

O-339-10

TRADE MARKS ACT 1994

CONSOLIDATED OPPOSITIONS

APPLICATION 2494221 BY Ms RUPINDER K GREWAL

TO REGISTER THE TRADE MARK 'SUZI MANN'

IN CLASSES 9, 16, 25, 35, 38 & 41

AND

OPPOSITION 98365 BY LITT CORPORATION LTD

AND

APPLICATIONS 2495243 & 2497781 BY LITT CORPORATION LTD

TO REGISTER THE TRADE MARKS 'SUZI MANN' AND 'SUZY MAAN'

IN CLASSES 35, 38 AND 41

AND

OPPOSITIONS 98850 & 98906 BY Ms RUPINDER K GREWAL

BACKGROUND

1. This case is essentially about who owns the goodwill generated by the use of a performing name – SUZY MAAN – for the presenter of a radio program.

2. Miss Rupri K Grewal (“Ms Grewal”) is the radio presenter and she says it is her goodwill.

3. Litt Corporation Limited (“Litt”) is the holding company of Sunrise Radio Limited (“Sunrise”). The opponent says that by virtue of the terms of Ms Grewal’s contract of employment the goodwill associated with the performing name belongs to Sunrise, and that Litt is therefore the owner of a common law right to SUZY MAAN.

4. The dispute arises in the context of three trade mark applications. The earliest application, dated 1 August 2008, under No. 2494221 was made by Ms Grewal. She applied to register SUZI MANN as a trade mark for the following goods and services:

Class 09:

Video cassettes, video tapes, cd's dvd's.

Class 16:

Magazines, newspapers, newsletters, periodical publications, books.

Class 25:

Clothing footwear, headgear.

Class 35:

Advertising services.

Class 38:

Broadcasting, voice over services, telecommunication services, chat room services, electronic mail services.

Class 41:

Entertainment services, educational services.

5. This application is the subject of opposition 98365 by Litt. The single ground of opposition is that Litt has an earlier right to SUZY MAAN and Ms Grewal’s use of SUZI MANN in relation to all the goods and services in the application would constitute passing off. Consequently, registration of Ms Grewal’s mark would be contrary to s.5(4)(a) of the Act.

6. On 14 August 2008, Litt made application No. 2495243 to register SUZI MANN as a trade mark for:

Class 35:

Advertising; production of radio and television advertisements; radio and television commercials; advertising services provided by radio, television and the internet; consultancy, advisory and information services including backup and helpline services, to all the aforesaid services.

Class 38:

Telecommunications services; chat room services; portal services; e-mail services; providing user access to the internet; radio and television broadcasting; consultancy, advisory and information services including backup and helpline services, to all aforesaid services.

Class 41:

Entertainment by radio and television; education services provided by radio and television; musical concerts by radio and television; production of radio and television programmes; recording studio services; distribution of radio and television programmes.

7. On 16 September 2008, Litt made a further application under No. 2497781 to register SUZY MAAN for:

Class 35:

Advertising; production of radio and television advertisements; radio and television commercials; advertising services provided by radio, television and the internet; consultancy, advisory and information services relating to all the aforesaid services.

Class 41:

Entertainment by radio and television; education services provided by radio and television; musical concerts by radio and television; production of radio and television programmes; recording studio services; distribution of radio and television programmes; consultancy, advisory and information services relating to all aforesaid services.

8. These applications are opposed by Ms Grewal under Nos. 98850 & 98906. The grounds of opposition are s.5(1), s.5(2) and s.5(4)(a) of the Act and are based on Ms Grewal's:

- claimed earlier common law right to SUZI MANN;
- earlier trade mark application for SUZI MANN, which she claims is identical or similar to SUZI MANN/SUZY MAAN and covers identical or similar goods and services to those in Litt's applications and that there is a likelihood of confusion.

9. The parties deny the other's claims. In particular, Ms Grewal relies upon the fact that Litt is not a party to the employment contract it cites in support of its case and further claims that, in any event, the part of the contract on which Litt relies is an unreasonable restraint of trade and is therefore void.

10. The oppositions were consolidated and this decision covers them all. In reaching my decision I have take account of all the evidence filed. The parties were asked if they wished to be heard, but neither party indicated that they did. Consequently, I

must base this decision on the evidence filed and the written submissions received from Ms Grewal's solicitors, Lawdit (Litt is not legally represented).

The Evidence

11. Litt's evidence consists of a witness statement dated 17 June 2009 by Mr Avtar Lit. Mr Lit is a Director of Litt. He provides (as exhibit AL1) a copy of an annual return to Companies House for the period ending 23 January 2009, which shows that Sunrise is a subsidiary of Litt.

12. Mr Lit says that the trade mark SUZY MAAN was created by Sunrise in July 2000. In this connection, he provides (as exhibit AL2) a copy of an employment contract dated 18 July 2000, which is signed by Ms Grewal. The relevant section of the contract states:

"10. COPYRIGHT AND OWNERSHIP:

- a) The complete copyright in any work done by you in the course of your employment shall vest in the Company.
- b) The Company shall be entitled without your further consent or concurrence (i) to record by any means any performance of any kind which you may at any time during your employment at the request of the Company give in any of the Company's programmes (whether broadcast or not) and (ii) to reproduce or authorise others to reproduce by any means a record of any such performance at any time whether during or after the determination of your employment.
- c) Broadcasters who are given stage names by Sunrise Radio Management may not use these stage names in any other Radio Station, publication or TV Station without the written consent of the Chief Executive. A Monetary Licence Fee for the use of the stage name may be demanded by Sunrise Radio Ltd. The current fee for this is £100 per hour. Broadcasters may not remove or take any jingles and any other promotional material when they leave. Such material remains the copyright of Sunrise Radio Ltd."

13. In parallel with the contract, Ms Grewal signed a letter of the same date addressed to the Chief Executive of Sunrise in which she a) acknowledged that the name SUZY MAAN had been given to her by Sunrise, and b) undertook not to use the name SUZY MAAN on any other Radio station or "media format" without the consent of Sunrise. Mr Grewal also undertook to ensure that future employers were made aware that the name SUZY MAAN "used by me for Sunrise Radio" remains "the copyright and intellectual property" of Sunrise.

14. Mr Lit says that "the trade mark has been used at Sunrise Radio broadcasting programmes in the United Kingdom since July 2000 prior to Grewal's registration on 1 August 2008" (the reference to "registration" is obviously an error – the witness means 'application').

15. Mr Lit provides some examples from 2007/8 of SUZI MANN (not SUZY MAAN) being used on third party web sites. The first is from 'redhotcurry.com' and shows

that “Suzi Mann – Sunrise” was nominated for best radio show in the UK Asian Music Awards 2008. The second is from ‘guardian.co.uk.’ from October 2007, which includes an article reporting that ITN was to launch a channel on YouTube. The content of this channel was to include a weekly show called ‘Bollywood Insider’ presented by “Sunrise Radio’s Suzi Mann”. The third is from ‘bizasia.co.uk’ and reports Sunrise competing strongly against the BBC Asian Network. The piece invites viewers to e-mail with their views on the top programmes from these two service providers. The list of candidates includes “Suzi Mann’s Hindi Top 20 (Sunrise)”.

15. Ms Grewal filed a witness statement dated 12 November 2009. She says that she started working for Sunrise in May 2000. Initially she was a receptionist, but shortly after she was offered the chance to become a presenter. In the week beginning 17 July 2000 she was given a contract and asked to sign it on the spot, which she did. Within a couple of months she was co-presenting Sunrise’s breakfast show, which she did for about 6 months. However, this didn’t work out and she returned to her role as a receptionist until February 2002 when she started to present the Bollywood Top 20 show once a week. Ms Grewal did this until around September 2002 when she was dismissed.

16. Ms Grewal says that she returned to work as a presenter for Sunrise around February 2003. She says that she was given a new contract (which is not in evidence) covering the period March 2003-March 2004, but she continued to present for Sunrise up until August 2004 when she says that:

“.....all the presenters were informed that we had to start submitting invoices for our services, essentially come off payroll and become freelancers. I did not mind as by such time my contract has expired and nothing further was signed. Thereon I became a freelance presenter.”

17. Ms Grewal provides (as annex 1) examples of invoices she supplied to Sunrise for her freelance presenting. The examples are dated late 2007/early 2008. The invoices are clearly for freelance presenting of a radio show under the on-air name of SUZI MANN.

18. Ms Grewal continues that:

“17. I continued to present for Sunrise Radio on a number of shows but I also offered my freelance services outside of Sunrise as did many other presenters. In 2005 there was a music event that I and another presenter, Paul Shah, were invited to host.

18. The fliers were distributed all around the West London area and Sunrise reception also had these on display. The Chief Executive and all of management were fully aware of all outside activities I pursued whilst still working for Sunrise Radio. There was never any objection and I was not reprimanded or stopped from doing this. Since 2004 to the present day, I freelance for a number of different organisations under the name Suzi Mann. I have build (sic.) up a good rapport with many media companies who wish to use my services, whether it be for voiceovers, radio, TV or live hosting of events. It is now shown to me under ANNEX 2 invoices raised and sent to various companies that I have done freelance work for.”

19. Annex 2 consists of copies of seven invoices again dated late 2007/early 2008, addressed to four different organisations for recording and production services. All three of the invoices for recording services were addressed to 'ITN ON'. In contrast to the invoices sent to Sunrise, there is no reference to the provision of services under the name SUZI MANN. However, it is apparent from the copies of web pages provided as annex 7 that Ms Grewal used the name SUZI MANN in the public facing services provided for ITN ON in connection with its programme, Bollywood Insider. Ms Grewal says that this show received a lot of publicity. The press coverage included as annex 7 is intended to show this. ITN own's press release is typical of the coverage of the launch of Bollywood Insider. It is dated May 29, 2007 and states:

"ITN On is launching a new made-for-mobile programme called Bollywood Insider. The programme, the first of its kind on mobile, will form part of ITV's made-for-mobile news channel currently available on 3, Vodafone, Orange and Virgin Mobile.

Initially a weekly show, Bollywood Insider is a two minute round up of the hottest stories and the latest promos with interviews from India's cinema and music scene hosted by Bollywood expert Suzi Mann. Suzi is a well known Bollywood actress and presents a weekly radio music show on the UK's leading commercial Asian radio station, Sunrise Radio."

20. Ms Grewal says that she also used the name SUZI MANN in the following ways after she became a freelance presenter in May 2003. Firstly, in live on-stage appearances at (unnamed) independent events. Secondly, at appearances for Sony TV and Sunrise at the Asian Lifestyle Show each year between 2005 and 2007. (Annex 4 shows pictures of Ms Grewal interviewing someone called Shah Rukh Khan at the 2007 event). Thirdly, some ad hoc television work for B4U television between 2005 and 2007, which included interviews with Bollywood celebrities. Fourthly, Ms Grewal claims to have done some 'voiceovers' on "Prime TV – Lifestyle Shows" (it is not clear how the name SUZI MANN was used in this context). Fifthly, Ms Grewal says that she conducted an interview with Cineworld Cinema in October 2007. A copy of the interview was published on page 36 of Cineworld's magazine and this makes up annex 6. This article shows that Ms Grewal was identified (under her performing name SUZI MANN) as a broadcaster for Sunrise and "now with ITN Bollywood Insider" (the mobile phone round up program described above). Sixthly, Ms Grewal says that she did a similar interview for Brit Asia Magazine in January 2008, again on the Bollywood theme.

21. In July 2008, Ms Grewal had a disagreement with Sunrise over proposed changes to the format of the Bollywood Top 20 radio show she presented for them. As a result, the relationship between Ms Grewal and Sunrise ended.

22. Ms Grewal says that in the 3 weeks after she left her show it was presented by another presenter who described herself as "sitting in for Suzi Mann". However, the presenter changed again on 2 August 2009 and the new presenter called herself SUZI MANN on air. This continued for 6 weeks. According to second hand accounts given to Ms Grewal by ex-colleagues at Sunrise, this led to calls from listeners who questioned why the new presenter was calling herself SUZI MANN.

23. Annex 3 to Ms Grewal's statement consists of copies of web based articles published by 'bizasia' about the changes at Sunrise Radio. The following excerpts are from a relatively recent article dated 12 November 2009.

"In an unusual move, the UK's popular Sunrise Radio has gone on and registered over ten DJ names to prevent other stations using the same.

The decision to trademark fifteen of its popular DJ names may have been taken as some have become synonymous to the station and somewhat a brand of their own.

Amongst the names that have been submitted for registration are Ameet Roshan, Amar Grewal, Jaz Sidhu, Raj Shukla, Suzi Mann, Reena Kapoor, Sonia Dutta, Sandy Khanna, Asif Choudary, Sunny Landa, Deepa Rai, Rani Gill, Ruby Raza, Shama Sood and Sheena Khan.

Recently, BizAsia.co.uk reported how the "real" Suzi Mann was removed from her 'Bollywood Top 20' show and replaced with a "new" Suzi Mann. We hear, the second Suzi Mann has been given her marching orders too and it remains to be seen whether a third Suzi Mann will take over the show on Saturday or another alias.

Sunrise Radio is known for giving new names to its presenters. In the past, Anushka formerly of Club Asia was given a new identity as Deepa Rai. Moreover, when the real Sonia Dutta left the station a few years ago, Sunrise retained her name and handed the duty of "Sonia Dutta" to another DJ. Similarly we've lost count of the varied 'Bossman's' and 'Paul Shah's' that have stepped foot at their studios.

What is your view on this? Is the name really that much of a big deal? Do you think Sunrise Radio is deceiving its listeners by making him/her believe the DJ still exists just because the name "lives on" even after the original presenter has quit or been fired?"

24. Ms Grewal says that the show she hosted was subsequently presented by performers using different names.

The s.5(4)(a) ground of opposition to Ms Grewal's application 2494221

25. The relevant part of s.5 is as follows:

(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,

(b) –

26. The requirements to succeed in a passing off action are well established and essentially consist of 1) the existence and ownership of a commercial goodwill identified by a sign, 2) a misrepresentation by the defendant through the use of a sign identical with, or similar to, the claimant's sign, such as to deceive the public, 3) damage (or the likelihood of damage) to the claimant's goodwill caused by the misrepresentation.

Relevant date

27. The relevant date for determining a s.5(4)(a) opposition is the date of the application for registration, 1 August 2008: see the wording of article 4(4)(b) of Directive 104/89/EC (which s.5(4)(a) is intended to implement in the UK) and, by analogy, paragraph 51 of the judgment of the Court of First Instance in Joined cases T-114/07 and 115/07, *Last Minute Network Ltd v OHIM*.

Ownership of goodwill in Suzy Maan/Suzi Mann

28. One of Litt's marks is identical to Ms Grewal's mark. The other is an alternative spelling of the same performing name. That such alternatives should exist is probably explained by the fact that the name was originally used for a radio presenter and therefore there was room for interpretation as to the correct spelling of it. I think it follows that whoever owns the goodwill in Suzi Mann also owns the goodwill in Suzy Maan, and vice versa.

The Law

29. Strictly speaking, there is a preliminary question as to whether there is any relevant goodwill generated by the use of a performing name in connection with radio shows and/or spin off activities. Both sides assume that there is. There is some doubt in my mind as to whether a name used only as a performing name for an individual, or their professional pseudonym, is capable of generating a commercial goodwill (as opposed to personal goodwill). However, there seems to be authority that supports the proposition that it may do so. In *Hines v Winnick* [1947] 64 RPC 113, Vaisey J. accepted that goodwill was attached to the made up name for the conductor of an orchestra which had performed on a BBC radio station for a period of 2-3 months. The facts in this case are a little different, but it is clear on the evidence that by the date of Ms Grewal's application a substantial number of people would have become accustomed to listening to radio broadcasts from Sunrise presented by SUZI MANN/SUZY MAAN, and that the performance characteristics of shows associated with that name would have affected the number of people listening to the programmes. This is borne out by the evidence that Ms Grewal's show was nominated for a number of awards, which must at least in part be attributable to her skill as a presenter. I will therefore proceed on the footing that the use of the name in question in relation to a radio show generated a commercial goodwill. The real question therefore is who owns the goodwill associated with the name SUZI MANN/SUZY MAAN.

30. Starting from basic principles, in the absence of agreement the ownership of goodwill is a question of fact to be determined on the evidence. The answer to the question "with whom does the public associate the goodwill?" will therefore usually determine who owns it.

31. The position may be different where a name is associated with an employee as a result of the activities that he or she was employed to undertake. In these circumstances the goodwill is liable to be the property of the employer. Accordingly, in *Kingston Miller v Kingston (Thomas) & Co. Ltd* [1912] 29 RPC 289, Warrington J.

rejected a claim that the founder of the defendant company had established his own goodwill as a result of such activities.

32. However, there may be an exception to the rule governing the ownership of goodwill associated with an employee in the case of writers, artists and performers. It is noted at paragraph 3-148 of *Kerly's Law of Trade Marks and Trade Names* (14th Ed.) that in such cases:

“The goodwill associated with the name, real or assumed, under which the individual produces his work has been said *prima facie* to belong to the individual, rather than to any publisher, impresario or even employer through whom the work reaches the public.”

33. *Hines v Winnick* (above) is an example of this, the plaintiff had been employed by the defendant, although in that case ‘employed’ seems to have meant ‘retained’. In *Forbes v Kemsley Newspapers* [1951] 68 RPC 183 an employed journalist was successful against his former employer. In that case Wynn-Parry J. held that a journalist who had written a series of articles for the Sunday Times under the pseudonym ‘Mary Delane’ was *prima facie* entitled to the associated goodwill. An attempt to read an implied term into the journalist’s contract of employment was rejected.

34. Litt says that in this case there is a relevant written agreement. That Ms Grewal signed a document granting the intellectual property rights in SUZY MAAN to Sunrise. I return to the facts below, but if that is so it is potentially relevant because a voluntary agreement may determine the question of ownership where there would otherwise be doubt. The law in this respect is helpfully summarised in paragraph 3-110 of *The Law of Passing Off, Christopher Wadlow, 3rd ed.* as being:

“Notwithstanding the rule against assignments in gross, the terms of a voluntary agreement deserve to be given effect in full when it serves to reinforce what would have occurred at common law or when ownership at common law would be uncertain. There are many situations in which, in the absence of agreement, the goodwill could almost equally be said to belong to one party or the other, and give effect to the choice of the parties avoids a difficult, pointless and unreliable enquiry. If so, it follows that the party agreed to own the goodwill is the only proper claimant in a passing-off action during the course of the agreement, that he alone is entitled to use the names or marks with which the goodwill is associated, and that on termination of the agreement it is he who immediately has the right to sue third parties, or even his former colleague, for passing-off.”

35. The net effect of the above is that I must decide who owns the goodwill in SUZY MAAN/SUZI MANN bearing in mind that:

- i) Goodwill is usually a question of fact based on public perception;
- ii) In the case of goodwill generated by an employee in the course of his employment, the goodwill usually belongs to the employer;
- iii) But in the case of an individual performer, it is liable to *prima facie* belong to the performer or artist, even if they are an employee;
- iv) Where there is doubt, an enforceable written agreement will be determinative.

36. I use the word 'enforceable' deliberately because it is part of Ms Grewal's case that her employment contract is not enforceable to the extent that it would prevent her from using the name SUZY MAAN because that would be an unlawful restraint of trade.

37. The questions I must therefore address are:

- i) Who is *prima facie* the owner of the goodwill associated with SUZY MAAN/SUZI MANN;
- ii) Is there a written voluntary agreement which requires that Sunrise should be regarded as the owner;
- iii) If there is, is that agreement enforceable?

The facts *prima facie*

38. There is a suggestion in the article shown at paragraph 23 above, that Sunrise established a practice whereby the performing names given to its presenters were sometimes transferred from one person to another, as happened briefly when Ms Grewal left Sunrise. That is potentially relevant because if the public had become accustomed to different individuals presenting radio shows for Sunrise under the same name, then it would point to the fact that any resulting goodwill was associated with the radio station rather than with the individuals presenting under the station's performing names. However, the mere existence of the article in question does not mean that its content is accurate and true. Litt has provided no evidence that this was an established practice at Sunrise at the relevant date, or that its listeners were aware of it. It seems inherently unlikely that Sunrise would have wanted them to be. After all, the purpose of retaining particular performing names when presenters changed would have been to maintain the appearance of continuity. It would therefore have been self defeating for Sunrise to tell its viewers that a new presenter was using a name previously used by a different presenter, even if that had happened. I therefore start from the more inherently likely proposition that Suzi Mann/Suzi Maan identified a particular presenter at Sunrise and that, as such, Sunrise's listeners would naturally have expected the name to denote the services of a particular performer. This may be contrasted with a name associated with a group of performers, such as a musical group, where the public may expect no more than that the name distinguishes the members of the group as constituted at the time.

39. I see nothing in Mr Lit's evidence which detracts from the conclusion that the name in question *prima facie* distinguished Ms Grewal. In particular, the use by the media of "Suzi Mann – Sunrise" to describe a nomination for best radio show in 2008 does not mean that Suzi Mann therefore distinguished Sunrise rather than Ms Grewal. This is because the reference to 'Suzi Mann' is clearly a reference to Ms Grewal's performing name. The reference to 'Sunrise' distinguishes the radio station on which her show was broadcast at that time.

40. Ms Grewal's evidence that prior to the date of her application (and whilst still presenting for Sunrise) she appeared as SUZI MANN at audio/visual events such as the Asian Lifestyle Show, on third party programmes (particularly Bollywood Insider), and in the other ways described at paragraph 20 above, points to the same

conclusion: that the name SUZI MANN/SUZY MAAN distinguished Ms Grewal's presentation services rather than Sunrise.

The effect of the employment contract/agreement

41. Litt says that the effect of the employment contract is that Sunrise is entitled to the goodwill associated with Suzy Maan. Ms Grewal points out that the original contract expired in September 2002 and that from August 2004 she worked for Sunrise as a freelance presenter. The implication being that she was no longer bound by the terms of the original contract (if she ever was).

42. The terms of paragraphs 10(a) and (b) of the contract plainly cover the ownership of the copyright/performing rights to Ms Grewal's radio shows for Sunrise. They say nothing about the ownership of goodwill in the performing name SUZY MAAN. However, paragraph 10(c) purports to prohibit Ms Grewal from using without Sunrise's consent any "stage name" given to her by it "in any other Radio Station, publication, or TV Station". Again the word 'goodwill' does not appear, but it is well established that a term may be implied if it clearly reflects the intentions of the parties at the time of the agreement. I think it is tolerably clear that the intention of the parties was to vest the ownership of any rights in SUZY MAAN with Sunrise.

43. The letter signed by Ms Grewal of the same date as the employment contract makes this even clearer because it states in terms that "the name SUZY MAAN...remains the...intellectual property of Sunrise Radio Ltd". A purest may say that goodwill is not intellectual property as such, but the agreement was obviously not drawn up with the assistance of an intellectual property lawyer and I think it makes it clear that the intention of the parties at that time was to vest whatever rights existed in SUZY MANN with Sunrise rather than Ms Grewal. The letter includes a further undertaking from Ms Grewal to make any future employer aware of the restrictions applying to her use of the name SUZY MAAN. In my view, the letter of 18 July 2000 should be regarded as part and parcel of the employment contract. However, it does not matter whether that is right or wrong, because if it not part of the employment contract then it is either a contemporaneous document showing that the intention of the parties to that contract was to vest any rights in the disputed name with Sunrise, or else it is a separate contract to the same effect. Either way, the documents show that the intention was to vest any goodwill associated with SUZY MAAN with Sunrise. Further, it is self evident that the contract applies to relevant uses of SUZY MAAN made after Ms Grewal's employment with Sunrise had ended. Consequently, it is neither here nor there that the original contract had expired prior to the date of Ms Grewal's trade mark application.

44. Ms Grewal states that a new contract was agreed in September 2002, but she has not provided a copy or indicated whether or how the terms of it varied from the terms of the original contract. In these circumstances, I find that it was likely to have been on the same terms as the original contract, or at least did not have the effect of varying the material term of that contract.

45. Ms Grewal's representatives rely on the fact that Litt was not a party to the contract between Ms Grewal and Sunrise. In my view, that does not prevent Litt from relying on that contract to establish Sunrise's ownership of the goodwill. It may have

a bearing on whether Litt is entitled to bring the opposition, but that is a separate issue to which I return below.

46. For the reasons given above, I find that, if the employment contract is enforceable, it vests the goodwill in SUZY MAAN with Sunrise.

Is the contract enforceable?

47. Ms Grewal's representatives rely on *Hepworth Manufacturing Company, Limited v Ryott* [1920] TLR 1 Ch. 1, as authority for her claim that her agreement with Sunrise is void to the extent that it purports to prevent her from providing performances for anyone other than Sunrise under the name SUZY MAAN. And, by implication, from claiming the benefit of the goodwill already established under that name.

48. In the cited case a film actor called Mr Ryott was given the stage name Stewart Rome under a contract of employment awarded to him by a firm of film producers. He subsequently appeared under that name in a number of films and thereby acquired a valuable reputation. Upon leaving the employment of the film producers he sought to work under the same name for rival film producers. The claimant sought to invoke a clause in Mr Ryott's contract of employment which effectively prevented the actor from working for anyone else in the relevant field under the name by which he was by then known. It was common ground that Mr Ryott could earn twice as much under his stage name as he could under his own name, and it was not disputed that the film producers had no other use for the name, it being accepted that the name would be deceptive when separated from the person to which it was attached in the public's mind.

49. The High Court, and subsequently the Court of Appeal, held that the contract was a partial restraint of trade and was not reasonably required for the protection of the employer. Consequently, it was unenforceable. I note that in reaching this view the court appears to have judged whether the contract was an unjustified restraint of trade as at the time that the action was brought.

50. The facts in this case bear some similarity to those in *Ryott*. Firstly, the stage or performing names were given to the employees by their employers. Secondly, by the relevant dates in the proceedings the stage or performing names had become merged in the public's mind with the persona of the respective employees. It is true that the majority of Ms Grewal's performances were radio shows rather than visual performances, and it was therefore less predictable that the performing name would become merged with the persona of a particular presenter. However, I think it is clear on the evidence that this is what in fact happened. Thirdly, the stage or performing name had become of particular value to the employee as a means of increasing their earnings compared to what they would be able to achieve under an alternative but unknown name. There was direct evidence to this effect in *Ryott*, and I am prepared to infer from the surrounding facts that it would also be so in this case. In that connection, I take judicial notice of the fact that in these times of celebrity culture even minor celebrities thereby acquire more earning power. And it is just as true today that as it was at the time of *Ryott* that the increased earning power of a celebrity depends upon the public's recognition of a recognisable name or face. In

the case of a person best known as a radio presenter, the recognition is liable to depend more on the name than the face.

51. I am therefore prepared to accept that the contract in question represented a partial restraint of Ms Grewal's trade.

52. There is also a potentially important factual difference between the cases: it is not common ground in this case that the stage name SUZY MAAN was of no use to the employer without Ms Grewal. I have given that matter due weight, but I do not think it is decisive for two reasons. Firstly, the evidence shows that Sunrise's attempt to replace Ms Grewal with another presenter under the same name failed and they eventually choose to replace her with presenters performing under different names. This suggests that the name was objectively of little or no value to Sunrise without Ms Grewal, even though Sunrise did not realise it. Secondly, even if there was some justification for Sunrise retaining any rights under the name SUZY MAAN, the value of that interest to Sunrise was very much less than Mr Grewal's interest in using the name in the course of her trade. I therefore find that the term was not objectively necessary or reasonable for the protection of the employer. That part of the contract is therefore unlikely to be enforceable in law.

53. It follows that the contract cannot be relied upon to determine which of the parties owns the goodwill in SUZY MAAN.

54. I am therefore left with my *prima facie* finding that the goodwill in SUZY MAAN/SUZI MANN belongs to Ms Grewal rather than Sunrise. Litt's opposition to Ms Grewal's application under s.5(4)(a) of the Act therefore falls at the first hurdle.

55. For the sake of completeness, I should mention that even if I am wrong about the contract, Litt's case would still have failed on a more technical ground. This is because according to article 2 of the Trade Marks (Relative Grounds) Order 2007, S.I. 2007/1976 ("the Order"), only the owner of an earlier right is entitled to bring opposition proceedings under s.5(4) of the Act. The section defines the owner of an earlier right as being "a person....entitled to prevent the use of a trade mark....". In most cases the ownership of goodwill within a group of companies is a non-issue in passing off proceedings because any potentially relevant member of the group can be joined as a claimant. However, Sunrise is not a party to these opposition proceedings. Consequently, if I had accepted Litt's claim that Sunrise owned the goodwill in SUZY MAAN I would still have had to reject an opposition brought by Litt on the grounds that Litt alone was not entitled to prevent Ms Grewal's use and was not therefore entitled to bring the opposition in accordance with article 2 of the Order.

Outcome of Opposition 98365

56. The sole s.5(4)(a) ground of opposition to Ms Grewal's application 2494221 therefore fails.

Oppositions 98906 and 98850

57. I approach these oppositions on the footing that, subject to a successful appeal against my decision in opposition 98365, application 2494221 – SUZI MANN – will

be registered in Ms Grewal's name. The application to register that mark has an earlier filing date than either of Litt's applications. Consequently, Ms Grewal's mark constitutes an 'earlier trade mark' for the purposes of s.5 of the Act.

58. The relevant parts of s.5 of the Act are as follows:

5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.

Identity/similarity of marks

59. It is self evident that the mark the subject of Litt's first application 2495243 – SUZI MANN – is identical to the mark covered by Ms Grewal's earlier application 2494221.

60. On behalf of Ms Grewal, it is pleaded that the marks SUZI MANN/SUZY MAAN are identical or similar. Marks are considered to be identical where they are literally so or where, viewed as a whole, any differences are so insignificant that they will go unnoticed by an average consumer: see case C-291/00, *LTJ Diffusion v Sadas*, [2003] F.S.R. 34.

61. The average consumer of the services covered by Litt's applications is likely to be either a business seeking advertising or telecommunications services, or a member of the public seeking telecommunications or entertainment services. In either case, the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect: see *Lloyd Schuhfabrik Meyer*, Case C-342/97 [1999] ETMR 690.

62. The respective marks are self evidently identical to the ear and, conceptually, appear to be the personal name of one and the same person. The marks are spelt differently and so they are not literally identical. Would the variant spellings of the name go unnoticed by an average consumer? In my view, on the facts of this case the different spellings are liable to go unnoticed, even by business users who may pay a higher level of attention than members of the general public. Accordingly, I find that the marks are identical for the purposes of s.5.

63. If I am wrong about that, the marks are aurally and conceptually identical, and highly similar from a visual perspective. In other words, if they are not identical, then they are virtually identical.

Identity/similarity of services

64. In my judgment, 'advertising services' covered by class 35 of Ms Grewal's application covers:

Advertising; production of radio and television advertisements; radio and television commercials; advertising services provided by radio, television and the internet;

- in class 35 of Litt's applications.

65. Advertising services does not cover 'consultancy, advisory and information services including backup and helpline services, to all the [advertising] services' in class 35 of Litt's application 2495243, but these services are plainly complementary and highly similar services. The same goes for 'consultancy, advisory and information services relating to all the aforesaid [advertising] services' in class 35 of Litt's second application 2497781.

66. The services covered by class 38 of Ms Grewal's application are:

Broadcasting, voice over services, telecommunication services, chat room services, electronic mail services.

67. These services cover most of the services in class 38 of Litt's application 2495243, namely:

Telecommunications services; chat room services; portal services; e-mail services; providing user access to the internet; radio and television broadcasting.

68. The remaining class 38 services (as set out below) in Litt's application are not identical, but they are plainly complementary and highly similar to the services covered by Ms Grewal's application.

Consultancy, advisory and information services including backup and helpline services, to all aforesaid [telecommunications and broadcasting] services.

69. In my view, 'entertainment services, educational services' covered by class 41 of Ms Grewal's application covers the following services listed in the corresponding class of both of Litt's applications.

Entertainment by radio and television; education services provided by radio and television; musical concerts by radio and television; production of radio and television programmes; distribution of radio and television programmes.

70. Litt's second application 2497781 also covers 'consultancy, advisory and information services relating to all aforesaid [entertainment and education] services'. These are not identical to the entertainment and educational services covered by Ms Grewal's application, but they are plainly complementary and highly similar to those services.

71. In addition, both of Litt's applications cover 'recording studio services' in class 41. In my view, these are not identical to 'entertainment services'. In reaching that view I

have taken account of the guidance of the Court of Appeal in *Reed Executive v Reed Business Information* [2004] RPC 40 to the effect that:

“Specifications of services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

72. I also bear in mind that descriptions of goods/services used in specifications should normally be given their ordinary meaning: see *Beautimatic International Ltd v Mitchell International Pharmaceuticals and Another* [2000] F.S.R. 267. In the light of this guidance, I think that the meaning of ‘entertainment services’ should be limited to services which provide entertainment. Given the words their ordinary meaning, ‘recording studio services’ do not provide entertainment. Rather they are services provided by a recording studio and those services are provided to entertainers.

73. This makes it necessary to consider whether the respective services are similar. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 where the ECJ 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.

74. Entertainment services do not have the same purpose as recording studio services (even though the one may be a means of producing the other), the respective services are not in competition and they are not complementary from the consumer’s viewpoint. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (TradeMarks and Designs) (OHIM) Case T- 325/06*, the General Court restated that “complementary” means that:

“.. 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”

75. The consumer is more likely to think of the provider of an entertainment service as a user of a recording studio service rather than that both services will be offered by the same undertaking. Consequently, the services are not complementary in a way that is relevant for these purposes. As there is no other apparent similarity between these services I find that they are not similar.

Outcome of oppositions 98906 and 98850

76. The above finding effectively settles the s.5(1) and (2) grounds of opposition to applications 2495243 and 2497781 in Litt’s favour so far as the registration of its marks for ‘recording studio services’ is concerned. This is because the law requires there to be some degree of similarity between the respective services before an

objection on these grounds can succeed: see *Waterford Wedgewood plc v OHIM*, Case C-398/07P.

77. My findings that the marks and most of the other services are identical determines the s.5(1) ground in Ms Grewal's favour and requires that Litt's applications be refused for:

Class 35

Advertising; production of radio and television advertisements; radio and television commercials; advertising services provided by radio, television and the internet;

Class 38

Telecommunications services; chat room services; portal services; e-mail services; providing user access to the internet; radio and television broadcasting.

Class 41

Entertainment by radio and television; education services provided by radio and television; musical concerts by radio and television; production of radio and television programmes; distribution of radio and television programmes.

78. It is left for me to decide whether Litt's use of the marks SUZI MANN and SUZY MAAN in relation to the remaining services in its applications, namely:

Class 35

Consultancy, advisory and information services including backup and helpline services, to [various advertising] services

Class 38

Consultancy, advisory and information services including backup and helpline services, to [various telecommunications and broadcasting] services.

Class 41

Consultancy, advisory and information services relating to [various entertainment and education] services

- will result in a likelihood of confusion on the part of the relevant public, including the likelihood of association with the earlier trade mark SUZI MANN.

79. In my judgment, the identity (or near identity) between the respective marks coupled with the high level of similarity between the respective services is likely to cause average consumers in the relevant sections of the public to believe that the respective services are provided by the same undertaking, or by economically connected undertakings. Consequently, the s.5(2) ground succeeds against both of Litt's applications as far as these services are concerned.

80. There is a further ground of opposition under s.5(4)(a) based on Ms Grewal's common law rights to the name SUZI MANN. In principle, that objection could succeed in respect of 'recording studio services' notwithstanding the failure of the s.5(1) and 5(2) grounds against these services based on Ms Grewal's earlier trade

mark. This is because it is not necessary in law for the parties to be engaged in the same field of activity in order to succeed in a passing off action or, by extension, in an opposition brought under s.5(4)(a) on the basis of such an earlier right.

81. However, on the facts the s.5(4)(a) case is no stronger than the case brought of the other grounds. This is because Ms Grewal's goodwill and reputation at the relevant date was relatively modest and quite narrowly focused on radio and other entertainment services. In these circumstances, it is very unlikely that anyone would think that she had extended her business to provide recording studio services. Consequently, the s.5(4)(a) ground of opposition is bound to fail because the use of Litt's marks for recording studio services would not constitute a misrepresentation and there would be no damage to Ms Grewal's goodwill.

82. The net result of the above findings is that Ms Grewal's oppositions succeed under s.5(1) or (2) against everything in Litt's applications, except for 'recording studio services'.

Costs

83. Ms Grewal has succeeded to a far greater extent than Litt and is therefore entitled to an award of costs. Neither party has asked for costs to be awarded on anything other than the usual contribution basis, and I see nothing about the case that would justify a different approach.

84. I therefore order Litt to pay Ms Grewal £2300 as a contribution towards her costs. This is made up of:

- £400 - for considering Litt's Notice of Opposition and filing a defence
- £600 - for filing oppositions to Litt's applications (including the official fees)
- £200 - for considering Litt's defence
- £1000 - for filing evidence and considering Litt's evidence
- £200 - for filing written submissions
- £100 - recognising that the oppositions to Litt's applications failed in one minor respect.

85. The above sum to be paid within 14 days of the end of the period allowed for appeal.

Dated this 29 Day of September 2010

**Allan James
For the Registrar**