

O-478-19

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3280565
BY LIME PARTNERS LIMITED
TO REGISTER IN CLASSES 9, 38 & 41
THE TRADE MARK**

LIME

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 412995
BY
LIME PICTURES LIMITED**

BACKGROUND

1) On 6 January 2018, Lime Partners Limited (hereinafter the applicant) applied to register the trade mark LIME in respect of the following goods and services, subsequently amended after the hearing mentioned below:

In Class 9: Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards.

In Class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; satellite communication services; telecommunications gateway services.

In Class 41: arranging and conducting of workshops and seminars; arranging and conducting of congresses; organization of exhibitions for cultural and educational purposes; publication of electronic books and journals online.

2) The application was examined and accepted, and subsequently published for opposition purposes on 30 March 2018 in Trade Marks Journal No. 2018/013

3) On 2 July 2018 Lime Pictures Limited (hereinafter the opponent) filed notice of opposition, subsequently amended. The opponent in these proceedings is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
	UK 2439774	27.11.06 08.08.08	9	Compact discs; pre-recorded audio and/or video tapes; instructional materials;

 <p>A series of four marks</p>			41	Production, presentation, rental, and leasing of television and radio programmes and of films and of sound and/or video recordings; production of pre-recorded video tapes, cassettes and discs, television series and live entertainment performances; production of content for showing on TV, broadband, Internet, mobile phones and other telecommunications media; creation of television programmes; the provision of recording-studio facilities; publication of educational text;
LIME PICTURES	UK 2439772	27.11.06 08.08.08	42	Creation of creative content and interactive features; creation of mobisodes.
			9	Compact discs; pre recorded audio and/or video tapes; instructional materials;
			41	Production, presentation, rental, and leasing of television and radio programmes and of films and of sound and/or video recordings; production of pre-recorded video tapes, cassettes and discs, television series and live entertainment performances; production of content for showing on TV, broadband, Internet, mobile phones and other telecommunications media; creation of television programmes; the provision of recording-studio facilities; publication of educational text;

			42	Creation of creative content and interactive features; creation of mobisodes.
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- a) The opponent relies upon the goods and services shown above for which its two marks are registered and also claims that it has reputation in all of these goods and services. The opponent contends that its marks and the mark applied for are very similar and that the goods and services applied for are identical and/or similar to the goods and services for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent relies upon the two marks shown above and claims that it has reputation in these marks in respect of the goods and services shown above and claims that use of the mark in suit would take unfair advantage of its mark as the marks/goods and services are identical/ similar. Use of the mark in suit would also dilute the distinctiveness of its mark. As such the mark in suit offend against section 5(3) of the Act.
- 4) On 15 February 2019 the applicant filed a counterstatement basically denying all the grounds of opposition. The applicant did not put the opponent to proof of use.
- 5) Only the opponent filed evidence, and both also seek an award of costs in their favour. The matter came to be heard on 27 June 2019 when the applicant was represented by an employee, Mr Morton; the opponent was represented by Mrs Moss-McGrath of Messrs W P Thompson.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 18 December 2018, by Anita Phillips the Senior Legal and Business Affairs Executive of the opponent company. She provides evidence in respect of the use of marks 2439772 & 2439774. She states that these marks have been used in relation to television production / programmes, social media campaigns and online content. She names a large number of television programmes which she states have been screened in the UK and include: Hollyoaks and Hollyoaks laters (channel 4); The only way is Essex (ITV); Geordie Shore (MTV); Educating Joey Essex (ITV); Celebs go dating (E4); Life on Marbs (ITV); Rocket's Island (BBC). Ms Phillips states that these shows are very popular, and instances Hollyoaks which has 260 episodes

per annum and attracts one and a half million viewers per episode. She provides the following turnover figures:

Year	£millions
2014	64.9
2015	62.8
2016	61.9
2017	61.6
2018	58.4

7) Ms Phillips states that the company has won a number of awards, including some in each of the last 5 years and these are listed at exhibit AP1. The opponent issues press releases and also social media releases regarding its shows. The company is also mentioned in the opening and closing credits for each of the programmes it makes. In addition to the programmes that it makes, others such as the BBC, ITV and Channel 4 use the opponent's studio facilities in Liverpool to produce their own programmes. The opponent also contends that the storylines in its programmes are educational as they often deal with themes which are current such as consent, suicide, mental health and LGBT issues. The opponent also provides other digital content such as "how to" videos and social media pages for TV channels. The opponent has also sold DVDs and CDs as spin offs from its TV shows.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The first ground of opposition is under section 5(2)(b) which reads:

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

(a)

(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."

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The mark in suit was published on 30 March 2018 at which point the opponent’s marks (2439772 & 2439774) had been registered for over five years. However, the applicant did not put the opponent to strict proof of use in its counterstatement.

12) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

13) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these

goods and services are likely to be selected by the average consumer in the course of trade. 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.”

14) At the hearing Mrs Moss-McGrath contended that the average consumer for all the opponent’s goods and services was the general public as they were the ones who would watch and/or listen to the opponent’s television and radio programmes. She contended that the credits which are shown at the beginning and end of every television show would be noticed by the average viewer and that the opponent would be associated with the programme. She contended that as many of the shows made by the opponent were shown on a number of different channels this would heighten the perception amongst the general public as to the originator of the show. She stated that this could be seen by the very well known series Game of Thrones which she claimed was attributed by the general public to HBO although no evidence to corroborate this, or indeed the opponent’s reputation amongst the general public was filed.

15) To my mind, the goods and services in this case are somewhat diverse. The goods of the two parties in class 9 are, broadly speaking, computer equipment including software, telephones, CDs and video tapes which will be purchased by the public at large including businesses. Such goods will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. I accept that such goods may be researched or discussed with a member of staff. Therefore, aural considerations must also be taken into account. To my mind even when selecting such goods the average consumer will pay attention to the item to ensure that it is compatible to their existing equipment, is suitable for their needs and or is what they enjoy. **Overall the average consumer for these types of goods is likely to pay a medium degree of attention to the selection of such goods.**

15) I next turn to consider the applicant's services in class 38, which are, broadly speaking, telecommunications services and the transmission of TV and radio programmes. These services will be sold to the general public including businesses. When choosing a telecommunication service for phone calls, broadband or streaming, the average consumer will pay at least an average amount of attention to ensure that the coverage in their area is adequate, or that (in the case of mobile phones) there is adequate coverage in areas that the consumer frequents. In choosing a provider of television and radio etc the average consumer will want to ensure that the choice of programmes is suitable to meet their requirements and that the technical back up exists to ensure continuous coverage. **Overall the average consumer for these types of goods is likely to pay a medium degree of attention to the selection of such services.**

16) Lastly, considering the opponent's services in class 41, these types of services will be purchased by entertainment outlets i.e. TV and radio broadcasters such as the BBC and ITV. The selection will be considered carefully and probably after the buyer has met the seller. The initial selection will probably be from advertisements (print or on-line) and visual aspects are the most important; but there will undoubtedly also be verbal recommendations and so aural considerations also have to be taken into account. It is normal to assume that businesses take slightly more care in making decisions regarding the purchase of goods and services as their survival may depend upon making the correct choice both economically and for the image of the business. **To my mind, the average business consumer for these types of services is likely to pay a medium to high degree of attention to the selection of the services covered by the application as the quality of the programmes purchased in from outside suppliers and subsequently shown to the public will have a direct bearing on the revenue streams of the broadcaster such as Sky.**

Comparison of goods and services

17) In the judgment of the Court of Justice of the European Union (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”.

18) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“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 für 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”.

19) In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

20) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

21) In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for 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."

22) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

23) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

24) I also note that if the similarity between the goods/services is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

25) Thus, where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar. The opponent has selected the parts of the specifications of its marks which it believes provides its strongest case. The specification relied upon in the instant case for each of its marks is identical.

26) I note that the specifications for the opponent’s two marks are identical and so I shall only carry out a single comparison test. I shall first consider the two parties goods in class 9. The two sides specifications are as follows:

Applicant’s goods in class 9	Opponent’s goods in class 9
Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards.	Compact discs; pre recorded audio and/or video tapes; instructional materials;

27) The opponent in its skeleton then refers to the factors set out at paragraph 16 above and simply states that the applicant’s class 9 specification is similar to the opponent’s specification of “compact discs” yet provides no explanation as to why. At the hearing Mrs Moss-McGrath did not address the similarity of the class 9 goods of the two parties but did provide the following comments as to why the applicant’s goods in class 9 were similar to the opponent’s services in class 41:

“The opponent's concern is that these are all goods that can be used regularly in the production of television and films, and for the rest of the services that are claimed in the contested application and for which we already have protection under the earlier rights.”

And:

“You get an awful lot of people, for example, who have their own YouTube channels and who buy equipment specifically for the broadcasting of their programmes on YouTube. They do it from home. They have to buy their equipment from somewhere. Lime Pictures is a very well-established television production company. So it is not as absurd as it may sound initially that there could be some link or association in the minds of the consumer.”

And:

“Computers and software are used all the time in television and film production.”

28) To my mind, and in the absence of any reasoned arguments to the contrary, the applicant’s specification of “computer hardware; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic control apparatus; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards” consists of items of equipment designed for entirely different purposes than a compact disc (CD). Whilst some of the items may be able to “read” a compact disc the nature, intended purpose and method of use of a computer or telephone is completely different to a CD. There is no evidence that the manufacturers of such items also produce CDs. **These items in the applicant’s class 9 specification are, in my opinion, completely different to the opponent’s class 9 specification of CDs.**

29) The applicant’s specification also includes the following “computer software; electronic memory devices; programmed-data-carrying electronic circuits”. The opponent’s specification includes the term “CDs”. It does not qualify what type of CDs so I am taking the view that the term covers only blank CDs and not the material upon them. If it did then CDs would cover most software, music, audio and visual recordings which seems to me to be an extremely wide meaning. Therefore, CDs without qualification should be given its core meaning of a compact disc upon which data can be stored / recorded. As a consequence I find that “electronic memory devices” are highly similar if not identical to CDs. As “computer software” is often sold on CDs these goods are similar in nature and method of use and so similar to a medium degree. Whilst “programmed-data-carrying electronic circuits” covers memory devices of different kinds then these are similar to a degree to CDs.

30) Turning to consider the applicant’s class 9 goods to the opponent’s class 41 services. The opponent contends that because it uses such equipment in producing its television and radio programmes, that the goods and services are similar if not identical. If one takes the contentions set out at paragraph 27 to their logical conclusion then any service which used a telephone or computer

in its provision would be viewed as similar or identical to the applicant's good. This is clearly absurd. **In my view, there is no similarity between the applicant's goods in class 9 and the opponent's services in class 41.**

31) Moving onto the applicant's services in class 38, the opponent has merely stated in its skeleton that these are similar to its class 41 and 42 services. For ease of reference the services of both parties are reproduced below:

Applicant's services in class 38	Opponent's services in classes 41 & 42
Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; satellite communication services; telecommunications gateway services.	41: Production, presentation, rental, and leasing of television and radio programmes and of films and of sound and/or video recordings; production of pre-recorded video tapes, cassettes and discs, television series and live entertainment performances; production of content for showing on TV, broadband, Internet, mobile phones and other telecommunications media; creation of television programmes; the provision of recording-studio facilities; publication of educational text; 42: Creation of creative content and interactive features; creation of mobisodes

32) The opponent contended:

“In Class 38 the applicant has claimed a number of services such as electronic transmission of images, transmission of data, audio, video and multimedia files; the broadcast of television over global communication networks; provision of telecommunications access; and telecommunications gateway services. They would be similar, in our view, to the presentation, rental and leasing of television and radio programmes and video recordings because those services are complementary.”

And:

“The services being claimed by the applicant -- transmission of data, audio and video and multimedia files, and broadcast of television over global communication networks, internet and wireless networks -- would surely be similar to the presentation and the rental and leasing of television and radio programmes, films and sound recordings.”

And:

“Because in order to present the television and film recordings you may well be presenting those through a number of different media, whether via television or online services, which they do, and in order to do that you would need the telecommunications services.”

And:

“If we have a service where the applicant is transmitting television programmes under the trade mark LIME, and our client is creating content which is shown through that kind of media -- it is also being transmitted under the name Lime Pictures -- I would say that those services are connected to one another. The transmission of the television programmes relies upon the telecommunications services. In this case the telecommunications services being claimed are specifically for the transmission of television, video and audio content.”

And:

“With regard to the Class 38 services, and in particular the telecommunication services that are being claimed by the applicant, we have a claim in Class 42 which is the creation of content and interactive feature, and particularly the creation of mobisodes. They are episodes which are created specifically for mobile phones. Again, we would say there is a connection between LIME being used as a brand for telecommunication services of exactly the same sort of content that the opponent has claimed in its earlier registrations.

Moving on to the instructional materials which are claimed in Class 9 of the earlier rights, and also the publication of educational text in Class 41, we would say that these are similar to education, teaching and training services. One does use the other, so we are creating content which is specifically for instructional and educational purposes, and Lime are claiming educational services that would use such content.”

33) To my mind, the applicant’s specification is effectively radio and television broadcasting such as that carried out by the BBC and ITV whereas the opponent’s services are the provision of programmes to be broadcast. In my opinion there is a degree of complementarity as I believe that the public would not be surprised if the broadcaster also made the programmes. I accept that the vast majority of TV networks do not, merely purchasing them from other broadcasters after they have been shown a few times or from independent producers. However, it is well known that the major broadcasters such as BBC, ITV and Sky also produce many of their own programmes. **I consider there to be a low degree of similarity between the services of the two parties in classes 38 and 41.** I do not accept the contention that the fact that the opponent also provides content for mobile

phones that this is either complementary or otherwise similar to the provision of telecommunication services. Strictly, the provision of telecommunications services relates simply to the provision of a telephone network. I accept that in today’s world this includes broadband so that smartphones can operate and view the internet etc. There is no evidence that the providers of such networks also provide the content that can be viewed. **In the absence of such evidence I am not willing to accept that there is any similarity of complementarity between the applicant’s class 38 services and the opponent’s services in class 42.**

34) I next turn to consider the class 41 services of the applicant and the comparison with the class 41 & 42 services of the opponent. For ease of reference these are:

Applicant’s services in class 41	Opponent’s goods in class 9 and services in class 41
Arranging and conducting of workshops and seminars; arranging and conducting of congresses; organization of exhibitions for cultural and educational purposes; publication of electronic books and journals online.	9: instructional materials; 41: Production, presentation, rental, and leasing of television and radio programmes and of films and of sound and/or video recordings; production of pre-recorded video tapes, cassettes and discs, television series and live entertainment performances; production of content for showing on TV, broadband, Internet, mobile phones and other telecommunications media; creation of television programmes; the provision of recording-studio facilities; publication of educational text;

35) To my mind, the opponent’s specification of “publication of educational text” would encompass the applicant’s specification of “publication of electronic books and journals online” and that these should **be regarded as identical services.**

36) In my opinion, the producing of educational or instructional materials is not similar to actually conducting workshops, congresses or exhibitions. **To my mind, the goods and services of the opponent are dissimilar to the remainder of the applicant’s services.** I am willing to accept that the publication of educational material could be complementary to arranging and/or conducting **educational events and so are similar to a low degree.**

37) My conclusions regarding the goods and services of the applicant are:

	Identical /highly similar	Medium / low Similarity	Dissimilar
Class 9	electronic memory devices;	computer software; programmed-data-carrying electronic circuits	computer hardware; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic control apparatus; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards
Class 38		Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; satellite communication services; telecommunications gateway services.	
Class 41	Publication of electronic books and journals online.	organization of exhibitions for cultural and educational purposes	arranging and conducting of workshops and seminars; arranging and conducting of congresses;

Comparison of trade marks

38) Clearly, the opponent's mark 2439772 provides the opponent with its strongest case. 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 them, 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.”

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

Opponent's trade mark	Applicant's trade mark
LIME PICTURES	LIME

40) When comparing the marks I take into account the views expressed in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part

of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

41) Visually it is obvious that both marks have the word LIME at their starts. This is a well-known name of a fruit and has, to the best of my knowledge, no meaning in respect of the goods and services in the instant case. The opponent's mark has, as its second element. The word PICTURES which is descriptive of many of the services it offers. In my opinion the distinctive and dominant element of the opponent's mark is the word LIME. There is a high degree of visual similarity.

42) Aurally, the marks are identical in their first word, with the opponent's mark having a second word which is not part of the applicant's mark. The marks are at least similar to a medium degree.

43) Conceptually, both marks provoke an immediate image of a small green fruit. Whilst the opponent's mark has a second word this will be seen as being descriptive of the goods and/or services being offered. Conceptually the marks are similar to at least a medium degree.

44) Overall. I believe that the marks have a high degree of similarity.

Distinctive character of the earlier trade mark

45) 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).”

46) The opponent’s mark consists of two well-known words. The first, LIME, has no meaning in relation to the goods or services for which the mark is registered, whereas the second word, PICTURES, would be seen as being descriptive of most of the goods and services offered by the opponent, and, in any event, is a commonly used word in this field and therefore non-distinctive. To my mind, the earlier mark **has at least an average degree of inherent distinctiveness**. The opponent has shown that it has made extensive use of its marks in the UK in relation to the production of television programmes and has won numerous awards for its work. **As such it has an enhanced degree of distinctives through use in relation to these services.**

Likelihood of confusion

47) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public including businesses who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay at least a medium degree of attention to the selection of goods and services in classes 9 and 38. Whilst in respect of the services in class 41 the average consumer is likely to pay a medium to high degree of attention to the selection of the services.
- the marks of the two parties have a high degree of similarity.
- the opponent's mark has at least an average degree of inherent distinctiveness and can benefit from an enhanced distinctiveness through use in relation to the production of television programmes.
- When comparing the goods and services of the two parties I found the following in respect of the applicant's specification:

the following class 9 goods are highly similar "electronic memory devices;"

the following class 9 goods are similar to a medium /low degree "computer software; programmed-data-carrying electronic circuits;"

the following class 9 goods are not similar "computer hardware; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic control apparatus; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards"

the services of the applicant in class 38 are complementary to the opponent's services and so are similar to a low degree.

the following services in class 41 were identical "Publication of electronic books and journals online".

the following services in class 41 were not similar "arranging and conducting of workshops and seminars; arranging and conducting of congresses"

the following services in class 41 were similar to a low degree organization of exhibitions for cultural and educational purposes".

48) I note that in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

49) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

50) In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

51) I also consider the issue of indirect confusion, and take into account the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

52) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

53) In view of all of the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused, directly or indirectly, into believing that the goods and services identified as being identical, highly similar or similar to a low degree and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in respect of all the goods and services in listed below:**

- In class 9: computer software; electronic memory devices; programmed-data-carrying electronic circuits.
- In class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; satellite communication services; telecommunications gateway services.
- In class 41: Publication of electronic books and journals online; organization of exhibitions for cultural and educational purposes.

54) In view of all of the above, and allowing for the concept of imperfect recollection, there is no likelihood of consumers being confused, directly or indirectly, into believing that the goods and services identified below as being not similar applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore fails in respect of the following:**

- In class 9: computer hardware; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic control apparatus; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards.
- In class 41:arranging and conducting of workshops and seminars; arranging and conducting of congresses.

55) I next turn to the ground of opposition under section 5(3) which reads:

“5. (3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

56) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

57) The first hurdle is the issue of reputation as set out at points (a) and (b) above. The onus is upon the opponent to prove that its trade marks enjoy a reputation or public recognition. Earlier in this decision I found that the opponent had provided evidence that it had a reputation in its LIME PICTURES mark UK 2439772 in respect of television programmes. As such it gets over the first hurdle of reputation in respect of mark UK 2439772.

58) The opponent also contended that its mark had reputation in education as a result of the storylines in its programmes and the awards it has won for highlighting social issues within its programmes. Mrs Moss-McGrath contended:

“In particular, we are not saying that the reputation for the television programmes automatically transfers to the LIME PICTURES trade mark, but certainly it is getting that level of exposure where we could reasonably ask to infer that there is a reputation for Lime Pictures for the television programmes. We would also say that that extends to the education campaigns that spin out of these television programmes. We have evidence there as well, which I think is at Exhibit AP/4 made by Ms. Phillips. That really refers to the different educational programmes, some of which are run in line with Government agencies I understand. These are very important to the client. The quality of the programmes allows it to make these educational statements and allows it to have these educational campaigns. That is very important to it. The client is particularly concerned that another company coming along and creating content under an almost identical trade mark could have genuine damage to its reputation for its programmes but also in terms of the educational campaigns as well.”

And:

“Those awards are not only for the television content -- the programmes themselves -- but are for the educational campaign. We have awards for example from MIND; the National Diversity Awards; the UK Sexual Health Awards; and Stonewall. These are very important to the opponent. Its ability to preserve the reputation that its trade mark has in the marketplace is very important to it. We would say that given the high degree of similarity between the parties' trade marks there is a clear link between LIME PICTURES and LIME when you take all of the other factors into consideration. I think the reputation that Lime Pictures has, not only for its television programmes and films but also its education campaigns over a period of time, is important. The opponent's concern is that there is a risk to its reputation and that it could be damaged. The reputation of the Lime Pictures brand in respect of those services could be damaged if Lime is granted this registration and produces television programmes under that branding. We would certainly also argue that the reputation that Lime Pictures has has been developed over a long period of time, and granting Lime Partners a registration for LIME for the creation of television, film content and the like would take advantage of the reputation that the opponent has worked very hard to create over a number of years.”

59) Whilst I accept that the opponent has won awards for raising social issues within the storylines of its programmes, I do not believe that this amounts to providing education services. Having a topical subject as part of a storyline does indeed raise awareness of an issue, however the programme is still entertainment and the opponent has not provided evidence that its clients, the broadcasters, have been educated in any way. Even if I were to accept that the general public were the clients of the opponent, it is hard to imagine, in the absence of evidence, how episodes of “The Only way is Essex” or Life on Marbs (Marbella)” would be perceived as providing educational services rather than be seen as simply entertainment. To my mind, the opponent can only rely upon its reputation for television programmes.

60) I next consider whether the public will make a link. In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual

similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

61) In C-252/07 *Intel Corp* [2008] ECR I-8823 at paragraph 42 the court set out the factors used to assess a link. Those factors include:

the degree of similarity between the conflicting marks;

the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

the strength of the earlier mark’s reputation;

the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;

the existence of the likelihood of confusion on the part of the public.

62) Earlier in this decision I found that the opponent’s mark LIME PICTURES is similar to the mark sought to be registered by the applicant to a high degree. The opponent’s mark LIME PICTURES has an average degree of inherent distinctive character but can benefit from an enhanced distinctiveness through use in relation to television programmes. I must now turn to consider whether the services in class 38 which I found to be similar to a low degree to the opponent’s class 41 services would be linked to the opponent if the mark in suit were used upon them. For ease of reference these services in Class 38 are: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and

illustrations over a global computer network; transmission of data, audio, video and multimedia files; satellite communication services; telecommunications gateway services.

63) To my mind, the opponent's reputation is inextricably linked to the provision of television programmes. Therefore, to my mind the average consumer would immediately link services connected with the provision of broadcasting services and the provision of telephone communications with the opponent. Phones are capable of connecting to the internet and therefore receiving television programmes and so I regard all the services set out in the paragraph above to relate to broadcasting services.

64) However, I do not believe that the goods applied for in class 9 or the services in class 41 are in any way similar to the provision of television programmes. Therefore, despite the similarity of the marks I do not accept that the average consumer would immediately link goods such as computers etc in class 9 or services connected with the provision of publications online, seminars, workshops and exhibitions with the opponent.

65) Because the relevant public would make the link between the use of the mark in suit upon the services in class 38 for which it is sought to be registered, there will inevitably be dilution of the opponent's mark, and, depending on the quality of the applicant's services, detriment. **The ground of opposition under section 5(3) succeeds in respect of the applicant's specification in class 38.**

66) Because the relevant public would not make the link between the use of the mark in suit upon either the goods in class 9 nor the services in class 41 for which it is sought to be registered, there will be no dilution of the opponent's mark and no possibility of detriment. **The ground of opposition under section 5(3) fails in respect of the applicant's specification in class 9 and 41.** The reason why the opponent is less successful than under section 5(2)(b) is because under the earlier test I was taking into account notional use for all the goods and services for which the mark is registered, whereas under section 5(3) I have to consider the opponent's actual reputation which is quite narrow.

CONCLUSION

67) The opposition under sections 5(2)(b) and 5(3) are only partly successful. Overall the opposition is successful in respect of the following goods and services:

- In class 9: computer software; electronic memory devices; programmed-data-carrying electronic circuits.
- In class 38: Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; satellite communication services; telecommunications gateway services.
- In class 41: Publication of electronic books and journals online; organization of exhibitions for cultural and educational purposes.

68) The opposition failed in respect of the following goods and services:

- In class 9: computer hardware; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic control apparatus; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards.
- In class 41: arranging and conducting of workshops and seminars; arranging and conducting of congresses.

COSTS

69) As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 16th day of August 2019

George W Salthouse
For the Registrar,
the Comptroller-General