

**O-329-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 3084008 IN THE NAME OF  
STARVERSE MEDIA LTD IN RESPECT OF THE TRADE MARK**



**IN CLASSES 9, 35, 38, 41, 42 AND 45**

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 501110 BY STAR TELEVISION PRODUCTIONS LTD**

## Background and pleadings

1) Starverse Media Ltd is the proprietor of the following mark that is registered in respect of the following list of goods and services:



**Class 9:** *Application programming interface for computer software that enables online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; computer software and telecommunications apparatus to enable connection to databases and the internet; computer software for application and database integration; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; data storage media; digital recording media; electronic publications recorded on computer media; interactive entertainment software for use with computers.*

**Class 35:** *Marketing, advertising and promotional services; online advertising on a computer network; organisation, operation and supervision of sales and promotional incentive schemes; presentation of goods on media for retail purposes; promoting the goods and services of third parties via computer and communication networks; providing an online facility for the exchange and sale of services and products of third parties via computer and communication networks; administration relating to sales methods; advertising and business services; advertising services; charitable services, namely promoting the awareness of charitable and philanthropic activities; compilation of information into computer databases; dissemination of advertising for others via the*

*internet; online advertising operating as and online and mobile platform featuring a variety of consumer goods and choices including but not limited to entertainment products, sports packages, event tickets and associated goods and services thereto; online promotion of artists, athletes and celebrities, iconic and other personalities; online retail store services connected with the sale of games, sports goods, clothing, sports wear, sports equipment, bags, belts, hats, stickers, badges, magazines, news, sports drinks, bedding; organisation of exhibitions for commercial or advertising purposes; organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; organization of exhibitions for commercial or advertising purposes; pay per click advertising; presentation of goods on communication media for retail purposes; promoting the goods and services of others by arranging for businesses to affiliate their goods and services with the goods and services of third parties by means of sponsorship relationships; provision of advertising space; sales promotion for others; subscriptions (arranging -) to a telematics, telephone or computer service [internet]; information, advisory and consultancy services relating to the aforesaid.*

**Class 38:** *Broadcasting of video and audio programming over the internet; broadcasting services; delivery of messages by audiovisual media; delivery of messages by electronic media; electronic communication services; interactive broadcasting; podcasting services; providing access to computer databases in relation to a social network, social integration and meetings; providing online and telecommunication services for interaction between users of computers, mobile and handheld devices and wired and wireless communication devices; providing online chat rooms and electronic bulletin boards; providing online communications links that transfer website users to other local and global web pages; providing online forums for communication on topics of general interest; telecommunication services enabling individuals to send, receive and share messages via email, instant messaging or a website on the internet; telecommunications services; transmission of messages including messages in the nature of comments, information, multimedia content, photos, audio, videos, movies, films, animation, pictures, images by electronic mail, instant*

*messaging, text messaging and via a global computer network and other computer and communications networks; webcasting services; wireless digital messaging services ; information, advisory and consultancy services relating to the aforesaid.*

**Class 41:** *Arranging for the sale of admission vouchers for events via a website and/or wireless device; entertainment; fan club organisation; fan club services; fan clubs; gaming; interactive entertainment services; live entertainment, live entertainment services; production of live entertainment; provision of live entertainment; music entertainment, film entertainment, concerts, road shows, light entertainment; organisation of a sporting event; organisation of conferences or exhibitions; organisation of events for cultural, entertainment and sporting purposes; preparation of entertainment programmes for broadcasting; production of audio tapes for entertainment purposes; production of live entertainment features; production of live-action, sporting and cultural events, educational sports programmes; provision of entertainment services and information relating to entertainment packages and event tickets via a searchable database; provision of ratings and recommendations in the field of sport activities via a website; event ticket booking services; provision of entertainment services and information via computer, electronic and online databases in the field of entertainment; providing news about current events and sporting activities via a global network; providing on-line electronic publications; provision of betting or gambling services on an online platform; ticket procurement services for entertainment events; ticket reservation and booking services for entertainment, sporting and cultural events; ticket services for entertainment, sporting and cultural events; information, advisory and consultancy services relating to the aforesaid.*

**Class 42:** *Computer services, namely, providing an interactive web site featuring technology that allows users to consolidate and manage social networks, accounts, and connections to existing and emerging application programming interfaces (apis); hosting an online website and applications for handheld devices for users to interact, communicate, publish and share*

*information, photos, audio and video content in any genre including sport, music, film, business; operating a website enabling users to create a personal or business webpage; information, advisory and consultancy services relating to the aforesaid.*

**Class 45:** *Providing a website on the internet for the purpose of social networking; information, advisory and consultancy services relating to the aforesaid.*

2) This registration was applied for on 1 December 2014. On 26 January 2016, Star Television Productions Ltd (“the applicant”) applied for the registration to be declared invalid. The following grounds are pleaded based upon section 47 of the Trade Marks Act 1994 (“the Act”), namely:

- The registration offends under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) because when compared with the applicant’s earlier mark, the registration relates to a mark that is conceptually identical and visually and aurally similar and the respective goods and services are either identical or similar. It is claimed that, as a result, there is a likelihood of confusion. The relevant details of this earlier mark are:

Mark and relevant dates	Goods and services
<p>25443676</p> 	<p><b>Class 9:</b> <i>Electric, electronic, facsimile, telex, telephone, telegram, data acquisition installations, apparatus and instruments, all for processing, logging, storing, transmission, display, reception, input, output or print-out of non-pictorial or graphical data; computers, computer terminals, computer keyboards and printers for use therewith; computer software; computer programs; computer memories; computer interfaces; microprocessors; modems; digital optical transmission apparatus and instruments; videos, CD-ROMs; parts and fittings for all the aforesaid goods.</i></p> <p><b>Class 16:</b> <i>Paper and paper articles, cardboard and cardboard articles; printed matter, newspapers and periodicals, books and magazines relating to television, entertainment, operation of satellite television and computer; stationery; photographs; card indexes, index cards, record cards, transfers (decalcomania); paper for computers; gift certificates; printed forms; binders; writing pens; labels; tags; cards; computer manuals; television program guides; ribbons for computer printers; computer programs in printed forms; instructional and teaching material (other than apparatus); typewriters and office requisites (except furniture).</i></p>



**StarPlus**

(Series of 2)

Filing date: 1 April 2010

Registration date: 27 January  
2012

**Class 38:** *Television and radio broadcasting services; digital television services; providing access to computer databases and the Internet; provision of telecommunications access and links to computer databases and the Internet; diffusion of television programmes; operation of earth-to-satellite television transmitters for transmission of signals to satellite; relaying of television programmes by satellite; operation of satellite-to-earth receiver aerials; frequency conversion of microwave signals relayed by satellite; dissemination of television programmes relayed by satellite receiver aerials by cable or by microwave link to television receivers of users; operation of television cable networks; provision and operation of radio, telephone, telegraph, satellite and of cable network communications systems; videotext and teletext transmission services; electronic and telecommunication transmission services; transmission of data and of information by electronic, computer, cable, radio, radiopaging, teleprinter, teletext, electronic mail, fax machine, television, microwave, laser beam, communications satellite or other communications means; provision of communication facilities for the interchange of data by electronic means; consultancy services relating to data communications; professional consultancy services relating to telecommunications; rental of communication apparatus; time sharing services for communications apparatus; and all the above also provided on-line from a computer database or the Internet; provision of information, consultancy services and advisory services relating to all the aforesaid services.*

**Class 41:** *Education and entertainment services in the nature of planning, production and distribution of live or recorded audio, visual or audiovisual material for broadcasting by radio and television or through film or videotape; entertainment services provided by means of the Internet; planning, production and distribution of television programs and films; news reporting; news reporters services; publication of books and printed matter relating to films, videotapes, radio and television; news publication; rental of sound recordings, films, film projectors, videotapes, video cassette recorders, radios and television sets and accessories therefor; providing cinema and theatre facilities; education and entertainment information services; presentation of live performances; organisation of education or entertainment competitions; entertainment including electronic and digital interactive media.*

**Class 42:** *Leasing access time to computer databases and the Internet; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; information relating to geophysical measurement, information technology, legal matters and legal services, industrial manufacturing standards, application of computer networks and computer systems, time, all provided on-line from a computer database or from the Internet; technical research; testing of computing, telecommunication, electrical and electronic apparatus and instruments; computer programming, software design and development; professional consultancy services relating to computer apparatus and instruments, computer networks, software and information systems; rental of computers, computer software, electrical and electronic apparatus and instruments relating to computing; updating computer software;*

	<i>provision of information, consultancy services and advisory services relating to all the aforesaid services.</i>
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- This registration date of the earlier mark, being the 27 January 2012, is less than five years before the application for invalidation was made. The significance of this is that the proof of use provisions set out in section 47(2) and section 47(2A) do not apply to the earlier mark and the applicant is entitled to rely upon the complete list of goods and services.
- The registration offends under section 5(4)(a) of the Act. The applicant claims goodwill throughout the UK since 2001 in respect of entertainment, production of television shows, provision of live entertainment (such as sport), social media platforms such a *Facebook* and *Twitter*, provision of advertising for third parties and sponsorship. It claims that this goodwill is identified by the following signs:



The applicant is a subsidiary of Star Group Limited that operates in the UK providing various branded channels that are aired on *Sky* and *Virgin Media* and used on social media websites such as *Facebook* and *Twitter*. The applicant uses its marks in the colour red and has a significant reputation and goodwill in the UK. Further, it is clear that the parties are in the same business sector. It is, therefore, submitted that use of the proprietor's mark will lead to misrepresentation and damage.

3) The proprietor filed a counterstatement denying the claims made and claiming that the word "star" is widely understood in the UK as meaning a famous person and pertaining to entertainment.

4) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. Both sides also filed written submissions that I will not summarise, but I will keep in mind. No hearing was requested and so this decision is taken following careful consideration of the papers.

### **Applicant's Evidence**

5) This takes the form of a witness statement by David James Ward, director of Star Advertising Sales Limited and deputy general counsel, Europe & Asia for 21<sup>st</sup> Century Fox Europe & Asia Inc. (both companies are wholly owned subsidiaries of Twenty First Century Fox, Inc., as is the applicant in these proceedings). Mr Ward is authorised by the applicant to make the witness statement on its behalf;

6) Mr Ward provides the following information:

- The applicant owns many "Star" branded television channels including "*StarPlus*" and "*StarPlus HD*";
- STAR is an acronym for Satellite Television Asian Region;
- In the UK, all these channels are aimed at the Asian market;
- The applicant sells advertising space on the Star branded channels in the UK;

- In the UK, the applicant’s “Star” channels are broadcast on platforms provided by *Talk Talk Telecom*, *Sky* and *Virgin Media* and are received by over 10 million viewers in the UK and Ireland;
- The “Star” channels website <http://uk.startv.com>;
- The *StarPlus* channel was launched in the UK on 21 February 1992 and the *StarPlus HD* channel was launched in the UK on 5 July 2012;
- both have been continuously broadcast since then and are available via cable by *Virgin Media*, satellite by *Sky Television* and Internet protocol television by *TalkTalk*. Exhibit JW4 includes an extract, dated 9 May 2012 from the *bizAs10* website (describing itself as “the UK’s only Asian media site”) announcing the launch of *StarPlusHD*;
- Also at Exhibit JW4 is an extract from *The Weekly Tribune*, 2<sup>nd</sup> – 8<sup>th</sup> March 2015, announcing that *StarPlus* is “officially UK’s No.1 Asian TV Channel” and shows the applicants Star device and *StarPlus* mark. Exhibit JW6 consists of historical extracts from the *Biz Asia UK* website obtained from the *Wayback Machine* Internet archive showing that for the weeks ending 17 June 2012, 20 October 2013 and 18 November, the *StarPlus* channel was the most viewed Asian channel in the UK;
- Variant uses of the applicant’s mark are shown at Exhibit JW5, and appearing in TV guides for *Virgin Media* and *Sky* and showing the words *StarPlus* appearing alongside the device rather than below it;
- Sales and marketing costs are disclosed and range from nearly £600,000 in 2011 to over £1 million in 2015;

### **Proprietor’s Evidence**

6) This takes the form of a witness statement by Laura O’Connor, Head of Global Strategy and Head of Strategy & Legal of the proprietor. Ms O’Connor provides a chronology of the dispute between the parties, but it is not necessary to detail this here.

7) Ms O’Connor states that the word “star” is descriptive and refers to numerous dictionary definitions contained in the proprietor’s counterstatement that illustrate that

it has a number of meanings including “a famous entertainer” or “a leading actress or actress or other well-known performer”. It is further stated that the word “star” is used in honest and commercial practices of trade, especially related to the entertainment sector. Examples of the word being used in this way from British news sources is provided at Attachment 7.

8) Ms O’Connor states that the applicant’s StarPlus *Facebook* page identifies that its origin is India and that it is India’s leading Hindi entertainment station. Further, she states that its *Twitter* account indicates a location in India. Ms O’Connor refers to extracts from these pages provided at Attachments 1 and 2 of the counterstatement.

9) Ms O’Connor makes numerous references to the requirements of filing and registering a mark before the EUIPO (formerly the “OHIM”), however, these have no relevance in these proceedings, not least because the earlier mark relied upon by the applicant is a national UK mark.

### **Applicant’s Evidence-in-reply**

10) This consists of written submissions from the applicant’s representative, Lewis Silkin LLP that I will not detail here, but I will keep in mind when reaching my decision.

### **Additional applicant’s evidence**

11) This consists of the statutory declaration of Kate E Bright, director of the applicant. This evidence was filed as a result of a late request accepted by the Registry to add a further three signs relied upon for the purposes of section 5(4)(a) so that a representative collection of the full family of marks, relied upon, were in play in these proceedings. Exhibits demonstrate use of these additional marks is also provided. For reasons of procedural economy, it is not necessary that I detail this evidence further.

## DECISION

### Legislation

12) Section 5 of the Act has application in invalidation proceedings because of the provisions set out in Section 47. The relevant legislation is set out below:

47. - (1) [...]

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

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

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

(4) [...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.

13) Sections 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

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

### **Comparison of goods and services**

14) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

15) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

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

16) I also keep in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market (MERIC)*, Case T-133/05:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

## **Class 9**

17) The applicant’s specification includes the term *electric, electronic, ... installations, apparatus and instruments, all for processing, logging, storing, transmission, display, reception, input, output or print-out of non-pictorial or graphical data*. Keeping in mind the guidance of the GC in *MERIC*, the following of the proprietor’s goods are covered by the term and they are, therefore, identical:

*telecommunications apparatus to enable connection to databases and the internet; data storage media*

18) In respect of the proprietor's *application programming interface for computer software that enables online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management*, these are covered by the applicant's term *computer interfaces* and following the guidance in *MERIC*, the respective goods are identical.

19) The proprietor's *computer software ... to enable connection to databases and the internet; computer software for application and database integration; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks;... interactive entertainment software for use with computers* are all covered by the applicant's *computer software* and *computer programs* and are, therefore, identical.

20) There is no equivalent in the applicant's specifications to the proprietor's *digital recording media* and the applicant makes no submissions regarding this term. However, it may be argued that the applicant's *electric, electronic .... apparatus ... for storing ... of non-pictorial data* includes these goods. If not, apparatus for storing non-pictorial data still describes goods that include those with the same purpose as the proprietor's goods, namely to store data. Consequently, their methods of use may be similar, they may share trade channels and may be in competition. Therefore, I conclude that the respective terms share at least a medium level of similarity.

21) Finally, in respect of the proprietor's *electronic publications recorded on computer media* these are highly similar to the paper publications included in the applicant's Class 16 specification, namely *printed matter, newspapers and periodicals, books and magazines relating to television, entertainment, operation of satellite television and computer*. These goods share the same intended purpose

and are likely to share trade channels and also be in direct competition to each other.

### **Class 35**

22) The applicant's earlier mark does not include any Class 35 services. In its written submissions the applicant identifies services for which its mark is used, but this is irrelevant for the purposes of its grounds based upon section 5(2)(b) of the Act because the comparison is between the goods and services covered by the scope of its earlier mark and those listed in the challenged registration. It makes no further submissions in respect to the proprietor's Class 35 specification. Further, it is not obvious to me that there is any similarity between the respective goods and services. In light of all of this, I conclude that the respective goods and services are not similar.

### **Class 38**

23) In its written submissions, the applicant claims that the proprietor's *broadcasting of video and audio programming over the internet* and *electronic communication services* are identical to its own *television and radio broadcasting services*. I agree, but even if a distinction can be drawn between traditional television and radio broadcasting and broadcasting over the Internet, it is a very small distinction with the nature, method of use and intended purpose all being identical. The respective services will also be in direct competition. If a distinction exists, there remains a very high level of similarity. This finding would also extend to the proprietor's *broadcasting services, interactive broadcasting* and *webcasting services*. The applicant also relies upon its *television and radio broadcasting services; digital television services* submitting that the proprietor's *broadcasting services* are identical. I agree.

24) The applicant submits that the following of the proprietor's services are identical to the services of the applicant identified below:

Applicant's services	Proprietor's services
<p><i>providing access to computer databases and the Internet.</i></p>	<p><i>providing access to computer databases in relation to a social network, social integration and meetings; providing online and telecommunication services for interaction between users of computers, mobile and handheld devices and wired and wireless communication devices;... telecommunication services enabling individuals to send, receive and share messages via email, instant messaging or a website on the internet and providing online communications links that transfer website users to other local and global web pages</i></p>

:

25) Once again, I agree that all of these services overlap or are covered by the proprietor's terms. I find that they are identical.

26) In respect of the proprietor's *providing access to computer databases in relation to a social network, social integration and meetings; providing online and telecommunication services for interaction between users of computers, mobile and handheld devices and wired and wireless communication devices;... telecommunication services enabling individuals to send, receive and share messages via email, instant messaging or a website on the internet and providing online communications links that transfer website users to other local and global web pages*, the applicant submits that they are all identical to its *providing access to computer databases and the Internet*. I agree. The proprietor's terms are all contained within the broader terms of the applicant's specification and are therefore, identical.

27) As submitted by the applicant, the proprietor's *delivery of messages by audiovisual media; delivery of messages by electronic media; interactive*

*broadcasting; podcasting services; providing online chat rooms and electronic bulletin boards; ...providing online forums for communication on topics of general interest;...; telecommunications services; transmission of messages including messages in the nature of comments, information, multimedia content, photos, audio, videos, movies, films, animation, pictures, images by electronic mail, instant messaging, text messaging and via a global computer network and other computer and communications networks; webcasting services; wireless digital messaging services are all identical to its electronic and telecommunication transmission services; transmission of data and of information by electronic, computer, cable, radio, radiopaging, teleprinter, teletype, electronic mail, fax machine, television, microwave, laser beam, communications satellite or other communications means; provision of communication facilities for the interchange of data by electronic means.* The proprietor's services are all contained within the applicant's broad terms, and applying the guidance in *MERIC*, are identical;

28) The proprietor's *information, advisory and consultancy services relating to the aforesaid* are self-evidently identical to the corresponding terms in the proprietor's specification.

#### **Class 41**

29) The applicant submits that the proprietor's *gaming; ... production of live entertainment; provision of live entertainment; music entertainment, film entertainment, concerts, road shows, light entertainment; organisation of a sporting event; interactive entertainment services; live entertainment, live entertainment services; provision of betting or gambling services on an online platform; ...; production of live entertainment [features]; provision of entertainment services and information relating to entertainment packages and event tickets via a searchable database; provision of entertainment services and information via computer, electronic and online databases in the field of entertainment* are identical to its *entertainment services in the nature of planning, production and distribution of live or recorded audio, visual or audiovisual material for broadcasting by radio and television or through film or videotape; entertainment services provided by means of the Internet; planning, production and distribution of television programs and films*

and *presentation of live performances; organisation of ... entertainment competitions; entertainment including electronic and digital interactive media*. I agree that all of these terms are covered by, or overlap with the terms identified by the applicant.

30) The applicant submits that the proprietor's term *production of live entertainment* is identical to its services. The actual term in the proprietor's specification is *production of live entertainment features*. Whilst this is not precisely the term identified by the proprietor, it is my view that the difference is such as to not materially change my conclusion. *Production of live entertainment features* is still covered by the proprietor's *entertainment services in the nature of ... production ... of live ... audio, visual or audiovisual material for broadcasting by radio and television or through film or videotape*. I find that these respective services are identical.

31) The applicant submits that the proprietor's *providing news about current events and sporting activities via a global network* is identical to its *news reporting; news reporters services*. Once again, I agree. The respective services are self-evidently identical.

32) The applicant submits that the proprietor's *providing on-line electronic publications* is identical to its *publication of books and printed matter relating to films, videotapes, radio and television*. My view is that these are not identical because the proprietor's services are online services, whereas the applicant's services relate to the publication of physical copies. Nevertheless, there is a high level of similarity because the intended purpose and method of use is identical or highly similar even though their nature is different. They will also have the same intended market and be in competition with each other.

33) In respect of the proprietor's *arranging for the sale of admission vouchers for events via a website and/or wireless device; ... event ticket booking services; ... ticket procurement services for entertainment events; ticket reservation and booking services for entertainment, sporting and cultural events; ticket services for entertainment, sporting and cultural events*, the applicant submits that these are

identical to its *providing cinema and theatre facilities and organisation of education or entertainment competitions*. There is an argument that the proprietor's services are covered by the applicant's terms, but on an ordinary and natural understanding of the applicant's terms, this is not obviously so. However, the various voucher and ticket services of the applicant are closely associated services to those of the proprietor with them sharing trade channels and the proprietor's services being complementary to those of the applicant, because "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking" (*Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06). I conclude that the respective services share a medium level of similarity.

34) The applicant also makes the submission that the proprietor's *fan club organisation; fan club services; fan clubs;...; educational sports programmes; ...; provision of ratings and recommendations in the field of sport activities via a website; ... information, advisory and consultancy services relating to the aforesaid* are similar to its own services, but does not provide any further detail. It is not obvious to me that these services are similar to any of the applicant's services and, therefore, in the absence of any explanation from the applicant, I conclude that there is no similarity. This finding relates to *information, advisory and consultancy services relating to the aforesaid* only insofar as they relate to the other services identified in this paragraph.

35) The following of the proprietor's services are not referred to by the applicant in its written submissions but there is a general claim in its statement of case that all of the proprietor's goods and services are identical or similar to its own:

*entertainment...organisation of conferences or exhibitions; organisation of events for cultural, entertainment and sporting purposes; preparation of entertainment programmes for broadcasting; production of audio tapes for entertainment purposes; ...; production of live-action, sporting and cultural events; sporting and cultural events*

36) I comment on each briefly:

- *Entertainment*: This term is self-evidently identical to the applicant's *entertainment services in the nature of planning, production and distribution of live or recorded audio, visual or audio visual material for broadcasting by radio and television or through film or videotape; entertainment services provided by means of the Internet* because these are a subset of the applicant's broad term;
- *organisation of conferences or exhibitions; organisation of events for cultural, entertainment and sporting purposes*: these services are not covered by the applicant's terms, but it's *presentation of live performances; organisation of education or entertainment competitions* describes very similar services. The respective services both involve organisation of events, albeit different events, and are, therefore, similar in nature, method of use and may be provided by the same type of undertakings and therefore it is likely that there may be overlap of trade channels.
- *preparation of entertainment programmes for broadcasting*: this term includes services that clearly overlap with the applicant's *entertainment services in the nature of planning, production and distribution of live or recorded audio, visual or audiovisual material for broadcasting by radio and television or through film or videotape*. I conclude that they are identical.
- *production of audio tapes for entertainment purposes and production of live-action, sporting and cultural events*: these terms clearly overlap with the applicant's "*production ... of live or recorded audio, visual or audiovisual material...*". They are identical.
- *sporting and cultural events*: These overlap with the applicant's *education and entertainment services in the nature of planning, production and distribution of live or recorded audio, visual or audiovisual material for broadcasting by radio and television or through film or videotape; entertainment services provided by means of the Internet and presentation of live performances; organisation of education or entertainment competitions; entertainment including electronic and digital interactive media*. The respective goods are identical.

37) Finally, in respect of *information, advisory and consultancy services relating to the aforesaid*, where these services do not relate to the services identified in paragraph 34, above, they are complementary to all the other services listed in the proprietor's Class 41 specification and the consumer will expect that there is some overlap of trade channels. I find that there is at least a medium level of similarity.

## **Class 42**

38) The applicant submits that the proprietor's *computer services, namely, providing an interactive web site featuring technology that allows users to consolidate and manage social networks, accounts, and connections to existing and emerging application programming interfaces (apis); hosting an online website and applications for handheld devices for users to interact, communicate, publish and share information, photos, audio and video content in any genre including sport, music, film, business; operating a website enabling users to create a personal or business webpage* are identical to its *computer programming, software design and development; professional consultancy services relating to computer apparatus and instruments, computer networks, software and information systems; rental of computers, computer software, electrical and electronic apparatus and instruments relating to computing*. I do not agree that they are identical. The proprietor's services can be characterised as providing a website and a software application to facilitate social networking. Such services are not covered by the programming and consultancy services of the applicant. The former is providing a platform for users to undertake social networking whereas the latter is providing programming and consultancy services. The applicant's consultancy services relating to computer networks includes computer networks in the form of social networks on computers, consequently, there is some similarity, but this is only at a medium level.

39) The applicant also submits that the proprietor's *information, advisory and consultancy services relating to the aforesaid* [being all the services listed in the proprietor's Class 42 specification] is identical to its *provision of information, consultancy services and advisory services relating to all the aforesaid services* [being all the services listed in the applicant's Class 42 specification]. It is self-evident from my findings above that these terms do not cover identical services,

however, consistent with my findings above, there is some similarity that I would describe as being at a medium level.

### **Class 45**

40) The applicant makes no submissions regarding similarity of the proprietor's services to its goods and services. In the absence of this and the fact that I see no obvious similarity with any of the applicant's services, I conclude that there is no similarity.

### **Comparison of marks**

41) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

42) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

43) The applicant's earlier marks consist of a series of two marks. It is my view that reliance upon either one of these marks will not materially improve the applicant's

case compared to reliance upon the other. Therefore, for procedural economy I will restrict my considerations to similarity of the proprietor's mark with the first mark in the applicant's series of marks. The respective marks are shown below:

Applicant's earlier mark	Proprietor's mark
	

44) The proprietor's mark consists of the device of a star placed centrally within the mark. The conjoined words STAR and VERSE appear directly below this device and are both placed upon a red coloured background. Whilst none of these elements are negligible and all contribute to the distinctive character of the mark, the device and words are equally dominant. The applicant's marks also contain a device of a star and the conjoined words "Star" and "Plus" in similar position and proportions as in the proprietor's mark. It follows that these elements are also equally dominant within the mark.

45) Visually, the marks are similar in that they both contain the device of a five fingered star below which appears two conjoined words, the first of which is "Star". However, there are also differences in that the second word in each mark is different, being VERSE and "Plus" respectively. Further, in the proprietor's mark the star device is made up of an arrow device forming three of the star's fingers with the two additional fingers added to the sides of the arrow to create the impression of a star. The star device in the applicant's mark is presented in a conventional manner but is shaded to create the impression that part of it is reflecting a bright light. Finally, the background colour of the proprietor's mark is red and the applicant's mark is

presented in black and white. Taking all of this into account, I conclude that the respective marks share a reasonably high level of visual similarity.

46) Aurally, only the word elements of the respective marks are likely to be referred to. The proprietor's mark will be referred to as STAR VERSE whereas the applicant's mark will be referred to as STAR PLUS. Clearly, there is similarity in that they share the same first word, but they differ in that the second word is different. Taking this into account, I conclude that the respective marks share a medium level of aural similarity.

47) Conceptually, both marks share similarity because of the presence of the word STAR in both marks and because this concept is reinforced in both because of the presence of a star device. The proprietor provides evidence that the word "star" has a number of meanings, one of which is as "a well known entertainer, actor or actress". I accept that this is one of the meanings, but in the context of both marks, where the word element appears in conjunction with devices of a star, the overriding impression created in the mind of the average consumer is likely to be that of a celestial body. There is a difference between the marks because the second part of the respective word elements are different being "Plus" in the applicant's mark and "VERSE" in the proprietor's mark. These have well known but different dictionary meanings. When factoring all of these points together, I conclude that the respective marks share a moderately high level of conceptual similarity.

### **Average consumer and the purchasing act**

48) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

49) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

50) The proprietor submits that there is no overlap of consumers between its services and the services provided by the proprietor. It further submits that the purchasing process is also different, with consumers of the applicants channel accessing it through payment to a television package provider such as Sky. It submits that, on the other hand, its services requires no card or set-top box and that the consumer has a billing connection with the proprietor. For the purposes of grounds based upon section 5(2)(b) of the Act, I must consider the respective lists of goods and services as set out in the registration and the earlier mark without reference to how the marks are actually used in the market place. The limitations as to the use made of the mark by the proprietor are not reflected in its specifications of goods and services. Therefore, I dismiss this approach.

51) The parties' goods and services are wide ranging and include, at one end of the spectrum, everyday purchases such as magazines, television programme guides, retail services, entertainment services provided by means of the Internet and gaming. The purchase of such goods and services are generally made by ordinary members of the public. The level of care and attention paid during the purchasing process is likely to be average, neither high nor low. Other goods and services, such as operation of earth-to-satellite receiver aerials are more specialised and likely to be accessed through business to business transactions. Access to such services is, therefore, likely to involve a higher than normal level of care and attention, but still not the highest. In between these examples fall the majority of the parties' goods and services that can be very broadly categorised as computer goods and computer services, business services, telecommunication services and broadcasting. Here the

level of care and attention is likely to be higher than in respect of everyday goods and services, but not the highest level. The average consumers for these goods and services varies and may, in some cases, be the general public, in others business and sometimes both.

### **Distinctive character of the earlier trade mark**

52) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

53) The earlier mark consists of a device of a star and the words “StarPlus” appearing on a dark background. Whilst individually, each element of the mark is not endowed with a particularly high level of distinctive character, when combined, they create a mark of average distinctive character.

54) The evidence demonstrates that the applicant's mark is used to identify a television channel available on different platforms in the UK, including via cable with *Virgin Media* and via satellite with *Sky*. The channel appears to have appeal with the Hindi speaking community within the UK, with the evidence also illustrating that it is the number one Hindi language channel in the UK. It is difficult to assess the impact of these facts upon the distinctive character of the applicant's mark. This is because there is no evidence before me to illustrate what proportion of the UK population is Hindi speaking, nor is there evidence relating to viewing figures or market share. In the absence of this information, there are difficulties in assessing whether enough of the UK average consumers (that consists of all of the consumers of the type of goods and services relied upon by the applicant and not just the Hindi speaking part of that group) have been exposed to and are aware of the channel. However, the evidence suggests some enhanced level of distinctive character. That said, I do not consider that some enhanced distinctive character will materially affect my decision.

#### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

55) The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

56) Firstly, the applicant claims that it uses its mark in the colour red, but this is not supported by its evidence. This is because all of its exhibits are in the form of black and white photocopies. I am therefore, unable to conclude that it uses its mark in the colour red. However, this does not materially impact upon my considerations because of the guidance of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd*, BL O-246-08 where, at paragraph 10, he stated that

“The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the Opponent’s device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions. ... The true position is that registration in black-and-white provides protection unrelated to colour.”

57) In its counterstatement, the proprietor submits that there is no information to show that UK consumers can purchase the StarPlus television channel on its own. This is not fatal to the applicant’s case because the way the applicant’s services are marketed in the UK are not relevant to my considerations because, as I have stated earlier, I must consider the case on the basis of the scope of the earlier mark and the challenged registration and not the respective marketing methods. Therefore, the fact that the applicant’s StarPlus television is available through a subscription to Sky rather than directly being paid by individual consumers is not relevant to my considerations.

58) The proprietor makes other criticisms of the applicant such as it does not bill consumers directly in the UK and that it does not hold a broadcasting licence. I take note of these, but dismiss the notion that they are relevant in my considerations under

section 5(2)(b). As I have mentioned above, I am concerned solely with considering the respective goods and services as set out in the parties' specifications.

59) The applicant also points to the absence of a chain of legal title between the marks owner and other group companies. For the purposes of these proceedings, the registration of the earlier mark relied upon is prima facie evidence that it may be relied upon as an earlier mark. It is not necessary for the applicant to disclose evidence of the existence of a chain of legal title. It is open for a party to challenge legitimacy of ownership of a mark by way of invalidation, revocation or rectification (depending on the pleaded case) but not by way of a counterclaim in proceedings against another mark. Consequently, the absence of evidence of a chain of legal title does not impact upon my considerations here.

60) I have found that:

- the greater proportion of the proprietor's goods and services are identical, highly similar or share a medium degree of similarity;
- a lesser proportion of the proprietor's goods and services are not similar to the applicant's goods and services;
- the words and "star" element share equal dominance in both marks;
- the respective marks share a high level of visual similarity, a medium level of aural similarity and a moderately high level of conceptual similarity;
- the parties' goods and services are wide ranging from everyday purchases made by ordinary members of the public where the purchasing process will involve an average level of care and attention, to specialist equipment and services that are purchased in business to business transactions where there is a higher and normal level of care and attention, but still not the highest. Between these two fall the majority of the parties' goods and services where the level of care and attention paid during the purchasing process is likely to be above average but not the highest level;
- the earlier mark is endowed with an average level of distinctive character that has some enhanced level of distinctive character, but not such as to materially affect my decision.

61) Taking all of the above into account, and in particular, the similarity between the respective marks that arises from them both having a similarly sized and placed figurative element in the form of a star below which is a conjoined word where, in both cases, it begins with the word STAR, I find that in respect of goods and services where there is a medium level of similarity or above, there is a likelihood of confusion. When taking imperfect recollection into account, the consumer is likely to confuse one mark for the other (so called “direct confusion”), but even if I am wrong and the consumer recalls differences between the marks, the similarity between the marks is such that they are still likely to assume that the goods and services provided under the respective marks originate from the same or linked undertaking (so called “indirect confusion”).

62) in summary, the grounds based upon section 5(2)(b) of the Act is successful in respect of the following list of goods and services:

**Class 9:** *Application programming interface for computer software that enables online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; computer software and telecommunications apparatus to enable connection to databases and the internet; computer software for application and database integration; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; data storage media; digital recording media; electronic publications recorded on computer media; interactive entertainment software for use with computers.*

**Class 38:** *Broadcasting of video and audio programming over the internet; broadcasting services; delivery of messages by audiovisual media; delivery of messages by electronic media; electronic communication services; interactive broadcasting; podcasting services; providing access to computer databases in relation to a social network, social integration and meetings; providing online and telecommunication services for interaction between users of computers, mobile and handheld devices and wired and wireless communication devices;*

*providing online chat rooms and electronic bulletin boards; providing online communications links that transfer website users to other local and global web pages; providing online forums for communication on topics of general interest; telecommunication services enabling individuals to send, receive and share messages via email, instant messaging or a website on the internet; telecommunications services; transmission of messages including messages in the nature of comments, information, multimedia content, photos, audio, videos, movies, films, animation, pictures, images by electronic mail, instant messaging, text messaging and via a global computer network and other computer and communications networks; webcasting services; wireless digital messaging services ; information, advisory and consultancy services relating to the aforesaid.*

**Class 41:** *Arranging for the sale of admission vouchers for events via a website and/or wireless device; entertainment; ...; gaming; interactive entertainment services; live entertainment, live entertainment services; production of live entertainment; provision of live entertainment; music entertainment, film entertainment, concerts, road shows, light entertainment; organisation of a sporting event; organisation of conferences or exhibitions; organisation of events for cultural, entertainment and sporting purposes; preparation of entertainment programmes for broadcasting; production of audio tapes for entertainment purposes; production of live entertainment features; production of live-action, sporting and cultural events, ...; provision of entertainment services and information relating to entertainment packages and event tickets via a searchable database; ...; event ticket booking services; provision of entertainment services and information via computer, electronic and online databases in the field of entertainment; providing news about current events and sporting activities via a global network; providing on-line electronic publications; provision of betting or gambling services on an online platform; ticket procurement services for entertainment events; ticket reservation and booking services for entertainment, sporting and cultural events; ticket services for entertainment, sporting and cultural events; information, advisory and consultancy services relating to the aforesaid.*

**Class 42:** *Computer services, namely, providing an interactive web site featuring technology that allows users to consolidate and manage social networks, accounts, and connections to existing and emerging application programming interfaces (apis); hosting an online website and applications for handheld devices for users to interact, communicate, publish and share information, photos, audio and video content in any genre including sport, music, film, business; operating a website enabling users to create a personal or business webpage; information, advisory and consultancy services relating to the aforesaid.*

63) The grounds based upon section 5(2)(b) fail in respect of the following services:

**Class 35:** *Marketing, advertising and promotional services; online advertising on a computer network; organisation, operation and supervision of sales and promotional incentive schemes; presentation of goods on media for retail purposes; promoting the goods and services of third parties via computer and communication networks; providing an online facility for the exchange and sale of services and products of third parties via computer and communication networks; administration relating to sales methods; advertising and business services; advertising services; charitable services, namely promoting the awareness of charitable and philanthropic activities; compilation of information into computer databases; dissemination of advertising for others via the internet; online advertising operating as an online and mobile platform featuring a variety of consumer goods and choices including but not limited to entertainment products, sports packages, event tickets and associated goods and services thereto; online promotion of artists, athletes and celebrities, iconic and other personalities; online retail store services connected with the sale of games, sports goods, clothing, sports wear, sports equipment, bags, belts, hats, stickers, badges, magazines, news, sports drinks, bedding; organisation of exhibitions for commercial or advertising purposes; organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; organization of exhibitions for commercial or advertising purposes; pay per click advertising; presentation of*

*goods on communication media for retail purposes; promoting the goods and services of others by arranging for businesses to affiliate their goods and services with the goods and services of third parties by means of sponsorship relationships; provision of advertising space; sales promotion for others; subscriptions (arranging -) to a telematics, telephone or computer service [internet]; information, advisory and consultancy services relating to the aforesaid.*

**Class 41:** *... fan club organisation; fan club services; fan clubs; ... educational sports programmes; ... provision of ratings and recommendations in the field of sport activities via a website; ... information, advisory and consultancy services relating to the aforesaid*

**Class 45:** *Providing a website on the internet for the purpose of social networking; information, advisory and consultancy services relating to the aforesaid.*

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

64) I will consider the opponent's grounds based upon section 5(4)(a) only insofar as it may improve its position over and above its grounds based upon section 5(2)(b). Therefore, I will consider the grounds in respect of the applicant's surviving services in Class 35, Class 41 and Class 45.

65) Section 5(4)(a) states:

"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, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

66) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

67) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

### ***Relevant date***

68) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of Section 5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the

CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened

act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: “date of commencement of the conduct complained of”. If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

69) Therefore, in the absence of any evidence of use of the proprietor’s mark before its filing date, or of any counterclaim to an earlier goodwill, the relevant date for the purposes of these proceedings is the filing date of the contested registration, namely 1 December 2014.

### **Goodwill**

70) The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455. A description of goodwill was provided by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), and it is still valid today:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

71) The existence of goodwill and the level of that goodwill is a point of contention between the parties, but it is not necessary for me to decide this point, for reasons that will become clear in the following paragraphs.

### ***Misrepresentation and damage***

72) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University*

*of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

73) Whilst there is no requirement for the proprietor’s services to be in the same field of activity that the applicant operates (see *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] FSR 155 (HC)), this is nevertheless a relevant factor. The proprietor’s registration has survived the grounds based upon section 5(2)(b) only in respect of services that I considered share no similarity to the applicant’s goods and services.

74) I also recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. Even if the applicant has goodwill identified by its signs I, nonetheless, find that members of the public are unlikely to be misled into purchasing the proprietor’s Classes 35, 41 and 45 services (as listed in paragraph 63) in the belief that they are the applicant’s services. For the reasons set out in my earlier comparison of goods and services, I consider that the business areas of the respective goods and services are too far apart for any economic connection to be made.

75) I find that the applicant’s grounds, insofar as they are based upon section 5(4)(a), fail to further improve upon its case based upon section 5(2)(b). In respect of the proprietor’s services in Classes 35, 41 and 42 (as listed in paragraph 63), the oppositions fail.

## **COSTS**

76) The applicant has been successful to a slightly greater degree than the proprietor and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I estimate that the applicant has been successful in respect of about 60% of the proprietor's goods and services. I also take account that both sides filed evidence and that the applicant filed written submissions in lieu of a hearing. With this in mind, I award costs as follows (reduced to 60% of the full award because of the partial success):

Preparing statement and considering counterstatement (including fee)	£500
Preparing evidence and considering other side's evidence	£900
Preparing submissions	£350
<b>Total:</b>	<b>£1750</b>
<b>(Reduction to 60%)</b>	<b>£1050</b>

77) I order Starverse Media Ltd to pay Star Television Productions Ltd the sum of £1050 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 15<sup>th</sup> day of July 2017**

**Mark Bryant**  
**For the Registrar**  
**The Comptroller-General**