

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

**IN THE MATTER OF APPLICATION NO: 7947 BY  
GEMSTAR DEVELOPMENT CORPORATION FOR RECTIFICATION OF THE  
REGISTER OF TRADE MARKS IN RESPECT OF REGISTRATION NO: B1386148  
STANDING IN THE NAME OF CANAL+**

**IN THE MATTER OF APPLICATION NO: 7948 BY  
GEMSTAR DEVELOPMENT CORPORATION FOR RECTIFICATION OF THE  
REGISTER OF TRADE MARKS IN RESPECT OF REGISTRATION NO: B1386150  
STANDING IN THE NAME OF CANAL+**

**IN THE MATTER OF APPLICATION NO: B1386149 BY  
CANAL+  
TO REGISTER A TRADE MARK IN CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO: 38435  
BY GEMSTAR DEVELOPMENT CORPORATION**

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

**IN THE MATTER OF Application No: 7947 by  
Gemstar Development Corporation for Rectification  
of the register of Trade Marks in respect of  
Registration No: B1386148 standing in the name of Canal+**

**IN THE MATTER OF Application No: 7948 by  
Gemstar Development Corporation for  
rectification of the register of Trade Marks in respect of  
Registration No: B1386150 standing in the name of Canal+**

**IN THE MATTER OF Application No: B1386149 by  
Canal+ to register a Trade Mark in Class 16**

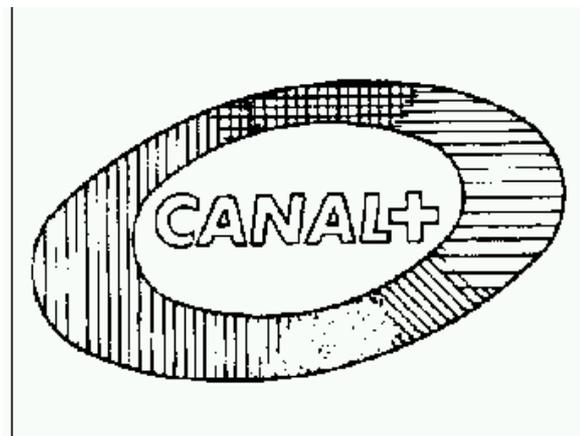
**and**

**IN THE MATTER OF Opposition thereto under No: 38435  
by Gemstar Development Corporation**

**BACKGROUND**

1. These three sets of proceedings all involve the same trade mark, the same parties and the same grounds on which the proceedings are based. Therefore, it is convenient to deal with them in one composite decision. Where there are any differences in, for example, the earlier rights on which a ground is based I deal with that separately. Otherwise, this decision covers all three sets of proceedings.

2. The trade mark in issue is shown below:



3. I note that the registrations and the application for registration contain the following limitations:

“The mark is limited to the colours black, blue, green, yellow, orange and purple as shown in the representation on the form of application, AND

Registration of this mark shall give no right to the exclusive use of the word and mathematical symbol “Canal+”“.

4. The two registrations and the application for registration stand in the name of Canal+, a French company; their company address is 85/89 Quai Andre Citroen, Paris. The details of their registrations and application are as follows:

Registration No: 1386148  
Date of Registration: 23 June 1993  
Class: 9  
Specification of Goods: “Films, audio and visual cassettes of recorded programmes and of cinematographic and entertainment works; televisions, radios, decoders, audio-visual apparatus and instruments; telecommunications and telematic apparatus and instruments; tape recorders, magnetoscopes, projectors, car radios, aerials, loudspeakers, amplifiers, microphones; cassettes, video cassettes, tapes, records; hi-fi apparatus; compact disc players; turn-tables; tuners; digital audio tape players; television and radio installations; all included in Class 9”.

Registration No: 1386150  
Date of Registration: 23 September 1992  
Class: 38  
Specification of Services: “Television and radio broadcasting; electronic communication services; transmission of radio and television programmes; subscription television broadcasting; teletext services; all included in class 38.

Application No: 1386149  
Date of Application: 30 May 1989  
Class: 16  
Specification of Goods: “Magazines, magazines relating to shows, audio-visual programmes; newspapers, periodicals, folders; all included in Class 16.

5. Gemstar Development Corporation of Pasadena, California, United States of America seek to rectify the register by the removal of the registrations. Their applications to do so were made on 5 February 1994. They also oppose the application for registration, which was accepted in Part B of the register, by the notice of opposition filed on 10 March 1994.

6. In all three sets of proceedings, brought under Section 32 of the Act in respect of the applications for rectification and Section 18 in respect of the opposition, the grounds are the

same, namely the trade mark should be removed from the register or refused acceptance:

1) under Section 10 of the Act, as it is descriptive of and non-distinctive for the goods specified, because it consists of the French word CANAL (meaning channel), the symbol +, and a device consisting of a simple geometric shape, which are non-distinctive

2) under Section 11 of the Act, because of the reputation acquired by the opponents as a result of their earlier use of the word PLUS and/or the symbol +

3) under Section 12 of the Act, because the trade mark the subject of the registrations and application for registration nearly resembles one or more of the trade marks owned by Gemstar. The trade marks on which they rely are set out later in this decision.

7. The applicants ask the Registrar to exercise her discretion in their favour to expunge the registrations and to refuse to register the application for registration; and in the alternative, to direct that the trade marks in suit should be amended so as to avoid potential confusion with Gemstar's trade marks and/or to meet the distinctiveness requirements of the Act. Canal+ filed counterstatements in which the grounds were all denied.

8. 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. Prior to the hearing the ground based upon Section 11 of the Act was dropped.

9. 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.

10. In their submissions to me learned Counsel acknowledged that the evidence of use of the Gemstar and Canal+ trade marks was of little assistance in these cases. This was because the evidence had been prepared and compiled for a number of actions between the parties ("one size fits all"). In these particular cases the evidence was either irrelevant, because it related to facts arising after the material dates, or did not address the points in issue. I have never the less undertaken below a summary of the evidence filed in case there is an appeal against this decision, or in case it might assist in the consideration of the other actions between the parties".

11. The evidence in all three sets of proceedings is very similar.

## **GEMSTAR'S EVIDENCE IN CHIEF**

12. Gemstar's evidence consists of three Statutory Declarations. The first dated 30 September 1996 is by Marie-Christine Mathieux. Ms Mathieux explains that she is a French citizen who has lived in the United Kingdom since 1970. She says that 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 word CANAL means Channel in English and that in her view the meaning of the French word CANAL would probably be understood by the majority of the United Kingdom population when used in connection with goods relating to radio and television broadcasting and receiving.

13. The second Declaration dated 6 May 1997 is by Louise Fawcett. Ms Fawcett explains that she is the Marketing Manager of Gemstar Marketing Limited (GML) which is a United Kingdom company. She adds that GML is responsible for sales and marketing of Gemstar Development Corporation's (GDC) intellectual property rights and operations throughout Europe. Ms Fawcett has full access to the relevant records and is authorised to speak on behalf of GML.

14. Ms Fawcett explains that on 27 July and 3 August 1996 (ie. some 7 years after the material date in these proceedings), GML conducted a survey at the Enfield and Chingford branches of CURRY superstores. The survey was conducted to determine the impact of VIDEOPLUS+ apparatus for television on the purchasing decisions of respondents intending to purchase a new television within two years of the survey. The survey was, says Ms Fawcett, organised and managed by her and the actual research was conducted by two temporary employees of GML. While the survey was not, says Ms Fawcett, conducted as an exercise in market research, nor was it organised and conducted to obtain evidence for the purpose of these proceedings, she believes that some of the findings are relevant. Exhibits LFE1 and LFE2 consist of the 95 completed questionnaires and a summary of the findings respectively. From this survey Ms Fawcett notes the number of television owners questioned who had heard of VIDEOPLUS+ apparatus was 82%, and the percentage of those questioned who had the VIDEOPLUS+ technology in their homes was 33%.

15. The third Declaration dated 11 April 1997 is by Donald McQueen. Mr McQueen explains that he is the Managing Director of (GML). He repeats the details already provided by Ms Fawcett and confirms that he also has access to the relevant records and is authorised to speak on behalf of GML.

16. Mr McQueen states that (GDC) is the proprietor of a number of trade marks which consist of or include the word PLUS. He adds that the trade mark PLUS and marks consisting of or including the word PLUS and/or the symbol + have been used continuously by GML in the United Kingdom since at least December 1991. Exhibit GDC(E)2 consists of examples of the various marks in use. In addition says Mr McQueen the trade mark (VIDEOPLUS+ one assumes) is applied by all major manufacturers of video cassette recorders (VCRs) to their VCRs to indicate that they incorporate VIDEOPLUS+ technology. Exhibit GDC(E)3 (which is hand dated 10 February 1995) is a list of these manufacturers. Mr McQueen adds that there are currently over 160 VCR models in the United Kingdom with this feature. Advertising/publicity material is provided at exhibit GDC(E)4 (the majority of which, if not all, post dates the material date in all these proceedings) while exhibit GDC(E)5 is a list of publications (produced from reports dated 1 September 1994 and 6 June 1996) which list the code numbers required to record programs from receivers onto video tape. This shows, says Mr McQueen, that all the major publishers of television listings buy this information from GDC/GML for publication in the United Kingdom. Exhibit GDC(E)6 is said to consist of an indicative range of advertising (commencing in November 1991) in which the various trade

marks have been promoted, this includes the VIDEOPLUS+ trade mark appearing on the exterior surface of a bus as well as the sponsorship of various competitions on commercial radio. Marketing expenditure in the periods 1991-1992 and 1992-1993 is estimated at £0.75m per year, with expenditure in the periods 1993-1994 and 1994-1995 amounting to £540k and £429k respectively. Mr McQueen comments that the VIDEOPLUS+ trade mark is also promoted indirectly every time a VCR bearing the VIDEOPLUS+ mark is sold or advertised, adding that in 1994 approximately 63% of the VCRs sold in the United Kingdom contained the VIDEOPLUS+ feature and as a consequence bore the VIDEOPLUS+ trade mark.

## **CANAL+S' EVIDENCE IN CHIEF**

17. This consists of a Statutory Declaration dated February 1998 by Maria Changivy. Ms Changivy explains that she is a lawyer employed by Canal+ and has held this position since May 1997. She states that she is authorised to speak for Canal+ adding that all of the details are within her own knowledge or are taken from the records of her company to which she has full access.

18. Ms Changivy comments that her company was formed on 14 August 1984 in France and has since that time used the trade mark CANAL+ and PLUS in France, the United Kingdom and throughout the world, adding that in the ten years from its formation her company had reached the position of being the world's leading pay-television company. She goes on to say that since merging with the Dutch Media Group Nethold in 1997, her company has nearly ten million subscribers throughout the world adding that the company remains the European leader in Pay TV systems which utilise decoders and encoders. She comments that her company's television programmes are not only broadcast but can also be purchased throughout Europe on video tape. Exhibit MC1 to her Declaration is a copy of her company's annual report of 1994 together with extracts taken from her company's annual report of 1996. With a worldwide turnover figure of £970m in 1995, Ms Changivy explains that approximate annual sales figures for the United Kingdom amounted to £237k in 1993, £1.1m in 1994 and £609k in 1995. Exhibit MC2 consists of a chart which shows the annual sales figures from 1993 to 1995 for products sold throughout the world through the CANAL+ distribution catalogues.

19. Ms Changivy concludes her Declaration by explaining that her company undertakes a substantial amount of worldwide advertising and promotion in respect of the trade marks + and PLUS. Worldwide advertising figures for 1993 to 1995 are provided and amount to £50m, £48m and £51m respectively. A selection of press extracts are provided as exhibit MC3.

## **GEMSTAR'S EVIDENCE IN REPLY**

20. This consists of two Statutory Declarations. The first dated 16 November 1999 is by Janice Trebble who is a Registered Trade Mark Attorney and a Partner in the firm of Saunders & Dolleymore who are Gemstar's professional representative in these proceedings. She explains that in May 1998 she instructed CDR International Limited to conduct an investigation into the commercial activities in the United Kingdom of Canal+. Exhibit JMT1E consists of a copy of a Statutory Declaration together with two exhibits. The Statutory Declaration is dated 17 February 1999 and is by Lindsay Hudson.

21. Ms Hudson explains that she is a Director of CDR who are a firm of investigators based in London. She adds that on 26 May 1998 her company received instructions (as indicated above) to conduct research into the activities of Canal+. Exhibit LH1 is a copy of these instructions. The actual research was, says Ms Hudson, conducted by Mr Eggleton a Consultant Investigator employed by CDR. Exhibit LH2 is a copy of the report sent to Mrs Trebble on completion of the research. The exhibit also consists of a Statutory Declaration by Richard Eggleton dated 17 February 1999. In his Declaration Mr Eggleton confirms his position in CDR International Limited adding that he has held this position since early 1998. He confirms that he has read Ms Hudson's Declaration adding that he conducted the research and compiled the report in exhibit LH2 of that Declaration. I do not propose to summarise Mr Eggleton's findings but note his conclusions below. He says:

*“3.1 Canal has extensive operations around the world, but we have found no evidence of its distribution in the UNITED KINGDOM, either from the company itself, pay-TV providers or the public. There is a limited company set up in the UNITED KINGDOM which may be connected to the parent company Canal on France, but this does not appear to have traded since its incorporation in 1996.*

*3.2 Canal have indicated that they have no distribution rights in the UNITED KINGDOM, although staff there have indicated there are ways around this due to the essentially boundary-free nature of the technology utilised”.*

22. The final Declaration dated 8 November 1999 is by Lydie Levy. Ms Levy explains that she is now the Managing Director of GML adding that she has full access to the relevant records, is authorised to speak on GML's behalf and is the successor to Mr McQueen (mentioned above) whose Declaration she has read. Ms Levy's Declaration provides information (in exhibits LL1E to LL4E) showing how the opponents' various marks are promoted.

## **PRELIMINARY DECISION**

23. At the start of the Main Hearing, Dr Colley on behalf of Canal+ sought an adjournment in order that these cases might be heard with fourteen other cases involving these (and similar) trade marks and these parties. Also, he sought leave to file further evidence on the matter of the likelihood of confusion between Gemstar's and Canal's trade marks.

24. Dr Colley's submissions are summarised as follows:

3. Having regard to the Trade Marks Registry's own practice and the overriding objective, now familiar from the Civil Procedure Rules, determination of these actions other than as a whole would be contrary to those for these reasons:

- (1) There are 18 actions pending between the same parties covering the same or closely similar issues.
- (2) There is no great or special urgency about the determination of these particular four cases. They were initiated in 1994 and much of the delay since then has been attributable to Gemstar, which has sought and obtained numerous

extensions of time.

- (3) The determination of these actions in isolation from the others will cause additional costs to be incurred, in that much the same issues will need to be prepared at least twice.
- (4) Counsel for Canal+ first received instructions on Wednesday 28 March 2001. As a result, inquiries as to whether there had been any evidence of confusion between Canal+ and Gemstar as a result of use of any of Canal+'s marks in the United Kingdom, whether before or after the relevant application dates, were put in hand. There had previously been a mis-appreciation as to the relevance of post application dated use within Canal+. It was only on Friday 30 March 2001 at approximately 4.00pm that a spreadsheet of "sales" with relevant dates and purchasers was received by Counsel for Canal+ who now sought time to investigate this material further. Also if appropriate leave to file further evidence dealing with the nature of these sales and use of the trade marks and consequently evidence of the presence or absence of any confusion between the Canal+ marks used and those relied upon by Gemstar.

25. In support Dr Colley exhibited correspondence between the parties and the Trade Marks Registry which indicated that the latter was willing to have all the actions heard simultaneously. Thus on proportionately, cost saving and equality grounds, I was asked to adjourn and give Counsel leave for Canal+ to have time to consider, compile and file additional evidence.

26. Mr Moody-Stuart on behalf of Gemstar objected to both requests. The fact that the same parties and same or similar trade marks were involved did not mean that these eighteen cases should all be heard together. There were different onuses and different dates involved which meant that it would not be particularly easy or convenient to consider them together. Small batches were perfectly manageable, particularly as the proceedings themselves had been underway for sometime. In respect of the additional evidence he noted that Canal+ had already had one request to file additional evidence refused (in respect of information on satellite footprints). There was in his view little substance in this request because there was only an indication of some sales under the trade marks (after the relevant period in these proceedings) and therefore the likelihood that these did or could have resulted in confusion could not reasonably be gauged.

27. I said that the Trade Marks Registry was, it seemed to me, always amenable to 'case management' in cases such as these. If the parties had agreed a timetable against which all of these cases could progress, then I have little doubt that the Trade Marks Registry would have endorsed it. However, for whatever reason, no such agreement between the parties was reached. I had therefore this request for an adjournment of the substantive Hearing, in order that the applicants/registered proprietors could consider filing additional and new evidence and then reconvene at a future date and allow all the cases between the parties to be determined together.

28. I refused all these requests. It seemed to me that they had come very late and there was no certainty that the evidence I was asked to adjourn and give leave to file, will if filed in fact

help determine the issues between the parties in relation to the distinctiveness objection under Section 10, nor was it clear, given that the sales were well after the material date here, that it would help resolve the objections under Section 12(1). Essentially the substantive decision required to be taken here is whether or not the trade mark in suit was capable of distinguishing the goods and services of the applicants/registered proprietors at the date of application/registration or whether it had acquired any distinctiveness by that time. The schedule submitted by Dr Colley in support of his request contained details of some use of the trade mark in suit. But many of the dates are years after the dates of the application/registrations in these cases and therefore well beyond the relevant date. Therefore, I am not at all clear how any additional evidence might assist me. Whilst there may be circumstances in which it is possible to take into account evidence of use after a relevant date, it has to be pretty clear that that evidence directly relates to the situation that was in being at the relevant time. I am not persuaded that that will be the case here because in the cases before me applications for registration were made in 1989 and the schedule contains details of transactions which occurred in the year 2000. I have no idea what has transpired between the date of application and that latter date, but clearly, much of the evidence which might be filed would have to be discounted as not relevant in relation to any of the grounds in these proceedings.

29. In reaching the above conclusions I take into account the guidance set out by the High Court in the **SWISS MISS** case [1998] RPC 889, which sets out the criteria against which the High Court should determine whether or not to admit additional evidence on an appeal from the Registrar (and this situation was not therefore on all fours). In doing so, it does not seem to me that it was fair or reasonable, the proceedings have been in being for so long and the date for a hearing having been appointed some time ago, to allow the adjournment sought or to give leave to the applicants/registered proprietors to consider matters and put in evidence. I directed therefore that the hearing continue on the basis of the materials already filed and before me.

## **SUBSTANTIVE DECISION**

30. The first matter I need to determine is whether Gemstar are, in relation to the applications for rectification, persons aggrieved. Section 32 of the Act, insofar as it is relevant in this case states:

“32.-(1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to the provisions of Section 54 of his Act, to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as the tribunal may think fit”.

31. The basis for determining whether an applicant for rectification is a person aggrieved is set down by Lord Herschell in **Powell v Birmingham Vinegar** (Vol 1894)11 RPC 4 at page 7 line 44 as follows:

“The respondents are in the same trade as the appellant; like the appellant, they deal

amongst other things in sauces. The courts below have held that the respondents are “persons aggrieved”. My lords, I should be very unwilling unduly to limit the construction to be placed upon these words, because although they were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited, inasmuch as it is a public mischief that there should remain upon the Register a mark which ought not to be there, and by which many persons may be affected who nevertheless would not be willing to enter upon the risks and expense of litigation.

Wherever it can be shown as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark if remaining on the Register would or might limit the legal rights of the applicant so that by reason of the existence of the entry upon the Register he could not lawfully do that which but for the appearance of the mark upon the Register he could lawfully do, it appears to me that he has a locus standi to be heard as a “person aggrieved”.

32. In this case the parties are in the same industrial or commercial sectors of the market and the applicants for rectification considers that the registered proprietors’ trade marks in some way effect their rights. The required status therefore exists and the applicants for rectification are persons aggrieved. I note that the registered proprietors do not take a point in the matter.

33. With that dealt with, and as indicated earlier, the issues in each set of proceedings are the same. I deal first with the allegation that the trade mark in suit is descriptive and non distinctive in respect of the goods and services covered by the registrations and the application for registration. As the two registrations are in Part B of the register and the application for registration has been accepted for registration in Part B this allegation is founded 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”.

34. Gemstar claim that the trade mark consists of the French word CANAL which means channel, and for the goods and services covered by the respective specifications this word is either descriptive or non distinctive. The addition of the + sign, which is a simple geometric shape and itself non distinctive they say, does not assist. Though the pleadings do not specifically address the elliptical device which also appears in the trade mark Mr Moody-Stuart in his skeleton said “It is submitted that the addition of a simple circle device surrounding those descriptive words does not suffice to render the words and device prima facie capable of distinguishing Canal’s goods and services from those of a third party”.

35. Mr Moody-Stuart relied upon **El Canal de Las Estrellas** [2000] RPC 291, a decision of Mr Geoffrey Hobbs QC acting as the Appointed Person. The head note, lines 30 to 50 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”.

36. Mr Moody-Stuart said that the French word CANAL in the trade mark would be well understood to mean channel. In support he used the evidence of Marie-Christine Mathieux, the French language teacher. Dr Colley submitted that Ms Mathieux was not competent to determine what the majority of the public would consider the trade mark to mean. He also pointed out that the trade mark consisted of the elliptical device which was limited to colour.

37. Having regard to the submission made and the above case it seems to me that there are

differences between the decided case and the cases before me. The former consisted of a phrase which was clearly made up of Spanish words and therefore very readily one would be able to read or translate them. In this case there is only a single word, CANAL which has a well known English meaning (a waterway). And there are two devices, a + sign and the coloured elliptical device which also appears in the trade marks. In my view, these differences mean that I can not give too much weight in the matters before me to the decided case. I must judge the matter myself. In doing so I first of all consider the goods and services upon which the trade mark is to be used. Because it is only then that the degree of descriptiveness or capacity to distinguish can be judged. In these cases there are a wide range of goods and services involved but some relate to television and electronic equipment together with services surrounding television and radio broadcasting such that the word channel could be seen as either descriptive or non distinctive. However, the word appearing in the trade mark is CANAL and it would only be after some thought, and when seen against some of the goods and services of the registrations/application that some members of the public might translate it into the word channel. But, at the same time, there is a very strong device element in the colour limited elliptical device and a significant one in the + sign. Neither can be ignored and must be considered in conjunction with the other elements. In doing so I reach the view that the trade mark in suit, as shown above, and with the colour limitations and disclaimers applied to it, is, prima facie, capable of distinguishing the goods and services of Canal from those of other undertakings. Even if the elliptical device was non distinctive (which it is not) I think that the three elements in combination are sufficient to form a distinctive trade mark as per **Diamond T** (1921) 38 RPC 373. Therefore, the request to have the existing registrations removed from the register under the provisions of Section 32 are refused and Gemstar's opposition to Canals' application for registration under Section 10 of the Act is similarly dismissed.

38. I turn to the grounds 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.

39. Gemstar rely upon the following earlier trade marks:

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)

40. 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.

41. Gemstar do have other registrations and applications incorporating the word PLUS, but they are in no better position with those marks than they are with the marks reproduced above.

42. 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 Gemstar of their PLUS trade marks in a normal and fair manner for any of the goods covered by the registrations, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their CANAL+ trade mark normally and fairly in respect of any goods or services covered by the proposed application or registrations?

43. First of all I consider the matter of the respective goods and services and apply the test laid down by Romer J in **Jellinek** [1946] 63 RPC 59 as to the:

- a. nature and composition of the goods
- b. the respective uses of the articles
- c. the trade channels through which the commodities respectively are bought and

sold.

44. Clearly there has to be some adaptation of that criteria to help consideration in the matter of a comparison between goods and services, as in this case.

45. It seems to me that Canal's Class 9 registration (B1386148) contains the same goods or goods of the same description as the Gemstar Class 9 registrations. I can also accept that Canals' services covered by the Class 38 registration (1386150) are associated with the goods covered by Gemstar's Class 9 registrations (eg the latter specification includes decoders for receiving satellite television broadcasts). But I do not consider that Canal's application for registration in Class 16 covers any goods which by any stretch of the imagination could be classed as the same or of the same description as those of Gemstar. The closest Mr Moody-Stuart got was to suggest that listing magazines might use the code used to programme video recordings through Gemstar's equipment. That is not close at all, in my view.

46. Moving onto a consideration of the marks themselves here I have regard 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 accordingly circumstances; and you must further consider what is likely to happen if each of these 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 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.”

47. Dr Colley also relied upon **Paton Calvert Cordon Bleu** Trade Mark [1996] RPC 94 to submit that Canal's and Gemstar's trade marks were visually and phonetically different. Mr Moody-Stuart submitted that the respective trade marks were 'identical or nearly resemble one another insofar as Gemstar's 'Plus' trade mark was concerned because their word was encapsulated in the + sign of Canal's trade mark.

48. As identified earlier in the decision, the evidence that each side submitted of their use of the trade marks is in my view not relevant and Counsel were right not to rely upon it. Also, the survey evidence which was put in is flawed, Dr Colley in his skeleton spelled it out as follows:

“Canal+ is justifiably extremely concerned at the way material relating to the Gemstar's survey evidence has been gathered and presented. It is material which was gathered and presented with no regard for the Registry's guidelines which are based on the criteria set out by Whitford J in the *John Player Special Case* or *Imperial Group Plc v Philip Morris Ltd* [1994] RPC 293 (“the Survey Criteria”). The Survey Criteria requirements may be summarised as that:

- (a) The interviewees are to be a representative cross-section of the relevant public.
- (b) The sample size is to be statistically significant.
- (c) The survey is to be conducted fairly.
- (d) All the interviews carried out are to be disclosed, including the number carried out, how they were conducted, and the totality of persons involved.
- (e) The totality of answers given is to be disclosed and made available.
- (f) The questions asked must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put.
- (g) The exact answers given and no some abbreviated form must be recorded.
- (h) The instructions to the interviewers as to how to conduct the survey must be disclosed.
- (i) Where the answers are coded for computer input the coding instructions must be disclosed.

Also the experience of the interviewers, the awareness of the interviewees of the reasons for the interview, and whether the survey questions are based on any false premises are relevant factors.

There is no evidence that there has been any attempt to comply with the Survey Criteria (a) to (i). It is submitted that it is clear that:-

- (1) The interviewees cannot in fact be identified as a representative sample of the relevant buying public because there are no details of the interviewees.
- (2) The sample size, (total 95 undifferentiated), are or may be statistically insignificant. (See *KENT Trade Mark* [1995] RPC 117 and *PHOENIX Trade Mark* [1985] RPC 122).
- (3) The survey invited speculation by interviewees.
- (4) There is no evidence from the interviewees themselves.
- (5) The survey was conducted in a way which is not disclosed.
- (6) The questions: ie what was asked and the order in which it was asked

prompted speculation of exactly the kind which a survey should avoid.

- (7) The survey was conducted by Ms Fawcett and two unnamed temporary employees. The evidence is silent as to their experience or inexperience in the satisfactory conduct of such surveys.

In all these circumstances Canal + submits that this survey did not comply with the guidelines was unfair and should be discounted”.

49. I agree. I only have therefore the respective trade marks, the authorities and the submissions to consider. Given my findings above that the Class 16 goods of Canal’s application for registration are not the same or of the same description as any of the goods covered by Gemstar’s registrations, I have to hold that the opposition to application No B1386149 be dismissed (whatever my view on the similarity of the trade marks). As for Canal’s registrations, the only similarity between the trade marks is the word PLUS in the Gemstar trade marks and the + sign in the Canal trade marks. This would only become apparent in oral usage of the respective trade marks. Bearing in mind the words of Farwell J in **William Bailey (Birmingham) Ld v A.C. Gilbert Co** [1935] 52 RPC 136 in which he indicated that in circumstances such as these trade marks should be considered as a whole and the comparison undertaken accordingly, it seems to me that there are significant visual differences in the trade marks. The Gemstar trade marks are word marks, Canal’s contain not only a different word but also devices which are essential features - the coloured elliptical device and the + sign. I also note that in the Canal trade marks the + sign is the second element and thus is not going to be predominant even in pronunciation, confusion is unlikely. That will be the position in my view even when the trade marks are used on the same goods. In summary and having regard to the above there will be no confusion in the minds of the public in respect of the trade marks which will lead to confusion in the goods or services. The trade marks can then remain on the register and the applications for rectification stand refused.

50. As the opposition and rectification actions have been unsuccessful Canal are entitled to a contribution toward their costs. Taking into account the fact that both sides evidence was, by and large, not germane but that three cases have been disposed of in a single hearing, I order Gemstar to pay to Canal+ the sum of £1500. This sum to be paid within seven days of the expiry of the appeal period or within seven 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**