

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2146979B  
BY EMAP PERFORMANCE LIMITED (PREVIOUSLY EMAP RADIO LIMITED)  
TO REGISTER THE MARK RADIO CITY IN CLASSES 35, 38 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50151  
BY RADIO CITY TRADEMARKS LLC**

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**IN THE MATTER OF Opposition thereto under No 50151  
by Radio City Trademarks LLC**

## **DECISION**

1. On 3 October 1997 EMAP Radio Limited applied to register the mark RADIO CITY for the following specification of services:

Class 35:

Advertising, marketing and promotional services.

Class 38:

Radio broadcasting services; radio programming, broadcasting and production services; wireless transmission and broadcasting of television programmes.

Class 41:

Radio entertainment services; production of radio programmes; education and instruction by or relating to television or radio; production and presentation of radio programmes; interactive information relating to radio or television broadcasting provided on-line from computer data bases or from facilities provided on the Internet (including web sites); information relating to radio or television broadcasting provided on-line from computer data bases or from facilities provided on the Internet (including web sites); information relating to radio or television broadcasting provided on-line from computer databases or the Internet; organisation of competitions and awards, arranging and conducting award ceremonies; presentation of awards for achievement; education and training services relating to radio or television broadcasting; arranging and conducting courses, conferences, exhibitions, events and seminars.

2. The application is numbered 2146979B.

3. On 9 September 1999 Radio City Trademarks LLC filed notice of opposition to this application. They are the proprietors of the following earlier trade marks:

No.	Mark	Class	Specification
2009209	RADIO CITY	25	Articles of leisure clothing and articles of casual clothing; shirts, T-shirts, tank tops, sweatshirts, polo shirts, windbreakers, jackets, sweatpants, sweatbands, hosiery, scarfs, shawls, skirts, shorts, slacks, trousers, jumpsuits, dresses, bathing suits, bathrobes, sweaters, hats, visors, headbands, wristbands, ties, belts, gloves, pyjamas, nightgowns, articles of underclothing, braces, overalls, boxer shorts, rompers, layettes, socks and dance costumes; athletic apparel; children's apparel; adorned leotards, tights, skirts, jackets, dresses, gloves, hats, masks, braces, headgear and shoes, all being for dance costumes; headgear, footwear, boots, shoes and slippers.
		41	Entertainment services relating to dance, theatre and musical performances and to movie shows and performances; production and presentation of theatrical, musical and cinematic shows and performances.
2122853	RADIO CITY ROCKETTES	25	Articles of clothing, headgear, footgear, boots, shoes and slippers.
		41	Entertainment services relating to dance, theatre and musical performances and to movie shows and performances; production and presentation of theatrical, musical and cinematic shows and performances; entertainment services by dance group; live stage performances, recorded and transmitted performances for television, and performances and appearances in connection with parades, contests, promotions, concerts, theatre productions, stage shows and movies.

4. The opponents also say that RADIO CITY is a well known mark within the meaning of Article 6 bis of the Paris Convention. Objection is said to arise under Sections 5(2)(b) and 5(4)(a). In fact the supporting text refers to identical or similar marks and thus appears also to contemplate an objection under Section 5(2)(a). There is also a request for the exercise of any

discretion available to the Registrar. I have no general or overriding discretion so need make no further reference to this aspect of the opposition.

5. The applicants filed a counterstatement denying the above grounds.

6. Both sides ask for an award of costs in their favour.

7. Both sides filed evidence. Neither side has asked to be heard and neither side has made written submissions beyond the observations made in the evidence itself. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

8. Section 5(2) reads:

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

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

9. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

10. Although I consider there is some conflict between the wording of the opponents' objection and the sub paragraph reference it is evident that they have one mark (No. 2009209) which is identical to the mark applied for and one (No. 2122853) which is similar. I propose therefore to take the objection at its broadest, that is to say that it arises under both sub paragraph (a) and (b) of Section 5(2). No. 2122853 has a slightly wider specification of goods and services but nothing in my view turns on the point. I will therefore approach the matter primarily on the basis of the opponents' registration No. 2009209 which gives rise to an objection based on identical marks. Having regard to the ECJ cases I bear in mind particularly that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa, the latter being the case here (*Canon v MGM*, paragraph 17) and that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it (*Sabel v Puma*, paragraph 24).

11. In the latter context the opponents have filed a declaration by Mechelle Evans, their Vice President. I can find nothing in this declaration or the supporting exhibits that remotely supports any claim to use in this country or any enhanced degree of distinctive character for the mark as a result of such use. In the circumstances I do not propose to summarise this

evidence. The character of the mark therefore rests on its inherent attributes. Although the words that make up the mark are dictionary words the combination is perhaps somewhat unusual in the context of the goods and services at issue. I, therefore, consider it to be a moderately strong mark.

12. The opponents have not identified in their statement of grounds or evidence the basis for their view that similar goods/services are involved and confusion likely. Nor have they filed any written submissions to assist me. They seek refusal of the application in its entirety. I therefore take it to be a blanket objection to the full range of goods and services tendered for registration.

13. In approaching the matter of similarity of goods/services I bear in mind the following guidance from the CANON case referred to above

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

and on the assumption that the opponents base their case mainly on their Class 41 service, the following passage from Jacob J's judgment in *Avnet Incorporated v Isoact Ltd*, 1998 FSR16

".... definitions of services .....are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes".

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

14. The opponents' earlier trade marks do not extend to two of the Classes of interest to the applicants - that is Classes 35 and 38. No explanation has been offered by the opponents to support their objection to these services. The applicants' Class 35 services do not seem to me to have any obvious point of similarity with the opponents' services. The Class 38 services are concerned with the means of diffusion of radio programmes and, bearing Jacob J's comments in *Avnet* in mind, they too must be considered different in kind to entertainment services. I, therefore, find that the application is unobjectionable in so far as it covers Class 35 and Class 38 services (Article 13 of First Council Directive 89/104 refers).

15. Class 41 presents rather more difficult issues not least because the applicants in particular have employed rather general and wide-ranging terms in their specification and neither side has offered written submissions on the issue of similarity. I, therefore, find myself in the position of having to strike a balance between not unduly restricting the potential meaning of terms within the respective specifications whilst at the same time not stretching their natural meaning beyond the essential characteristics of those services. On that basis it seems to me

- the opponents' services are generally specific as to subject matter (eg. dance, theatre, musical performances etc) and, in the absence of any reference to a medium such as radio or television, might naturally be taken to refer to live entertainment services. But they are not in so many words restricted in this way. Thus "entertainment services relating to ..... "musical performances" could conceivably include a radio broadcast of a music concert
- radio entertainment services must embrace and be in conflict with entertainment services generally
- services of production and presentation of radio programmes would cover both the technical aspects of producing programmes (the provision of studio facilities etc.) and the production of the artistic content of the programmes. That is to say the term could include radio entertainment services
- "information relating to radio or television broadcasting...." seems to me to contain an element of ambiguity as to whether it is intended to cover the process of broadcasting or the content of what is broadcast. From the fact that the services have been applied for in Class 41 I assume it is in fact the latter. Even so it is, it seems to me, in essence an information service rather than an entertainment service
- organisation of competitions, award ceremonies etc. in the context of a radio or TV show are, or can be, presented as a form of entertainment service
- "education and training services relating to radio or TV broadcasting" presents similar difficulties of interpretation to the information services referred to above. On the whole I take them to be different in kind to the opponents' entertainment services
- "arranging and conducting courses, conferences, exhibitions, events and seminars" would not generally be considered similar to entertainment services. They have what one might call a largely instructional or educational function or that is how I think the average person would construe such terms. My only doubt is the inclusion of 'events' which could be something akin to an entertainment service (I note for instance that Ms Lund-Beck refers to the applicant's involvement with radio road shows and other live musical entertainment events).

16. There is a further piece to the jigsaw in that the applicants have filed evidence of use of their mark. No express reliance is placed on honest concurrent use in either their statement of grounds or their evidence but I assume that they have filed evidence of use with this in mind. I will briefly consider this use but noting at the same time that the opponents have filed no detailed evidence to support any claim to use in this country (thus the impact of concurrent use has not been tested).

17. The position in relation to honest concurrent use was set out in CODAS Trade Mark, 2001 RPC 240 and in particular the following passage

"In the circumstances and for the reasons above, I reject Mr Hacon's submission that because the proprietor of the earlier trade mark against which the applicant for registration has claimed honest concurrent use has opposed the application, the provisions of section 7(2) make the refusal mandatory. However, as I have already said, the mere fact that there has been honest concurrent use is not a defence, which in itself will save an application, but it is one of the "relevant" factors which should be taken into account in determining whether there is a likelihood of confusion."

I adopt that approach.

18. Two statutory declarations have been provided by the applicants. The first is by Timothy Ralph Schoonmaker, Chief Executive of EMAP Performance Ltd and the second by Christine Lund-Beck, the applicants' trade mark attorney. Mr Schoonmaker says the trade mark RADIO CITY was first used in the United Kingdom in 1974. The mark and the goodwill relating thereto was acquired by the applicants in 1991. He says that the trade mark has been used in relation to all the activities associated with a radio station, such as radio broadcasting, radio entertainment services and advertising. (Ms Lund-Beck expands on this somewhat and says that in addition to radio broadcasting services the mark has been used on related ancillary goods and services and that the reputation this gives rise to has been enhanced by activities in relation to the organisation, presentation and provision of live musical events and entertainment such as radio road shows, pop concerts, shows, events, displays and parties; the organisation of events for sporting purposes; the organisation of competitions and awards and the publication of printed matter). The mark is also said to appear on all publicity, advertising and merchandising material produced by the radio station as well as on administrative stationery relating thereto. Mr Schoonmaker gives turnover for the years 1984 to 1997. This ranges from £2.84 million in 1985 to £7.37 million in 1997 and averages around £4 million per annum. The mark is also said to have been promoted in a variety of ways with the advertising spend for the years 1993-1997 put at £1.67 million.

19. The applicants' claims in relation to services and goods as described by Mr Schoonmaker and Ms Lund-Beck are broad ones. However there is just a single exhibit by way of substantiation of this use (TS1 to Mr Schoonmaker's declaration). This consists of eight photocopied pages showing what appears to be a photocopy of two cassette covers; a copy of photographs taken (I assume) outside the applicants' premises with signage showing Radio City 96.7; pictures of the mark Radio City 96.7 in use at a road show event or concert; an advertisement and programme for a Radio City Ladies' Racing Evening (well after the material date); and a mousemat and coaster imprinted with Radio City 96.7. With the exception of the item that is clearly after the material date none of the items are dated. This evidence is in my view wholly insufficient to support the generality of the claim that is being made and is of little assistance to the applicants beyond confirming their existence as a radio broadcaster.

20. The result of all this is that, bearing in mind that the applicants' mark and the opponents' mark (No. 2009209) are identical, I find there is a likelihood of confusion to the extent that the applicants' services may be said to be entertainment services albeit that they are offered

within the context of the activities of a radio programme. However the guidance from the CANON case is that

"22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar."

21. I am not persuaded that, without placing an unduly wide construction on the opponents' specification, the remainder of the applicants' Class 41 specification is open to objection. In reaching that view I do not discount the possibility that some people encountering the applicants' mark may be reminded of the opponents' mark. But, as was noted in *Sabel v Puma* (paragraph 26), mere association in the sense that the later mark brings the earlier mark to mind is not sufficient for the purposes of Section 5(2). I will deal with the consequences of this below after a brief diversion to the opponents' claim under Section 5(4).

22. In fact the opponents in their statement of grounds appear to link their case under Section 5(4)(a) with the claim that RADIO CITY enjoys the status of a well known mark within the meaning of Article 6 bis of the Paris Convention. Well known marks are brought within the definition of "earlier trade mark" in Section 6(1)(c) and thus have a part to play in proceedings under Section 5(1),(2) and (3). Section 5(4)(a) is, by contrast, based on common law rights. The conventional test for determining whether a party has succeeded under this Section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark*, 1998 RPC 455. Briefly the test requires the opponents to show the three elements - goodwill, misrepresentation and damage. As the opponents have provided no information on use of their mark in this country they are bound to fall at the first hurdle. I do not, therefore, need to consider the Section 5(4)(a) case any further.

23. The consequences of the above finding under Section 5(2) is that the application will be allowed to proceed to registration if, within 28 days of the end of the appeal period, the applicants file a Form TM21 restricting their specification as follows:

Class 35:

Advertising, marketing and promotional services.

Class 38:

Radio broadcasting services; radio programming, broadcasting and production services; wireless transmission and broadcasting of television programmes.



Class 41:

Interactive information relating to radio or television broadcasting provided on-line from computer data bases or from facilities provided on the Internet (including web sites); information relating to radio or television broadcasting provided on-line from computer data bases or from facilities provided on the Internet (including web sites); information relating to radio or television broadcasting provided on-line from computer databases or the Internet; education and training services relating to radio or television broadcasting; arranging and conducting courses, conferences, exhibitions, and seminars.

24. If the applicants do not file a Form TM21 restricting their specification in this way the application will be refused in its entirety.

25. As both sides have achieved a measure of success I do not propose to make a costs award in favour of either party. If the applicants do not restrict their specification as set out above and the application is refused then the opponents will be entitled to ask for a supplementary decision in relation to the consequence as to costs.

**Dated this 17<sup>TH</sup> day of August 2001**

**M REYNOLDS  
For the Registrar  
The Comptroller-General**