. ANL relied upon the 1994 Mark only to the extent that it had used it in relation to newspapers, which it contended were a sub-set of the printed publications in the specification of the mark. It contended that the marks were similar and that newspapers are highly similar to advertising services such that there was a likelihood

## O-249-15

of confusion. A substantial amount of evidence was filed in the invalidation proceedings.

17. There was another hearing before Mr Landau on 29 January 2014. Both parties were represented as before. In his second decision dated 14 February 2014, O/078/14, Mr Landau found that:
  - a. ANL had proved genuine use of the 1994 Mark in the material period in respect of newspapers;
  - b. ANL's evidence showed that newspapers on occasion supply the same services as a stand-alone advertising agency;
  - c. advertising services and newspapers were similar to a moderate degree;
  - d. the trade marks enjoy a good deal of similarity;
  - e. there was a likelihood of confusion;
  - f. Bauer's registration was to be cancelled in respect of advertising services; and
  - g. ANL was entitled to costs off the usual scale because it had had to produce evidence which Bauer knew would serve no purpose; but
  - h. Bauer was not entitled to off the scale costs on the basis that ANL's application was an abuse of process.
  
18. Bauer appeals the second decision, both as to the substantive point under section 47 (in particular, the finding that newspapers were similar to advertising services) and as to costs. Bauer also raised for the first time in its Grounds of Appeal a fall-back position, namely that if the Hearing Officer was held to have been right to find a likelihood of confusion in respect of advertising services as a whole, it would seek to amend its specification to "radio advertising services." ANL countered this by proposing a fall-back position of its own for the opposition in its skeleton argument for the appeal.
  
19. When the two appeals finally came to be heard, both parties were represented by counsel as before.

**Grounds of Appeal from decision O/241/13**

20. ANL appealed on the basis that the Hearing Officer should have upheld the opposition and maintained the Metro Radio Mark on the register only in respect of limited services in Classes 38 and 41, all relating essentially to radio broadcasting and entertainment. ANL argued that the Hearing Officer was wrong to hold that Bauer had used the Metro Radio Mark:
- a. in respect of services of arranging (etc) concerts, and live and musical entertainment, by use of the name “Metro Radio Arena” on the basis that such use was merely promotional;
  - b. in respect of advertising, marketing and promotional services when the evidence showed only the sale of advertising space; and
  - c. in respect of website services (etc) when all that was shown was that Bauer had a website promoting the radio station, which was used as an adjunct to the station.
21. In the circumstances, ANL submitted that the Hearing Officer had erred in his assessment of the likelihood of confusion and had, in particular, failed to carry out that assessment by reference to circumstances obtaining at the relevant date in 2000.

**Grounds of Appeal from decision O/078/14**

22. Bauer appealed on the basis that the Hearing Officer should have held that there was no similarity between newspapers and advertising services, identifying a number of ways in which he was wrong to conclude that there was such similarity. If that primary position failed, then, as I have said above, Bauer sought to amend its specification to “radio advertising services.” It did not spell out the consequences which it said would flow from such amendment. Bauer also appealed the Hearing Officer’s decision on costs, denying that it should have been ordered to pay off-the-scale costs to ANL but seeking its own costs on a compensatory, off-the-scale basis.

**Approach to the appeal**

23. There is no dispute between the parties as to the appropriate approach for me to adopt on these appeals. This was restated recently by Mr Daniel Alexander QC sitting as the Appointed Person in *Indian trade mark* BL O/439/14 and I gratefully adopt his summary of the position, the relevant parts of which read as follows:

"5. This appeal is a review of the hearing officer's Decision. Robert Walker LJ (as he then was) said of such appeals:

"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle" (*Reef Trade Mark* [2003] RPC 5 at [28]; see also *BUD Trade Mark* [2003] RPC 25).

6. Mr Justice Arnold recently summarised the principles in the light of the more recent authorities from the Court of Appeal and the Supreme Court as follows in *Shanks v Unilever Plc & Ors* [2014] EWHC 1647 at [27]-[28]:

"The role of the appeal court

27. The role of the appeal court was recently reviewed by Lewison LJ in *Fine & Country Ltd v Okotoks Ltd* [2013] EWCA Civ 672, [2014] FSR 11, where he said:

"50. The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. There are many examples of statements to this effect. I take as representative Lord Hoffmann's statement in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416, 2423:

'Secondly, because the decision involves the application of a not altogether precise legal standard to a combination of features of varying importance, I think that this falls within the class of case in which an appellate court should not reverse a judge's decision unless he has erred in principle.'

51. Where the appeal is (or involves) an appeal against a finding of fact, the role of an appeal court is as stated by Lord Mance in *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325 at [46] ...

28. I would add that the Comptroller-General of Patents is a specialist tribunal, and therefore the warning given by Baroness Hale of Richmond in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49, [2008] 1 AC 678 at [30], ... is apposite in this context:

" ... This is an expert tribunal charged with administering a complex area of law in challenging circumstances. To paraphrase a view I have expressed about such expert tribunals in another context, the ordinary courts should

approach appeals from them with an appropriate degree of caution; it is probable that in understanding and applying the law in their specialised field the tribunal will have got it right: see *Cooke v Secretary of State for Social Security* [2002] 3 All ER 279, para 16. They and they alone are the judges of the facts. It is not enough that their decision on those facts may seem harsh to people who have not heard and read the evidence and arguments which they have heard and read. Their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts or expressed themselves differently. ... "

7. These general principles are just as much applicable to appeals from the Comptroller as to other appeals and I have therefore borne them in mind in addressing the grounds of appeal, particularly those where an overall factual evaluation by the hearing officer has been made."

### **Merits of the appeals**

#### ***a) ANL's appeal re Bauer's Class 41 services: arranging, organising and provision of concerts, live entertainment and musical entertainment***

24. Bauer relied upon use of the Metro Radio Mark as the name of an arena in Newcastle, the Metro Radio Arena. The Hearing Officer found at paragraph 43 of his decision that the evidence showed that the arena had been used during the relevant periods for a variety of events such as concerts, dancing and dancing on ice, cage fighting and wrestling, and comedy. The issue on the appeal was not as to the nature or extent of those events, but as to the nature of the connection made between the Metro Radio Mark and those events.

25. In her first witness statement, Ms Aitchison said "My company has promoted the trade mark Metro Radio across the whole of the United Kingdom by sponsoring the famous Arena in Newcastle." She described concerts which had taken place at the arena and explained that world wrestling entertainment events at the arena had been shown live on Sky Box Office, the pay-per-view television service. She exhibited what she described as examples of publicity material promoting concerts at the arena, which do show use of the Mark upon them, although to my mind the nature of the exhibited documents is far from self-explanatory. Ms Ellington also dealt with

use of the Mark in relation to the arena in her first witness statement. She stated that Bauer had sponsored “the regions [sic] premier sports and entertainment venue which bears the name Metro Radio Arena” since 2004. She too exhibited a few examples of publicity material which she stated were for concerts at the arena.

26. Bauer’s involvement with the arena appears to have been only as a sponsor, and there was no suggestion in the evidence that Bauer had done anything within the categories of services in Class 41, or was directly or even indirectly responsible for the organisation of the events at the venue. ANL therefore argued that Bauer’s use was not use of the Metro Radio Mark in relation to Class 41 services, but merely a sponsorship deal intended to promote its core radio station services, and there was no evidence that any performers, promoters or members of the public perceived any Class 41 services as being provided by Bauer or would have seen the use of the name Metro Radio Arena as anything but the name of the place where an event was taking place. The Hearing Officer had found that other activities carried on by Bauer (such as running competitions and awards) were purely promotional of its core radio services and did not amount to genuine use of the Mark in relation to such services. The Hearing Officer made that distinction at paragraph 43 of his decision:

“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 ... 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.”

27. ANL submitted that the Hearing Officer had not properly explained the distinction which he drew in paragraph 43 and that his conclusions therefore disclosed an error of principle. It did not matter whether the sponsorship was for a particular event or for the venue more generally, in neither case was there use designed to create or maintain a share of the market in the Class 41 services. Moreover, the test for genuine use of the Mark in relation to those services was not whether it was used for sponsorship, but whether the relationship would be viewed by the public as sponsorship and thus as merely promoting the radio station's core services. The Hearing Officer had erred in not considering that point. Bauer submitted that the essential question was whether the Mark was used to distinguish services provided at that venue from services at other venues and whether the name of the venue was likely to be taken as an indication of source in relation to the services provided at that venue.
28. In *Stichting BDO v BDO Unibank* [2013] EWHC 418 (Ch) at [51], Arnold J. cited and approved a list of principles extracted from the CJEU authorities which govern the requirement for genuine use, provided by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42]. Arnold J. added references to the *Sunrider* case, to produce this summary of the principles:
- 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].
  - 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].
  - 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].
  - 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].
  - Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].
  - 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].

- 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].
  - 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].
29. Since the decision in *Stichting BDO*, the CJEU has further considered the question of genuine use in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM*. The Court referred to *Ansul* and *La Mer*, but held at [32] that not every commercial use of a mark will automatically be deemed to constitute genuine use of the trade mark.
30. In Case C-495/07 *Silberquelle* [2009] ETMR 28, in particular, the Advocate General said at paragraph 56 of his Opinion that a trade mark which did not compete on the market for the goods for which it is registered had not been put to genuine use for those goods, and the Court, approving that approach, said:
- “19 ... it is essential ... to maintain the rights conferred by a mark for a given class of goods or services only where the mark has been used on the market for goods or services belonging to that class.
20. ... 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.”

## O-249-15

31. At paragraph 42 of his decision, the Hearing Officer referred to *DaimlerChrysler AG v Alavi ('Merc')* [2001] ETMR 98 and concluded:

"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".
32. The Hearing Officer considered that a proprietor may rely upon use which has been made by a licensee or someone else using the mark with the proprietor's consent. Bauer's evidence did not suggest that it had direct responsibility for running the arena, or that it had put on any of the events, but proved only that the Mark had been used in connection with the arena or events at the arena through a sponsorship deal. No details of the nature of that deal were provided.
33. I do not consider that there was any error of principle in the Hearing Officer's view that the question to be decided was whether the use made of the Metro Radio Mark as part of the name of the arena was to maintain or create a market for the Class 41 services in the specification (whether or not it also had some promotional benefit for the radio station) or was *merely* promotional of the radio station. This is a matter of fact. For instance in *Comic Enterprise Ltd v Twentieth Century Fox Film Corp* [2014] EWHC 185 (Ch), [2014] E.T.M.R. 46, T-shirts had been sold bearing the Claimant's mark, but this was found to have been done purely to promote the Claimant's business as a venue; it was not aimed at creating or maintaining an outlet for T-shirts. Its specification in Class 25 was therefore revoked. That result may be contrasted with that in *Merc*.
34. During the appeal hearing, a number of examples were posited of cases of sponsorship of events or venues which might fall into one or the other category, but in my view all such cases will turn on their own specific facts. I think that the Hearing Officer was right to think that in an appropriate case the use of a mark *may* be seen both as indicating source and as promoting the sponsor's core business.

## O-249-15

35. Paragraph 43 of the decision could have been more clearly expressed, but in my view it shows that Mr Landau considered that Bauer's use of the Metro Radio Mark as the name of the arena did serve the dual purpose which he had identified in his paragraph 42, and had been used for the purpose of identifying the source of services offered under it and so with the aim of maintaining, etc, a market for the Class 41 services. In the circumstances, it does not seem to me that ANL is right to criticise the Hearing Officer's approach or reasoning in paragraph 43.
  
36. In my judgment, the Hearing Officer was entitled to reach the conclusion set out in paragraph 43 of his decision, to the extent that it was supported by the evidence before him and showed genuine use during the periods relevant to the opposition/revocation. Of course the burden of proving genuine use fell upon Bauer and, as the Hearing Officer commented, in some respects the evidence which Bauer provided was of relatively low quality. In particular, its evidence failed in some cases to specify the dates of particular uses of the Mark which it relied upon or to explain properly what particular exhibits were meant to prove. For example, there was a good deal of evidence filed to show that a range of different sorts of entertainment had been offered at the arena during the relevant periods, but the nature or relevance of some of the supporting documents was unclear.
  
37. It was submitted on behalf of ANL that there was no evidence of any involvement by Bauer in arranging, organising or presenting any events; the arrangement between Bauer and the operators of the arena was purely one of sponsorship and no evidence was given as to the nature of the arrangement other than in those bald terms. Nevertheless, it does not seem to me realistic to suggest that this means that there was no evidence that anyone carried out the Class 41 activities under the Metro Radio Mark with Bauer's consent; there was ample evidence of substantial use of the name of the arena on a wide range of such services. Whatever the details of the sponsorship arrangement, plainly it permitted or required use of the Mark in relation to the arena and events there.

38. Given the limitations of the evidence before the Hearing Officer, I have concluded with some hesitation that the Hearing Officer was entitled to find that the average reasonably perspicacious member of the public would have been likely to assume that there was some commercial connection between the radio station and the entertainment services, and that the name of the arena was not merely promotional of the radio station. I do not think that ANL identified either an error of principle or a material error in this part of his decision.
39. I therefore reject the first limb of ANL's appeal against the first decision.

***b) Class 35: Bauer's appeal of the second decision, ANL's appeal of the first decision and Bauer's Respondent's Notice and fresh evidence for that appeal.***

40. ANL's appeal in respect of the Class 35 services is intertwined with Bauer's appeal in the second decision. The invalidity proceedings had been launched but not heard at the time when the first proceedings were heard. In the first decision, the Hearing Officer decided that Bauer had proved use of the Metro Radio Mark in respect of "advertising, marketing and promotional services" in Class 35, and as a result upheld its opposition to relevant parts of ANL's 2000 Application. ANL says that the Hearing Officer got this wrong and that if Bauer had proved use of its Mark for any Class 35 services, it was for a narrower range of services for the purposes of the opposition; the specification should have been narrowed down to a sub-category of advertising services, and should not have been maintained in respect of the whole range of advertising, marketing and promotional services.
41. In the second decision, the Hearing Officer decided that the Metro Radio Mark registration for advertising services was wholly invalid by reason of ANL's prior rights in the 1994 Mark. ANL says that this was right, and so the opposition to its 2000 Application ought not to have succeeded upon the basis of any Class 35 services, whilst Bauer appeals on the basis that the Hearing Officer was wrong to invalidate the Mark, thus leaving the basis of its opposition to the Class 35 services in ANL's

2000 Application. Alternatively, Bauer's position on the appeal was that at least a narrower range of services could survive to form the basis of the opposition. If so, on the appeal ANL in its turn proposed a revised specification of its application which it argued would survive the opposition.

42. It would have been helpful had the two sets of proceedings been consolidated and dealt with by one decision of the Hearing Officer. For whatever reason, that did not happen. Furthermore, the parties could not agree whether (as, unsurprisingly, ANL proposed) the appeal of the first decision should be stayed pending the second decision. However, as a result of the parties' agreement to adjourn both appeals whilst they attempted to resolve their trade mark disputes, the request for a stay became academic, and both appeals were heard together.
  
43. The date for the assessment of invalidity was 3 October 1997, so that to the extent that the Metro Radio Mark was held invalid, it could not be relied upon in Bauer's opposition to ANL's 2000 Application: it was common ground between the parties that the extent to which the Metro Radio Mark survived the invalidity attack on its Class 35 services following Bauer's appeal, including its fall-back position on the appeal, must be taken into account in my consideration of ANL's appeal in respect of Bauer's opposition to *its* Class 35 specification. My initial draft judgment did not reflect that position, and counsel drew this to my attention. I have no doubt that I have an "untrammelled inherent jurisdiction" to alter the draft judgment so as to correct and deal fully with this point, to clarify my judgment, amplify my reasons and eliminate any inconsistencies (see e.g. *In re L* [2013] UKSC 8 and *IBM United Kingdom Holdings v Dalgleish* [2015] EWHC 389). In particular, I can and should deal with Bauer's fall-back position and ANL's consequential fall-back. As anticipated at the time of the initial hearing of the appeal, I held a short supplemental hearing after circulation of my draft judgment, at which counsel helpfully addressed me both on the necessary corrections to the draft judgment and on the parties' fall-back positions.

44. I will start by ruling on Bauer's appeal relating to the substantive part of the second decision. I shall then deal with ANL's appeal of the first decision in so far as it relates to Class 35, and with Bauer's late Respondent's Notice and its application to adduce fresh evidence in relation to ANL's appeal, as these raised matters which relate only to the Class 35 services.

*The second appeal – invalidity of Bauer's Class 35 services*

45. The Hearing Officer decided in his second decision that newspapers (for which ANL's 1994 Mark is registered, as a sub-set of its registration for "printed publications") are similar to "advertising services" and concluded that there was a likelihood of confusion between the Marks. ANL had not challenged the rest of Bauer's Class 35 specification, for marketing and promotional services. Bauer's appeal essentially contested the finding of similarity between the parties' respective goods and services.
46. The Hearing Officer discussed at some length the evidence filed in the invalidity proceedings, which was intended to show that the role of a newspaper was not simply to provide advertising space, but also involved the provision of wider creative advertising services. He found at paragraph 44 that ANL had been "supplying services that a stand-alone advertising agency would. The evidence shows that this is the case across the newspaper industry and not just the case with Metro." He noted that the exhibits filed on behalf of ANL post-dated the date of filing of Bauer's Metro Radio Mark registration but he said that there was nothing to suggest that this had not been the position at that relevant date.
47. Mr Landau considered the law on similarity and in particular the notion of complementarity of goods and services, citing the decision of Mr Daniel Alexander QC sitting as the Appointed Person in *Elliott's Trade Mark Application (Luv)* [2014] RPC 13. The goods in issue in *Luv trade mark* were far removed from the goods/services in issue before the Hearing Officer, but it seems to me that in addition to the passages cited by the Hearing Officer the following paragraphs from that decision are of some relevance:

“35. ... at the relevant level of generality for the purpose of an evaluation of similarity, condoms, lubricants and vibrators do share an intended purpose.

36 To take an analogy from sport, it is true that, on one view, cricket bats, cricket pads and cricket nets have different purposes and are used and handled in very different ways but their common purpose is to enable people to play specifically cricket (rather than sport in general) and to do so safely. They are sensibly regarded as part of a broader class of “cricket equipment”. In my judgment, the position is similar with respect to the goods in question here... they are all goods intended to be used on the occasion of a specific physical activity, albeit one of more widespread appeal than cricket.

37 Finally, on this issue, the hearing officer did not refer to one factor which, at least in some of the cases, has been regarded as of considerable significance, namely that the respective kinds of goods were, in fact, produced by the same manufacturers. ...

38 This supports a conclusion that an average consumer is likely to consider that goods of those kinds come from the same trade source since, in fact, for a number of prominent brands, they do.”

48. Here, rather similarly, the Hearing Officer said at paragraph 54:

"The evidence shows that there is more than an economic link between *newspapers* and *advertising*; *newspapers* are active in both selling *advertising* and to some extent designing *advertising* ... *Newspapers* in relation to advertising are not just the newsagent's window into which a card is placed; in terms of both the work that newspapers undertake in relation to advertising and in relation to the economic importance of advertising. ...

There are two relevant publics for *newspapers*: the readers and the advertisers, which will include advertising agencies as well as persons using the newspaper's own advertising services. ... Complementarity must be considered in relation to either of the relevant public's. Taking into account the relevant public as being advertisers, the position of advertising in newspapers, the rôle of the newspaper in acting in a creative fashion in relation to advertising; advertisers would think that the responsibility for *newspapers* and *advertising services* lies with the same undertaking. The respective goods and services are complementary. "

49. At paragraph 56, the Hearing Officer concluded that there was a moderate degree of similarity between the goods and services.

50. Bauer appealed against that aspect of the decision. It complained that the evidence upon which the Hearing Officer had relied related to a period long after the relevant date and argued that the fact that newspapers have recently offered creative advertising services did not prove that advertising services are similar to newspapers. In particular, Bauer submitted that the Hearing Officer had ignored various decisions of the Boards of Appeal of OHIM and the OHIM Guidelines, all of which showed that newspapers are not similar to advertising services.
51. The Hearing Officer quoted from and discussed the Board of Appeal decisions and the OHIM Guidelines in his decision; in my view it is clear that he did not ignore them but declined to follow them. The Guidelines dated 2 January 2014 describe advertising services in such a way as to make it clear that they were considering creative advertising services, provided by "specialised companies which study their client's needs and provide all the necessary information and advice of the marketing of their products and services ..." No consideration appears to have been given to services consisting of the dissemination of or provision of space for advertising. Similarly, in the decision relied upon by Bauer, the Boards of Appeal compared newspapers to the sort of creative advertising services provided by an advertising agency, rather than to any sub-category of provision of advertising space, etc. For instance, the Fourth Board of Appeal of 10 July 2012, No R 1534/2011-4, *Medio Systems, Inc. v Starcut Oy:n konkurssipesä* said:
- “14. In Class 16, the contested mark covers printed matter in general and specific printed products, such as newspapers, booklets and pamphlets. These goods are different in nature and methods of use from any of the services covered by the earlier mark. The applicant’s goods in Class 16 and the opponent’s services in Class 35 do not target the same consumers. Whereas the applicant’s goods are addressed to the general end consumer, the opponent’s services target professional consumers or companies. In fact, only undertakings or public bodies are interested in starting an advertising campaign in order to foster the sale of a product or a service.
- 15 The opponent argues that the applicant’s goods in Class 16 are complementary to advertising services as, for example, printed matter might contain advertising material. ... the fact that printed matter can contain advertisements does not make it similar to advertising services. ... The opponent’s services have the purpose of designing an advertising or marketing campaign whereas the applicant’s goods are just the support for the transmission of information which can be an advertisement. Thirdly, consumers

receiving a pamphlet or a newspaper with an advertisement will not conclude from this that the pamphlet or newspaper is produced by the company which ordered the advertisement. Thus, the applicant's goods and the opponent's services in Class 35 are dissimilar."

52. The Hearing Officer commented that those decisions were based on the premise that the only users of advertising services are "the professional public" or "undertakings or public bodies" and that this excluded individuals who may advertise in particular by using classified advertisements. Furthermore, at paragraph 49 he observed that those views did not appear to be based on evidence and were contrary to the evidence which had been filed by ANL. He recorded at paragraph 26 of the decision the evidence that 30% of ANL's classified advertising was placed directly by individuals or businesses. As a result, the Hearing Officer's comments seem to me to be justified, at least to the extent that he had before him evidence that some advertising services are offered to members of the general public and not just to professional intermediaries. He also considered at paragraph 61 the level of care which might be taken by the average consumer when purchasing the goods/services and concluded that even less sophisticated advertisers would be relatively careful about their purchasing decision. There was therefore a distinction to be drawn between the facts predicated by the Boards of Appeal and the evidence before the Hearing Officer, and I do not consider that the Hearing Officer can be criticised for having drawn his own conclusions in the matter. More to the point, those decisions did not consider specifically the services of provision of advertising space, etc.

53. Mr Malynicz also cited to me some OHIM Opposition Division decisions which found more specifically that the dissemination of advertisements is not a service which is similar to newspapers. However, such decisions are not binding upon me and generally are limited in value because each such decision turns on its particular facts and evidence. Moreover, I am aware of at least one such decision which came to the opposite conclusion (*Hospimedica*, No B 1 136 102, 24/02/2010):

*"Advertising* in the contested application is a general term from the heading of class 35 which covers all types of advertising activities, including, among others, *rental of advertising space* (a term mentioned in the List of Goods and Services in Alphabetical Order of the Nice classification). Selling of advertising space is a

typical activity of many professional journals, such as the opponent's journal in the field of health care. Although the primary purpose of these journals is not to carry out advertising activities, it cannot be denied that the providers of these journals are effectively active on the advertising market and that the journals act to a certain extent as an advertising medium. Consequently, the goods and the services compared are considered to be similar, although to a low degree."

I do not, therefore, consider that there is anything in these Opposition Decisions which should lead me to conclude the Hearing Officer made any error in his decision on this point.

54. Bauer submitted that members of the public who are the relevant consumers of classified advertising services are different to the consumers of newspapers; this was important because goods or services intended for different publics cannot be complementary (Case T-76/09 *Mundipharma GmbH v. OHIM*, 22 June 2011, at [30]). However, in my view the evidence showed that the relevant public for both these goods and services is (or includes a sufficient proportion of) the general public. In the circumstances, so far as relevant, I reject Bauer's criticism of the Hearing Officer's analysis of the similarity of the parties' respective goods and services. For the reasons which I set out in paragraphs [72]-[77] below, I also reject the Ground of Appeal based upon the Hearing Officer's alleged misunderstanding of the decision in *Yell Ltd v Louis Giboin* [2011] EWPC 9. In my judgment, there is no error of principle or other material error in the Hearing Officer's decision that there was a likelihood of confusion between Bauer's "advertising services" and ANL's newspapers.
55. However, the Hearing Officer did not consider the fall-back position now raised by Bauer, namely whether the Class 35 specification was only partially invalid, and could be maintained for a narrower description of services. Bauer had not raised the possibility of a fall-back position with the Hearing Officer.
56. At the resumed hearing of the appeal, ANL sought to persuade me that if there was no error in the Hearing Officer's second decision as far as it went, I could not consider Bauer's fall-back position which was raised for the first time on the appeal. I do not accept that submission. On the contrary, I consider that I must deal with the point, which was raised in the Grounds of Appeal, whether or not I go on to find that

Bauer has proposed a fall-back position which is acceptable. The merits of the fall-back position must be considered and the same criteria have to be applied in considering ANL's own fall-back position on the appeal of the opposition, which was proposed in response to Bauer's fall-back in the invalidity proceedings.

57. Sub-section 47(5) of the 1994 Act provides that where grounds of invalidity exist in respect of only some of the goods or services for which a mark is registered, it shall be declared invalid as regards those goods or services only. Nevertheless, no blame attaches to the Hearing Officer for failing to consider whether a narrower specification within Class 35 could have been maintained pursuant to sub-section 47(5), as the point was not raised before him. Sub-section 47(5) reflects Article 13 of Directive 2008/95 which provides:

"Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only."

58. In *Sensornet Trade Mark* BL O/136/06, Mr Richard Arnold Q.C., as he then was, sitting as the Appointed Person, held that where an objection to registrability only applies to some goods or services in the specification applied for, Article 13 requires the application only to be refused in so far as it covers those goods or services and to be allowed to proceed in respect of the remainder. In *Giorgio Armani SpA v Sunrich Clothing Ltd* [2010] EWHC 2939, Mann J considered that this could be done in a variety of ways: by "blue pencilling," by an express qualification ("save for [the goods in respect of which the opposition succeeded]") or by a reformulation of the specification. Subsequently, the UKIPO issued first TPN 1/2011 and then TPN 1/2012, setting out its view as to how that guidance should be applied in cases of a defended invalidity application. TPN 1/2012 reflects Mann J's guidance, and in cases of reformulation says that a Hearing Officer "may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording" of a narrower

specification. That will be done only in cases where the Hearing Officer considers that there is “real practical scope to give effect to Article 13.”

59. In addition, it is well-established that a trade mark applicant or owner may raise the possibility of narrowing the specification of his mark on appeal even if it was not raised before the Hearing Officer. Whether the proposal is accepted will depend on a number of factors: see for example *Advanced Perimeter Systems v Keycorp* (“*Multisys*”) [2012] RPC 14 and [2012] RPC 15, and *YouView v Total* [2012] EWHC 3158 especially at [14]-[17], both of which were appeals in oppositions, and my own decisions on appeal in an invalidity case, *Tradocs*, BL O/395/12 and O/205/13, in which I applied the test set out by Mr Daniel Alexander QC (also sitting as the Appointed Person) in *Multisys*.
60. In *Multisys*, the appellant had not taken up the Hearing Officer’s offer to amend its specification, nor was any fall-back suggested even in the Grounds of Appeal. Instead, the suggestion that a narrower specification might be acceptable was raised for the first time in oral argument at the appeal. Mr Alexander adverted both to the desirability of reaching a fair result overall and to the potential procedural unfairness to the other party of giving permission to raise a fall-back position only on appeal. He set out at [72]-[90] the conditions in which, in his view, it might be right to permit a narrower specification to be considered for the first time on appeal, although he emphasised in his supplementary decision (BL O/468/11) his view that the arguments for and against doing so should be weighed in each individual case. At paragraph [87], he said:
- “I have no doubt that some of the services within [the appellant's] broad specification or objectionable, ... It is less clear that all are. In these circumstances, it is preferable to give the parties an opportunity to make brief further written submissions on whether consideration of a narrower specification is appropriate at this stage and, if so, whether there is such a specification which would not be open to objection ...”
- He went on at [90]:
- “Unless a more limited class 42 specification for [the appellant's] mark can be devised which is *clearly not objectionable*, the Hearing Officer's decision refusing the mark in its entirety will stand.” (emphasis added).

61. Then at [7] of Mr Alexander QC's supplementary decision he explained that one of the objections taken to the appellant's proposed narrower specification was
- "... that there are services within [the appellant's] proposed revised specification which are sufficiently similar to the goods in respect of which [the opponent's] mark is registered for use of the mark Multisys in relation to them to give rise to a risk of confusion. In my judgment, although [the opponent] is not clearly right about this, equally, it is not so clearly wrong as to admit of no possible argument. In the Main Decision I said that any more limited specification had to be *clearly* unobjectionable. In my judgment, [the] revised specification is still too broad to satisfy that requirement."
62. The most significant factors to be considered in the present case are (1) whether an alternative specification can be devised which is clearly unobjectionable, and (2) whether it is fair to ANL to let Bauer amend its specification at this stage or whether it would, for instance, have been necessary to adduce evidence as to the acceptability of any fall-back specification.
63. In the course of the appeal, Bauer proposed several different alternative specifications. First, in the Grounds of Appeal, it proposed "radio advertising services." Then in Mr Malynicz's initial comments on my draft judgment he suggested that an appropriate fall-back specification would be "provision of advertising space, time and media by means of the radio and internet" (this reflected my view of the use that Bauer had proved of the Metro Radio Mark). In his skeleton argument for the resumed hearing he suggested adopting the alternative wording "advertising, marketing and promotional services save for newspapers" but this last proposal was not pursued at the hearing. Mr Malynicz submitted that Bauer could have kept a wider specification on the basis of partial invalidity, but it would have been pointless in the light of the findings on non-use. The parties agreed that the significant point was whether Bauer could maintain a specification which covered advertising on the internet as well as on the radio.
64. ANL did not argue that "radio advertising services" was an objectionable fall-back specification, nor that there were other reasons (apart from that of principle, which I have dismissed above) why Bauer's registration should not be maintained for radio advertising services. It seems to me that ANL was realistic in not seeking to argue

that there was a likelihood of confusion if Bauer's mark were used for radio advertising services. In the circumstances, it does not seem to me that I should decline Bauer's application to maintain radio advertising services in its specification following the invalidity application.

65. Bauer's alternative fall-back position was only raised after circulation of my initial draft judgment and was disputed by ANL on the grounds first that the proposed specification was not clearly unobjectionable, and secondly that the lateness of the proposed specification meant that ANL had not had the opportunity of filing relevant evidence. Mr Speck QC said that in the absence of any inkling of Bauer's proposed fall-back his client's evidence had not been tailored to show whether, how or to what extent use of the Metro Radio Mark in relation to advertisements on the internet might have led, in 1997, to a likelihood of confusion with ANL's mark for newspapers.
66. It is necessary for me to be careful not to consider the potential conflict between newspapers and internet advertising services on the basis of present circumstances, as the importance of the internet and the manner of its use in all walks of commerce has grown substantially since 1997. Mr Malynicz rightly objected to Mr Speck making some submissions at the resumed hearing which amounted to giving oral evidence about the "presence" of newspapers on the internet in 1997. I place no reliance on Mr Speck's "evidence" on the point. However, there were some brief references to advertising on the internet even in ANL's existing evidence. ANL had produced a witness statement from Mr Martin Smith, who stated that "in newspapers online advertising began to be more widely sold from around 2003/4" and added "In the late-1990s, digital media advertising was not being sold in any appreciable amounts." This suggests that there was or at least may have been *some* advertising sold for display on internet versions of newspapers at about the relevant date, although this did not happen on a large scale. In addition, some of Mr Smith's exhibits consisted of extracts from 'BRAD' directories, and I see that one such extract from January 1998 included an index referring to electronic media, though the pages relating to electronic media were not reproduced in the exhibit.

67. Hence, if ANL had been forewarned of the need to deal specifically with the likelihood of confusion between the parties' marks if used on newspapers on the one hand and internet advertising services on the other, it seems likely that it could have produced more evidence about the nature and extent of advertising carried online and as to the average consumer's familiarity with such advertising as at the relevant date in 1997. As a result, I consider that there is some force in Mr Speck's complaint that the lateness of Bauer's production of its alternative fall-back wording was unfair because ANL could otherwise have fully addressed the question of internet advertising in its evidence.
68. The existing evidence is not designed to deal specifically with the prevalence or nature of advertising on the internet or the provision of internet advertising services at that date, which makes it difficult to assess the likelihood of confusion if the Metro Radio Mark had then been used for internet advertising. Taking into account both the change of medium from newspapers to internet advertising services and the care with which advertising services are likely to be chosen, in my view it is possible that there would at the relevant date have been no likelihood of confusion. In the circumstances, I do not consider that ANL is clearly right about its objection to the maintenance of internet advertising services in Bauer's specification. On the other hand, in my judgment ANL's position is not so clearly wrong as to admit of no possible argument. In the circumstances, I do not consider it possible to say that Bauer's second fall-back position is *clearly* unobjectionable; it cannot be said that there would have been no risk of a likelihood of confusion in 1997.
69. In addition, there is a risk of procedural unfairness if Bauer's fall-back position is accepted. One reason for Mr Alexander's view that a fall-back must be clearly unobjectionable is, I think, to avoid any unfairness in depriving a party of the opportunity to put forward its best evidence to show that a fall-back position is not acceptable. ANL has not had the opportunity to seek to address the point in evidence nor to have a first instance decision on the point. I bear in mind that refusing to allow Bauer to adopt a specification which includes internet advertising may have

important consequences for it. Nevertheless, on balance it seems clear to me that Bauer's second fall-back specification should not be allowed.

70. The appeal of the second decision is therefore allowed to the extent that the Metro Radio Mark is to be deemed invalid save for radio advertising services and the unchallenged marketing and promotional services.
71. That disposes of the second appeal save in relation to costs, and I will deal with that element of the appeal in the section on costs at the end of this judgment.

*ANL's appeal re Bauer's Class 35 services*

72. The first issue which I need to consider in relation to ANL's appeal of the first decision in relation to the Class 35 services is the meaning of the expression "advertising services." It appears that in the opposition/revocation proceedings, it was common ground between the parties that the mere offering of space "so that others can advertise" did not amount to the provision of advertising services in Class 35. The transcript also shows that Bauer did not claim that running a website amounted to providing advertising services. Mr Speck QC relied upon the judgment of HHJ Birss QC (as he then was) in *Yell Ltd v Louis Giboin* [2011] EWPC 9, in which he said at paragraph 116:

"[The Defendant] 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."

73. As a result of its position as to the meaning of advertising services, Bauer put its argument to the Hearing Officer on the basis that it had not merely been offering space for others to advertise, but had offered a wider range of advertising,

promotional and marketing services to its clients under the Metro Radio Mark, such as artwork design and the design of advertising campaigns. Bauer relied upon the evidence of Ms Aitchison who had said in her witness statement of October 2009:

"Advertising is a core service which my company offers under the trade mark Metro Radio. We offer a range of services to our clients including artwork design, website builds, web search engine optimisation, on air and online advertising ... We have a dedicated and creative team made up some of the most talented and sort [*sic*] after writers in the country. Examples of the companies which have used our advertising services are GNER, North Tyne Tourism, Virgin Holidays, Volvo and the NHS."

It is notable that Ms Aitchison's witness statement did not state that Bauer or its predecessor, EMAP, had been carrying out those sorts of services (which I shall call for convenience "creative services") prior to 7 February 2008, the end date of the period for proof of use for the opposition. Her witness statement was however made during the relevant period for the revocation proceedings. She referred to an exhibit SA9 consisting of a single page from the Metro Radio website, downloaded on 15 October 2009, parts of which were relied upon by Mr Malynicz at the hearing before Mr Landau to show the nature of the advertising services which Bauer claimed had been offered to a variety of clients. Ms Aitchison described the document in her witness statement:

"... SA9 is a print-out from the page of my company's website concerning our advertising services and listing the adverts which we created for The Tile Shed in 2008."

The print-out described services apparently then on offer from Metro Radio and Magic 1152 (another radio station in the Bauer/EMAP stable), and gave brief details of a number of advertising campaigns which were run on Metro Radio and Magic 1152. However, the only indication of the date of any such campaign related to The Tile Shed:

"The Tile Shed first came on air in January 08 with a three month campaign that included strong creative and a measurable offer."

Neither the witness statement nor the print-out specified whether the Tile Shed campaign was aired on Metro Radio or Magic 1152 or perhaps both.

74. Ms Ellington gave similar evidence in her witness statement made in 2012, saying:

“Metro Radio is and always has been a commercial radio station and generates income by advertising and promoting the goods and services of third parties during broadcasts. At the radio station we work with both advertising agencies who provide material created for broadcast on behalf of their client and we also have a team who are able to create an advert or devise a campaign for [sic] client. ... Advertising, promotional and marketing services are provided in a number of different ways including the traditional advertisement broadcast on air, and increasing by sponsorship whereby a business is promoted through association with a particular feature or show ...”

She exhibited a list of advertising agencies which had advertised with the radio station from 2001 to 2010, sample invoices relating to “sales of advertising on Metro Radio” from 2003 to 2010, and a list of the type of promotional activities typically provided for a client (this took the form of web pages downloaded on 21 January 2011 – after all of the relevant dates). She, like Ms Aitchison, failed to say when creative, promotional or marketing services were first provided under the Mark. Further, despite exhibiting invoices for sale of advertising space in the relevant periods, she did not give any evidence as to turnover in creative, promotional or marketing activities, or identify any of the invoices which she exhibited as relating to the provision of creative services, as opposed to the sale of air-time. Bauer did not suggest that she had produced any such invoice.

75. At paragraph 50 of the first decision, the Hearing Officer noted that neither of the witnesses gave any dates when any creative (“non-diffusion”) services were supplied. Ms Ellington’s exhibit relating to promotional activities was from too late a date and those exhibits which were from the relevant dates only proved the provision of the diffusion of advertising. Similarly, Ms Aitchison's exhibit SA9 emanated from after the proof of use period for the opposition and so could not be relied upon in relation to it.

76. Bauer seeks to challenge the Hearing Officer's conclusions in paragraph 50 by its late-filed Respondent's Notice, and in any event wishes to supplement Ms Aitchison's evidence by filing further evidence in the form of her second witness statement.
77. The Hearing Officer said that Bauer's evidence was "very limited" in relation to services other than supplying media for the diffusion of advertisements. Although he did not say so expressly, it is clear from paragraph 51 of his decision that the Hearing Officer concluded that Bauer had not proved that it had made genuine use of the Metro Radio Mark in any relevant period in relation to any advertising services other than the diffusion of advertisements by radio and by the website. As I have said, both parties had submitted that the diffusion of advertisements did not amount to use of "advertising services." At paragraph 49 of his decision, the Hearing Officer held that HHJ Birss QC had not come to a concluded view in *Yell v Giboin* as to whether the diffusion of advertising was an "advertising service", and I agree that the Hearing Officer was not precluded by *Yell* from reaching his conclusion that such services may be an advertising service.
78. However, he went further, and held that use for diffusion of advertisements proved that there had been use of the Metro Radio Mark in respect of "advertising, marketing and promotional services" in Class 35. He remarked at paragraph 51 that "The very purpose of a commercial radio station is to advertise; that is how the owners make their profits. ... Equally, in relation to websites, the commercial model is often based on advertising." He took the view that "Advertising is not just about creation of advertisements; it is also about the diffusion of the advertisements." In conclusion, the Hearing Officer said at paragraph 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 those media would represent a genuine category or sub-category."*

79. The Hearing Officer considered the law as to genuine use in paragraphs 36 to 40 of his first decision. ANL did not suggest that his analysis of the law was wrong, but argued that he had misapplied the law and had erred in concluding that Bauer's sale of advertising space on its radio station and its associated website warranted the retention of the broad specification "advertising, marketing and promotional services." ANL submitted that as there was no use other than in relation to the diffusion of advertising, the whole of the Class 35 specification should have been revoked, or alternatively that if the sale of advertising space is a form of advertising service, the Hearing Officer went wrong in failing to consider whether such use justified maintenance of the whole of the Class 35 specification or whether, on the contrary, the specification should have been limited.
80. ANL submitted that an appropriate sub-category of service was the "sale of radio advertising space." Mr Speck QC relied upon the taxonomy of the 2014 edition of the Nice Classification for Class 35. The class heading includes the word advertising but not the words marketing or promotional services. The services within the Class include "Provision of advertising space, time and media" which has two sub-categories "rental of advertising space" and "rental of advertising media." This should perhaps be contrasted with the 7<sup>th</sup> edition of the Nice Classification, which was that in force when the Metro Radio Mark was applied for, which instead included "Dissemination of advertising matter" and "Rental of advertising space." ANL therefore claimed that an appropriate sub-category of services could and should have been carved out of the very broad category of services maintained by the Hearing Officer. Bauer maintained its position below but also sought to rely upon its late Respondent's Notice and its fresh evidence. It is convenient to deal with those points now.

*Late Respondent's Notice*

81. The Respondent's Notice should have been filed in August 2013. It was not filed until 27 January 2014. No proper explanation has been given as to why it was filed so late, and I am puzzled by Bauer's explanation that it only realised that the point needed to be raised when it received ANL's skeleton argument in the invalidity application. It

seems to me that Bauer ought to have seen the need to re-run the advertising services argument as soon as it received ANL's appeal notice. In any event, Bauer submitted that given (a) the very substantial delay before the hearing of the appeal, (b) the fact that the Notice was filed two months before the original hearing date set for the appeal, and (c) the Notice relied upon a point which had been argued below, there would be no prejudice to ANL in permitting Bauer to rely upon the Notice.

82. ANL strenuously objected to the application to permit Bauer to rely upon the Respondent's Notice, pointing out the lack of any explanation for the delay, but also complaining of inadequacies in the Notice itself, as it failed to identify any errors in the Hearing Officer's decision. This, it argued, prejudiced ANL, which was unable to prepare to meet a particularised attack on the decision.
83. In my judgment the Notice is inadequately particularised. It does not make it plain that Bauer wished to rely principally upon the evidence furnished by Ms Aitchison at SA9 to show genuine use in relation to advertising services other than supplying media for the diffusion of advertisements. The Notice referred to paragraph 50 of the Hearing Officer's decision, but that paragraph did not deal only with that exhibit or that point. Normally, such inadequacy would be a serious matter, see *Coffeemix* [1998] R.P.C. 717. Nevertheless, I consider that the point which Bauer wished to make would have been clear to ANL throughout, as the letter of 27 January 2014 by which the application was made to file the Respondent's Notice enclosed an extract from the transcript of the hearing before Mr Landau in which Mr Malynicz addressed the Hearing Officer on the impact of SA9. It was therefore tolerably clear to me and would also have been clear to ANL that what Bauer wished to do was to re-run the argument dismissed by the Hearing Officer that it had made use of its Mark on creative services during the relevant periods, on the basis of the evidence which had been considered by the Hearing Officer. I do not consider that ANL was prejudiced by the defects in the Notice or by its lateness.
84. In the circumstances, I permit Bauer to rely upon the Respondent's Notice.

*Fresh evidence on appeal*

85. As I have said, on 21 March 2014, that is almost 2 months after making its application to file its Respondent's Notice out of time, Bauer submitted an application to adduce fresh evidence on ANL's appeal. That application was not foreshadowed by the Respondent's Notice. The evidence consisted of a second witness statement of Ms Aitchison dated 19 March 2014 and three exhibits. The first exhibit was a repeat of the original SA9, but the other exhibits contained new documents. Bauer's position on the appeal was in essence that it did not need the fresh evidence because its original evidence was good enough and the fresh evidence merely explained why that was so and added some details to it. According to Mr Malynicz's skeleton argument the new witness statement was intended "simply to amplify that the service [to The Tile Shed] was indeed provided in November/December 2007 and that the page shown at SA9 was in materially the same form prior to the date it was printed in 2009," as shown in the new exhibit SA12.
86. ANL objected to the admission of the fresh evidence, pointing not only to the delay in producing it but also to the numerous opportunities which Bauer had had to file such evidence prior to the hearing before Mr Landau. Ms Aitchison's first witness statement had, after all, been filed in 2009 and the hearing before Mr Landau did not take place until May 2013. Furthermore, ANL had challenged her first witness statement in its submissions dated 20 January 2010, arguing that many of her exhibits were undated, with no corroborating evidence as to the date, whilst other exhibits were dated after the relevant period so there could be no assumption that undated exhibits were from the relevant period. As to SA9 in particular, ANL had submitted that the print-out was dated outside the relevant period and did not evidence genuine use of the Mark for advertising services. It seems to me that Bauer was thereby put on notice that the relevance of SA9 was challenged, in accordance with the usual practice following *Extreme* [2008] R.P.C. 2, even if no request had been made to cross-examine the witness. Bauer had opportunities to file further evidence at that stage, but filed nothing more.

87. As I have said, SA9 is dated after the relevant period. Ms Aitchison did not explain in her first witness statement how it showed relevant use within the relevant period for proof of use for the opposition. On the contrary, most of her paragraph 11 was wholly unspecific as to date and the comment she made about SA9 was that it showed the creation of adverts for The Tile Shed "in 2008", so potentially after the end of the relevant period in early February 2008. Bauer's skeleton below said only that SA9 showed advertising services being provided under the Mark, whilst the transcript shows that Mr Malynicz did not rely more heavily upon the reference to The Tile Shed than upon the other undated creative services mentioned in SA9 to argue that it showed Bauer providing creative services under the Mark. Whilst he argued that the evidence was "credible, believable and properly dated" he did not deal with the difficulty that the only reference to a date in the relevant period for the opposition was that the Tile Shed campaign came on air in January 2008.
88. Ms Aitchison concentrated in her second witness statement upon the evidence relating to the Tile Shed campaign and said that the Hearing Officer had been wrong to find that the evidence at SA9 did not relate to services provided prior to 7 February 2008. She said that it showed that services were provided to The Tile Shed within the proof of use period. She stated that work had been done in late 2007 in relation to the campaign which had first aired in January 2008, and she produced as a new exhibit SA11 some scripts for those radio advertisements dated November 2007. The scripts are on headed paper which has at the top both 'Metro Radio' and 'Magic 1152.' Beneath those marks is a bold heading "**creative services – emap performance**"- Ms Aitchison had explained that Bauer acquired the company running Metro Radio from EMAP Consumer Media in 2008. She said that the scripts were prepared by Bauer's employee Tom Turner, whilst the exhibits state that the scripts are copyright of "Metro Radio & Magic 1152 Creative Services." Ms Aitchison also produced a further exhibit, SA12, showing the results of some searches on the "Wayback Machine," which she said showed that Metro Radio was offering advertising services in the years prior to February 2008. For instance, one such page is from May 2006 and says "Whether you're looking for advertising, creative solutions or a sponsorship and promotions package, Metro Radio can create a tailor

made solution to any question. ... Our creative team has the most talented and sought after writers in the country ... From a detailed brief take to writing and production, our creative team works closely with clients to deliver results."

89. There was no dispute between the parties as to the principles applicable to an application to adduce fresh evidence on appeal to the Appointed Person. Mr Speck QC reminded me of the summary of the law which I set out in my decision in BL O/147/13, *Naturex*, as follows:

"13. As May LJ said in *Du Pont De Nemours & Company v S.T. Dupont* [2003] EWCA Civ 1368, [2004] FSR 15, [2006] 1 WLR 2793 at [95] on "an appeal by way of review the court will not receive evidence which was not before the lower court unless it orders otherwise. There is an obligation on the parties to bring forward all the evidence on which they intend to rely before the lower court, and failure to do this does not normally result in indulgence by the appeal court."

14. *Ladd v Marshall* (1954] 1 WLR 1489, [1954] 3 All ER 745, [1954] EWCA Civ 1 identified three considerations for admitting fresh evidence on appeal. These apply to trade mark appeals. May LJ went on in *Du Pont* to say at [103-4]:

"103 .... Pumfrey J in my view correctly summarised the position in paragraph 57 of his judgment [in *Wunderkind Trade Mark* [2002] R.P.C. 45], where he said:

'There is no doubt that in a trade mark appeal other factors outside the *Ladd v. Marshall* criteria may well be relevant. Thus in my judgment it is legitimate to take into account such factors as those enumerated by Laddie J in *Hunt-Wesson*, provided always that it is remembered that the factors set out in *Ladd v. Marshall* are basic to the exercise of the discretion to admit fresh evidence and that those factors have peculiar weight when considering whether or not the overriding objective is to be furthered.'

104. This passage, in my view, properly recognises that the same principles apply in trade mark appeals as in any other appeal to which Part 52 applies; but that the nature of such appeals may give rise to particular application of those principles appropriate to the subject matter."

15. Hence, whilst factors other than the *Ladd v. Marshall* requirements may be relevant to trade mark appeals, they are basic to the exercise of my discretion. The three points are: (1) the evidence could not have been obtained with reasonable diligence for use at the hearing below, (2) the further evidence is such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive, and (3) the evidence is such as is presumably to be believed.

16. The additional/overlapping considerations relevant to trade mark appeals identified in *Wunderkind* and *Hunt Wesson* are:

- “1. Whether the evidence could have been filed earlier and, if so, how much earlier.
2. If it could have been, what explanation for the late filing has been offered to explain the delay.
3. The nature of the mark.
4. The nature of the objections to it.
5. The potential significance of the new evidence.
6. Whether or not the other side will be significantly prejudiced by the admission of the evidence in a way which cannot be compensated, *e.g.* by an order for costs.
7. The desirability of avoiding multiplicity of proceedings.
8. The public interest in not admitting onto the register invalid marks.””

90. The evidence in Ms Aitchison’s second witness statement could have been made available for use below. That factor tells strongly against its admission. It is also significant that no real explanation was offered by Bauer as to why it was not produced to the Hearing Officer, despite both the length of time which Bauer had had to consider its position in relation to advertising services, and the opportunities it had to produce further evidence before the first hearing. Ms Ellington’s witness statement could have expanded upon Ms Aitchison’s evidence as to use on creative services, but failed to do so in any meaningful way. The only explanation given by Ms Aitchison is that Bauer could not have anticipated that the Hearing Officer would not take account of the text of SA9 as providing sufficient proof of use of the Mark for creative advertising services prior to February 2008. I do not accept that point. Ms Aitchison’s first witness statement lacked substance. Bauer should have appreciated its inadequacies from the outset and all the more so once challenged by ANL. It failed to expand upon its evidence as to creative services even when filing Ms Ellington’s witness statement in 2012.

91. In my judgment, the application therefore fails the first of the *Ladd v Marshall* considerations, as well as the second consideration set out in *Hunt Wesson*. There is no reason to doubt the veracity of the witness statement and supporting documents. It is to that extent credible, although ANL challenged it for the reasons set out below.

92. The parties disagree as to the significance of the new evidence in terms of its potential to have an important influence on the result of the case. Bauer, whilst

wishing to persuade me that the original evidence provided sufficient proof of use on creative services, naturally submitted that the evidence reinforced the original evidence, especially as to the date of the services provided to The Tile Shed. ANL did not accept that the fresh evidence provided any such clear-cut proof. It submitted that it was not clear from the scripts at Exhibit SA11 whether the creative services had been supplied under the Metro Radio Mark or, for instance, under the EMAP mark. In addition, Mr Speck QC submitted that as a matter of law the mere fact that it might be possible to show that creative work had been carried out for a single client prior to the relevant date for the opposition would not necessarily suffice to prove genuine use of the Metro Radio Mark in relation to creative services. These were all matters which Mr Speck QC submitted could and should have been tested by cross-examination of the witness, so that to admit the evidence on appeal and deny ANL the opportunity to test the evidence in that way would prejudice it. Admission of the fresh evidence, he said, would require the matter to be remitted to the IPO, plainly a deeply unattractive prospect where there have already been such significant delays in resolving these disputes.

93. Further, Mr Speck QC submitted that Bauer had not provided any evidence at all as to the scale, frequency or extent of its use of the Mark in relation to creative advertising services. Hence, it was still not possible to assess whether there had been sufficient use of the Mark to satisfy the tests laid down in Case C-40/01 *Ansul* and Case C-259/02, *La Mer* in which the CJEU held at paragraph 21:

“use of the mark may in some circumstances be sufficient to establish genuine use ... even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.”

In those circumstances, Mr Speck QC said, even the fresh evidence was not necessarily probative of genuine use of the Mark for those services prior to 7 February 2008 or the later relevant dates for the revocation.

94. The Hearing Officer set out the law as to the need for adequate proof of use of a mark, as established in *Ansul* and *La Mer* and the summary of the position set out by

Arnold J in *Stichting BDO* (see [28] above). In addition, I bear in mind the comments made by Mr Alexander QC sitting as the Appointed Person in BL O/236/13, *Plymouth Life Centre*:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. Use should be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned ...

20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time [to] review the material that it has to prove use of it. Courts and tribunals are not unduly harsh as to the evidence they are prepared to accept as establishing use. In *Almighty Marketing Ltd. v Milk Link Ltd.* [2005] EWHC 2584 (Ch) (18 November 2005) a case primarily concerning the requirements of rule 31 of the Trade Mark Rules which require a proprietor to show prima facie use at the first stage of proceedings, Kitchin J (as he then was) analysed the requirements of evidence of use by reference to the authorities and said:

17. In *Carte Bleue Trade Marks* [2002] RPC 31 Mr. Knight, the principal hearing officer acting for the registrar, observed at paragraph 35:

"Therefore it seems to me that the Act and the Rules indicate that at least initially the registered proprietor in seeking to defend himself against an allegation of non-use need only show use at the outset which indicates clearly to those concerned that a proper defence is, and can be, mounted in relation to the allegation that the trade mark has not been used. "

If, in using the expression "proper defence", the hearing officer meant an arguable defence then I respectfully agree with him. After referring to another decision by one of the registrar's hearing officers in *Adrenalin* [O/BL336/99] he continued, at paragraph 37:

"From my point of view I would simply reinforce what has been said in these decisions and in the Manual, that the sort of evidence that one would normally hope to see is copies of brochures, catalogues, pamphlets, advertisements, etc all of which show use of the trade mark in question together with some indication of the sales of goods, or the provision of services during the relevant periods. Clearly this cannot be an exhaustive list and is merely an example of documents which might be sent in."

I agree with the hearing officer that evidence of this kind is highly desirable. If the proprietor files such evidence it will assist in clarifying the issues at an early stage and may even serve to shorten the proceedings. It is not, however, a requirement of rule 31(3). If the proprietor is able to establish that it has an arguable defence to the application without filing such evidence then, in my judgment, it is not obliged to do so.

21. Having considered the evidence and the observations of the Hearing Officer, Kitchin J continued:

22. In my judgment the hearing officer fell into error ... in seeking to apply the decision *Carte Bleue* as if it were laying down a code as to the specific

documentary evidence which must be filed in order to satisfy rule 31(3). In particular, and as is apparent from paragraph 25 of the decision, he appears to have been of the view that it was incumbent upon the appellant to provide information such as brochures, catalogues, pamphlets, advertisements or the like together with an indication of the sales of goods achieved under the mark during the relevant period. There is no requirement upon the proprietor to provide such information although it may be desirable for him to do so. The rule only requires that the evidence, considered as a whole, establishes that the proprietor has an arguable defence to the application for revocation.

22. The burden lies on the registered proprietor to prove use. However, that and other cases show that there is no particular way in which use must be established. ... there is also no hard and fast way in which use must be proved. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more, so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

...

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

95. I accept some of Mr Speck's criticisms of the second witness statement of Ms Aitchison. Despite the manifest inadequacies of the first statement, the new statement is still remarkably lacking in any solid or specific details of the broader categories of creative services which Bauer claims were carried out under the Mark prior to 7 February 2008, and identifies only a single instance of such services having

been supplied to a client before that date. Exhibit SA12 certainly contains copies of earlier pages from the metroradio.co.uk website, which indicate that creative services were on offer in 2006 and 2007, but there is no evidence of turnover in creative services during the relevant periods, nor of the numbers of clients to whom such services were provided. Not a single invoice has been identified and exhibited for the provision of such services, even though it has been possible to exhibit invoices for diffusion services from the relevant periods. In my view, the exhibit does not prove (without more) that there was real commercial exploitation of the Mark for the requisite purpose at relevant times. Furthermore, the scripts for the Tile Shed campaign do not clearly show that the creative services were provided under the Metro Radio Mark; it seems quite possible that they were provided under the mark EMAP, a problem which might equally apply to the services offered on the website. As a result, it does not show (as the CJEU said in *Ansul* at [43]) whether such use was warranted in the economic sector concerned to maintain or create a share in the market for the services protected by the Mark, or prove the scale and frequency of use of the Mark. In my judgment, it arguably falls short of the type of evidence which would normally be produced in order to prove genuine use and which ought to have been available to Bauer in this case.

96. Further, had this second witness statement been produced in advance of the hearing before the Hearing Officer, I accept that it is possible that ANL might have sought and been given permission to challenge it by cross-examination, although I think it more likely that ANL would have simply argued that the evidence in the second witness statement still failed to provide sufficient evidence of use of the Mark on creative services.
97. In my judgment it is not appropriate to permit Bauer to adduce this fresh evidence on appeal for these reasons:
- a. It is very late, and there is no proper explanation for the delay;
  - b. Bauer was put on notice that ANL would dispute the probative value of its original evidence by ANL's written submissions in January 2010 but failed to take the opportunities given to it to supplement the evidence and produce

solid and more specific evidence of use of the Mark across the range of Class 35 services. It should have been clear to Bauer, which was at all times professionally represented, that its evidence of use on creative services was insufficient or at least that ANL was going to argue that it was insufficient;

- c. The fresh evidence is not necessarily of significant probative value;
- d. It would be prejudicial to ANL to permit Bauer to rely on the evidence now, so that ANL could not challenge it further than it has done already. It would be completely inappropriate to remit this matter to the IPO for a further hearing; and
- e. Bauer suggested that public policy should weigh in favour of valid marks being kept on the Register. If there is such a policy (as opposed to a public policy to ensure that invalid marks are expunged from the Register), it does not seem to me that it outweighs the other factors in this case.

98. I therefore dismiss Bauer's application to adduce the second witness statement of Ms Aitchison on the appeal, and the appeal and cross-appeal must be decided in the light of the evidence before the Hearing Officer.

*Use on creative advertising services?*

99. The Hearing Officer found that there was not sufficient proof of use of the Metro Radio Mark for any Class 35 services other than the diffusion of advertisements. I will deal separately with the position in relation to the opposition and the application for revocation.

- a. *Opposition:* The narrative of the witness statements did not relate to the relevant date for the purpose of the opposition but was broadly couched in the present tense. The only evidence relied upon by Bauer, in the end, was the single sentence in SA9 as to the Tile Shed advertising campaign launched in January 2008. Bauer argued that this was adequate to prove use of the Mark in relation to creative services in the relevant period, and criticised the Hearing Officer because he did not comment specifically upon that point. In the light of the transcript this seems an unfair criticism to me. Bauer now wishes to place far more reliance upon the reference to the Tile Shed

campaign than it did at first instance, doubtless because it appreciates the inadequacy of the evidence in terms of proving use during the relevant period.

It seems to me that the Hearing Officer cannot be said to have failed to give adequate weight to Ms Aitchison's first witness statement which, for the reasons discussed above, fell far short of proving that there had been genuine use of the Mark on creative services during the relevant period for the opposition.

- b. *Revocation*: Ms Aitchison's first witness statement was made before the end date for the purpose of the revocation application but Ms Ellington's evidence was made well after it, as the Hearing Officer commented. Ms Aitchison said, as set out above, that the Mark had been used for a range of advertising services, including creative services and she identified some large companies which had used Bauer's "advertising services". However, she did not specify the nature of the *particular* advertising services used by those named clients and it does not seem to me that this amounted to clear evidence that such clients had been provided with creative services under the Mark. Her evidence could have been clarified and supported by the production of invoices for creative services during the relevant time period, but none were produced.

The only evidence, therefore, supporting her claim that creative services had been provided during the relevant period is again her exhibit SA9, and again I note that she mentioned specifically only the advertisements created for The Tile Shed. There is nothing that I can see in the rest of the text on SA9 which clearly shows the provision of creative services to any other client.

100. In the circumstances, it seems to me that there was no material error or error of principle in the Hearing Officer's conclusion that the evidence before him was not sufficient to prove genuine use of the Metro Radio Mark in relation to creative services for any relevant period. I therefore reject Bauer's cross-appeal on this point.

*Appropriate specification*

101. The next question raised by ANL's appeal is whether in the circumstances the Hearing Officer was right to maintain the whole or any part of the Class 35 specification for advertising, marketing and promotional services, which I must now consider in light of the partially successful invalidity proceedings which reduced the specification to "radio advertising services, marketing and promotional services." Both parties had submitted before the Hearing Officer that supplying services for the diffusion of advertisements did not fall within the Class 35 services for which the Mark was registered. ANL now says that such services do fall within Class 35 but it contends that they constitute only a sub-category of advertising services so that the specification should be partially revoked.
102. I do not find it easy to follow the Hearing Officer's reasoning in paragraph 51, but he plainly concluded that supplying services for the diffusion of advertisements was part of the wider Class 35 services for which the Mark was registered. This conclusion seems to me to be one which the Hearing Officer was entitled to reach. As Floyd J (as he then was) said in *Youview TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch); [2013] E.C.C. 17:
- "12 ...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in *The Chartered Institute of Patent Attorneys (Trade Marks) (IPTRANSLATOR)* (C-307/10) [2012] E.T.M.R 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. 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."
103. The fact that the services of an advertising agency or of a media agency may not include the provision of facilities or space for the diffusion of advertisements does not, in my view, mean that the latter are not also properly part of the wider Class 35 services for which the Metro Radio Mark was registered. To exclude them from "advertising services" altogether would in my judgment strain the language so as to produce an unnaturally narrow meaning of the term. The Hearing Officer in my

judgment construed the specification properly, reflecting reality as well as the various editions of Class 35.

104. The Hearing Officer set out in paragraphs 39 and 40 of his decision the need to decide upon a specification which fairly represented the services on which the Mark had been used, by reference to Case T-126/03 *Reckitt Benckiser ("Aladin")* and BL O/345/10, *Euro Gida*, 6 October 2010. It was common ground between the parties before me that where only partial use has been shown, a trade mark specification should (as the Court put it in *Aladin*) be reduced to a sub-category of goods or services "capable of being viewed independently;" the division must not be arbitrary but can only be done where there is a coherent category or sub-category of goods/services. In *Euro Gida* Mr Hobbs QC said that the task is to reduce the coverage of the registration so as to prevent the proprietor from claiming absolute protection for the trade mark in relation to goods or services of a kind for which there has not been genuine use, and it is necessary to identify and define 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" by reference to the perceptions of the average consumer. The tribunal is required to make a value judgment as to what is a fair specification in the light of the use that has been made of the mark, putting the decision taker in the position of the average consumer of the services in question. In *Nirvana* BL O/262/06, 18 September 2006, Mr Richard Arnold QC (as he then was, sitting as the Appointed Person) concluded at [57] that in the context of revocation proceedings the English courts "have firmly adopted the perception of the average consumer of the goods in question as providing a suitable benchmark." He considered (following *Animal* [2003] EWHC 1589, [2004] F.S.R. 19) that in deciding what is a fair description the average consumer must be taken to know the purpose of the description.
105. Paragraphs 51 and 52 of the first decision do not show that the Hearing Officer considered whether the use of the Metro Radio Mark when supplying media for advertising services justified retention of all of the "advertising, marketing and promotional services" for which the Mark was registered. In paragraph 51 he found

that such services were advertising services; in paragraph 52 he said that advertising, marketing and promotional services are all “part and parcel” of the same service, and went on to consider whether the fact that Bauer’s services had been provided only by means of the radio and internet meant that the specification should be limited to those media. But in neither paragraph is there any discussion of whether the diffusion services were a distinct sub-category of advertising, marketing or promotional services. The Hearing Officer should have decided whether use had been proved only in relation to a suitable sub-category of services. If he did so, he failed to explain his reasoning. I do not think that this is merely a lack of felicity in the manner in which the Hearing Officer expressed himself; it seems to me to be a lacuna in the decision.

106. In my judgment, it is possible (and right) to limit Bauer’s Class 35 specification. I consider that the use made by Bauer could and would properly be seen by the average consumer as a sub-category of services, distinct from both creative services and media agency services, and even further removed from marketing and promotional services. If, therefore, the Hearing Officer’s comment that advertising, marketing and promotional services are all “part and parcel” of the same service was intended to show that he viewed the diffusion services offered by Bauer as indistinguishable from the rest of those services that seems to me to be an error. I should add that he did not find that there had been any use of the Mark in relation to marketing or promotional services – the only use was in supplying services for the diffusion of advertisements.
107. It seems clear that the services provided were for advertisements to be aired on the radio, as one would expect. Bauer also said that it had sold advertising space on its website and this was supported by the witness statement of Ms Ellington. In my view, the Hearing Officer was justified on the evidence in concluding at paragraph 52 that Bauer had offered its diffusion services both on the radio and the website and had proved genuine use of the mark for such services, in terms of having used it so as to create or maintain a share of the market for them. However, its use on the internet is

now irrelevant in the light of my finding following the appeal in the invalidity proceedings that Bauer's specification is limited to "radio advertising services"

108. The Hearing Officer gave no reason for his view that Bauer's rights should not be limited to reflect the media on which the Mark had been used, but the question of whether that was a lacuna in his decision is also irrelevant in the light of my finding that Bauer's specification is limited to "radio advertising services."
109. The appropriate sub-category of services taking into account the Hearing Officer's findings as to non-use and my findings on invalidity can in my judgment best be described as "Provision of advertising space and time by means of the radio."
110. Bauer's opposition to ANL's 2000 Application is to be considered in the light of proof of use on those more limited Class 35 services, whilst Bauer's specification in Class 35 shall be revoked save for "Provision of advertising space and time by means of the radio."

***c) ANL's appeal re Bauer's Class 38 and Class 41 services***

111. ANL had put Bauer to proof of use and sought revocation of the Metro Radio Mark in respect of most of the services for which the Mark was registered in Classes 38 and 41. The Class 38 specification was broad, covering telecommunications services and a wide range of specific broadcasting services of all kinds, and the Class 41 specification included not only radio entertainment services of various kinds but also interactive information provided on-line, and a host of other activities.
112. ANL had sensibly accepted Bauer's use of the Mark in respect of "radio broadcasting services, radio programming, broadcasting and production services; radio broadcasting and transmission" in Class 38 and "radio entertainment services; production of radio programmes; entertainment by or relating to radio; production, presentation of radio programmes and entertainment services [in so far as this relates to radio broadcasting]" in Class 41.

113. The Hearing Officer dealt with the question of the use established by the Metro Radio website under the heading "Internet." He listed the sorts of features shown on the website, which included items closely linked to the radio station such as a "listen again" facility, as well as broader items such as weather forecasts, news and sport, competitions, and quizzes. He concluded that it had its "own stand-alone presence, despite its link with the radio station. The contents of the pages are quite extensive." At paragraph 54 he said:

"Website services are a clear and well established category of service; consequently a fair specification will limit the appropriate part 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 *telecommunications services*)

**Interactive information provided from a website; information provided from a website - class 41"**

114. ANL appealed this finding on the basis that (a) it was not clear what the term "website services" meant, (b) just running one's own website is not providing a telecommunications service or providing information from a website.

115. It seems to me that there is substance in ANL's complaint about the Hearing Officer's statement that "Website services are a clear and well established category of service." He did not say what type of services they are, let alone how they have been well-established and I do not find this self-evident. There are many kinds of services which relate to websites which do not fall within Class 38. For instance, website design, maintenance or hosting would not fall within Class 38 but within Class 42. This suggests to me that the term "website services" lacks the necessary level of specificity, and it does not seem to me that it is sufficient to say, as Bauer did, that the meaning of the term will be clarified by the fact that it is registered in Class 38 because in cases of ambiguity, class number is an aid to construction of the

## O-249-15

specification: *Altecnic* [2001] EWCA Civ 1928 [2002] RPC 34. Even if put into the context of Class 38, it is not clear what is meant by the term 'website services.'

116. Class 38 includes mainly services allowing a person to communicate with another by a sensory means, including those which allow one person to talk to another or place a person in oral or visual communication with another. The current Class 38 taxonomy adopted by the UKIPO amongst others has a sub-set of communication services which consists of "computer communication and internet access" including a variety of terms such as "providing access to the internet" and "access to websites, content and portals." These terms are in my view apt to cover the sorts of services provided by internet service providers; the essence of the services is the provision of access to web pages, not the provision of the content of the websites to which access is sought by the user, or other services provided by the person responsible for running the website. This again shows that one cannot easily construe the term 'website services' within this Class, and it is necessary to define the term with more precision.
117. Furthermore, it is important not to lose sight of the test which I must apply in relation to non-use, namely whether the use has been made for the purpose of acquiring or maintaining a market share in the relevant services. It does not seem to me that Bauer used its Mark in relation to its website for the purpose of acquiring or maintaining a market share in providing access to websites, but all of that use related to the website either as an asset in itself, or, to use Mr Speck's term, as an adjunct to the radio station.
118. For these reasons, in my judgment the use which Bauer has made of the Metro Radio Mark on its website does not justify the retention of "website services" in Class 38, and the Hearing Officer erred in that respect. I have considered carefully whether the evidence showed genuine use in relation to any services properly falling within Class 38 (no fall-back specification in that class having been proposed by Bauer) but it seems to me that it does not. To this extent, ANL's appeal succeeds.

119. Bauer's specification in Class 41 included not only various radio entertainment services but also "interactive information provided on-line from computer databases or the Internet; information provided on-line from computer databases or the Internet." The Hearing Officer held that Bauer had used the Mark on its website in relation to a rather narrower category of such services, namely "Interactive information provided from a website; information provided from a website - class 41." Again he failed to set out his reasoning for that conclusion, although presumably it arose from the list of elements of the website which he set out at paragraph 53 as having been identified from the evidence.

120. ANL argued that the Metro Radio website was no more than an adjunct to the radio station proper, even if it was monetised by the sale of advertising space on the website. Hence, Mr Speck said, there had not been genuine use of the Mark in relation to the services of provision of information. The Hearing Officer found that the website had a life of its own, despite its link with the radio station. That conclusion strikes me as odd, in the light of Ms Ellington's evidence about it. She said at paragraph 7 of her witness statement dated 16 January 2012:

"The web site provides an additional platform which enables the radio broadcast output of Metro Radio to be provided on-line under [sic] and reach a larger audience as the broadcast is not limited by transmitter range. The web site also enables the offerings of the radio station, such as advertising, promotions and marketing, competitions, quizzes, promotional offers, news and events to be provided in a visual form. The web site also enables those offerings to be supplemented."

The printouts which she exhibited to that witness statement were intended to illustrate those comments.

121. In the circumstances, and bearing in mind that evidence of Ms Ellington on behalf of Bauer, it seems to me that Mr Speck was right to say that the website was essentially an adjunct to the radio station. Furthermore, I do not understand why the Hearing Officer considered that the website provided information rather than any other service within Class 41. He had found some sorts of information on the webpages,

much of it relating to the radio station, some of it more general information such as news or weather reports, but other elements of the website do not seem to me to have provided information at all, but were more in the nature of entertainment pages, such as webcams of the radio station, links to music videos, quizzes and jokes.

122. In the circumstances, it does not seem to me that the Hearing Officer was right to conclude that Bauer had proved use of the Metro Radio Mark for the purpose of creating or maintaining a market share in the provision of information as such. The website was intended to provide an additional platform for the radio station and to provide similar services to it. In my judgment, the use made of the website properly maintained Bauer's specification for "entertainment by or relating to radio including such entertainment provided from a website; production, presentation of radio programmes and radio entertainment services including such entertainment provided from a website." It did not show that there had been genuine use of the Metro Radio Mark in relation to the provision of information or interactive information online.

123. ANL's appeal in relation to Class 41 succeeds to that extent.

***Conclusions on non-use***

124. The result of my variation of the Hearing Officer's findings on revocation (taken together with ANL's original concessions as to use) means that the Metro Radio Mark remains registered with effect from 24 July 2004 for:

**Class 35:** Provision of advertising space and time by means of the radio.

**Class 38:** Radio broadcasting services; radio programming, broadcasting and production services; radio broadcasting and radio transmission.

**Class 41:** Radio entertainment services; production of radio programmes; entertainment by or relating to radio, including such entertainment provided from a website; production, presentation of radio programmes and radio entertainment services, including such entertainment provided from a website; arranging, organising, presentation and provision of concerts, live entertainment, musical performances.

125. Like the Hearing Officer at paragraph 63 of the first decision, I see no need to draw any distinction between the services on which there has been proof of use and those for which use has been shown for the revocation application.

**Likelihood of confusion**

126. I turn now to the question of the appeal on the likelihood of confusion for the opposition. ANL took three points, which I shall deal with together in relation to each Class of opposed goods and services:

- a. I should consider the impact of any change to the remaining specification of the Metro Radio Mark;
- b. The Hearing Officer had erred in carrying out the comparison by reference to factors pertaining to 2013, not as matters stood at the relevant date in 2000; and
- c. The Hearing Officer had erred in assessing the likelihood of confusion by reference to overlarge categories of goods/services, which was not the right approach to take where the level of similarity was variable.

127. The likelihood of confusion has to be considered in relation to numerous goods and services. Most of the criticisms of the Hearing Officer’s assessment of the likelihood of confusion relate to his view of the similarity of the various goods and services. However, I have not lost sight of the need to carry out a global assessment of the likelihood of confusion and I bear in mind that the Marks are similar, not identical (metro.co.uk and metro.com, and Metro Radio) and that the relevant type of confusion is as to trade origin (see [29] of the CJEU’s judgment in *Canon*).

128. The specifications to compare are as follows:

Bauer’s surviving specification	The goods and services opposed in ANL's specification
---------------------------------	---

## O-249-15

	<b>(excluding those goods/services in relation to which the Hearing Officer dismissed the opposition)</b>
	<b>Class 9:</b> digital music (downloadable) provided from the internet; digital music (downloadable) provided from MP3 internet web sites
<b>Class 35:</b> Provision of advertising space and time by means of the radio	<b>Class 35:</b> 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 commercial and advertising purposes;
<b>Class 38:</b> Radio broadcasting services; radio programming, broadcasting and production services; radio broadcasting and radio transmission.	<b>Class 38:</b> 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; television, cable television and radio broadcasting services; news agency services; information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the internet;
<b>Class 41:</b> Radio entertainment services; production of radio programmes; entertainment by or relating to radio, including such entertainment provided from a website; production, presentation of radio programmes and radio entertainment services, including such entertainment provided from a website; arranging, organising, presentation and provision of concerts, live entertainment, musical performances.	<b>Class 41:</b> 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; organisation of ... 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; 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.

### *Opposition to the goods in Class 9*

129. Bauer submitted to the Hearing Officer that the Class 9 goods in ANL's 2000 application were similar to 'radio broadcasting via the Internet' within its specification in Class 38. The Hearing Officer agreed that Bauer's radio broadcasting services in Class 38 would include broadcasting via the Internet, and took judicial notice of the fact that it was common practice for radio broadcasters to offer podcasts, which could include downloadable material, and in particular music. He

therefore found that the nature of the goods and services was the same (i.e. music supplied digitally) which could be provided by the same providers through the same channels of trade. He found them highly similar.

130. ANL appeals this finding. It submitted that the Metro radio website was only set up in 1999, and there was no evidence that it was providing radio broadcasting via the Internet by 2000. Moreover, there was no evidence before the Hearing Officer that radio broadcasters offered podcasts as early as in May 2000, still less that Bauer had done so under its Mark. It seems to me that ANL has correctly identified an error in the Hearing Officer's decision in this regard and the Hearing Officer was wrong to conclude without the benefit of evidence relating to the relevant period that the goods and services were highly similar. He did not consider whether the goods were similar to radio broadcasting which was not made via the internet, nor whether they were similar to the radio entertainment services in Bauer's Class 41 registration (a point made in Bauer's Statement of Grounds, if not at the hearing below).
131. Considering the point afresh, it seems to me that there is a moderate level of similarity between the Class 9 goods and radio broadcasting/radio entertainment services, in terms of the uses and users of each and the extent to which they are competitive. There was no evidence that, at the relevant time, radio broadcasters provided downloadable music, which would have supported a conclusion that the average consumer would have been likely to consider that the goods and services had the same source. However, I consider that it is self-evident that the provision of musical entertainment by the radio is to some extent substitutable for and competitive with music which is digitally downloaded.
132. The Hearing Officer took into account at paragraph 98 the enhanced distinctiveness of Metro Radio Mark in relation to the services supplied at the Metro Radio Arena. That was also an error, in my view, because Bauer's sponsorship of the Arena began only in 2004, whilst the likelihood of confusion had to be assessed as at the relevant date in 2000. Nevertheless, there is a level of intrinsic distinctiveness in the word Metro, and Metro is the more distinctive part of the Metro Radio Mark, at least when

used in relation to radio broadcasting or entertainment services. On the other hand, the addition of the word Radio is in my view liable to be noticed by a consumer when used in the context of services provided by radio.

133. I note the Hearing Officer's unchallenged findings as to the average consumer for the Class 9 goods (the public at large) and the relatively low level of care which is likely to be taken choosing such goods.
134. Taking all these factors into account, as well as the identity of the distinctive parts of both parties' Marks, I conclude that even allowing for the errors I have identified, the Hearing Officer was entitled to conclude that there was at the relevant date a likelihood of confusion between ANL's Class 9 goods and Bauer's radio broadcasting or radio entertainment services. I therefore uphold the Hearing Officer's decision to refuse ANL's 2000 Application for these goods in Class 9.

*Opposition to the services in Class 35*

135. The Hearing Officer held at paragraph 79 that the following services were identical to the services for which he had maintained Bauer's specification in Class 35:

Advertising and 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.

At paragraph 82 he held that the "organisation of exhibitions and trade fairs for commercial purposes" were services undertaken for the promotion and marketing of goods and services and so also fell within the specifications for which he had maintained Bauer's Class 35 services.

136. Given the much narrower specification for which it is in my view appropriate to maintain Bauer's Class 35 services, it is necessary for me to revisit those findings.
137. In my view, ANL's advertising services and classified advertising services overlap with the "provision of advertising space and time by means of the radio," and so are

identical to this part of Bauer's specification. ANL put forward various possible limitations of its advertising services which, it argued, would avoid any likelihood of confusion. Initially, ANL submitted that any overlap could be avoided by amending its specification by adding the phrase "not being radio advertising services." In my initial judgment I indicated that I found that form of wording to be an acceptable variant of the usual "not including ..." format.

138. At the resumed hearing of the appeal, ANL submitted that if Bauer's specification was limited (as I have found it should be) to the provision of advertising space and time by means of the radio, its Class 35 specification would be acceptable if qualified by the phrase "not being the provision of advertising space and time by means of the radio." I accept that in some circumstances a change of medium may avoid a likelihood of confusion, as between newspapers and the diffusion of advertisements on the radio, but I do not regard a change of medium whether expressed in this or any other terms as a panacea in terms of avoiding a likelihood of confusion. Anticipating my view on this point, ANL put forward two further fall-back positions in advance of the resumed hearing before me. It proposed either:
- a. "advertising services; classified advertising services; none of the aforesaid being radio or television advertising services;" or
  - b. "advertising services and classified advertising services of and relating to advertising in printed media."

Bauer did not pursue its opposition in relation to proposal (b). The acceptability of ANL's other proposed fall-back specifications depends upon the factors which I have discussed above in relation to Bauer's fall-back, especially the helpful tests suggested in *Multisys*.

139. In my view both "advertising services and classified advertising services not being the provision of advertising space and time by means of the radio" and "advertising services; classified advertising services; none of the aforesaid being radio or television advertising services" are moderately similar to Bauer's remaining specification. All would share some users and it seems probable to me that such services could be provided through the same trade channels. Such services would be

purchased with a modicum of care by both professionals and average members of the public but as to the first proposal there seems to me to be a clear connection at least between advertising services relating to the radio and the television, sufficient to lead to a likelihood of confusion in respect of such services. I therefore reject ANL's first fall-back specification.

140. As to the version excluding both radio and television advertising, I have some difficulty in assessing the risk of a likelihood of confusion in relation to advertising services for all other media. The parties agreed that the range of potential marketing media is very wide and the evidence did not seek to address it all. In particular, neither party's evidence really addressed the issue of advertising on the internet as at the relevant date in 2000. Again, I recognise the danger of assessing the likelihood of confusion with the benefit of hindsight, rather than targeted evidence. However, I have held that I cannot exclude the possibility of a likelihood of confusion arising between these marks used for newspapers and the diffusion of advertising on the internet as at 1997. Similarly, I consider that the evidence before me does not show that I can exclude the possibility of a likelihood of confusion arising between these marks used for diffusion of advertising on the radio and advertising services (which phrase includes the diffusion of advertising) on the internet in 2000. Despite the different channels for the advertisements, the services would share some users, could be provided through the same trade channels and could be either competitive or complementary to each other. All such services would be purchased with a modicum of care by both professionals and average members of the public. However, on balance, I do not find the specification "advertising services; classified advertising services; none of the aforesaid being radio or television advertising services" to be clearly unobjectionable. There may therefore be a likelihood of confusion and this fall-back specification cannot be adopted.

141. For the same reasons, I find that there is a likelihood of confusion in relation to "advertising services provided on-line from a computer database or from the internet; compilation of advertisements for use as web pages on the internet." None of ANL's fall-back positions saves this part of its specification.

142. I therefore conclude that ANL's advertising services are to be limited to the only alternative specification put forward on the appeal, which Bauer did not oppose: "advertising services and classified advertising services of and relating to advertising in printed media."
143. Mr Malynicz submitted that ANL's "promotion" services are highly similar to if not synonymous with Bauer's advertising services. I do not accept that contention: both advertising and promotion are intended to increase a brand's sales or renown, but I consider that the average consumer could and would distinguish between the sorts of activities used for promotion (such as those run by Bauer described by Ms Ellington and by the Hearing Officer at [15] and [17] of the first decision) and advertising services. The difference is greater between promotion services and the diffusion services for which Bauer's Class 35 specification is maintained, nevertheless, there is some level of similarity, and again conceivably the services might be offered through the same trade channels. Initially, I took the view that there would be no likelihood of confusion between "the provision of advertising space and time by means of the radio" and promotion services of all kinds, but on reflection it seems to me that promotion services on the radio, television or internet could lead to a likelihood of confusion with the Metro Radio Mark. In order to exclude any likelihood of confusion it is necessary for ANL's promotion services to be registered for a more limited range of media uses and I consider that the appropriate course is to apply the same exclusion as in its fall-back for advertising services. I conclude that ANL's application may proceed to registration for "promotion services relating to printed media."
144. In my judgment the organisation of exhibitions and trade fairs for commercial purposes is not similar to "the provision of advertising space and time by means of the radio" for the reasons given by the Hearing Officer at paragraph 81 of his decision in relation to business services. I therefore allow ANL's appeal on this point and reject the opposition to the 2000 Application for these services.

## O-249-15

145. At paragraph 83 of the first decision the Hearing Officer stated that a broad range of the services in ANL's Class 38 specification were identical or very similar to Bauer's Class 38 services. However, he was of course comparing ANL's services to a wider range of services than I have concluded was appropriate. As a result, it seems to me that the only services in ANL's specification which are identical to those in Bauer's specification are "broadcasting services" and "radio broadcasting services" and I think that the Hearing Officer was plainly right to consider that there is a likelihood of confusion in relation to those services.
146. The rest of the services listed under paragraph 83 seem to me to fall into several categories:
- a. Communications services and information services relating thereto and delivery of digital music by telecommunications: these services are in my view similar though not identical to Bauer's radio broadcasting services.
  - b. Telecommunication or communication services provided on-line: 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. These are similar to Bauer's services but to a much lower degree, given the limitation to radio on the one hand and the internet on the other;
  - c. Provision of music: providing access to digital music web sites on the internet; providing access to MP3 web sites on the internet. These services seem to me not to be similar to Bauer's Class 38 services or at most peripherally similar to them;
  - d. News agency services: again, I do not see these as similar to Bauer's Class 38 services or at most peripherally similar to them.
147. In paragraph 87, the Hearing Officer held that television and cable broadcasting services are similar to a high degree to radio broadcasting, in part because he considered that they could all be provided through the same means, e.g., by a

television or the internet. I am unconvinced by that point but nevertheless the services are clearly similar to a reasonable degree.

148. In my view, there is a likelihood of confusion in relation to communications services and information services relating thereto, delivery of digital music by telecommunications, and television and cable broadcasting services, but not the further services which I have listed in paragraph 146 (b) to (d) above. ANL's appeal will be allowed in respect of those services.

149. Lastly the Hearing Officer held that information services relating to all of the Class 38 services, and such services provided online etc., stood or fell with each substantive service. I agree.

*Opposition to the services in Class 41*

150. At paragraph 83 of the first decision the Hearing Officer stated that a broad range of the services in ANL's Class 41 specification were identical or very similar to Bauer's Class 41 services. However, again he was of course comparing ANL's services to a wider range of services than I have concluded was appropriate. Nevertheless, I agree with the analysis in paragraph 83 except for "organisation of exhibitions," "provision of information relating to education" and "sports information services." In my view:

- a. "organisation of exhibitions," may at times be carried on through the same trade channels as "arranging, organising, presentation and provision of concerts, live entertainment, musical performances" and therefore has a modest level of similarity to such services; and
- b. "provision of information relating to education" is not similar to Bauer's Class 41 services
- c. "sports information services" may be provided as part of radio entertainment but are not otherwise very similar to it.

In my view, there is no likelihood of confusion in relation to the organisation of exhibitions or the provision of information relating to education but there is a likelihood of confusion in relation to sports information services.

151. The Hearing Officer's conclusions in paragraph 91 as to various television services and in paragraph 93 as to providing digital music from the Internet and MP3 Internet websites do not seem to me to be affected by my views as to the extent of Bauer's Class 41 services.

**Costs**

152. Both parties have had a measure of success in ANL's appeal of the first decision. Although quite a lot of time was spent in relation to Bauer's application to adduce fresh evidence on appeal, which I refused, on balance I consider that I should make no order as to the costs of that appeal.
153. I will also vary the costs order made below which reflected the Hearing Officer's view that Bauer had been more successful than ANL; he gave Bauer 1/3 of the costs it would have had if it had been wholly successful. As I have set aside a number of his findings in Bauer's favour, reducing the scope of Bauer's success in the opposition, it seems to me that the right order is that there be no order as to the costs below.
154. Bauer's appeal from the second decision included an appeal against the costs order. The Hearing Officer awarded ANL off-the-scale costs of £5,000 for its costs of proving that it had made use of the 1994 Mark in relation to newspapers, as well as its scale costs of the application. He refused Bauer's own application for its costs off-the-scale, which it made on the basis that ANL's invalidity application was based upon a complete change of approach as between the two cases. Bauer appealed both of those orders.
155. ANL's 1994 Mark is registered for printed publications, but in the invalidity application it relied upon it only in so far as the specification included newspapers. This was made very clear in correspondence in which ANL asked whether Bauer really wished to put it to proof of use in relation to newspapers. Bauer nevertheless put ANL to proof of use. Its reasons for doing so were not that it hoped that would resolve the invalidity claim, but because it considered that a finding of partial invalidity would be useful to it in its wider dispute(s) with ANL. Proof of use was thus

sought “for commercial reasons, for tactical reasons, for litigation reasons, for negotiation reasons” (as Mr Malynicz submitted to me). The Hearing Officer considered that Bauer had no real wish or need for the proof of use claimed and the correspondence showed that there was "no sense or logic" to its approach; "The costs were incurred by [ANL] in relation to evidence that Bauer knew full well would serve no purpose." He considered that Bauer had acted unreasonably. He therefore awarded ANL £5000 towards its costs of proof of use. He did not pluck the figure from the air; £5000 was the sum suggested by Mr Speck at the hearing, and he was subsequently provided with detailed figures, showing that the total was significantly higher.

156. Bauer complained that the Hearing Officer did not approach the issue of off-the-scale costs in accordance with principle, because he did not refer to *Rizla* [1993] RPC 365. It claimed that it was entitled to call upon ANL to prove use of its mark under s 47(2A) of the Act, and should not have been criticised for doing so. Furthermore, it claimed to have had good reasons to wish ANL to have to prove the extent of its use of its 1994 Mark. However, the Hearing Officer explained very clearly why he considered that Bauer had caused ANL to spend significant sums wholly unnecessarily, even though Bauer would ordinarily have been entitled to require ANL to prove use of the 1994 Mark. I consider that the decision was within the scope of the Hearing Officer's wide discretion as to costs and do not consider it appropriate to reverse his decision on the point.
157. Nor do I propose to reverse the Hearing Officer's refusal to award Bauer its costs of the invalidity application off-the-scale. I do not consider (any more than did the Hearing Officer) that ANL's application was an abuse of process, much as I find the timing of it unfortunate.
158. In normal circumstances I would have ordered ANL to pay Bauer's scale costs below, but that does not seem appropriate when I would not have allowed the appeal at all had it not been for the fall-back offered only on appeal. As a result, I refuse Bauer's appeal as to the costs below. I propose to make an Order as to the costs of

the invalidity application (i) that Bauer shall pay ANL the £5000 off-the-scale costs ordered by the Hearing Officer and (ii) that there shall otherwise be no order as to the costs below.

159. As to the costs of Bauer's appeal, I have concluded that the Metro Radio Mark is only partially invalid. Bauer's appeal has succeeded, but has not done so to the extent sought, or for the reasons Bauer gave, but only because of the fall-back proposed on the appeal. Had that been Bauer's sole point on the appeal, it might have had a claim to the costs of the appeal, but as it is, both sides have had a measure of success on the appeal. I will therefore make no order as to the costs of Bauer's appeal.

### **Conclusions**

160. My findings are therefore as follows:

- a. ANL's appeal of the first decision is allowed in part.
- b. Bauer's application to file its Respondent's Notice out of time is allowed.
- c. Bauer's application to file fresh evidence on the appeal is refused.
- d. Bauer's cross-appeal is refused.
- e. The Metro Radio Mark is partially revoked such that its specification is to be limited with effect from 24 July 2004 to:

**Class 35:** Provision of advertising space and time by means of the radio

**Class 38:** Radio broadcasting services; radio programming, broadcasting and production services; radio broadcasting and radio transmission.

**Class 41:** Radio entertainment services; production of radio programmes; entertainment by or relating to radio, including such entertainment provided from a website; production, presentation of radio programmes and radio entertainment services, including such entertainment provided from a website; arranging, organising, presentation and provision of concerts, live entertainment, musical performances.

- f. ANL's 2000 Application is to be permitted to proceed to registration in respect of
  - i. The unopposed goods and services in Classes 16, 36, 39 and 42.
  - ii. Class 9: 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).

- iii. Class 35: 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; advertising services and classified advertising services of and relating to advertising in printed media; promotion services relating to advertising in printed media; the organisation of exhibitions and trade fairs for commercial and advertising purposes.
- iv. Class 38: 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; Telecommunication or communication services provided on-line: 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; news agency services; information services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database or from the internet.
- v. Class 41: 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;

## O-249-15

organisation of exhibitions; provision of information relating to education; 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.

- g. Bauer's appeal is allowed in part;
- h. There shall be no Order as to the costs of either appeal, nor of the costs of the first decision below, but Bauer shall pay ANL £5,000 in respect of its costs of the second decision, to be paid by 5 pm on 25 June 2015.

Amanda Michaels  
The Appointed Person  
26 May 2015

---

**Mr Adrian Speck QC** instructed by Bird & Bird LLP represented ANL.

**Mr Simon Malynicz** instructed by Boulton Wade Tennant represented Bauer.