

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO: 1480494 BY  
CANAL + TO REGISTER A TRADE MARK IN CLASS 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 43699 BY GEMSTAR DEVELOPMENT CORPORATION**

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**BACKGROUND**

1. On 22 October 1991, Canal + of 85/89 Quai Andre Citroen, 75015 Paris, France applied to register the mark shown below in Class 41.



Following examination, the mark was accepted in Part B of the Register and published for the following services:

“Radio and television entertainment and educational services; publication and distribution of books, magazines, newspapers, audio and/or visual recordings; subscription of magazines, newspapers, and audio and/or visual recordings; subscription of audio-visual tapes, video tapes, magnetic tapes, floppy discs; loans of books; rental of apparatus and instruments for transmitting, recording and/or reproducing of sound and/or images; rental of apparatus and instruments for the encoding or decoding of television signals; rental of films, television programs, radio programs and audio and/or visual recordings; rental of theatre sets; rental of television and radio studios; production of television and radio programs; show production services; circus services; music hall and orchestra services; organisation of competitions, debates and discussions; reporting Radio and television entertainment and educational services; publication and distribution of books, magazines, newspapers, audio and/or visual recordings; subscription of magazines, newspapers, and audio and/or visual recordings; subscription of audio-visual tapes, video tapes, magnetic tapes, floppy discs; loans of books; rental of apparatus and instruments for transmitting, recording and/or reproducing of sound and/or images; rental of apparatus

and instruments for the encoding or decoding of television signals; rental of films, television programs, radio programs and audio and/or visual recordings; rental of theatre sets; rental of television and radio studios; production of television and radio programs; show production services; circus services; music hall and orchestra services; organisation of competitions, debates and discussions; reporting services for television and radio; agencies for artists; all included in Class 41".

I note that the advertisement of the application for registration contained the following disclaimer, under Section 14 of the Act:

Registration of this mark shall give no right to the exclusive use, separately, of the words "Le Studio" and the word and mathematical symbol "Canal +".

2. The application is opposed by Gemstar Development Corporation of Pasadena, California, United States of America. Objections are said to arise as follows:

1) under Section 10 of the Act, as the mark applied for is descriptive of and non-distinctive for the services specified in that it consists of the French words LE STUDIO (meaning the studio) the French word CANAL (meaning channel) and the symbol + .

2) under Section 12 of the Act, because the mark applied for nearly resembles one or more of the marks owned by the opponents. The principal trade marks relied upon by the opponents are shown in the Annex to this decision.

An objection under Section 11 of the Act was withdrawn prior to the hearing.

3. The opponents ask for the Registrar to exercise her discretion in their favour to refuse the application.

4. The applicants filed a counterstatement in which the grounds of opposition are denied.

5. Both sides seek an award of costs in their favour and both sides filed evidence. The matter came to be heard on 2 April 2001. The applicants were represented by Dr Peter Colley of Counsel instructed by Browne Jacobson. The opponents were represented by Mr Thomas Moody-Stuart of Counsel instructed by Saunders & Dolleymore.

6. By the time the matter came to be heard the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later part of this decision are references to the provisions of the old law.

7. It was common ground between the parties that the evidence filed in support of the pleadings (and which has been filed in seventeen other actions between the parties) was for the most part not germane. It was evidence of use outwith the relevant date in these proceedings. The only piece of evidence which I need to take into account is a Statutory Declaration dated

30 September 1996 by Marie-Christine Mathieux. Ms Mathieux explains that she is a French citizen who has lived in the United Kingdom since 1970; she is fluent in the French and English languages and has been a teacher of the French language at Watford Grammar School for girls since 1977. She states that the French words LE STUDIO CANAL+ mean “the Studio Channel+” in English and in her view the meaning of these words would probably be understood by the majority of the United Kingdom population when used in connection with services relating to radio and television broadcasting and receiving.

## DECISION

8. The opponents’ first objection is based upon Section 10 of the Act which states

“10.-(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof”.

9. In support of the allegation that the trade mark is descriptive and non distinctive, and therefore not capable of distinguishing the services of the applicants from those of other traders, Mr Moody Stuart relied upon the evidence of Ms Mathieux and the judgement of Mr Geoffrey Hobbs QC acting as the Appointed Person in **El Canal de Las Estrellas** [2000] RPC 291. In Mr Moody-Stuart’s view the plain meaning of this trade mark to the English speaking public is “The Studio Channel Plus” (or Channel Plus: the Studio). The disclaimer to the separate use of “Le Studio” and “Canal+” did not save the trade mark, it was wholly incapable of distinguishing the services of Canal+ from those of any other concern and there was no evidence of use sufficient to show that the mark has acquired distinctiveness. In his view this opposition was on all fours with the facts in **El Canal de Las Estrellas**. As such, the application should be refused.

The head notes from the quoted authority state:

“**Held**, dismissing the appeal:

(1) There was no rule that foreign words had to be examined for registrability by reference to their meaning in translation. The purpose of translation was to ensure that foreign words were not registered without knowing their meaning.

(2) For registration, foreign words needed only to be capable of functioning satisfactorily as trade marks in relation to the goods or services supplied in or from the United Kingdom, whether or not they would also qualify for protection elsewhere.

(3) The less obscure a foreign word was, the greater the weight which had to be given to its meaning in translation.

(4) Traders engaged in intra-Community trade were not, unjustifiably, to be prevented from using words in the language of other member states of the European Union.

(5) Spanish was a modern language widely understood and spoken in the United Kingdom. Spain was a trading partner of the United Kingdom and a fellow member of the European Union. The services specified in the application were supplied nationally and internationally.

(6) EL CANAL DE LAS ESTRELLAS was easily recognisable as Spanish which when used in respect of the services specified would be understood as laudatory and not a reference to stellar bodies.

(7) The disclaimers offered did not cure the defects of the mark”.

10. Dr Colley submitted that Ms Mathieux was not competent to give a view on the way in which the English speaking public would view the trade mark. In relation to the authority quoted by Mr Moody-Stuart he submitted that in that case the trade mark was a clear and natural Spanish phrase, which suggested itself as being a Spanish phrase; in other words, it struck one in the face as being Spanish. That was not the case here. The word CANAL did not suggest itself as being the French word for Channel. Whilst he accepted that there was a translation issue, it did not, in his view, suggest itself in anything like the same way as the terms in **El Canal de Las Estrellas** did.

11. As always, I must look at the trade mark in suit and determine whether in relation to the services for which registration is sought it is capable of distinguishing the services of the applicants from those of other traders, bearing in mind the quoted case. For a significant proportion of the specification I think that Mr Moody Stuart accepted that the trade mark was capable of distinguishing the applicants' services eg. publication and distribution of books, magazines and newspapers and circus services. But for such items as television entertainment services and rental of apparatus and instruments for transmission, recording and/or reproducing of sound or images, is the trade mark, which consists of the French phrase LE STUDIO and the word CANAL and the mathematical symbol +, capable of doing so? I take the view that in the context of this trade mark, when seen alongside the term LE STUDIO, the word CANAL would also be seen as a French word meaning Channel when used in

connection with eg. production of television and radio programmes. That said, it seems to me that, unlike the term **El Canal de Las Estrellas**, the terms in this trade mark do not hang together in the same way to point to a descriptive meaning. What is the Studio Channel anyway? Also the presentation of the terms is unusual, one is superimposed on the other, and there is the addition of a + sign.

12. Considering matters in the round it seems to me that the trade mark in suit, as a whole, does not suggest the level of descriptiveness or non-distinctiveness to which Mr Moody Stuart sought to point me. There is a degree of novelty about the presentation of the terms and the device which, coupled with the disclaimers, mean that it can function as a trade mark in relation to all the services covered by the application for registration. It is capable of distinguishing the applicants' services from those of other traders. The objection under Section 10 is therefore dismissed.

13. I turn to the ground of objection based upon Section 12(1) of the Act which states:-

“12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description”.

14. The reference in Section 12 to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

The established test for objections under Section 12(1) is set down in **Smith Hayden & Co Ltd's application** [Volume 1946 63 RPC 101]. Adapted to the matter in hand the test may be expressed as follows:

Assuming user by the opponent of their PLUS trade marks in a normal and fair manner for any of the goods covered by the registrations of the trade marks is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their trade mark LE STUDIO CANAL+ normally and fairly in respect of any services covered by the proposed registration?

15. Adapting the test set out in **Jellinek** (1946) 63 RPC 59, I consider first of all whether the services for which the applicants seeks registration could be regarded as services that would be associated with the opponents' goods. Bearing in mind the nature of the opponents' goods, which are principally electrical equipment all for entertainment purposes, I think it reasonable to conclude that some of the applicants' services could be associated directly or

indirectly with the opponents' goods eg. rental of apparatus and instruments for the encoding or decoding of television signals associated directly with radio and television apparatus and cable box controllers. I go on to consider the respective trade marks.

16. Both parties at the hearing drew my attention to the guidance set down by Parker J in **Pianotist Co's Application** (1906) 23 RPC 774 at page 777:

"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

17. The applicants' trade mark includes as an element the + sign which will be pronounced PLUS. The opponents' trade marks consists of or include the word 'PLUS'. But the applicants' trade mark has two other elements which I think predominate, the word CANAL and the phrase LE STUDIO. Therefore, in my view, whether when viewed or used aurally the applicants' trade mark is different from the opponents' trade marks; I am satisfied therefore that confusion in the minds of the public leading to confusion between the respective goods and services is most unlikely. Therefore, the ground of objection based upon Section 12(1) is dismissed.

18. The opposition having been dismissed the applicants are entitled to an award of costs. Thus I order the opponents to pay to the applicants the sum of £800. This sum to be paid within seven days of the expiry of the appeal period or within 7 days of the final determination of the matter.

**Dated this 6<sup>TH</sup> Day of July 2001**

**M Knight  
For the Registrar  
The Comptroller General**

## ANNEX

Number	Mark	Goods/Services
952147	PLUS	Photographic, cinematographic and optical apparatus and instruments and utensils included in Class 9 for use therewith, and parts and fittings included in Class 9 for all the aforesaid goods (8 December 1969)
979367	PLUS	Sound recording and sound reproducing apparatus and instruments; record players, tape recorders; and parts and fittings included in Class 9 for all the aforesaid goods (18 August 1971)
1132300	PLUS	Radio and television apparatus and instruments; sound recording and sound reproducing apparatus and instruments; telecommunicating apparatus and instruments; telephone apparatus and instruments; monitoring apparatus (none being medical apparatus); telephone answering machines; computers and electronic data processing apparatus and instruments; parts and fittings included in Class 9 for all the aforesaid goods. CANCELLED IN RESPECT of computers, electronic data processing apparatus and instruments and parts and fittings for these cancelled goods (18 April 1980)
1453000	PLUSCODE	Video cassette and cable box controllers; all included in Class 9 (23 July 1990)