

IN THE MATTER OF APPLICATION NOS. 2269373 AND 2269371 IN THE  
NAME OF HELEN HYDE

AND IN THE MATTER OF OPPOSITIONS NOS. 80538 AND 80538 THERETO  
BY REED MIDEM ORGANISATION SA

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DECISION

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Introduction

1. On 5 May 2001 Helen Hyde applied to register two series of trade marks. Application No. 2269373 was for the following series of four word marks: m.d.e.m./mdem/M.D.E.M/MDEM. I would observe that, since registration of a word mark covers use of that word both in upper case and lower case lettering, it is not apparent to me that the second and four marks in the series are different. The first mark differs from the third mark in the series because the first mark has a full stop after the second m whereas the third mark does not.
2. Application No. 2269371 was for the following series of two device marks:



The applicant claims the colours dark blue and gold as an element of the first mark in the series: the letters are blue while the three shapes between the letters are gold.

3. Both marks were sought to be registered in respect of the following goods and services:

Class 16: Paper, cardboard and goods made from these materials; printed matter; photographs; instructional and teaching materials; paper and documents for use at conferences; magazines; booklets; books; maps; brochures; leaflets; stationery; pens; notepaper; coasters made of paper or cardboard; folders; printed carrier bags.

Class 39: Arranging travel; hiring of transport vehicles; provision of information about accommodation, journeys, timetables, tariffs and methods of transport.

Class 41: Arranging and conducting conferences, seminars, meetings, lectures and events; organisation of exhibitions; provision of recreation services; liaising with presenters and speakers; information and consultancy relating to the aforesaid services.

Class 42: Arranging accommodation; hiring of venues for conferences, meetings, seminars, lectures; hiring and leasing of furniture, equipment and facilities for conferences and events; provision of catering services; design of conference materials, fliers and invitations; research into venues for conferences; information and consultancy services in relation to the aforesaid.

4. In due course both applications were opposed by Reed Midem Organisation SA on grounds raised under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. In support of the ground of opposition under section 5(2)(b) the opponent relied upon the following earlier registrations owned by the opponent:

Mark	Number	Effective Date	Class	Specification
MIDEM	CTM 270587	15.05.96	35	Organization of showrooms and exhibitions for commercial or advertising purposes.
			38	Communications, among other, relations with the press; telecommunications, multimedia telecommunications; telecommunications by computer terminals, by data communication channels, by radio, by telegrams, by telephone; electronic mail; computer aided transmission of messages and images; transmission of data by data communication codes; transmission of data contained in data banks; electronic mail, transmission services, displaying information from a data bank stored on computers; communication services, electronic and by computers; electronic data exchange; news and information agencies; radio broadcasting, communications by telegrams, by telephone or data communications; telex services; radio and television broadcasting; satellite transmission of sounds and images; gathering and dissemination of information, data transmission by access code.
			41	Organization of showrooms and exhibitions for cultural or educational purpose, arranging and conducting of congresses, colloquiums, seminars, symposiums, conferences, publication of books and texts (other than publicity texts).
 <p>Registration of this mark shall give no right to the exclusive use of a device of a musical note.</p>	988733	11.03.72	16	Paper, paper articles, cardboard and cardboard articles, all included in Class 16; printed matter, newspapers, periodical publications, books, photographs; instructional and teaching materials (other than apparatus).

5. Both parties filed evidence and attended a hearing. In a written decision dated 16 May 2005 (O/135/05) Mr George Salthouse acting for the Registrar upheld the opposition in relation to Application No. 2269373, but dismissed it in relation to Application No. 2269371. Both sides now appeal.

Relevant provisions of the Trade Marks Act 1994

6. Section 5 of the Trade Mark Act 1994 provides as follows:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

- (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
  - (a) by virtue of any rule of law (in particular the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade....

#### The hearing officer's decision

7. Having reviewed the parties' evidence, the hearing officer first considered the ground of opposition under section 5(2)(b). He began by directing himself in accordance with the Registrar's standard summary of the jurisprudence of the Court of Justice of the European Communities in Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4881. This summary is very well known and it is unnecessary to repeat it here.
8. The hearing officer next considered the inherent distinctiveness of the opponent's two marks. He rejected a submission by the applicant that use made of those marks by the opponent had rendered them descriptive, and held that (i) the CTM was inherently distinctive in relation to the whole of the specification and (ii) the UK mark had a high degree of inherent distinctiveness.
9. So far as acquired distinctiveness is concerned, the hearing officer held that MIDEM was famous among the UK music industry as the name of a music industry conference or festival held every January in Cannes and therefore the

CTM had acquired distinctiveness in relation to the provision of a music festival. He held that the UK had no acquired distinctiveness as it was unused.

10. The hearing officer then compared the respective specifications of goods and services. He held that: (i) the applicant's Class 16 goods were identical to those covered by the opponent's UK mark; (ii) there was a degree of similarity between the applicant's Class 39 services and those covered by the opponent's CTM and in particular its Class 41 services; (iii) some of the applicant's Class 41 services were identical to some of the opponent's Class 41 services and the balance were quite similar to the opponent's Class 35 services and some of its Class 41 services; and (iv) the applicant's 42 services were quite similar to the opponent's Class 35 services and some of its Class 41 services.
11. Next the hearing officer considered the identity of the average consumer of the applicant's goods and services, and held that the Class 16 goods and Class 39 services would be purchased by members of the general public while the Class 41 and Class 42 services were more specialised services which would be acquired by companies.
12. The hearing officer then compared the respective marks as follows:
  42. I shall first compare the applicant's mark 2269373 to the opponent's mark CTM 270587. The applicant's mark consists of a series of four, with two marks shown in both upper and lower case as follows "mdem/MDEM" and "m.d.e.m/M.D.E.M". To my mind the first set without the punctuation between the letters is very similar visually to the opponent's mark "MIDEM". Whilst a single letter difference can, on occasions, alter a mark considerably I do not believe it does so in this instance. Aurally the marks are not very similar as, contrary to the claims made by the opponent, I do not believe that the average consumer will fill in the space between the first letter "m" and the three other letters "dem". If they try to pronounce it at all I believe that it will be as "em-dem". With the punctuation marks between the letters there is far less visual similarity whilst the applicant's mark would, in my opinion, be pronounced by the average consumer as a series of four letters "em-dee-ee-em". This compares to the opponent's mark which is easily pronounced as "my-dem" or "mid-em". Neither mark has a conceptual meaning. As the applicant's mark has been applied for as a series I have to come to a consensus view, which is that the applicant's

mark 2269373 is visually and aurally similar to the opponent's mark 270587.

43. I shall now compare the applicant's mark 2269373 to the opponent's mark 988733. As stated earlier the applicant's mark consists of a series of four, with two marks shown in both upper and lower case as follows "mdem/MDEM" and "m.d.e.m/M.D.E.M". The opponent's mark is a very stylised mark with both letter "M"s being in capital letters whilst the letters "i" and "e" are lower case. Sitting in the middle of the mark is a musical note which has some visual similarity to a letter "d" and so the mark can be viewed as the word "MIDEM". I do not believe that the fact that the mark is in white letters against a black background is significant. Clearly, there is a degree of visual similarity as both marks start and end with a letter "M" and both have as their second to last letter, a letter "e". However, overall I believe that the visual differences outweigh any visual similarity. Aurally the applicant's mark will as stated earlier be pronounced "em-dem" or "em-dee-ee-em". The opponent's mark if it is pronounced will be "my-dem" or "mid-em". Neither mark has a conceptual meaning. Overall there is, in my opinion, a degree of visual and aural similarity between the applicant's mark 2269373 and the opponent's mark 988733.
44. Moving onto the applicant's mark 2269371, I shall first compare this to the opponent's CTM 270587. Visually there are minor similarities in that each mark starts and ends with a letter "M" and both contain the letters "d" and "e". Both are very short marks, and it is accepted that even minor differences can make a significant impact. In this instance the opponent's mark is a single word whereas the applicant's mark because the letters are interspersed by punctuation would be clearly seen as a series of four letters and not as a word. The use of the circle, triangle and square devices between the letters would be noticed by the average consumer as they are unusual and are not standard punctuation devices. Whilst the first part of the series has a colour claim the second part of the series is in black and white. I do not believe that the colours blue and gold are particularly significant. As stated earlier the opponent's mark would be seen as a word and pronounced "my-dem" or "mid-em" although, unless educated otherwise, the average consumer would not know what the word meant. The applicant's mark would, because of the very unusual devices between the letters, be seen as a group of four letters. In my view they would be pronounced in this manner just as the UN and the CIA are always pronounced as a series of letters even though they could be seen as single words. Although there are some visual similarities I believe these are outweighed by the visual differences and the marks are very different aurally. Neither has any conceptual meaning. In my view the applicant's mark 2269371 and the opponent's mark CTM 270587 are not similar.
45. Lastly, I compare the applicant's mark 2269371 with the opponent's mark 988733. The opponent's mark is a very stylised mark with both

letter “M”s being in capital letters whilst the letters “i” and “e” are lower case. Sitting in the middle of the mark is a musical note which has some visual similarity to a letter “d” and so the mark can be viewed as the word “MIDEM”. I do not believe that the fact that the mark is in white letters against a black background is significant. Visually both marks have the letter “m” at the start and at the end, both also have a letter “e” as the last but one letter. The opponent’s use of a musical note and the applicant’s use of very unusual punctuation creates a significant visual difference which completely outweighs any similarity. The applicant’s mark would, because of the very unusual devices between the letters, be seen as a group of four letters. In my view they would be pronounced in this manner just as the UN and the CIA are always pronounced as a series of letters even though they could be seen as single words. The opponent’s mark if it is pronounced will be “my-dem” or “mid-em”. Neither mark has a conceptual meaning. In my view the applicant’s mark 2269371 and the opponent’s mark 988733 are not similar.

13. Taking all of these factors into account, the hearing officer concluded that there was a likelihood of confusion between Application No. 2269373 and the opponent’s marks in relation to all the goods and services applied for, while there was no likelihood of confusion between Application No. 2269371 and either of the opponent’s marks in relation to any of the goods or services applied for.
14. The hearing officer then turned to consider the ground of opposition under section 5(4)(a), which he did only in relation to Application No. 2269373. He began by directing himself in accordance with *WILD CHILD Trade Mark* [1998] RPC 455.
15. Next the hearing officer considered whether the opponent had showed goodwill in either of the pleaded marks. He held that it had not done so in relation to the UK mark as there was no evidence of use. As for the CTM, he held as follows:
  54. With regard to its CTM 270587 the opponent has not filed turnover figures for the mark in the UK. The average cost per delegate to the annual conference in France was provided but it was not entirely clear to whom these fees were paid. Claims were also made about the provision of travel, accommodation and services to delegates as well as the provision of space and stands to exhibitors. These services were

offered as is clear from the programmes of previous events, but whether they are utilised by the participants is not certain. Again no specific turnover figures were provided.

55. Considered overall it seems clear that the opponent had some trade in the UK prior to the relevant date. However, the deficiencies in the evidence make it impossible to assess the extent of the opponent's goodwill in the businesses conducted under its "MIDEM" trade mark.
  56. The applicant accepted at the hearing that the mark MIDEM is known by the UK music industry as the name of a famous music conference which takes place in France. For the opponent, Mr Malynicz tried to persuade me that the opponent's reputation and its goodwill would extend to the provision of ancillary services such as travel, accommodation and business services provided to those attending the conference, and also to the services provided to those exhibiting at the conference. However, I believe that I should be slow to extend the sphere of the opponent's reputation and goodwill in the absence of clear evidence such as turnover figures. It was accepted at the hearing that the opposition under Section 5(4)(a) added only two points to the Section 5(2)(b) opposition. The first point was that the specification of the opponent would encompass all the ancillary services which it claims are provided at the festival. The second point was in relation to the colour claim of the applicant's 2269371 mark as the opponent claims to have used identical colours.
  57. I accept that this ground of opposition considers the actual use made of a mark and its reputation and goodwill. However, this requires the opponent to show that it has goodwill and reputation in such goods and services. It is not enough to rely upon reputation in one field and then seek cross over into ancillary activities. As to the question of the colour claim of the applicant I note that the opponent filed a single piece of evidence which consisted of a sample of headed notepaper which had the colours blue and orange upon it. No claims were made as to the extent of use of these colours or the date when such a colour scheme was first used. I also note that the extensive array of exhibits filed do not reflect widespread use of these colours.
16. Finally, the hearing officer held that, in view of his earlier conclusion that there was no likelihood of confusion with regard to Application No. 2269371, there would not be any misrepresentation. Accordingly he dismissed this ground of objection to that application.

### Standard of review

17. Counsel were agreed that hearing officer's decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances 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.

### Applicant's grounds of appeal

18. In summary, the applicant's main grounds of appeal are as follows:
- (1) The hearing officer was wrong to dismiss the applicant's argument that the opponent's marks were descriptive and therefore not distinctive since (a) the evidence to that effect was overwhelming, (b) the hearing officer had in part mischaracterised the applicant's argument and (c) the hearing officer had wrongly regarded it as material that *MIDEM* was not a dictionary term.
  - (2) The hearing officer had wrongly failed to consider the applicant's argument that the opponent had not produced the assignment by which it had acquired its UK mark and therefore could not rely upon this mark.
  - (3) The hearing officer had wrongly failed to take into account the applicant's unchallenged evidence as to the absence of any actual confusion between the applicant's marks and those of the opponent.

### Opponent's grounds of appeal

19. In summary, the opponent's main grounds of appeal are as follows:

*Section 5(2)(b)*

- (1) The hearing officer's decision in relation to Application No. 2259371 was inconsistent with his decision in relation to Application No. 2259373 since there was no material difference between the two series of marks.
- (2) The hearing officer had failed to consider what were the dominant and distinctive components of the applicant's marks.
- (3) The hearing officer had wrongly applied a "one meaning" rule, i.e. he had considered that there was only one way in which consumers could perceive or pronounce a mark, whereas he should have approached the matter on the basis that different consumers might perceive or pronounce the same mark in different ways.
- (4) The hearing officer had failed to apply the "interdependency" principle established by the jurisprudence of the ECJ.

*Section 5(4)(a)*

- (5) The hearing officer had failed to consider the effect of evidence which showed that the opponent had used the word MIDEM in a variety of forms.
- (6) The hearing officer was wrong to hold that the opponent's goodwill could not be assessed in the absence of turnover figures, and in particular he was wrong not to hold that the opponent had goodwill in relation to the provision of various services ancillary to the provision of a music festival.
- (7) The hearing officer had effectively imposed a requirement of a "common field of activity" which was wrong in law.

Descriptive or distinctive

20. Counsel for the applicant argued that, while the word MIDEEM would be inherently distinctive to the average consumer if unused, the opponent's use of the mark had educated the relevant consumers to understand that it described an event. In effect, he argued that MIDEEM was the name of the bundle of services provided by the opponent and thus did not function as a trade mark: cf. cases such as *Shredded Wheat Co Ltd v Kellogg Co of Great Britain* (1940) 57 RPC 137. He sought to buttress this submission by arguing that the trade mark used by the opponent in relation to the event was REED MIDEEM and that there were many third party trade marks associated with the event. He boldly invited me to apply the test proposed in my decision in *Le Mans Autoparts Ltd* (O/012/05) at [43] and ask whether, if a person unconnected with the opponent and unauthorised by it were to organise another music festival under and by reference to the name MIDEEM, would the relevant consumers think that the organiser was the same as, or at least economically linked with, the organiser of the well-known MIDEEM festival? He contended that the answer to this question was no. He argued that I could and should overturn the hearing officer's rejection of this argument for the reasons summarised above.
21. I do not accept these submissions. In my judgment all the evidence relied upon by counsel for the opponent as demonstrating that MIDEEM is descriptive shows the precise opposite. In my view the hearing officer was entirely correct to find that MIDEEM was famous amongst persons connected with the UK music industry as the name of a particular music festival organised by the opponent, and therefore distinctive at least in relation to the service of organising music festivals. MIDEEM is not the name of that service, and therefore there is no analogy between the present case and cases like *Shredded Wheat*. If the question posed in *Le Mans* is asked, I consider that the answer is clearly yes.
22. The hearing officer may have misunderstood the applicant's argument when he said in paragraph 29 of his decision that the applicant was silent as regards

the distinctiveness of the mark in relation to goods and services other than the provision of music festivals, but even if the opponent's mark had become descriptive in relation to that service, it is difficult to see that it would thereby have become descriptive of all the other goods and services in respect of which it is registered.

23. Counsel for the applicant is right that a mark may be descriptive even though it is not yet a dictionary word. I do not read the hearing officer as holding otherwise, but even if he did err in this respect, it did not affect the remainder of his reasoning in relation to this issue or undermine his conclusion.

#### Ownership of Registration No. 988733

24. By an amendment to its Statement of Grounds during the course of the proceedings, the opponent pleaded it was the registered proprietor of Registration No. 988733. In her amended Counterstatement the applicant admitted the "existence" of this registration, but not its "validity or relevance to these proceedings". Counsel for the applicant argued that this plea put title in issue; that, since the opponent had not put the assignment by which it acquired the registration in evidence, the opponent had not shown that it also acquired the goodwill in the trade mark; that this raised a prime facie case that the mark was deceptive and hence invalid; and hence the opponent could not rely upon this registration.
25. In my judgment this argument is misconceived at every stage. In my view the Counterstatement did not put title in issue. Even if it did, the opponent has been registered as the proprietor of Registration No. 988733 and Mr Rhodes of the opponent gave unchallenged evidence that the opponent was now the proprietor of that registration. Nor did the Counterstatement put validity in issue: to do so it is not enough to say that validity is not admitted, a positive case of invalidity must be pleaded. By virtue of section 72 of the 1994 Act the registration of the opponent as proprietor of Registration No. 988733 is prima facie evidence of the validity of the registration and of any subsequent assignment or other transmission of it. I am baffled as to how a mere failure by

the registered proprietor to produce an assignment could result in this presumption being overcome. I am also baffled as to how this could prevent the opponent from relying on the registration when it does not need to be the proprietor of the registration in order to do so: *BALMORAL Trade Mark* [1999] RPC297.

26. It is fair to say that, when I put these points to counsel for the applicant in the course of argument, he retreated and confined himself to arguing that, since the opponent had not produced any assignment, it could not rely upon the goodwill attaching to the mark for the purposes of its section 5(4)(a) objection. He also drew to my attention some correspondence shortly before the appeal hearing in which the opponent's trade mark attorneys stated that, contrary to what the hearing officer had apparently believed, the opponent had not become the registered proprietor as a result of an assignment, but had always been the registered proprietor and had changed its name. He pointed out that this statement had not been substantiated despite a challenge from the applicant's solicitors. I see no reason to doubt this statement, however. In any event the points I have made above still hold good.

Absence of actual confusion

27. As the hearing officer related in his decision, in her witness statement the applicant explained that she was a sole trader who provided "behind-the-scenes" event management services. From 1994 until May 2001 she had traded as "Managing Directions Event Management". In May 2001 she had abbreviated her trading name to "m.d.e.m." and started using the marks applied for. The applicant explained that her business was highly specialised and that her services and clients differed from those provided by the opponent. She stated that she had not heard of MIDEM prior to the dispute and that no actual confusion had arisen by the date of her statement (February 2004). The applicant also served supporting statements from a customer and a supplier.
28. Counsel for the applicant argued that, although this evidence post-dated the application date, it shed light backwards on the position at the application date.

He submitted that it indicated that there was no likelihood of confusion, and that the hearing officer had erred in not taking it into account.

29. The hearing officer did not deal with this argument in his decision, although it is clear that it was an important plank in the applicant's case before him. For the reasons I set out in *Professional Cycle Manufacturing Ltd's Application* (O/238/05) at [34], I consider that the hearing officer should have explained, even if briefly, why he rejected the argument as it appears he did. His failure to give any reason at all for rejecting it means that I cannot review the correctness of his reasoning. I must therefore consider the merits of the argument myself.
30. In my judgment the absence of actual confusion does not support the conclusion that there is no likelihood of confusion in relation to the goods and services specified in the applications for the simple reason that the range of services in relation to which the applicant has actually used the marks is much narrower. As explained in *Professional Cycle* at [37]-[39], since oppositions must be determined upon the hypothesis of normal and fair use of the marks applied for across the whole width of the specification, absence of actual confusion cannot be probative if the use actually made of the marks does not correspond to this hypothetical situation.
31. At my suggestion, during the hearing counsel for the applicant adopted a fall-back position, which was to argue that there would be no likelihood of confusion if the applicant's specification were tightly restricted to the services she has actually provided to date. It is clear that the hearing officer was not asked to consider this fall-back position, and therefore he cannot be criticised for not doing so. Counsel for the opponent did not raise any objection of principle to this approach, but did not accept that such a restricted specification would suffice to avoid a likelihood of confusion. It is convenient to defer expressing my conclusion on this point until after I have considered the points raised by the opponent's appeal with regard to section 5(2)(b).

### Inconsistency

32. The opponent relies upon my observations in *Mohammed S Al Ajlan Sons Co's Applications (O/074/04)* at [14] that cases which are materially alike should be treated alike and that it is an error of principle to arrive at different conclusions in respect of them. Counsel for the opponent argued that there was no material difference between the two series of marks applied for and that the hearing officer's reasoning in respect of the two applications was inconsistent.
33. It is implicit in the hearing officer's decision that the series of marks which are the subject of Application No. 2269371 are sufficiently different to the series of marks which are the subject of Application No. 2269373 to justify the conclusion that use of the former will give rise to a likelihood of confusion whereas use of the latter will not when all other circumstances are the same.
34. In my judgment this is improbable on its face given that the first series of marks includes "m.d.e.m." and the second series includes a monochrome mark in which the letters "m d e m" are separated by a circle, triangle and square positioned and sized in a manner similar to punctuation marks. In my view it is untenable given that in paragraph 44 of his decision the hearing officer analysed the second series as consisting of letters interspersed with punctuation, albeit that the devices were not standard punctuation devices, which would thus be seen and pronounced as a group of four letters; while in paragraph 42 the hearing officer held that, because the first and third marks in the first series included punctuation marks, they would be pronounced as a group of four letters. In short, I agree with the opponent that the hearing officer's reasoning is inconsistent.
35. In my judgment all six (or five) marks in the two series would be perceived by the average consumer as variations upon a single theme, namely as different presentations of the mark MDEM. Although the second series comprises two devices, the devices are merely slightly visually stylised versions of this mark, and I consider that many consumers would pronounce this series in the same

way as the first series. In my view this analysis is supported by the applicant's evidence as to the manner in which she has used the marks applied for.

36. I would add that I consider that the hearing officer was right to conclude in paragraph 42 that at least some consumers would be likely to pronounce the applicant's marks as "em-dem", since "em-dee-ee-em" is rather a mouthful (compare, say, OHIM which is usually said as "oh-him"). I do not believe that the appearance of punctuation would alter this (although it might affect the proportions of consumers who pronounced the marks in the two ways), or that it would not happen with the second series.

#### Distinctive and dominant components

37. Counsel for the opponent argued that the marks applied for, or at least some of them, were composite marks; that the hearing officer had failed to assess what the distinctive and dominant components of those marks were; and that, had he done so, he ought to have concluded the overall impression of the marks was dominated by the letters MDEM. In support of this argument he relied upon the decision of the Court of First Instance in Case T-6/01 *Matratzen Concord GmbH v OHIM* [2002] ECR II-4335 and the reasoned order of the ECJ in Case C-3/03P *Matratzen Concord GmbH v OHIM* (28 April 2004).
38. I do not agree that the hearing officer failed to assess the distinctive and dominant components of the marks. In my view he did just that. In any event, I consider that this argument adds little to the opponent's first argument.

#### One meaning

39. Counsel for the opponent argued that, in assessing the applicant's marks, the hearing officer had applied a one meaning rule akin to that applied in cases of libel and malicious falsehood (see e.g. *Vodafone Group plc v Orange Personal Communications Services Ltd* [1997] FSR 34). I do not agree that the hearing officer applied a one meaning rule. Indeed, in his assessment of the opponent's

marks he plainly did not. In any event, I consider that this argument adds little to the opponent's first argument.

#### Interdependency

40. Counsel for the opponent argued that the hearing officer failed to apply the interdependency principle since he had failed to give the opponent's marks the wider penumbra of protection they warranted due to their reputation. I do not accept this. In paragraph 46 of his decision the hearing officer stated that he was taking into account all of the factors set out previously, which included the reputation of the opponent's marks he had found established, and I believe he did so.

#### Assessment with respect to section 5(2)(b)

41. Since I have accepted the opponent's first ground of appeal, and since the hearing officer was not asked to consider the applicant's fall-back position, I must make my own assessment of the section 5(2)(b) objection. In my judgment the hearing officer came to the right conclusion with regard to Application No. 2269373 as it stands for essentially the right reasons. For the reasons given above, I consider that he should have reached the same conclusion in relation to Application No. 2269371 as it stands.
42. Turning to the applicant's fall-back position, it seems to me that the following specification of services covers the services that the applicant actually provides:

Class 39: Provision of logistical advice concerning conferences and similar events to corporate clients; hiring of transport for conferences and similar events on behalf of corporate clients.

Class 41: Provision of behind-the-scenes event management services for conferences and similar events to corporate clients.

Class 42: Carrying out research into venues for conferences and similar events for corporate clients; hiring of venues, caterers, entertainers and other suppliers for conferences and similar events on behalf of corporate clients.

43. In my judgment the absence of actual confusion in relation to these services is not conclusive of the absence of a likelihood of confusion, but it is a relevant consideration to take into account.
44. More importantly, it seems to me that the services provided by the opponent are different to those covered by the opponent's CTM. As the hearing officer rightly noted, Jacob J stated in *Avnet Inc v Isoact Ltd* [1998] that specifications of services should be interpreted as being confined to the core of the possible meanings of the terms used. The opponent's closest services are those in Class 35 and Class 41, and in essence these cover arranging and conducting conferences and the like. Thus in principle the opponent could be a customer for the applicant's services. By contrast the opponent's customers are those who attend its conferences etc. Moreover, the opponent's reputation is in a narrower field still, namely those connected with the UK music industry.
45. Another relevant factor is the identities of the average consumers of the respective services. The consumers of the applicant's services are the appropriate employees of companies on whose behalf the applicant provides its services: training managers, procurement directors, HR managers, facilities managers and the like. These are knowledgeable persons acquiring very specialised services. Moreover, it is clear from the applicant's evidence that this is field in which personal contacts are very important. The consumers of the opponent's services are the appropriate employees of its customers: marketing directors, sales directors and the like. In the case of the opponent's services these will be people employed by companies connected with the UK music industry. Again these are knowledgeable persons acquiring specialised services.
46. Looking at the matter in the round, it is my judgment that the use of the applicant's marks in relation to the services set out in paragraph 42 above will not give rise to a likelihood of confusion.

#### Section 5(4)(a)

47. In my judgment the objection under section 5(4)(a) adds nothing to the opponent's case. Counsel for the opponent argued that it did for two main reasons.
48. First, he argued that the opponent had used the mark MIDEM in a variety of stylised representations, but that the opponent's CTM only covered use of the mark in upper and lower case in ordinary fonts. I do not accept this: see by analogy my judgment in *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] RPC 28 at [134]-[150]. I cannot imagine that the opponent would accept such a restricted interpretation of its rights if it were suing for infringement.
49. Secondly, he argued that the evidence showed use of the mark in relation to various ancillary services not covered by the CTM. As noted above, he criticised the hearing officer for holding that the absence of turnover figures meant that it was impossible to assess the extent of the opponent's goodwill and for applying a common field of activity test. In my judgment the hearing officer did not apply a common field of activity test. As for the assessment of goodwill, the hearing officer may have gone too far in saying that the mere absence of turnover figures made it impossible to assess the extent of goodwill; but I think that the hearing officer was justified in saying that the opponent's evidence was not sufficiently comprehensive and detailed to give a clear picture of the opponent's goodwill in the ancillary services.

#### Conclusion

50. The applicant's appeal in relation to Application No. 2269373 is allowed to the extent that the application will be allowed in relation to the services set out in paragraph 42 above. The opponent's appeal in relation to Application No. 2269371 is allowed to the extent that the application will be refused save in relation to the services set out in paragraph 42 above. Otherwise both appeals will be dismissed.

Costs

51. I was asked to defer my decision on costs until after my substantive decision on the basis that there had been without prejudice save as to costs correspondence which might have a bearing on that matter. Accordingly I will entertain written submissions on costs provided that they are received within 14 day of the date of this decision.

14 November 2005

RICHARD ARNOLD QC

Mark Engelman, instructed by Be, appeared for the applicant.

Simon Malynicz, instructed by Fry Heath Spence, appeared for the opponent.