

O-507-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3016037  
IN THE NAME OF GARY JONES  
FOR REGISTRATION OF THE TRADE MARK

MAGIKANA

AND

OPPOSITION THERETO UNDER NO 401299  
BY BAUER RADIO LIMITED

## Background

1. Application no 3016037 was filed on 30 July 2013, stands in the name of Gary Jones (“the applicant”) and seeks registration of the trade mark MAGIKANA in respect of a range of services in class 41 of the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).
2. Following publication of the application in *Trade Marks Journal* 2013/036 on 6 September 2013, Notice of opposition was filed by Bauer Radio Limited (“the opponent”). The opposition is founded on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) based on the following trade marks and sign:

Marks and grounds	Dates	Specification relied upon
2147048 Sections 5(2) and 5(3) MAGIC	Filing date: 3 October 1997 Date of entry in register: 7 June 2002	Services in Classes 38 and 41
2281117 Sections 5(2) and 5(3) MAGIC	Filing date: 18 Sept. 2001 Date of entry in register: 7 January 2005	Services in Classes 35, 38 and 41:
2405032 Section 5(2) and 5(3) 	Application date: 27 October 2005 Date of entry in register: 1 June 2007	Goods in Class 16: Services in Classes 38 and 41
2542123 (series of 2) Sections 5(2) and 5(3) MAGIC 105.4 	Filing date: 17 March 2010 Date of entry in register: 3 Sept. 2010	Goods in Classes 9 and 16 Services in Classes 38 and 41
MAGIC Section 5(4)	Use claimed since July 1990 throughout the UK	“the activities of a radio station, which includes radio broadcasting and radio entertainment services”

3. The applicant filed a counterstatement in which he denies the claims made.
4. Only the opponent filed evidence. It also filed submissions in lieu of attendance at a hearing. The applicant did not file written submissions nor did he seek a hearing. I therefore make this decision after a careful review of all the papers before me.

### **Decision**

5. I intend to deal first with the grounds brought under section 5(2)(b) of the Act, which states:

“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.”

6. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. The opponent relies under this ground on the four marks shown above at paragraph 2. As can be seen from the dates shown, they are earlier marks within the meaning of the Act. Whilst three of them had been registered for more than five years at the date the application was published, the applicant indicated in its counterstatement that he did not put the opponent to proof of their use. The opponent is therefore entitled to rely on each of its marks in respect of all the goods and services for which they are registered.

8. The following principles 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.

## The principles

“(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, in certain circumstances, 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 causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.”

9. Taking the above case law and principles into account, the test I have to apply in considering an objection under section 5(2)(b) is whether there are similarities in the respective marks and goods and services which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed.

### **Comparison of the respective goods and services**

10. 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”.

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

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

12. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated:

“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”.

13. Whilst the opponent has indicated in its notice of opposition that it relies on its earlier marks for each of the goods and services for which they are registered, I intend to begin the comparison on the basis of the respective services as registered and applied for in Class 41 only. For ease of reference, the services to be compared are as follows:

Earlier marks	Application
<p>Radio entertainment services; none relating to magic (2147048 and 2281117)</p> <p>Music, radio, entertainment services; inter-active information relating to music and radio broadcasting provided on-line from computer databases or the Internet; information relating to music and radio broadcasting provided on-line from computer databases or the Internet; provision of information relating to music and radio broadcasting for access via communication and computer networks; organization of competitions and awards through a radio broadcasting station; organization, conducting, production of shows, events, displays and parties all relating to a music radio broadcasting station (2405032)</p> <p>Publishing services; services relating to the publication of printed matter, periodical publications, printed publications, books and magazines; publication of material which can be accessed from databases or from the Internet; interactive information relating to education, entertainment, sport and cultural activities provided on-line from computer databases or the Internet; information relating to education, entertainment, sport and cultural activities provided on-line from computer</p>	<p>Special event planning; Entertainment in the nature of ethnic festival; Music festival services; Entertainment in the nature of ethnic festival; Cultural activities; Cultural services; Organisation of entertainment and cultural events; Organisation of events for cultural, entertainment and sporting purposes; Providing cultural activities; Sporting and cultural activities; Arranging of conferences relating to cultural activities; Arranging of conventions for cultural purposes; Arranging of demonstrations for cultural purposes; Arranging of exhibitions for cultural purposes; Arranging of festivals for cultural purposes; Exhibitions (arranging-) for cultural purposes; Festivals (organisation of-) for cultural purposes; Fetes (organisation of-) for cultural purposes; Music festival services; Organising events for cultural purposes; Organization of events for cultural purposes; Organization of shows for cultural purposes; Organizing cultural and arts events; Ticket reservation and booking services for entertainment, sporting and cultural events.</p>

<p>databases or the Internet; provision of information relating to education, entertainment, sport and cultural activities for accessing via communication and computer networks; electronic publishing. Organisation of competition and awards; arranging and conducting competitions; arranging and conducting award ceremonies; presentation of awards for achievement; education and training services; arranging and conducting courses, conferences, exhibitions, events and seminars; organising, conducting, production of shows, events, displays, and parties; organisation of events for cultural, entertainment and sporting purposes; organisation of competitions; organisation of sporting competitions and sports events; radio broadcasting entertainment services; television broadcasting entertainment services; radio entertainment services; television entertainment services; publication of printed matter; advisory and consultancy services relating to the aforesaid (2542123)</p>	
--	--

14. In his counterstatement the applicant submits:

““Magikana is a small, independent, non-profit spiritual and musical gathering in a very remote mountain farm in Llanddewi Brefi, Cerigidion. We have been operating for the past 12 years and we cater for families and artists to come together once a year in the beautiful Cambrian mountains and celebrate through a diverse selection of holistic, spiritual and tribal activities. We are a non-commercial activity based around donations and help from the local community. Our following is <500 people. We are a unique spiritual and ethnic festival experience that involves camping with families, nature trekking and enjoying music in a remote valley.”

He goes on to submit (his emphasis):

“As can be seen, **Magikana is an ethnic and cultural festival, none related to the broadcast industry, or media of any kind.** In fact even music is a sub component of our product.

**The opponents list of services are all related to media, radio broadcast, and broadcast related events.**

The opponent's services within the class 41 are exclusively **Radio Entertainment Services; NONE RELATING TO MAGIC.**

Our services are strictly concerning cultural gatherings and music festivals of an ethnic nature.”

15. In its written submissions dated 30 September 2014, the opponent states:

“By way of example only, the Opponent's earlier registration no. 2405032 covers “*music entertainment services*” and “*organisation of shows, events... all relating to a music radio broadcasting station*” in Class 41 which are identical and highly similar to “*music festival services*” claimed by the Applicant in Class 41. Additionally, the Opponent's earlier registration no. 2542123 covers “*organisation of events for cultural, entertainment and sporting purposes*” in Class 41, and the same services is claimed in the Application. Further examples and analysis are found in the documents already on file, in particular the Statement of Grounds and submissions of 20 June 2014.”

16. The statement of grounds attached to the Notice of opposition does not in fact give any further examples or analysis: the opponent merely states that the application “include[s] the services which are identical with or similar to those goods/services for which the Opponent's earlier marks are protected.” In its submissions dated 20 June 2014, the opponent states the services of the application are identical and similar to those of the earlier marks. It submits:

“It is submitted that the services in the Application are identical and similar to those covered by the Earlier Rights. Indeed, in the Applicant's counterstatement they make reference to their use of the mark in relation to musical gatherings. These are the exact same services covered by the Earlier Rights, for example “*music entertainment services*” are covered by No. 2405032.

Furthermore, the uses and users of the goods and services are identical, being the general public. The trade channels through which the services are advertised would be identical. As such, the services at issue are competitive.

The Application covers services that are both of core interest to the Opponent and that directly overlap with the Earlier Rights. Although the Class 41 specification of the Application contains a number of terms, all are closely tied to arranging and running events, particularly musical and cultural events, and therefore the specification is not as broad as it first appears. By way of example only, the terms covered by the Application are all identical, or at least highly similar, to services covered by the Earlier Rights, for example “*music, radio, entertainment services; organization, conducting, production of shows, events, displays and parties all relating to a music radio broadcasting station*” covered by UK No. 2405032 and “*arranging and conducting courses, conferences, exhibitions, events and seminars; organising, conducting, production of shows, events, displays and parties; organisation of events for cultural, entertainment and sporting purposes*” covered by UK No. 2542123.”

17. Whilst both parties' submissions include references to the services actually provided by each of them, I have to make the comparison under this ground on a notional basis taking into account the specifications of the four earlier marks as registered and for which the application has been made.

18. The applicant's *special event planning* I find to include, and therefore to be identical to the opponent's *organization, conducting, production of shows, events, displays and parties all relating to a music radio broadcasting station (2405032)* and *arranging and conducting...events and organising, conducting, production of ...events and organisation of events for cultural, entertainment and sporting purposes (2542123)*.

19. The applicant's *entertainment in the nature of ethnic festival and Music festival services* I find to be included within, and therefore identical to the opponent's *Music, ...entertainment services (2405032)* and *organisation of events for cultural, entertainment...purposes (2542123)*.

20. The applicant's *Cultural activities, Cultural services; Organisation of entertainment and cultural events; Organisation of events for cultural, entertainment and sporting purposes; Providing cultural activities; Sporting and cultural activities; Arranging of conferences relating to cultural activities; Arranging of conventions for cultural purposes; Arranging of demonstrations for cultural purposes; Arranging of exhibitions for cultural purposes; Arranging of festivals for cultural purposes; Exhibitions (arranging-) for cultural purposes; Festivals (organisation of-) for cultural purposes; Fetes (organisation of-) for cultural purposes; Organising events for cultural purposes; Organization of events for cultural purposes; Organization of shows for cultural purposes; Organizing cultural and arts events;* I find to be identical to the opponent's *Radio entertainment services: none relating to magic (2147048 and 2281117) Music, radio, entertainment services (2405032)* and *arranging and conducting courses, conferences, exhibitions, events and seminars; organising, conducting, production of shows, events, displays, and parties; organisation of events for cultural, entertainment and sporting purposes; organisation of competitions; organisations of sporting competitions and sports events; radio broadcasting entertainment services; television broadcasting entertainment services; radio entertainment services; television entertainment services (2542123)*. I find these services of the opponent are highly similar if not identical to the applicant's only other remaining service, *Ticket reservation and booking services for entertainment, sporting and cultural events*. This is because many such events require those who wish to attend or take part to obtain a reservation and/or ticket and such services are part and parcel of the organisation and provision of such events.

### **The average consumer and the nature of the purchasing process**

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

22. 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.”

23. As submitted by the opponent, the services are such as are purchased by the general public. They are services which are widely available and for which the visual aspects of the mark are likely to come to the fore though not to the extent that the other aspects can be ignored, particularly where those services are provided by e.g. radio broadcasting. However they are selected, the average consumer is likely to take a reasonable, though not the highest, degree of care with the purchase.



### **The comparison of the respective marks**

24. 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*:

“.....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.”

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

26. For ease of reference, the marks to be compared are as follows:

Opponent's earlier marks	Applicant's mark
<p>MAGIC</p>  <p>MAGIC 105.4</p> 	<p>MAGIKANA</p>

27. The applicant submits:

“The trademark Magikana is completely different to the opponents (sic) trademark Magic. Magic contains 5 letters, Magikana contains 8 letters. Of these letters only the prefix Magi uses the same letters. It (sic) a 50% difference in characters used. Magikana contains 4 syllables MA-GI-KA-NA, compared with MA-GIC for the opponent, making them phonetically unique. Our name Magikana is inspired on two words MAGI (latin for sorcerer/wizard), and Arcana (spiritual knowledge). The word reflects a bridge between the Magi (wizards) and the Kana (knowledge).

Magikana is a completely invented word for our concept which does not already exist in the trademark database. Magic is a generic word, found in the dictionary and used in countless forms and established trademarks.”

28. The opponent submits:

“The Mark of the contested application incorporates almost the whole of the earlier registered mark MAGIC by using the prefix “MAGI”. The element “MAGIK” used in the later mark is visually almost identical to the Opponent’s mark MAGIC and is phonetically identical. As a result of subsuming the Opponent’s mark, both the respective marks have a dominant element “MAGIC” and are visually highly similar. The inclusion of the suffix “ana” is insufficient to distinguish the Mark from those of the Opponent. The respective marks overall are highly visually, phonetically and conceptually similar. The Mark as a whole is likely to be considered as a sub-brand of the Opponent.”

29. Each of the opponent’s marks consists of the word MAGIC, whether alone or with the numerals 105.4 and whether in plain block capitals or in a cursive script with the tittle of the letter i in a contrasting colour. Whilst the stylisation in some of the marks forms part of the overall impression, it is the word MAGIC which plays a far greater relative role. In his evidence filed on behalf of the opponent, Steven David

Parkinson, its Managing Director, states that 105.4 is the frequency on which the opponent broadcasts the radio station it produces. In respect of radio broadcasting services, the 105.4 element will not be distinctive. For other services it has no meaning but I consider that in each case, it is the word MAGIC which is the dominant and distinctive element of the mark. The applicant's mark consists of a single word no part of which is highlighted in any way. It has no separate elements and its distinctiveness rests in its whole.

30. Each of the respective marks begins with the same four letters which leads to a degree of visual similarity between them. The following (fifth) letters are a C or K which are visually striking in their difference. The applicant's mark is a longer word with a different ending and these lead to further visual differences. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends but this does not mean it is an invariable rule. Considered as wholes, as I am required to do, I find there is a low degree of visual similarity between the respective marks.

31. Aurally, there is a degree of similarity between the respective marks given the likely pronunciation not only of the first four letters in each mark but also because of the likely identical pronunciation of the letters C or K which immediately follow them. There are aural differences created by the respective lengths of and syllables making up the marks and their different endings. It is also possible that some may articulate the numerals within the opponent's series of two marks which would lead to further differences. On balance, I find the respective marks to be aurally similar to a moderate degree.

32. The opponent's marks consist of the word MAGIC. This is defined, in the Collins Online dictionary in the following way:

“noun:

the art that, by use of spells, supposedly invokes supernatural powers to influence events; sorcery: the practice of this art;

the practice of illusory tricks to entertain other people; conjuring:

any mysterious or extraordinary quality or power ⇒ the magic of springtime:

adjective:

of or relating to magic ⇒ a magic spell;

possessing or considered to possess mysterious powers ⇒ a magic wand;

unaccountably enchanting ⇒ magic beauty;

(*informal*) wonderful; marvellous; exciting;

33. Despite Mr Jones' explanation, there is no evidence to suggest the average consumer would be aware of the intended meaning behind the coining of his mark. I agree that the average consumer is likely to see it as an invented word but one with

no particular meaning. That said, I do not exclude the possibility that some may see it as alluding in some way to magic. For those who do so, the marks are conceptually similar to a moderate degree but for most, the position will be neutral.

### **The distinctiveness of the earlier marks**

34. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV supra*, 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).”

35. The opponent has filed evidence in the form of a witness statement of Steven David Parkinson, referred to above, who states he has been associated with the company for more than eight years. Mr Parkinson states that the opponent produces and broadcasts a radio station based in London. The station first aired on 9 July 1990 and has approximately 3 million listeners across the UK. He states this is approximately 4.8% of the UK population and 36% of the London population which is where it has its “core listeners”.

36. Mr Parkinson gives the following details of turnover and advertising spend under the trade marks:

YEAR	TURNOVER	ADVERTISING
2008	17,491,382	1,850,447
2009	16,398,878	2,120,259
2010	15,720,496	1,837,640
2011	16,734,238	1,863,349
2012	15,509,114	1,738,927
2013	14,646,657	1,532,611

Not all of the figures for 2013 will be relevant given the material date in these proceedings. Indeed, much of the information and exhibits referred to and provided by Mr Parkinson date from after the relevant date in these proceedings and do not assist in showing what the position was at that date. For these reasons, I do not include it in this summary of evidence.

37. Mr Parkinson states that revenue is raised through various streams such as sponsorship of shows, on-air advertising, online advertising and through television. Advertising is said to be carried out via terrestrial television, including on ITV and Channels 4 and 5, in the press, including Closer and Grazia magazines and the Evening Standard and Metro newspapers and on billboards and buses. Some examples showing the various marks relied upon, which date from before the material date, are included within the exhibits at SP06, SP07 and SP08. The station has also run various competitions giving away 6-figure cash prizes in 2006 and 2007 which is said to have attracted press attention.

38. The word MAGIC, as defined above, has a laudatory meaning and the earlier marks have a relatively low degree of inherent distinctiveness for the services for which they are registered. They are registered for a wide range of services. Whilst the opponent has filed evidence showing use of its marks, that evidence which dates from before the relevant date refers overwhelmingly to its use as a radio station. I consider it is sufficient to show the distinctive character of the earlier marks has been enhanced to a moderate degree through use in relation to radio broadcasting services only.

### **Likelihood of confusion**

39. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. I also have to factor in the distinctive character of the earlier mark as the more distinctive they are the greater the likelihood of confusion. I must also keep in mind the average consumer for the 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 on the imperfect picture of them he or she has retained in mind.

40. I have found the respective services are identical or highly similar; they are such as are used by the general public who will take a reasonable but not the highest degree of care over the purchase; the respective marks have a low degree of visual similarity, a moderate degree of aural similarity and, at best, a moderate degree of conceptual similarity; the earlier marks are of low inherent distinctiveness which has been enhanced through their use to a moderate degree in respect of radio broadcasting services.

41. Taking all matters into account and despite the enhanced degree of distinctiveness in the marks in respect of radio broadcasting services, I find there is no likelihood of direct or indirect confusion between the respective marks. Whilst both begin with the same four letters, the differences between them outweigh the

similarities even where identical services are concerned bearing in mind the reasonable degree of care that will be taken in their selection. Those differences are more apparent given that the mark MAGIKANA will be seen as an invented word whereas MAGIC is an ordinary word in everyday use. In view of my finding in respect of identical services, I do not intend to go on to consider the position in respect of the opponent's other goods and services as it can be in no better position under this ground in respect of them.

### **The objection under section 5(3) of the Act**

42. Section 5(3) of the Act states:

“(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 Community trade mark or international trade mark (EC), in the European Community) 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.”

43. The opponent claims that the applicant's use of its mark would:

“take unfair advantage of or be detrimental to the character or the repute of the Opponent's trade mark by suggesting a link between the Applicant's sign and the Opponent's trade mark in the mind of an average consumer. Consumers seeing the sign MAGIKANA are likely to believe that the services covered by the Applicant's mark are organised, sponsored or otherwise endorsed by the Opponent or a related undertaking when in fact this is not the case. The association of the mark with the Opponent's long and established reputation as a provider of radio and television broadcasting services together with the activities of a radio station is intended to annex and harness the reputation and to encourage consumers to acquire or (sic) the services of the Applicant in the mistaken belief it is these are (sic) the services of the Opponent. This takes unfair advantage of the character and repute of the Opponent's trade mark by reducing the amount of marketing required to promote the Applicant's services. Traders may choose to purchase radio and/or television advertising from the Applicant which they might otherwise have placed with the Opponent and thus the use of the contested mark may also affect the economic behavior (sic) of the public. In addition, the use of the Opponent's trade mark in relation to services over which they have no control or influence is detrimental to the character and repute of the Opponent's trade mark.”

44. Under this ground, the opponent relies on the same four earlier marks as set out in paragraph 2 above. It claims to have used its marks in relation to the activities of a radio station, which includes radio broadcasting and radio entertainment services since July 1990 and in relation to television broadcasting and television entertainment services since September 1991. As indicated above, its evidence shows it has a reputation for radio broadcasting services.

45. 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, *Addidas-Salomon*, [2004] ETMR 10 and Case 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 likelihood 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*).

46. 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).”

47. In *Intel Corporation Inc v CPM (UK) Ltd* (C-252/07) (“Intel”) the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstance of the case...

42 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.”

48. I take note that both the CJEU and the GC have reiterated the comment made in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 (albeit in relation to

section 10(3)) that the purpose of the Regulation is not to prevent registration of any mark which is identical or similar to a mark with a reputation and am mindful of the comments of Patten J in *Intel Corporation Inc v CPM United Kingdom* [2006] EWCH 1878 where he stated:

“But the first step to the exploitation of the distinctive character of the earlier mark is necessarily the making of the association or link between the two marks and all that Neuberger J is, I think, saying in this passage [Premier Brands at p789] is that the existence of a later mark which calls to mind the earlier established mark is not sufficient to ground an objection under s.5(3) or s10(3) unless it has one or other of the consequences specified by those provisions. It must be right that the making of the association is not necessarily to be treated as a detriment or the taking of an unfair advantage in itself and in cases of unfair advantage it is likely to be necessary to show that the making of the link between the marks had economic consequences beneficial to the user of the later mark.”

49. Although the issue of the effect on economic behaviour arose in the above case in the context of detriment or dilution, it is, I believe, reasonable to infer that similar considerations would also arise in the context of the question of unfair advantage. Indeed in *Electrocoin Automatics Limited v Coinworld Limited and Others* [2005] FSR 7, Mr Geoffrey Hobbs Q.C, sitting as a Deputy Judge stated:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, “the link” established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

50. In *C A Sheimer (M) Sdn Bhd’s TM Application (VISA)* [2000] RPC 484 Geoffrey Hobbs Q.C. sitting as the Appointed Person considered whether Sheimer’s mark “would, without due cause:

(iv) take unfair advantage of the distinctive character or repute of Visa International’s earlier trade mark”.

In setting out his finding, he stated:

“I think it is clear that Sheimer would gain attention for its products by feeding on the fame of the earlier trade mark. Whether it would gain anything more, by way of a marketing advantage, than that is a matter for conjecture on the basis of the evidence before me. Since I regard it as quite likely that the distinctive character or reputation of Visa International’s earlier trade mark would need to increase the marketability of Sheimer’s products more substantially than that in order to provide Sheimer with an unfair advantage of the kind contemplated by Section 5(3) I am not prepared to say that requirement (iv) is satisfied.”

51. I must be satisfied, therefore, that, for those people who make a link between the respective marks, the link they make affects their economic behaviour and, if so, that

the reputation of the earlier mark is transposed to the later mark with the result that marketing and selling of the applicant's services becomes easier.

52. As set out above, the opponent has shown it has been broadcasting a radio station under the mark MAGIC since 1990. There is no evidence it has ever used anything other than the word MAGIC within its trade marks (i.e. it has not changed or otherwise adapted the word MAGIC itself) and the differences between the respective marks lead me to find that the relevant consumer would not make a link between them. Even if I am wrong in this, I do not consider that the applicant would gain any unfair advantage through the use of his mark. It is not clear to me exactly what advantage he would gain and, furthermore, there is no evidence of any intention on his part nor any other added factor that would support the opponent's claim under this ground. In relation to dilution, I can see no reason why the capacity of the earlier marks to distinguish the opponent's services would be diminished to any extent, and certainly not one that would have any impact on the economic behaviour of the relevant public. That being the case, the opposition brought under section 5(3) of the Act fails.

### **The objection under section 5(4) of the Act**

53. Section 5(4)(a) of the Act states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

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

54. Under this ground, the opponent relies on its use of the word MAGIC since July 1990 in respect of “the activities of a radio station, which includes radio broadcasting and radio entertainment services”.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent’s goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this

case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

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

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

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

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

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

59. In his counterstatement, the applicant states: "we have been operating for the past 12 years..." but does not state that he has done so under the mark in suit nor has he filed any evidence which allows me to establish whether, and if so, he has made use of his mark before the date of the filing of his application for registration. I intend to consider the position as at the date of filing of the application which is 30 July 2013.

60. Also in his counterstatement, the applicant accepts that the opponent "is a large broadcast radio station". Given the evidence it has filed which supports this and which shows use of the sign MAGIC, there can be little doubt that it has the necessary goodwill to found an action in passing off and the first requirement is met.

61. The second requirement refers to deception or confusion. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

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

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

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

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

62. In my consideration of the objection under section 5(2)(b) above, I found that there was not a likelihood of confusion between the applicant's mark and the opponent's earlier marks MAGIC/MAGIC 105.4. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

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

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

64. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC), Mr Iain Purvis QC, as a Recorder of the Court stated that:

“54. Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–7 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.”

65. As I indicated earlier, it is possible (I put it no higher than that) that there may be some people who will see the applicant’s mark as alluding to MAGIC. This may lead them to wonder whether there is a trade connection between the two parties but I see no reason to support a finding that a substantial number will make any such connection. I consider the opponent has failed to satisfy the second requirement of passing off. That being so, the objection under section 5(4)(a) fails.

## **SUMMARY**

66. The opposition has failed under each of the grounds on which it was brought.

67. The applicant, having succeeded, is entitled to an award of costs in its favour. I take into account that the opponent filed evidence and whilst some was of no relevance to the matters I had to determine, it would have taken some time to review. The opponent also filed written submissions in lieu of attendance at a hearing. I also note that the applicant represented himself and that his involvement was confined to the filing of a brief counterstatement. The fact that the applicant represented himself means that he is not entitled to an award of costs from the usual scale but rather is entitled to a proportion of it. I do not consider it necessary or proportionate to make further enquiries as to the costs to which the applicant has been put. In all the circumstances, I consider the sum of £500 to be a reasonable award to reflect the time and effort involved in defending his application.

68. I order Bauer Radio Ltd to pay Gary Jones the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 1st day of December 2014**

**Ann Corbett  
For the Registrar  
The Comptroller-General**