# O/1055/25

**CONSOLIDATED PROCEEDINGS**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3654091**

**BY FIFTH SEASON, LLC**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO**

**UNDER NO. 428206 BY**

**CANAL+ THEMATIQUES**

**AND**

**IN THE MATTER OF TRADE MARK NOS 901217546 & 901712876**

**IN THE NAME OF CANAL+ THEMATIQUES**

**AND**

**IN THE MATTER OF THE APPLICATIONS FOR THE REVOCATION THEREOF UNDER NOS. 504551 & 504552 BY**

**FIFTH SEASON, LLC**

## BACKGROUND AND PLEADINGS

1. These consolidated proceedings concern an opposition to the application that now stands in the name of Fifth Season, LLC ("Fifth Season") to register **FIFTH SEASON** ("the opposed mark") as a trade mark in the United Kingdom for goods and services in Classes 9, 35, 36, 38 and 41. A full list of the goods and services can be seen in the table in paragraph 85 of this decision.

2. They also concern revocation actions brought against two marks owned by Canal+ Thématiques ("Canal+"), one of which is relied upon in the opposition. I shall set out the pertinent details of these registrations shortly.

### The Opposition

3. The application to register **FIFTH SEASON** as a UK trade mark ("UKTM") was originally made by WME IMG, LLC, Fifth Season's predecessor in title. For the purposes of simplicity, I shall refer to the applicant for this mark as "Fifth Season" even when describing events that took place before the assignment of the application to Fifth Season. Nothing turns on this.

4. The application has a filing date of 10 June 2021. It was accepted and published for opposition purposes on 13 August 2021.

5. On 15 November 2021, the application was opposed by Canal+. The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and concerns all the goods and services in the application. Canal+ relies on UK Trade Mark ("UKTM") No. 901217546 ("the 546 mark"), **SEASONS**, which is a UK comparable mark with a filing date of 23 June 1999 and a registration date of 22 June 2000. It claims seniority from UKTM No. 2056723, which has a filing date of 15 February 1996 and a priority date of 5 December 1995. By virtue of this priority date, the 546 mark qualifies as an earlier mark under section 6(1)(a) of the Act. It is registered for the following services, all of which are relied on:

> *Class 38*
> *Communications via Hertzian wave, satellites or cable; issuing of documents, broadcasting of films and television programmes; communications services,*

*namely news and information agencies; radio broadcasting, communications by telegrams or communications by telephone; transmission of information by teleprinter; transmission of information using all means of communications and telecommunications for public information.*

*Class 41*

*Production of motion pictures, television series and television broadcasts; production of shows; theatrical agencies; rental of motion pictures, film recordings, sound recordings and stage set accessories; production of radio and television programmes; arranging of competitions for education or entertainment; arranging and conducting of congresses, colloquiums and conferences.*

6. Under section 5(2)(b), Canal+ claims that the marks are highly similar, as the dominant and distinctive element of the opposed mark is “SEASON”, which is visually, phonetically and conceptually highly similar and almost identical to the 546 mark. It adds that the marks as a whole are similar. Canal+ also claims that the goods and services are identical or similar, and that there is a likelihood of confusion, including a likelihood of association, on the part of the public.

7. Under section 5(3), Canal+ claims that the 546 mark enjoys a significant reputation for all the services protected under the registration. It argues that, in view of the proximity of the goods and services and the similarity of the marks, consumers may assume that there is an economic connection between the two parties, or that they have entered into a partnership or commercial venture permitting use of Canal+’s mark. This assumption may entice customers to purchase goods and services sold under the opposed mark in the belief that they are connected in some way with Canal+’s mark.

8. Canal+ further claims that damage could occur in one or more of the following ways:

a) The opposed mark is likely to take unfair advantage of the 546 mark, with the image of the 546 mark being transferred to Fifth Season, which would benefit from the power of attraction of the 546 mark and unfairly exploit its reputation, without having made the associated investment;

b) There is a real risk of detriment to Canal+'s reputation by association, although Canal+ does not explain in any more detail how this would occur; and/or

c) There is a risk of detriment to the distinctive character of the 546 mark, reducing the ability of the earlier mark to identify Canal+'s services. This could foreseeably result in a loss of sales and change in economic behaviour of the relevant consumers.

9. On 24 January 2022, Fifth Season filed a defence and counterstatement denying the claims made and putting Canal+ to proof of use of the 546 mark. In particular, it denies that the marks are similar and argues that the differences between them generate a clearly distinguishable overall impression that precludes the likelihood of confusion. It also denies that "SEASON" is the dominant and distinctive element of the opposed mark, and that the goods and services are similar. In addition, it claims that the average consumer will pay a higher-than-average degree of attention and care during the purchasing process, and so is more likely to notice the differences between the marks in question. For these reasons, it denies that there is a likelihood of confusion between the marks.

10. Under section 5(3), Fifth Season denies that the 546 mark has a reputation and denies all other claims under this ground.

**The Revocations**

11. On 24 January 2022, Fifth Season made an application for the 546 mark to be revoked under section 46(1)(b) of the Act on the basis of non-use during the period 9 June 2016 to 8 June 2021, with an effective revocation date of 9 June 2021.

12. On the same day, it also applied for UKTM No. 901712876 ("the 876 mark") to be revoked on the grounds of non-use during the same period. The 876 mark is shown below. It has a filing date of 19 June 2000 and a registration date of 24 September 2001. The colours brown and green are claimed.


13. The 876 mark stands registered for the following goods:

*Class 14*

*Precious metals and their alloys other than for dental purposes, for goods for men; horological and chronometric instruments for men; pins of precious metal for men; watches and watch straps for men.*

*Class 18*

*Leather and imitations of leather and goods made of these materials (included in this class) for men; trunks and travelling bags for men, umbrellas for men; parasols and walking-sticks for men.*

*Class 25*

*Clothing for hunting, shooting and fishing (except rainproof clothing for women, fashion garments for women and underclothing for women); hats, footwear (except orthopaedic footwear).*

14. Canal+ denied that the 564 and 876 marks had not been put to genuine use during the periods claimed.

**HEARING AND REPRESENTATION**

15. The matter came to be heard before me by videolink on 2 May 2025. Canal+ was represented by Stephanie Wickenden of Counsel, instructed by D Young & Co LLP, and Fifth Season was represented by Jacqueline Reid of Counsel, instructed by Pennington Manches Cooper LLP.

**RELEVANCE OF EU LAW**

16. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the

European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

**EVIDENCE AND SUBMISSIONS**

17. Canal+ filed evidence in chief in the form of a witness statement from Clément Hellich-Praquin, Corporate General Counsel of Groupe Canal+, a position he has held since 2016. He confirms that the opponent is a wholly owned subsidiary of Groupe Canal+. His witness statement is dated *"this 11th day of 2024"*. I am prepared to accept that this is 11 January 2024, particularly given that the first page of the witness statement is marked *"January 2024"*. It is accompanied by 15 exhibits. Some of these exhibits were originally in French and a selection of these has been translated. There is a witness statement from Charlotte Joyce Dittner, a translator at Priory Translations Limited, dated 2 February 2024, in which she confirms that she has carried out the translations and is well acquainted with the English and French languages.

18. There is also a witness statement from Sarah Brooks, a Senior Associate and Trade Mark Attorney at D Young & Co LLP, the representative of Canal+. It is dated 11 January 2024 and is a vehicle for exhibiting information on broadcasters in the UK and Europe which produce and create a wide range of content, including podcasts and digital media, available on software applications. The companies are ITV, Sky and RTL.

19. There is no evidence from Fifth Season, but it filed written submissions dated 5 April 2024.

20. Canal+ considered that these submissions gave rise to a right to file evidence in reply. The request was granted. Mr Hellich-Praquin filed a second witness statement dated 3 June 2024. This evidence has been adduced in answer to Fifth Season's request that Canal+ provide proof that it is the rightful, legal and beneficial owner of the 546 mark, and to show that ordinal numbers (first, second, third, etc.) are commonly used within the industry and so would be perceived as non-distinctive by the average consumer. Also exhibited is a selection of website printouts and articles showing examples of multimedia content producers that stream and/or broadcast their

own content and/or the content of third parties; and multimedia content producers that have partnerships and/or affiliations with third parties to stream and/or broadcast multimedia content.

21. In her skeleton argument and during the hearing, Ms Reid made several criticisms of this evidence. Given the general nature of some of these, I shall address them here.

*Foreign language evidence*

22. Ms Reid submitted that the untranslated exhibits should be disregarded. The Tribunal's practice manual refers to the decision of Professor Ruth Annand, sitting as the Appointed Person, in *Pollini*, BL O/146/02. In that case, the Hearing Officer had been presented with a selection of invoices in Italian and consequently found himself unable to assess the nature of any protectable goodwill. Professor Annand said:

> "30. Mr Hacon told me that his researches had revealed little relevant to the issue of exhibits in a foreign language. I referred him to the Practice Direction to Part 32 of the Civil Procedure Rules, in particular, 32PD-010.2, which provides:
>
> > 'Where an affidavit is in a foreign language:
> >
> > (1) the party wishing to rely on it-
> >
> > > (a) must have it translated, and
> > > (b) must file the foreign language affidavit with the court, and
> >
> > (2) the translator must make and file with the court an affidavit verifying the translation and exhibiting both the translation and a copy of the foreign language translation.'
>
> Similar provision is made in relation to witness statements by 32PD-023.2. There is also Rule 72(1) of the Trade Marks Rules 2008 ("TMR"), which states that the registrar may require any document filed with or sent to her to be translated into English. In *Bayer AG v Harris Pharmaceuticals Limited* [1991] RPC 170, Hoffmann J. held that there is no obligation on a person

giving discovery of a document in a foreign language to provide a translation of that document.

31. Rule 55(4) of the TMR applies the practice and procedure of the High Court with regard to witness statements to proceedings in the registry. Moreover, as has been remarked recently (see, for example, Pumfrey J in *WUNDERKIND Trade Mark*, 28 November 2001) proceedings before the registrar are intended closely to resemble proceedings in court.

32. It seems to me that exhibits in a foreign language ought to be treated in the same way as the statutory declaration, affidavit or witness statement in conjunction with which they are used. Accordingly, where an exhibit is in a foreign language, a party seeking to rely on it in registry proceedings must provide a verified translation into English."

23. Ms Wickenden referred me to the decision of another Hearing Officer (Mr Oliver Morris) in *SIMPLY*, BL O/025/15. After quoting from the Tribunal's work manual and the Appointed Person's decision in *Pollini*, he said:

"17. I do not consider that either the Work Manual or Prof Annand's decision creates a hard and fast rule that a non-English exhibit to a witness statement should be automatically disregarded if it has not been translated. To do so would be to drive a cart horse through the road of common-sense. I say this because there will be a good many occasions where it is plain, on the face of the exhibit, that something can be taken from it. In these proceedings, it is plain, as Mr Rundle submitted, that at the very least a stylised version of the word SIMPLY has been used on the materials exhibited. I accept, though, that the absence of a translation means that sometimes the context of the exhibited documents may not be clear. I have reflected such concerns in my summary above, and will also come back to them later. Subject to the caution I have expressed, the non-English exhibits will not be disregarded."

24. This appears to me to be a sensible approach. The IPO provides what is intended to be a low-cost Tribunal, so that parties are not deterred from seeking, protecting or defending their intellectual property rights. Where something can be taken from the exhibits, it would seem to run counter to this policy objective to require translations.

However, where the context of any document is not clear, the party filing it runs the risk of an untranslated document not telling the story that the party intends or of the hearing officer being unable to understand its relevance. Individual hearing officers' knowledge of foreign languages will vary and it is not in the interests of fairness for the probative value of any exhibit to depend on the luck of the draw in the allocation of a hearing officer. Consequently, I shall consider the untranslated evidence from the position of someone who does not understand French. I set out below a summary of the evidence that has been filed on the question of the use made of the earlier marks and record what I have taken from it.

*The witness statement of Ms Dittner*

25. While acknowledging that Ms Dittner states that she is well acquainted with the French and English languages, Ms Reid criticised the evidence for not containing a CV or other credentials. In addition, she drew my attention to the Translator's Note accompanying the witness statement. This says:

> "1. Please note that we have left the titles of television programmes and the like in French in our English translation.
>
> 2. We believe that there may be a typing error in the penultimate line of the third paragraph of the right-hand column on page 12 of the French text, and that 'des illiers de kilomètres' should probably be 'des **m**illiers de kilomètres'. We have translated it as such in our English translation ('thousands of kilometres'; middle of page 12)."

Ms Reid submitted that this note showed that the translations had not been carried out by Ms Dittner alone, as she states in her evidence, but by more than one person.

26. I have noted above that Fifth Season filed written submissions on 5 April 2024, which was after Ms Dittner's evidence had been admitted into the proceedings. These submissions go through Mr Hellich-Praquin's evidence in chief, exhibit by exhibit, setting out its criticisms of each. It has not, however, made any submissions relating to Ms Dittner's evidence. The concerns described above were first set out in Ms Reid's skeleton argument or, in the case of the submissions on the Translator's Note, at the hearing itself. Ms Wickenden submitted that the challenge had been made too late in

the day.[1] I agree with her. As this point was raised only at the hearing, Ms Dittner has been denied the opportunity to respond to the challenge. Furthermore, I consider that it is not uncommon for individuals to use the plural "we" in a professional or corporate context. For these reasons, I dismiss this criticism.

27. Turning now to Ms Dittner's credentials, I note that her witness statement complies with the guidance in the Tribunal Manual at section 4.8.4.2:

> "… Exhibits must similarly be translated if they are to be relied upon (Pollini BL O/146/02). The translator should prepare their own witness statement, statutory declaration or affidavit stating that they are (at least) familiar with English and the other language. …"

28. Ms Reid referred to a single instance in which the translations were dismissed because the translator had not demonstrated the required expertise. This was *PURE LIFE*, BL O/0334/24, in which the Hearing Officer dismissed a translation from Croatian into English because the translator had claimed to be fluent in Russian and Ukrainian, which she had stated were 70% similar to Croatian, as they are all Slavic languages. The Hearing Officer had reasonable grounds for doubting whether the translator was able to provide an accurate translation.[2] The situation in that case was not on all fours with the situation here. Ms Dittner has said, under a statement of truth, that she works for a professional translating firm and is familiar with both English and French. I have no good reason to believe that she was not telling the truth.

29. Ms Reid also submitted that Ms Dittner (or another translator) had gone beyond what would have been expected in translating the acronym "PAF" as *"French audiovisual landscape"* and *"Seasons Hebdo"* as *"Seasons Weekly"*.[3] The translator's note says that *"the titles of television programmes and the like"* have been left in French, but Ms Reid submitted that the examples quoted showed that this had not always been the case. On inspection of the relevant exhibit, I can see that the translation includes the French title of the programme (*"Seasons Hebdo"*) followed by the translation in square brackets. In my view, this example does not go against what has been said in the translator's note: the title of the programme is there, in French.

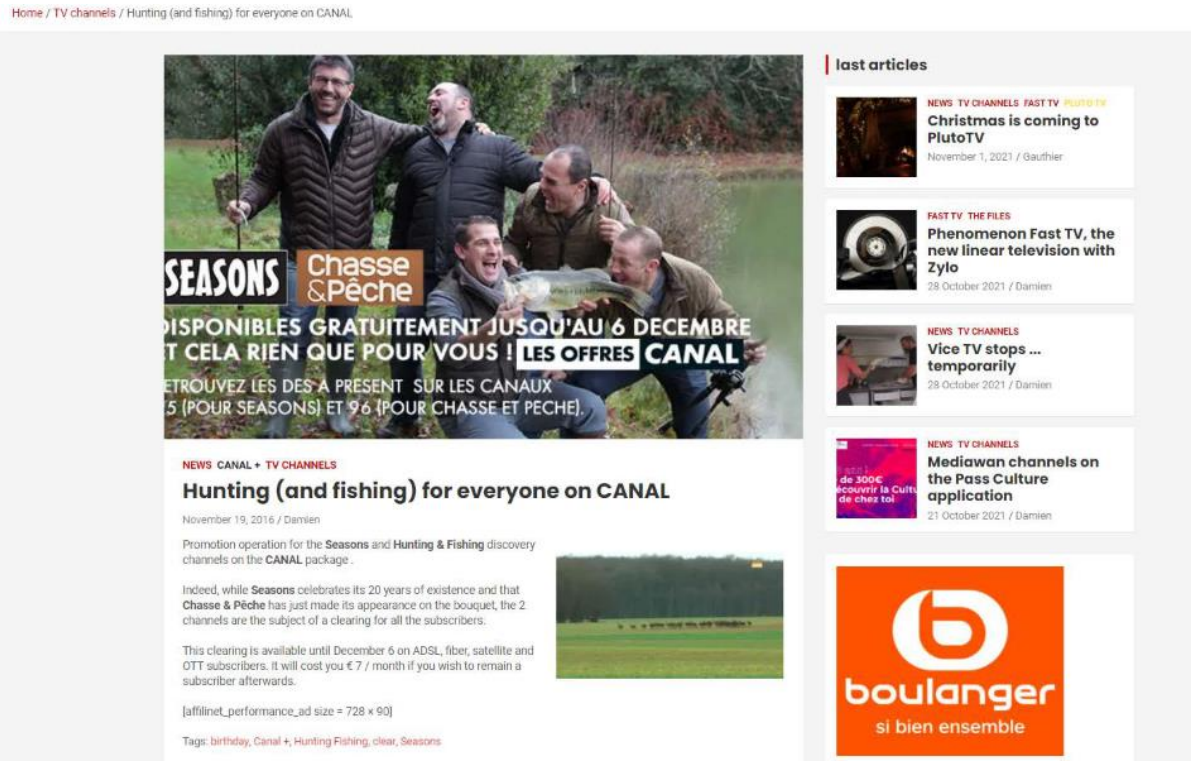
[1] Transcript, pages 17-18.
[2] See paragraphs 11 and 12.
[3] See Exhibit CJD1, Exhibit CHP3, pages 1 and 21.

This leaves the single example of the translation of "PAF". The capitalisation of the letters suggests that it is an acronym. I have dismissed the criticisms of Ms Dittner's credentials, and so I am prepared to accept that her translation of this term is reliable.

*Machine translations*

30. Ms Reid submitted that some of the English-language exhibits to Mr Hellich-Praquin's first witness statement had in fact been machine-translated. An example is the following article that appeared on the website planetecsat.com and is dated 19 November 2016.[4] The text in the picture at the top of the article is in French and I agree with Ms Reid that some of the text does not read like idiomatic English or even a literal translation carried out by a human. For example, the second paragraph is as follows:

> "Indeed, while **Seasons** celebrates its 20 years of existence and that **Chasse & Pêche** has just made its appearance on the bouquet, the 2 channels are the subject of a clearing for all the subscribers."




31. I shall treat such exhibits with caution and explain below what I take from them.

[4] Exhibit CHP2, page 2.

*The evidence of Ms Brooks*

32. Ms Reid submitted that Ms Brooks' evidence consisted of internet research carried out by other people, and so was therefore hearsay. She argued that hearsay evidence is typically given little or no weight unless it can be corroborated by witnesses or by documentary evidence. I do not think that there is much in this criticism. Ms Brooks states that the internet searches were carried out internally within D Young under her supervision.[5] The exhibit contains extracts from publications and websites of ITV, Sky and RTL (which owns a number of channels in EU Member States). Some of the website screenshots are taken from the Wayback Machine. I have no reason to believe that these are not genuine documents or websites, and I note that Ms Reid has not made such an allegation. I shall take them into account to the extent necessary for my decision.

*Evidence in reply*

33. Finally, I come to the challenge to the evidence in reply. Ms Reid had no issue with the admissibility of paragraphs 1, 2, 3 and 6 of Mr Hellich-Praquin's second witness statement and the associated exhibits, but considered that permission had not been granted for the rest of the evidence. The evidence was filed on 4 June 2024 and admitted on 13 June 2024, when the evidence rounds were closed. The evidence that Ms Reid objected to contained information on CANAL+ BUSINESS, a means of distributing television services to businesses such as hotels and retirement homes. I shall say more about this in due course. She also objected to the admission of the evidence in Exhibit CHP19, which consists of print-outs showing examples of multimedia broadcasters that broadcast or stream their own content and that of third parties, or content providers who have relationships with broadcasters or streaming services. It appears from the case file that Fifth Season did not object to this evidence at the time, or at any point until the skeleton argument was filed. In my view, the appropriate time to make the objections would have been shortly after they had been filed. I therefore dismiss this challenge although, as will be seen, the evidence to which Ms Reid objected has had no impact on the outcome of this decision. I also note that

[5] Paragraph 2.

these exhibits were not relied upon by Ms Wickenden in her oral submissions on the substantive matters.

## REVOCATION ACTION AGAINST THE 876 MARK

34. In her skeleton argument, Ms Wickenden accepted that the evidence does not show use of the 876 mark for the goods for which it is registered.[6] She stated that Canal+ no longer maintains its defence of this mark and so it shall be revoked in its entirety with effect from 9 June 2021.

## DECISION

35. I shall deal first with the revocation action against the 546 mark. As Fifth Season seeks an effective revocation date of 9 June 2021, the extent to which the action is successful has a direct bearing on the opposition, given the opposed mark's filing date of 10 June 2021.

### Revocation against the 546 mark

36. Ms Wickenden admitted in her skeleton that use had not been shown for the following services:

> *Class 38*
> *Issuing of documents; radio broadcasting, communications by telegrams or communications by telephone; transmission of information by teleprinter.*
>
> *Class 41*
> *Theatrical agencies; rental of … stage set accessories; production of radio … programmes; arranging of competitions for education or entertainment; arranging and conducting of congresses, colloquiums …*

37. The 546 mark will be revoked in respect of these services with effect from 9 June 2021.

38. The services that remain the subject of the revocation proceedings are as follows:

[6] Paragraph 19.

*Class 38*

*Communications via Hertzian wave, satellites or cable; broadcasting of films and television programmes; communications services, namely news and information agencies; transmission of information using all means of communications and telecommunications for public information.*

*Class 41*

*Production of motion pictures, television series and television broadcasts; production of shows; rental of motion pictures, film recordings, sound recordings …; production of … television programmes; arranging and conducting of … conferences.*

39. Section 46 of the Act is as follows:

"(1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the

distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or the court, except that –

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

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

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation were existing at an earlier date, that date."

40. As the 546 mark is a comparable mark, paragraph 8 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

> "(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the 'five-year period') has expired before IP completion day-
>
> (a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and
>
> (b) the references in sections 11A and 46 to the United Kingdom include the European Union.
>
> (3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day-
>
> (a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM; and
>
> (b) the references in sections 11A and 46 to the United Kingdom include the European Union."

41. The relevant period during which Canal+ must show use of the 546 mark is 9 June 2016 to 8 June 2021. For the period up to 31 December 2020, the relevant territory is the EU, while for the period from 1 January 2021 to 8 June 2021, it is the UK. Ms Wickenden admitted that the 546 mark had not been used in the UK[7] and so in practice it is the period 9 June 2016 to 31 December 2020 that I have to consider.

42. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

[7] Transcript, page 94.

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W. F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at

[36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use

if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

'19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

…

> 22. … it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.'"

*Ownership of the 546 mark*

43. The first point that Arnold LJ distilled from the case law was that genuine use should be by the proprietor, or with its consent. Mr Hellich-Praquin gave an account of the corporate history of the ownership of the 546 mark in his first witness statement. He states that a television channel called "Seasons" had been created in 1996 by a company called MultiThématiques, which merged with another company, Planète Cable, in 2020. Since 2020, the merged undertaking had used the name CANAL+ THEMATIQUES and it was a subsidiary of Groupe Canal+.[8] Fifth Season challenged this account and put Canal+ to proof that it is the rightful, legal and beneficial owner of the 546 mark. Exhibit CHP16 contains documents purported to show the chain of ownership of the 546 mark. The first of these is the application form for the EUTM from which the comparable 546 mark was derived. It shows that the application was filed in the name of MULTI THEMATIQUES. The second is a notarial certificate signed by Mr Hellich-Praquin that confirms that the aforementioned merger and name change took place on 31 January 2020. It then states that it was *"Subscribed and sworn to*

[8] Paragraph 1.

*before me on this 03 day of July, 2023"* and gives the name and seal of a notary public, Mr Edouard Fiévet. No documents are attached.

44. Ms Reid denied that the notarial certificate demonstrated that the 546 mark had been assigned. Ms Wickenden submitted that other parts of the evidence referred to the Seasons brand as part of the Canal+ group and so I should not doubt the veracity of the witness statement.[9] Dated examples can be found in the press articles in Exhibit CHP3, and the translations of those articles in Exhibit CJD1. For instance, a 2016 article from *Télé Cable Satellite* describes it as one of the *"specialty channels in the Canal+ group"*.[10] That said, the mark stands registered in the name of CANAL+ THEMATIQUES and, according to section 72 of the Act,

> "In all legal proceedings relating to a registered trade mark (including proceedings for rectifications of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it" (my emphasis).

I have no reason to doubt the evidence of Mr Hellich-Praquin on the assignment of the mark and am therefore prepared to proceed on the basis that any use of the mark in connection with television channels broadcast by Canal+ was made by the proprietor or with its consent.

*Evidence of use*

45. Mr Hellich-Praquin states that the 546 mark has been used for services connected with the SEASONS media channel since 1996.[11] He says that information about the type of programmes and other services can be found in third-party articles in Exhibit CHP2. Some of these are dated before the relevant period, but they do include the article dated 19 November 2016 that Ms Reid submitted was machine-translated and that I have reproduced above in paragraph 30. What I take from this article is that the channel had been in operation for 20 years and that a special offer was available to mark the anniversary. The article immediately following it is from www.echosdunet.fr

[9] Transcript, pages 95-96.
[10] Exhibit CJD1, Exhibit CHP3, page 1.
[11] First witness statement, paragraph 9.

and was last updated on 29 December 2020, two days before IP completion day.[12] This describes the subject matter of the channel as hunting and fishing and says that it is included in a particular Canal+ subscription package or may be purchased as an add-on. Even if it is purchased as an add-on, it comes as part of a package containing other channels. Programmes can be viewed on television, computer, smartphone and tablet. The Wikipedia articles in Exhibit CHP1 dated 1 January 2020 state that some Canal+ channels are available on digital terrestrial television, but there is no evidence that these include SEASONS. The final article in this exhibit is undated, apart from a comment (in French) dated 20 April 2021, after IP completion day.[13]

46. Exhibit CHP3 contains press articles, which have been translated by Ms Dittner in Exhibit CJD1. I shall not summarise all of them, as many predate the relevant period. The points that I take from the articles are as follows:

a) The channel is available through Canalsat, which I infer is a satellite television service;[14]

b) In 2016, it was reported to be profitable, in part because of lower programming costs;[15]

c) *Seasons Hebdo* is a weekly magazine programme;[16]

d) SEASONS has also filmed documentaries, including programmes about fishing on the island of Martinique (filmed in 2018),[17] a documentary about deer stalking and reports on hunting from the Spanish border to the Italian border (filmed in 2019),[18] and documentaries on fishing, discussed in an article dated 12 July 2020.[19]

47. In 2018, the channel was available in the 27 current EU Member States (and not the UK).[20] Exhibit CHP4 appears to have been machine-translated, but I am prepared to accept it as evidence that the channel's output was available in the EU Member

[12] Exhibit CHP2, pages 3-8.
[13] Exhibit CHP2, pages 9-14.
[14] Exhibit CJD1, Exhibit CHP3, page 2.
[15] Exhibit CJD1, Exhibit CHP3, page 1.
[16] Exhibit CJD1, Exhibit CHP3, page 1.
[17] Exhibit CJD1, Exhibit CHP3, pages 24-25.
[18] Exhibit CJD1, Exhibit CHP3, pages 28-29, 30-31.
[19] Exhibit CJD1, Exhibit CHP3, pages 33-34.
[20] First witness statement, paragraph 12; Exhibit CHP4.

States. Mr Hellich-Praquin gives evidence that it was available in Switzerland[21] and an otherwise undated article in Exhibit CHP2 says that it was also accessible in Canada.[22]

48. Exhibit CHP6 contains price and subscription information in French. Mr Hellich-Praquin says that they show that SEASONS has been included in Canal+ promotional packages. However, the documents either date from before the relevant period or after IP completion day, so, even if they were in English, they do not tell me anything about use during the relevant period in the relevant territory.

49. There is no specific evidence on the number of subscribers during the relevant period. Mr Hellich-Praquin has provided confidential figures for the number of subscribers to packages including the channel and information on the number of users in contact with the channel.[23] These figures cover the first four months of 2021 and, as SEASONS was not available in the UK, they are not directly relevant to an assessment of genuine use of the comparable mark. Mr Hellich-Praquin also gives an annual sales figure that is also confidential, but he does not state what period this figure relates to or break it down by goods and services or by territory.[24] He states that the pay-TV revenue of his company was €170.5 million in 2018 and €171 million in 2019,[25] but SEASONS is only one of the channels provided by the company. Consequently, these figures do not add much to the picture created by the evidence. The information on pay-TV revenue comes from a 2021 report *Le Guide des Chaînes*, which covers the years 2019 and 2020. Extracts from the report can be found in Exhibit CHP8, along with extracts from the 2011 and 2013 reports. All are in French and have not been translated. I am therefore unable to tell whether they contain any further information that would assist Canal+.

50. Mr Hellich-Praquin says that the SEASONS channel is available through the CANAL+ BUSINESS service which is offered to hotels, healthcare facilities and retirement homes. I note that he uses the present tense here. Exhibit CHP9 contains *"recent"* screenshots from the CANAL+ BUSINESS option. They were captured on 4 January 2024 and there is no evidence to show that these options were offered

[21] First witness statement, paragraph 15.
[22] Exhibit CHP2, page 10.
[23] First witness statement, paragraphs 16-17.
[24] First witness statement, paragraph 18.
[25] First witness statement, paragraph 19; Exhibit CHP8.

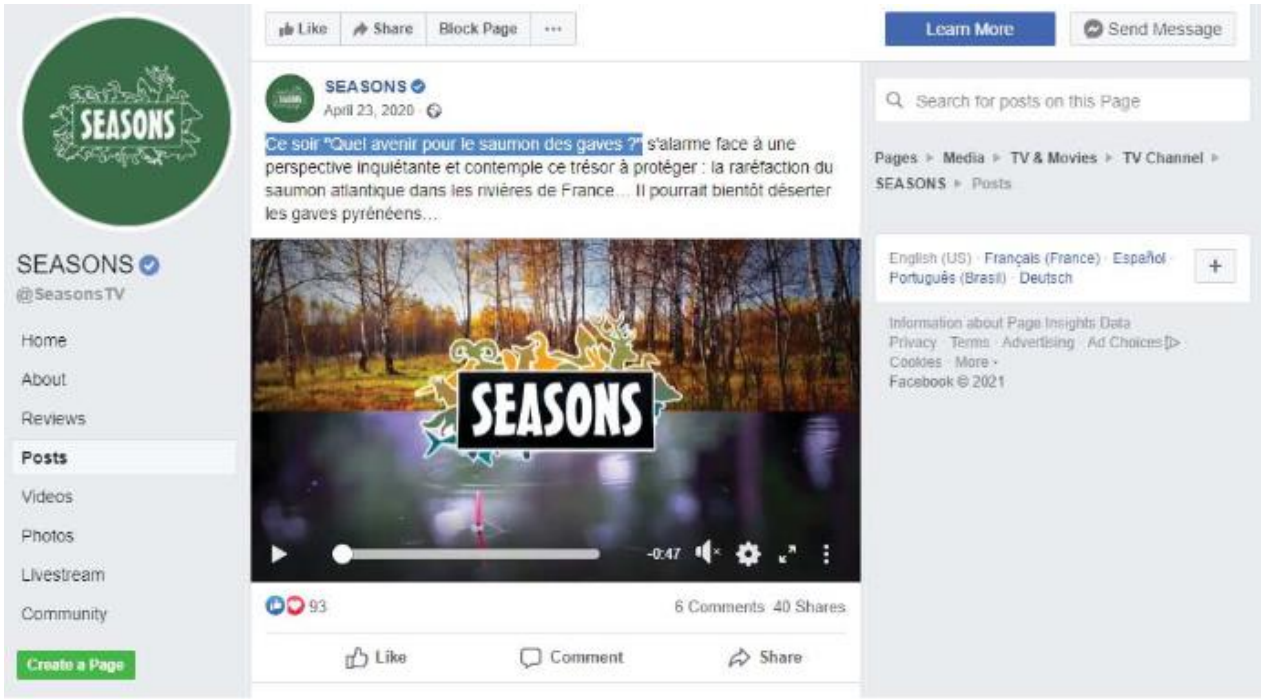
during the relevant period or, if so, the extent to which the mark had been used in connection with them.[26] Further information on this option has been provided by Mr Hellich-Praquin in his second witness statement. This is some of the evidence filed in reply to which Ms Reid objected. The accompanying Exhibit CHP17 is in French and has not been translated. I am informed by the witness that it contains sample flyers with information on the CANAL+ BUSINESS option. They are dated 2023-2024 and show me nothing more than that the channel was an option included in some of the packages. Mr Hellich-Praquin states that these flyers are representative of ones that were distributed during the relevant period. The most I can take from this exhibit is that the SEASONS channel was one of many that were offered, but I do not see that this adds anything to the evidential picture.

51. Mr Hellich-Praquin provides information on the numbers of social media followers in Exhibit CHP10. These amounted to 143k on Facebook, 10.1k on YouTube and 3,670 on Twitter. However, the print-outs date from 4 November 2021, which is after the relevant date. Ms Wickenden submitted that evidence from a period just after the relevant date could still be considered to the extent that it shed light backwards on the position during the relevant period. The same might, in principle, apply to evidence relating to the EU after IP completion day. In relation to the social media followers, she argued that such numbers were unlikely to be achieved overnight. Ms Reid, on the other hand, submitted that much could change in a relatively short period of time. I prefer the submissions of Ms Reid on this point. A large increase in interest may arise relatively suddenly, perhaps as a result of promotional activity or external developments. However, I can see from this exhibit that videos were uploaded to the SeasonsTV YouTube channel two to four years before the date that the screenshot was taken.

52. Exhibit CHP11 contains 22 social media posts dated from 28 November 2016 to 3 July 2020. While these are all in French, I can see that the mark appears in various forms which I shall consider later. The post below is taken from Facebook and is dated 14 September 2017:[27]

[26] First witness statement, paragraph 20.
[27] Exhibit CHP11, page 2.


The following post is dated 23 April 2020:[28]

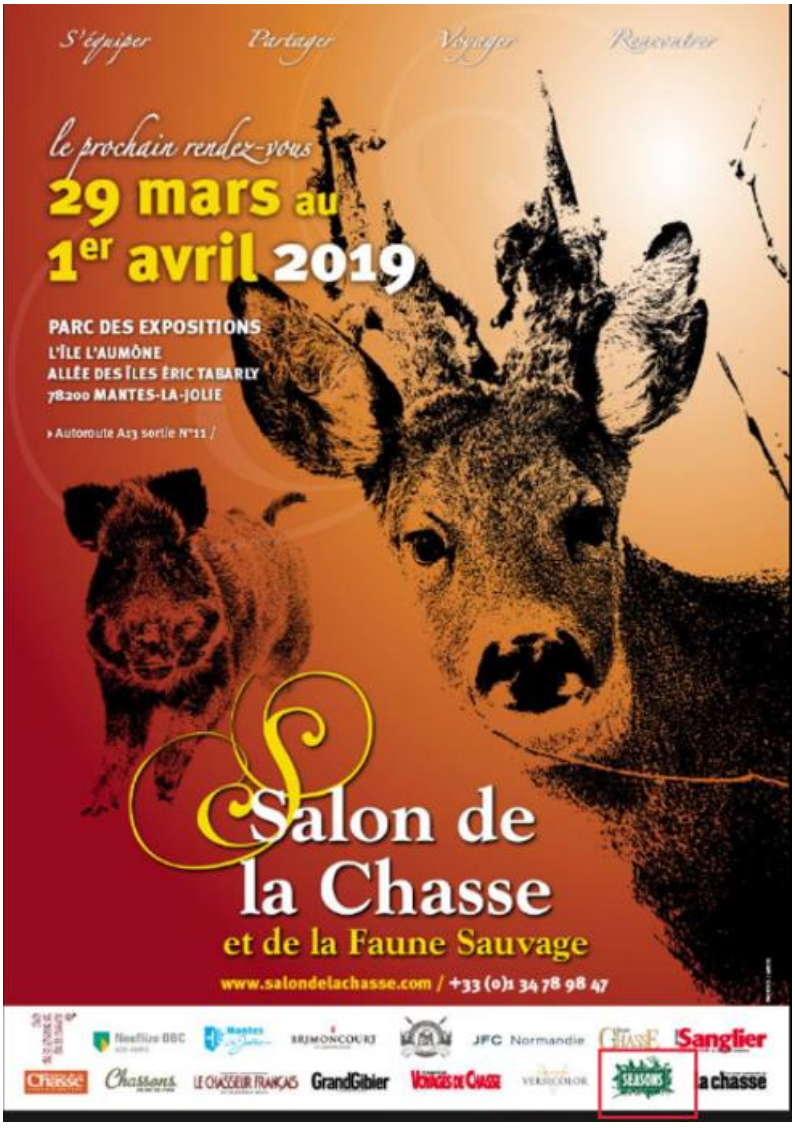



53. Mr Hellich-Praquin also states that the company has produced content for DVDs since at least 2011.[29] Exhibit CHP12 contains examples but these are either undated

[28] Exhibit CHP11, page 18.
[29] First witness statement, paragraph 24.

or dated after the relevant period. There is also a Facebook post dated 28 March 2019 showing DVDs, but there is nothing to tell me when the programmes were made.[30]

54. Mr Hellich-Praquin does not give any figures on the amounts invested in promoting the 546 mark. The only sponsorship activity shown in the relevant period concerns a number of game fairs and similar events, with the mark being shown on posters and programmes, such as the following example:[31]




55. Exhibit CHP15 contains examples of marketing emails sent to subscribers dated 14 May 2021, 19 June 2021 and 19 September 2021. They are in French and have not been translated. However, I can see that some of them contain price information,

[30] Exhibit CHP11, page 10.
[31] First witness statement, paragraph 25; Exhibit CHP13, page 14.

but I am unable to discern little else from them. Mr Hellich-Praquin states that *"similar correspondence containing digital campaigns were sent to my Company's subscribers prior to 2021 and during the period 9 June 2016 and 31 December 2020."*[32] He does not give any information on the extent of the distribution.

*Assessment of the evidence*

56. I have referred to the different forms of the mark that have been used. These comprise the word "SEASONS" and the forms shown below which I have taken from images already reproduced in this decision:



57. I have reproduced this second variant form as it appears in the header of the YouTube account shown in Exhibit CHP10 on page 2, as this is the clearest image. A comparison with the Facebook post from 2017 shown in paragraph 52 above confirms that it is the same, apart from the green background. I also note that it sometimes appears in coloured variants: see the second post shown in paragraph 52. The word "SEASONS" is clearly visible in these forms. With reference to the second variant, I recall that the Court of Justice of the EU (CJEU) stated in *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12 at paragraphs 32-36, that use of a mark encompasses use of that mark with, or as part of another mark, so long as it continued to be perceived as indicative of the origin of the goods or services at issue. I consider that that would be the case here.

58. In addition, the word SEASONS appears with the word HEBDO, as below:[33]

[32] First witness statement, paragraph 27.
[33] Exhibit CHP11, page 1.


59. It can also be seen in the still from a YouTube video reproduced in paragraph 52 above. Ms Reid submitted that this was not used of the mark "SEASONS", but of "SEASONS HEBDO". I accept that a consumer who does not know that "hebdo" is French for "weekly" may not perceive SEASONS *solus* as indicative of origin of any services supplied under that form.

60. The evidence is not without its flaws, but on the basis of what I have before me I am prepared to accept that there has been genuine use of the 546 mark in relation to a television channel and the production of programmes shown on it. In coming to this view, I have looked at the evidential picture as a whole and borne in mind the case law that states that there is no *de minimis* level of use that must be shown. Ms Reid submitted that, as the channel was only available as part of a package, there was no indication that the customer actually wanted to purchase it. However, I consider that the use of the mark is trade mark use which denotes the origin of the services, that it has been used and promoted throughout the relevant period in the EU.

61. Ms Wickenden submitted that the use of the mark in association with the game fairs represented use for *Arranging and conducting of … conferences*. She referred me to paragraphs 70 and 71 of the judgment of Arnold LJ in *easyGroup v Nuclei*. In

that case, EASYOFFICE's website clearly gave the viewer the impression that EASYOFFICES had some responsibility for the services supplied. This included statements such as *"From affordable start up offices to iconic landmark buildings, we have them all"* and customer testimonials (*"found the perfect office for us…", "perfectly suited my needs"*). In contrast, the use of the mark here is more that of advertising. It does not convey the message that Canal+ had anything to do with the quality of the event. I find that use has not been shown for *Arranging and conducting of … conferences*.

62. Ms Wickenden submitted that the fact that the SEASONS channel was available by subscription was evidence of use of the mark for *Rental of motion pictures, film recordings and sound recordings*.[34] It is familiar law that the terms in a specification of services should not be construed widely but be *"confined to the core of the possible meanings attributable to the terms"*: see *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), paragraph 56. In my view, the average consumer would understand a rental service to be one in which they purchase the ability to watch or listen to a specific film or sound recording for a limited period of a few days or weeks, at a time that is convenient for them. I agree with Ms Reid that this differs from a subscription to a television channel. Subscribing to a service means that the consumer may watch whatever is being broadcast live, or in this day and age take advantage of a "catch-up" service. For as long as they pay the subscription and the broadcaster makes the content available, they may choose to watch it. To my mind, the time-bound nature of access to a specific film or recording is what makes the service a rental service. I find that use has not been shown for *Rental of motion pictures, film recordings and sound recordings.*

63. Finally, Ms Wickenden submits that use of the mark for *Communications services, namely news and information agencies* is shown by the magazine programmes broadcast on the SEASONS channel, particularly by Seasons Hebdo.[35] I understand that a news and/or information agency is an organisation that gathers news stories and sells them on to newspapers, radio and television broadcasters, and so on. There is no evidence that the mark has been used for these services.

[34] Party A's skeleton argument, paragraph 22.
[35] Party A's skeleton argument, paragraph 22.

64. I must now decide whether the terms that are left after the concessions made by Ms Wickenden and the findings I have made above represent a fair specification.

*A fair specification*

65. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

> "244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.
>
> 245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to

arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. … It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

66. This approach was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

"261. … First, there can be no doubt that an application to register a mark in respect of a broad category of goods or services may be made *partly* in bad faith in so far as the broad description includes distinct sub-categories of goods or services in relation to which the applicant never had any intention to use the mark, whether conditionally or otherwise. In my view, that emerges clearly from the decision of the CJEU in this case. The approach to be adopted in such a case was explored and explained by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp* [2017] EWCA Civ 1834; [2018] ETMR 10, at paras 241-249 and, so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use."

67. In *easyGroup Limited v Easy Live (Services) Limited & Ors* [2025] EWCA Civ 946, Arnold LJ gave further consideration to the approach to identifying independent subcategories:

> "82. As the Court of Justice made clear in *ACTC* and *Ferrari*, the essential criteria which must be applied in determining whether a category of goods or services can be divided into independent subcategories are purpose and intended use. It is not sufficient that different goods may be aimed at different publics or sold in different shops or that different goods or services belong to different market segments. These criteria are easier to apply to goods than to services, in particular because it is easier to distinguish between the purpose and the intended use of goods than it is to distinguish between the purpose and the intended use of services. In the case of services, it seems to me that the logic of the Court of Justice's approach means that one should consider the intended mode of use of the services in question."

68. Ms Reid's primary position was that the evidence did not show use for any of the services in the specification. As an alternative, she submitted that a fair specification would consist of only the following:

> *Class 38*
> *Transmission of information in the French language in relation to hunting and fishing by way of a subscription television channel*.[36]

69. I consider that this term does not meet the requirements set out in the case law. I do not see the listed services as having a different purpose or use from *Transmission of information* on other subjects. The consumer is using the transmission services in order to gain information that will increase their knowledge or entertain them. Following Arnold LJ, I note that it is not sufficient that the material may be aimed at hunting and fishing enthusiasts, rather than people who enjoy other types of programmes. Consequently, I dismiss this proposed fair specification and will make my own assessment.

[36] Applicant's skeleton argument in consolidated proceedings, paragraph 54 and Annex B.

70. I begin with Class 38 and *Broadcasting of films and television programmes*. I have touched on the problems in attempting to identify independent subcategories for services such as these. Whatever the subject of the films and programmes, the purpose and intended use are, in my view, the same. I have found that the mark has been used for a television channel that shows programmes. The term "film" is harder to define. It can mean content that is intended to be shown first in cinemas, but may also be used, for example, for hour-long documentaries or for short segments in other programmes that are shown on television.

71. I need to pause here for a moment and address Ms Reid's submission that, if Canal+ were using the mark at all for transmitting programmes, the use should be characterised as "narrowcasting", rather than "broadcasting". She argued:

> "Broadcasts are for the general public at large. Narrowcasting is a different term. It is within communications, but it is for a specific audience, so narrowcasting, rather than broadcasting, appears to be what is done when you are having a subscription channel because you are not communicating this to all and sundry, it is communicated only to those persons who pay for it, so it is a defined, narrow class of people, so it is narrowcasting rather than broadcasting."[37]

72. In my view, however, the average consumer would understand the term "broadcasting" to encompass subscription television channels, as these adopt the same "one-to-many" model of communication as public television channels. Furthermore, if the term "narrowcasting" is used for channels intended for a specialist audience, it may not be clearly understood, as an individual viewing a specification may not be able to discern where the line is drawn between broad- and narrowcasting. Consequently, I consider that a fair specification would include *Broadcasting of films and television programmes*.

73. I turn now to *Communications via Hertzian wave, satellites or cable*. This is a broad term and includes different modes of communication, such as television broadcasting, radio broadcasting, telephony and data transfer. I have found that the mark has been used for a television channel, which is different in purpose and intended use from some

[37] Transcript, page 79.

of the other services that fall under this broad heading. I have considered whether it would be appropriate to limit the term, but the limitation that I would apply would be *"namely, broadcasting of films and television programmes"*. This is repetitious and so I shall remove the whole term.

74. The final term remaining in this class is *Transmission of information using all means of communications and telecommunications for public information*. Ms Wickenden accepted that the term was broad and included independent subcategories. She added:

> "We know telecommunications must include broadcasting for public information, so if there is a need for this to be narrowed, it should at least include *'broadcasting for public information'*." [38]

75. The purpose of these services is clearly signalled in the wording of the term in the specification. This aligns with one of the purposes of the television services provided by Canal+. However, it is a broad term that would include other types of communication, for example public health or safety information delivered through a range of different communication methods, such as text message alerts, emails, bulletin boards, and so on. In *Ferrari SpA v DU*, Joined Cases C-720/18 and C-721/18, the CJEU said:

> "43. As is apparent from paragraph 37 of this judgment [in *ACTC*], the only relevant question in that regard is whether a consumer who wishes to purchase a product or service falling within the category of goods or services covered by the trade mark in question will associate all the goods or services belonging to that category with that mark."

76. I do not consider that the consumer would associate all the services belonging to the category of *Transmission of information using all means of communications and telecommunications for public information* with the 546 mark. I keep in mind that Canal+'s programming is available through internet services and so I consider that a fair specification would be *Transmission of information in the form of films and television programmes for public information*.

[38] Transcript, page 45.

77. Class 41 covers entertainment services. Ms Reid drew a distinction between what she saw as creative services (screen writing, directing, and so on) which she argued were to be found in Class 35 and the organisational services (production).[39] With respect, I do not agree. *Screenplay writing* is included in Class 41, as is *Film directing, other than advertising films*. Advertising and publicity content is where Class 35 comes into play. In addition, in my view the average consumer would understand the term *Production* in Canal+'s specification to encompass the whole process of delivering a film or television programme that can be shown to the public. I consider that a fair specification would include *Production of motion pictures, television series and television broadcasts* and *production of … television programmes*.

78. *Production of shows* is a broader term, and in my view would include the production of live entertainment staged, for example, in a theatre. I put this point to Ms Wickenden. She said that she had understood the term to mean *Production of television shows* but accepted that the production of live action theatre shows would be an independent sub-category.[40] I find that a fair specification would include *Production of television shows*.

79. The revocation action brought against the 546 mark is therefore partially successful. It will remain registered for the following services:

> *Class 38*
> *Broadcasting of films and television programmes; transmission of information in the form of films and television programmes for public information.*
>
> *Class 41*
> *Production of motion pictures, television series and television broadcasts; production of television shows; production of television programmes.*

80. Canal+ may also rely on these services for the purposes of the opposition.

81. The 546 mark is revoked with effect from 9 June 2021 for the following services:

[39] Transcript, page 80.
[40] Transcript, page 44.

*Class 38*

*Communications via Hertzian wave, satellites or cable; issuing of documents; communications services, namely news and information agencies; radio broadcasting, communications by telegrams or communications by telephone; transmission of information by teleprinter; transmission of information using all means of communications and telecommunications for public information.*

*Class 41*

*Theatrical agencies; rental of motion pictures, film recordings, sound recordings and stage set accessories; production of radio programmes; arranging of competitions for education or entertainment; arranging and conducting of congresses, colloquiums and conferences.*

## The Opposition to Fifth Season's application

### Section 5(2)(b)

82. Section 5(2)(b) of the Act is as follows:

> "A trade mark shall not be registered if because–
>
> …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

83. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater 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; and

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

***Comparison of goods and services***

84. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court ("GC") said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when

> "82. … 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."

85. The goods and services to be compared are shown in the table below:

| **Contested goods and services** | **Earlier services** |
|---|---|
| *Class 9*<br>*Downloadable mobile software application providing motion pictures, television shows, and multimedia entertainment content; podcasts about multiple subjects and featuring* | |

| Contested goods and services | Earlier services |
| --- | --- |
| *a wide variety of general interest entertainment.* | |
| *Class 35*<br>*Creative and content development services in the fields of motion pictures, television shows, and multimedia entertainment content; distributorship services in the fields of motion pictures, television shows, and multimedia entertainment content.* | |
| *Class 36*<br>*Financial services namely providing financing for motion pictures, television shows, and multimedia entertainment content.* | |
| *Class 38*<br>*Broadcasting of podcasts, video-on-demand, television and radio programs; telecommunication services, namely transmission of podcasts; telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communications networks, and the internet.* | *Class 38*<br>*Broadcasting of films and television programmes; transmission of information in the form of films and television programmes for public information.* |

| Contested goods and services | Earlier services |
|---|---|
| *Class 41*<br>*Entertainment services in the nature of development, creation, production and post-production of motion pictures, television shows, and multimedia entertainment content; providing non-downloadable entertainment content in the nature of motion pictures, television shows, and multimedia entertainment content; distribution of motion pictures, television shows, and multimedia entertainment content; providing entertainment services via a global communication network in the nature of online motion pictures, television shows, and multimedia entertainment content information; providing online non-downloadable motion pictures, television shows, and multimedia entertainment content; providing a website featuring entertainment information.* | *Class 41*<br>*Production of motion pictures, television series and television broadcasts; production of television shows; production of television programmes.* |

86. I have already referred to the case law covering the interpretation of terms in specifications: see paragraph 62 above. I also keep in mind the judgment of the GC in *Gérard Meric v OHIM*, Case T-133/05, where it 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."

87. In making my comparisons, I will use the services I consider to be closest to the goods and services in the specification of the opposed mark. I have drawn upon the table provided in paragraph 28 of Ms Wickenden's skeleton argument, although it should be recalled that Canal+ is not able to rely upon the entirety of the specification of the 546 mark. Ms Reid's submissions were based on a comparison with the proposed fair specification that I have rejected in paragraph 69 above. I have, however, taken them into account.

Class 9

*Downloadable mobile software application providing motion pictures, television shows, and multimedia entertainment content*

88. I shall use *Transmission of information in the form of films and television programs for public information* for my comparison. The contested goods enable the user to watch content, including films and television programmes, by means of a software application downloaded to a mobile phone, tablet or computer. The purpose is the same as that of Canal+'s service and the goods are targeted towards the same users as the services. The method of use is different, as is their nature. Ms Wickenden submitted that the goods are complementary to the services. I agree. The use of the software application depends on the transmission of content to that application, and I consider that the average consumer is likely to believe that the goods and services are the responsibility of the same undertaking. I find that they are similar to a medium degree.

*Podcasts about multiple subjects and featuring a wide variety of general interest entertainment*

89. Ms Wickenden submitted that these goods are similar to *Broadcasting of films and television programmes* on the basis that the purpose of the goods and services is highly similar, namely, to entertain and inform the user. They are likely to be targeted towards the same users. I also consider that the subjects of the podcasts could include films and television programmes. With one being a good and the other a service, their

nature is different. If there is any similarity in the method of use, it is at a low level: a podcast in Class 9 will be downloaded and then listened to, while the Class 38 broadcasting services will be watched by accessing the service on a television, computer or other audio-visual device. There is a degree of competition in that an individual wanting to be entertained or informed could choose to download a podcast or watch a television service. Ms Wickenden also refers me to the evidence of Ms Brooks and submits that ITV and Sky produce podcasts, as well as run broadcasting services. This evidence accords with my own experience as a member of the general public. In my view, the average consumer will be accustomed to broadcasters creating podcasts. Taking all these factors into account, I find that the goods and services are similar to a medium degree.

Class 35

*Creative and content development services in the field of motion pictures, television shows, and multimedia entertainment content*

90. Ms Wickenden submits that these services are identical to its Class 41 services, namely *Production of motion pictures, television series and television broadcasts; production of television shows; production of television programmes*. In paragraph 77 above, I referred to Ms Reid's submissions on Class 35 services, which she characterised as including screenwriting, directing, and so on. I said that I disagree with this assessment. This was in the context of considering a fair specification for the 546 mark. Now I must construe the contested term and I remind myself that the Nice Classification is purely an administrative tool. When interpreting terms used in a specification, it may be of assistance where those terms are unclear or where they could appear in more than one class: see *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)* [2018] EWHC 3608 (Ch), paragraph 94. I find the words used for this service quite clear: they would involve the development of concepts for films, television shows and other content and the creative activities needed to bring them to the point where they can be made. It could include screenwriting, art design, the composition or choice of music, and so on. I consider that these are included under the broader heading of *Production of motion pictures, television series and television broadcasts* for the reasons I have already explained.

Consequently, I find them to be identical per *Meric.* If I am wrong in this, I find the services to be highly similar.

*Distributorship services in the field of motion pictures, television shows, and multimedia entertainment*

91. I shall compare these services to Canal+'s *Production of motion pictures, television series and television broadcasts*. Ms Reid argued that a distinction could be drawn between distributorship and distribution services. I asked her to elaborate on this point and she said:

> "Distribution is the act of actually distributing product. A distributorship service is providing services which support the distributor who is carrying out the distribution, so it's a different level of the chain."[41]

I am not persuaded that this sheds a great deal of light on the purported distinction. I therefore remind myself that, in construing the meaning of a service, I should keep in mind the core of the possible meanings attributable to the term. It is my view that the average consumer would understand distributorship and distribution services to be the same thing.

92. Ms Wickenden submitted that there is a complementary relationship between the contested services and *Production of motion pictures, television series and television broadcasts*. I acknowledge that, in order for an undertaking to be able to distribute motion pictures, television shows and multimedia entertainment, that content must first be produced. In my view, it is likely that the average consumer of these services, who will be a business such as a cinema company or a broadcaster, may assume that that the same undertaking is responsible for both the production and the distribution of the content, although it is also possible that the services will be the responsibility of different companies. There may therefore be a degree of complementarity. There is some overlap in user, as a television broadcaster, for example, may use both services, and it is possible that there will be some overlap in trade channels. The nature of those services is different, and I consider that the method of use is also likely to be different. Overall, I find that the services are similar to a low to medium degree.

[41] Transcript, page 90.

Class 36

*Financial services, namely providing financing for motion pictures, television shows, and multimedia entertainment content*

93. Ms Wickenden submitted that these services are identical to *Production of motion pictures, television series and television broadcasts; production of television shows; production of television programmes*, on the basis that all content production must be financed. She referred me to the financing of the Seasons channel by subscriptions and Wikipedia articles that described Canal+ as *"a major source of finance for domestic film production, participating in the financing of the vast majority of films produced in France"* as well as producing films.[42] The fact that a single undertaking might provide both services does not in itself mean that they are identical. In my view, the Class 36 services involve the putting together of finance, through obtaining public funding such as government grants and private investment, arranging any necessary financial instruments, providing loans, and so on. These financial services are used by the undertakings producing the films, television programmes or other content. Their primary purpose is different and the nature and method of use of the services differs. There is a degree of complementarity, as the average consumer may believe that the same undertaking is providing both services. Overall, I find that the services are similar to a low to medium degree.

Class 38

*Broadcasting of … television programs*

94. These services are identical to Canal+'s *Broadcasting of films and television programmes.*

[42] Exhibit CHP1, page 6.

*Telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communications networks, and the internet*

95. This is a broad term that includes Canal+'s *Transmission of information in the form of films and television programmes for public information.* Consequently, I find the services to be identical per *Meric*.

*Broadcasting of podcasts, video-on-demand … and radio programs; telecommunication services, namely, transmission of podcasts*

96. The nature of these services is highly similar to the nature of Canal+'s Class 38 services. They are targeted towards the same users and there is likely to be some overlap in trade channels. In addition, they share the same purpose and there is likely to be a degree of competition between them. I find them to be highly similar.

Class 41

*Entertainment services in the nature of development, creation, production and post-production of motion pictures, television shows, and multimedia entertainment content*

97. In line with my earlier reasoning, I find the above services to be identical to Canal+'s *Production of motion pictures, television series and television broadcasts*, per *Meric*.

*Providing non-downloadable entertainment content in the nature of motion pictures, television shows, and multimedia entertainment content; providing online non-downloadable motion pictures, television shows, and multimedia entertainment content; Providing entertainment services via a global communication network in the nature of online motion pictures, television shows, and multimedia content information*

98. I interpret these services, which are Class 41 services, not as broadcasting services, but as services by which the user can access films, television or other multimedia entertainment over the internet, or some other global communication network. The services share the same purpose as Canal+'s *Broadcasting of films and television programmes* and are targeted towards the same users. There is some similarity in nature and method of use of the services. There are likely to be some

shared trade channels and the average consumer may assume that the same undertaking is providing both services. They are in competition with each other, as the user in search of entertainment may choose to watch a television channel or select content on demand. I find the services to be highly similar.

*Distribution of motion pictures, television shows, and multimedia entertainment content*

99. In my view, the same reasoning applies for these services as for *Distributorship services in the field of motion pictures, television shows, and multimedia entertainment*. I find them similar to *Production of motion pictures, television series and television broadcasts* to a low to medium degree.

*Providing a website featuring entertainment information*

100. I shall compare these services to Canal+'s *Broadcasting of films and television programmes*. Ms Reid submitted that the user, as with all the Class 41 services, is a broadcaster. That may be the case, but I consider that a member of the general public is also likely to use such a website. There is likely to be an overlap in trade channels and the average consumer would expect a broadcaster to provide a website containing information about its programmes. I find that the services are similar to a medium degree.

***Average consumer and the purchasing process***

101. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes 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 and services in question: see *Lloyd Schuhfabrik*, paragraph 26.

102. I shall divide the opposed goods and services into two groups. The first consists of the Class 9 goods, Class 38 services and the following services from Class 41: *Providing non-downloadable entertainment content in the nature of motion pictures, television shows, and multimedia entertainment content; providing entertainment services via a global communication network in the nature of online motion pictures,*

*television shows, and multimedia entertainment content information; providing online non-downloadable motion pictures, television shows, and multimedia entertainment content; providing a website featuring entertainment information.* The Class 38 services of Canal+ would also fall within the group. The average consumer of these goods and services is a member of the general public seeking entertainment and information. The price of the goods and services varies: some online entertainment services may be purchased on a subscription or on a pay-per-view basis; other goods and services will be free to the user. Ms Wickenden submitted that the level of attention paid would be low, as the average consumer would choose what to watch by flicking through television channels. With respect, I do not consider that this is the appropriate comparison. The law is clear that the average consumer is reasonably circumspect. When they are choosing to sign up to a broadcasting service or download an app, they are paying more attention than when idly flicking through channels in search of something to watch that evening. The average consumer will give consideration to features such as price, content, and the means of accessing services. Overall, it is my view that they will pay a medium degree of attention. They will choose goods or services after browsing the internet, app stores or podcast apps, or seeing the goods and services reviewed or advertised in other media. The purchasing process is likely to be predominantly visual, although I consider that the average consumer may also receive word-of-mouth recommendations. The aural aspects of the mark cannot be ignored.

103. The second group of services consists of the services in Classes 35 and 36 and the following services from Class 41: *Entertainment services in the nature of development, creation, production and post-production of motion pictures, television shows, and multimedia entertainment content; distribution of motion pictures, television shows, and multimedia entertainment content*. Canal+'s Class 41 services would fall within this group. In my view, the average consumer of these services is a business in the film or television industry or a company broadcasting or transmitting content. They will purchase these services in order to create that content or to have a variety of programmes and/or films to offer to their customers. The services are likely to be fairly costly and it is likely that the average consumer will pay a high degree of attention when making a purchasing decision. They will consider the price, the range of services offered, contractual, intellectual property and other legal issues, along with

the demographics and tastes of their audience or potential audience. I have no information on the purchasing process, but I consider it is likely to be considered and involve documentation on which the relevant marks will appear. Consequently, it is my view that the purchasing process is likely to be largely visual, although I do not discount the possibility that the average consumer may hear the marks spoken.

***Comparison of the marks***

104. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

> "34. … it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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."

105. Artificial dissection of the marks would therefore be wrong, although it is necessary for me 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 the marks.

106. The respective marks are shown below:

| **Opposed mark** | **546 mark** |
|---|---|
| **FIFTH SEASON** | **SEASONS** |

107. The earlier mark consists of a single word, with no other elements to contribute to its overall impression. The opposed mark has two words. Ms Wickenden submitted that the second of these words is the dominant element of the mark. She compared

the word “fifth” to a non-distinctive element such as “the” or “a”.[43] Canal+ has adduced evidence to show the use of ordinal numbers in relation to series, seasons and episodes of television programmes and films. I do not see that this evidence proves that numbers are non-distinctive when used in trade marks. In my view, the two words of the opposed mark will be read together, and the distinctive of this mark lies in the whole.

*Visual comparison*

108. The second word of the contested mark is almost identical to the earlier mark. The only difference between those words is the additional letter “S” at the end of the earlier mark. The first word in the contested mark is a noticeable difference between the marks. Ms Reid accepted that there is some visual similarity, but that it is at a low level. Taking all these factors into account, I find that the marks are visually similar to a medium degree.

*Aural comparison*

109. Both marks are likely to be pronounced in the usual way, with the earlier mark containing two syllables and the contested mark three. I consider that the marks are aurally similar to a medium degree.

*Conceptual comparison*

110. Ms Wickenden submitted that the 546 mark would be understood to refer to seasons of the year, although she noted that the word “season” was also used to denote a time period more generally. She also argued that the word had a secondary meaning, but only in connection with television shows or podcasts, where it would be understood as referring to a specified series of the show or podcast. She added that the words “season” and “series” were not entirely interchangeable, as one would not refer to one’s favourite TV season, instead of one’s favourite TV series. Turning to the opposed mark, her view was that the addition of the word “fifth” at the beginning of the mark did not make any contribution to the conceptual meaning of the word “season”;

[43] Skeleton argument, paragraph 34.

it merely denoted that it was number five in a series of at least five things. She submitted that the marks were conceptually similar to a high degree.

111. Ms Reid argued that the 546 mark would be perceived as referring to the seasons of the year. She drew my attention to evidence indicating that the content of the programming reflected those different seasons. She considered that the meaning of the opposed mark was ambiguous:

> "61. … It could be viewed (i) as a fanciful term which is a reference to a season of the year in addition to the four known seasons, akin to a sixth sense or (ii) a fifth series, but this would have to refer to a particular show having 4 earlier series to be understood as a descriptive use."[44]

112. In my view, some consumers will perceive the 546 mark as referring to seasons of the year. However, I also consider that there will be a group that understand it to mean series of a particular TV show or podcast. I am not persuaded that the fanciful notion of an additional season of the year is the first thing that will come to the mind of the average consumer on encountering the opposed mark. Rather, I consider that they would perceive it as referring to the fifth of a series. The second group of consumers are likely to understand it to mean the fifth series of a television show, while for the first group it may bring to mind a fifth period of time more generally. For example, one might talk about a football manager's fifth season in charge of a team. It is my view that for the first group of consumers there is no conceptual similarity between the marks, but for the second group there is a high degree of conceptual similarity.

***Distinctive character of the earlier mark***

113. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "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

[44] Applicant's skeleton argument in consolidated proceedings, page 17.

> 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)."

114. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it. However, the question of enhanced distinctiveness should be assessed through the eyes of the average UK consumer. As the 546 mark has not been used in the UK, I shall only consider the inherent distinctive character of the mark.

115. Ms Wickenden accepted that the distinctive character of the 546 mark could arguably be slightly lower for services related to television.[45] Ms Reid submitted that the term was *"not very distinctive"* and referred me to an article that stated that *"As its name suggests, the rest of the programs obviously follow hunting and fishing trends according to the seasons and regions of the world"*.[46] She accepted that this was one of the articles she believes to have been machine-translated. As I have already said, I am treating these articles with some caution. Furthermore, I have not limited the specification of the 546 mark in the way Ms Reid had proposed. I considered that it was not appropriate to limit it by the content of the programmes shown on the channel.

116. For the group of consumers who perceive the 546 mark as a reference to series of a television show, I consider that it is allusive of television services and so has a low degree of inherent distinctive character when used for those services. In my view, all the services that remain in the fair specification fall within this description. This is because the line between television programmes and films/motion pictures is somewhat blurred. I refer again to the comments I made in paragraph 70 on the

[45] Transcript, page 50.
[46] Transcript, page 84; Exhibit CHP2, page 14.

definition of films. Motion pictures, literally meaning “moving images”, would, in my view, include television programmes.

117. For the group of consumers who perceive the 546 mark as a reference to the seasons of the year, the 546 mark has a medium degree of inherent distinctive character regardless of the services in the fair specification.

***Conclusions on likelihood of confusion***

118. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods and services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind 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 that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that 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 or vice versa.

119. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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 recognised 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI', etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

120. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of

circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

121. Earlier in my decision, I found that:

a) The opposed goods and services were identical or similar to a high, medium or low to medium degree to the services that I considered to be a fair specification for the earlier mark,

b) The opposed goods and services could be divided into two groups. The average consumer of the first of these is a member of the general public paying a medium degree of attention in a largely visual purchasing process. The average consumer of the second of these is a professional paying a higher degree of attention in what would still be a largely visual purchasing process;

c) The marks are visually and aurally similar to a medium degree;

d) A group of consumers would perceive the 546 mark as referring to seasons of the year, while another group would think that it denoted series of a television show or podcast;

e) For the first group of consumers, the marks do not share any conceptual similarity; for the second group, the marks are conceptually highly similar;

f) For the first group of consumers, the 546 mark has a medium degree of inherent distinctive character; for the second group, the 546 mark has a low degree of inherent distinctive character when used for television services; and

g) The inherent distinctive character of the 546 mark has not been enhanced through use.

122. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ (as he then was) held that, if it is found that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court, then that court may properly find infringement. The reasoning applies equally

under section 5(2). In my view, a significant proportion of the relevant public would find the 546 mark allusive and low in distinctive character.

123. In *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, BL O/0368/23, Ms Emma Himsworth KC, sitting as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHWC 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Ms Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness in paragraph 44 as follows:

> "(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.
>
> (2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.
>
> (3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.
>
> (4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.
>
> (5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.
>
> (6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical."

124. The coinciding element of both marks is low in distinctive character for goods and services related to television and podcasts. I remind myself here that I found that the overall impression of the opposed mark lay in the mark as a whole. Consequently, the impact of the word "fifth", which has no counterpart in the 546 mark, is not insignificant. I therefore find that the average consumer is unlikely to mistake one mark for the other and so be directly confused between them.

125. Turning now to the likelihood of indirect confusion, I consider that the common element in the marks, the word "season" either in its singular or plural form, is not so distinctive that the average consumer would assume that only Canal+ would be using it in a mark. I have considered the evidence in Exhibit CHP18 that shows examples of use of the ordinal numbers (first, second, third, etc.) in articles discussing films and television programmes. In my view, these are examples of ordinary English usage (such as *"Welcome back to Eden for a second season", "Wonder Woman 1984: 10 ways the film sets up the third movie", "Peter Morgan previews the 'difficult' fifth season of 'The Crown'"*). There is no evidence that these are words that one would expect to find in a brand extension. Even if – notionally – the later mark were to call to mind the earlier mark, this would be mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. I find that there is no likelihood of indirect confusion.

126. The section 5(2)(b) fails.

**Section 5(3)**

127. Section 5(3) of the Act is as follows:

> "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 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."

128. As the 546 mark is a comparable mark, Paragraph 10 of Part 1 of Schedule 2A of the Act is relevant. It reads:

> "(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to-
>
> (a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and
>
> (b) the United Kingdom include the European Union."

129. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, Canal+ must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

130. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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 Salomon*, 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) 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.

i) 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 on the earlier mark; *L'Oréal*, paragraph 40.

j) 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal.*

131. I have already found that the marks are similar. With respect to reputation, I consider that the evidence I have already summarised falls short of what would be required to show that the 546 mark had a reputation within the EU. This is because there is very little evidence about the extent to which the relevant public, which is the general public, would have been aware of the mark. There is no information on viewing figures within the relevant date and the financial information cannot be attributed to the SEASONS channel alone. In addition, the evidence of advertising and promotion is fairly limited. However, even if I am wrong on the question of reputation, I consider that a link would not be made in the mind of the relevant UK public. This is because the mark has not been used in the UK.

132. The section 5(3) ground fails.

**OUTCOME**

133. The application for revocation against UKTM No. 901217546 is partially successful. With effect from 9 June 2021, it is revoked for the following services:

> *Class 38*
> *Communications via Hertzian wave, satellites or cable; issuing of documents; communications services, namely news and information agencies; radio broadcasting, communications by telegrams or communications by telephone; transmission of information by teleprinter.*
>
> *Class 41*
> *Theatrical agencies; rental of motion pictures, film recordings, sound recordings and stage set accessories; production of radio programmes; arranging of competitions for education or entertainment; arranging and conducting of congresses, colloquiums and conferences.*

134. It remains registered for the following services:

> *Class 38*
> *Broadcasting of films and television programmes; transmission of information in the form of films and television programmes for public information.*
>
> *Class 41*
> *Production of motion pictures, television series and television broadcasts; production of television shows; production of television programmes.*

135. The application for revocation against UKTM No. 901712876 is wholly successful. The mark is revoked in its entirety with effect from 9 June 2021.

136. The opposition has failed and Application No. 3654091 may proceed to registration.

**COSTS**

137. Both parties have enjoyed some success in these consolidated proceedings. The greater share in this success has gone to Fifth Season and therefore I am minded to make an award of costs in its favour, reflecting the relative success. At the hearing, I

indicated that I considered that costs on the scale were appropriate in these proceedings. However, Ms Reid asked at the hearing for costs off the scale in relation to the revocation application against the 876 mark, the defence of which was maintained until the skeleton argument. She maintained that the continued defence had been an act of bad faith. I said that I would seek separate submissions on costs.

138. Fifth Season therefore has 14 days from the date of this decision to file submissions on costs in relation to the revocation application against the 876 mark. Canal+ will then have 14 days from the receipt of those submissions to make its own submissions on costs. I will then issue a decision on the costs for the consolidated proceedings and set the appeal period.

**Dated this 13th day of November 2025**

**Clare Boucher,**
**For the Registrar,**
**Comptroller-General**