

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2181480
BY VIACOM INTERNATIONAL INC.
TO REGISTER THE TRADE MARK:
BYTESIZE
IN CLASSES 18, 25 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 49953 BY
THE BRITISH BROADCASTING CORPORATION**

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IN THE MATTER OF Opposition thereto under No 49953
by The British Broadcasting Corporation

Background

1. On 6 November 1998 Viacom International Inc. of New York, USA applied to register the trade mark **BYTESIZE**. The application was published with the following specification:

Leather and imitations of leather and goods of these materials; animal skins, hides; trunks and travelling bags; umbrellas; parasols and walking sticks; bags; backpacks; satchels; haversacks; knapsacks; rucksacks; valises; holdalls; cases; wallets; pouches; articles of luggage; tote bags; beachbags; shopping bags; shoulder bags; belts; cases; key cases; key fobs; purses; straps; thongs; leather shoulder belts; whips, harness and saddlery; gym bags, duffel bags, bum bags, briefcase type portfolios, briefcases - class 18

Clothing; footwear; headgear; sportswear; swimwear; leisurewear; knitwear; nightwear; shirts, t-shirts, sweatshirts; jeans, trousers; hats, caps; boots; shoes, sandals, slippers; belts, scarves, gloves, socks; ties; outer-clothing, casualwear; jackets, suits, skirts, stockings, tights, sweaters, dresses, blouses - class 25

Radio and television entertainment services; preparation of radio and television programmes; production of films and live entertainment features; production of cinematographic films and TV shows; production of animated motion pictures and television features; services relating to cinema and to television entertainment, and to live entertainment performances and shows; entertainment, education and instruction by or relating to radio and television; film, music, sport, video and theatre entertainment services; production, preparation, presentation, distribution, syndication, networking and rental of television and radio programmes and of films, animated films, and sound and video recordings; services relating to motion picture entertainment, to television entertainment and to live performances and shows; organisation, production and presentation of events for entertainment purposes - class 41

2. On 7 July 1999 The British Broadcasting Corporation filed notice of opposition to this application.

3. The opponent originally submitted various grounds of opposition but in his submission limits himself to the ground that use of the opposed trade mark would be liable to be prevented under the law of passing-off; registration of the application in suit would, therefore, be contrary to section 5(2)(a) of the Act.

4. The applicant filed a counterstatement denying the ground of opposition.

5. Both parties seek an award of costs.
6. Only the opponent filed evidence. Both parties agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.
7. Acting on behalf of the Registrar I duly give the following decision.

Opponent's evidence

8. The opponent's evidence consists of a witness statement dated 6 February 2001 by Catherine Jane Boulton, who is Head of Product Development, BBC Educational Publishing.

9. Ms Boulton states that in mid 1997 the opponent created a new product designed to aid students with GCSE examination revision. She states that the product was available in a variety of media including books and printed materials, CD ROMs, television programmes and on-line via a dedicated website. Ms Boulton states that the brand name for this new product was devised in August/September 1997 and that since that time all such goods and services have been provided under the BITESIZE mark.

10. Ms Boulton states that in October and November 1997 the opponent mailed pre-launch publicity material to all secondary schools in England, Wales and Northern Ireland. She states that separate BITESIZE products have been developed for Standard Grade examinations in Scotland. She states that extensive trailers were used to publicise the launch of BITESIZE between 30 January and 12 March 1998 and again between 27 March and 16 April 1998. She asserts that the campaign resulted in the rapid creation of considerable goodwill in the BITESIZE mark. Exhibit CJB-1 consists of a selection of trailers for BITESIZE in relation to both GCSE and Standard Grade. It is noted that the BITESIZE logo appears in the top corner of the trailers, which include extracts from the series. There is also an extract from a television programme - which appears to be a magazine programme with the title of "Really Useful". In this extract the launch of the product is discussed. One of the participants comments that people should set their video recorders for the programmes, there is also an extract from the website. Taking into account the details of the launch date given by Ms Boulton this television extract would have emanated from early 1998, prior to the date of the filing of the application. The representative of the product who appears in the programme comments that the information is represented in bite size chunks, hence the name. The trailers also emphasise the bite size chunk nature of the product.

11. Ms Boulton states that in January 1998 the first seven BITESIZE revision guides were published in the following GCSE subjects: English, French, Geography, German, History, Maths and Science. Exhibited at CJB-2 are the guides for French, German and History. The guide for French is for Standard Grade and so presumably for Scotland, it was first published in 1999 and so is after the relevant date. Also exhibited is a book of revision tips - however this was first published in 2000 and so is also after the relevant date. Ms Boulton goes on to state that since January 1998 further subjects have been added but she does not give dates. Ms Boulton states that the opponent has developed a BITESIZE revision course in Welsh - she exhibits at CJB-3 a leaflet in Welsh and English. However, as the leaflet refers to the most popular revision service in 1999 it must emanate from after the date and so, again, after the relevant date. Ms Boulton states that

the guides are designed to be used by students and teachers (in conjunction with corresponding guides available in other media) as teaching and revision aids for GCSE (or in Scotland Standard Grade) courses. She states that there have been significant sales of BITESIZE branded revision guides both before and since the application in suit was filed. She exhibits at CJB-4 a table showing the volume and value of sales of BITESIZE branded revision guides to June 2000. However, no indication is given as to the volume and value of sales up to the date of the filing of the application in suit and so this information does not assist the opponent.

12. Ms Boulton states that in addition to the sale of printed study aids, the opponent's commercial subsidiary (BBCW) has published two CD-ROMs under the BITESIZE mark - one for GCSE maths and one for GCSE science. Exhibited at CJB-5 are samples of the CD-ROMs. However, they all indicate a date of production of 1999, again after the date of the filing of the application in suit and so again do not have a bearing upon the instant proceedings.

13. Ms Boulton states that the BITESIZE website was launched in February 1998. She exhibits at CJB-6 printouts for the home pages for each of the revision courses covered by the web site. She states that the site also enables teachers and students to interact on-line and exhibits printouts of these web pages at CJB-7. Again all the printouts are after the relevant date. However, this is hardly surprising as it would be impossible to download from the past.

14. Ms Boulton states that the website has attracted a large number of hits since it was launched. She states that from April 1998 until the date of the filing of the application in suit there were approximately 1,375 million hits on the web site. She then goes on to give figures in relation to hits after the relevant date, and so which do not have a bearing upon the instant proceedings.

15. Ms Boulton states that as part of the project the opponent has produced twenty six television programmes of two hours duration each; these have been transmitted overnight between three and five a.m. on Saturdays on BBC 2 with the express aim of allowing students and teachers to record the programmes in the following GCSE subjects - English, French, Geography, German, History, Maths and Science. She states that prior to the date of the filing of the application in suit there were some seventy eight broadcast hours covering the above subjects. She exhibits at CJB-8 details of the broadcast dates prior to the filing of the application in suit. She states that the actual audience figure is low because the programmes are broadcast overnight to allow students, teachers, parents and schools to record the programmes. The audience figures range from 3,000 to 158,000, with a great deal of variation.

16. Ms Boulton states that the 1998/1999 evaluation report - exhibited at CJB-9 - demonstrates that the actual number of viewers is far greater than the above figures as the recorded programmes are used across the country as revision guides. She refers to figures for the 1998/1999 academic year. This period would cover a time after the relevant date and so cannot be clearly allocated to a time prior to the date of the filing of the application in suit. Ms Boulton goes on to refer to matters which are after the relevant date.

17. Ms Boulton states that it is important to note that not only are BITESIZE products and videotapes used by and/or shown to substantial numbers of students and teachers nationwide during the academic year but in many cases students' families are also aware that the opponent markets and/or provides BITESIZE revision guides in a variety of media.

Ms Boulton states that, as detailed on page 9 of the Evaluation Report exhibited as CJB-9, a three-step publicity campaign is carried out to promote BITESIZE products and services during each academic year. In November a mail shot of leaflets is sent to teachers and schools. This is followed in January/February by distribution of free guides, posters and leaflets to parents and students and posters and more leaflets to schools. These tie in with the launch of new programmes/subjects and CD-ROMs. The last stage takes place around Easter to coincide with the last minute panic buying and revision by GCSE students. She states that television trailers are also used to promote the opponent's revision guides and study aids in the latter two stages. She exhibits at CJB-10 publicity materials, guides and order forms. The evidence of Ms Boulton indicates that the use in the 1998/1999 would have commenced in November, and the bulk of use in 1999. As the application in suit was filed on 6 November 1998 I consider that use in relation to the academic year 1998/1999 cannot be taken into account. Much of the material exhibited does not bear a date or emanates from after the relevant date. Certain of the material gives a date but no indication of the year. However, certain of the material relates to programmes in relation to French, Geography and German that are identified as being broadcast in 1998 prior to the date of the filing of the application in suit. In certain of the material there is also reference to the web site "going live" on 1 February 1998.

18. Ms Boulton goes on to deal with expansion of BITESIZE revision aids in 2000 in relation to KS3 - which I assume means Key Stage 3. Clearly, again, this is not relevant to the instant proceedings as it is after the relevant date.

19. Ms Boulton states that the opponent has accrued a significant reputation in the BITESIZE mark in relation to study aids and revision guides. She states that there is no doubt in her mind that BITESIZE is extremely well-known and that products and services appearing under the mark are recognised (both at the time of her declaration and before the filing of the application in suit) by a substantial number of students, teachers and parents in the relevant market. She states that she believes that consumer confusion will ensue from the use and/or registration of the application in suit given the goodwill in the opponent's mark and the fact that the application in suit is phonetically identical to the opponent's BITESIZE mark.

20. She states that the likelihood of confusion is further increased by the clear overlap which exists between the specification of the application in suit and the goods and services upon which the opponent has used its BITESIZE mark prior to the filing of the application in suit.

21. Ms Boulton states that the class 41 specification of the application in suit essentially covers the production and presentation of sound and video recordings (including television programmes) and the provision of education and instruction services.

22. She states that the opponent and its subsidiary BBCW are known to routinely exploit major brands by marketing spin-off merchandise derived from its programmes and services. She states that as a result it is conceivable that if the application in suit is registered in respect of goods in classes 18 and 25 the public may think that these goods are associated with or endorsed by the BBC.

Submissions of the opponent

23. Much of the submission rehearses the facts of the case and the evidence of Ms Boulton, all of which have been dealt with above and so I will not further rehearse them here.

24. The opponent submits that the applicant has not filed any evidence and, accordingly, has failed to substantiate any rights he claims to have acquired through the use of the trade mark BYTESIZE. He states that the registrar is invited to draw inferences from the fact that the applicant has failed to adduce evidence to rebut the opponent's claim that registration of the application in suit would be contrary to the provisions of section 5(4) of the Act.

25. The opponent submits that he has acquired a reputation or goodwill in the field of education under the mark BITESIZE and is well-known under this trade mark.

26. He contends that the use and/or registration of the trade mark BYTESIZE amounts to a misrepresentation by the applicant which is likely to lead the public to believe that the goods and services offered by the applicant are the goods and services of the opponent.

27. In substantiating its claim that deception or confusion of the public is likely, the opponent submits that:

- a. the opponent has acquired a significant reputation
- b. the respective fields of the activity of the applicant and the opponent are likely to overlap to a considerable degree, particularly in relation to educational services in class 41, however by reason of spin off merchandising also in classes 18 and 25
- c. the respective trade marks are phonetically identical
- d. the trade mark of the applicant is likely to be used in a similar manner as the mark of the opponent in class 41 - as a brand description for educational services
- e. use and/or registration of the applicant's trade mark is likely to deceive all adults and children concerned with the use and/or purchase of educational materials and services

28. The opponent submits that he is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

29. Consequently the opponent submits that he is likely to succeed in an action for passing-off and, therefore, has substantiated his claim to an earlier right.

Submissions of the applicant

30. The applicant submits that the opponent has to show that he enjoyed goodwill in the trade mark BITESIZE as of the date of the filing of the application in suit, 6 November 1998. He states that the opponent commenced use of BITESIZE only eleven months or so prior to the filing of the

application in suit. He submits that various parts of the witness statement of Ms Boulton should be disregarded as they relate to periods after the relevant date. (I have noted this at various points in my summary of the evidence.)

31. The applicant submits that use of a trade mark does not per se equal goodwill. He “notes with interest” that the evidence of the opponent comprises nothing in the way of independent comment as to the goodwill attaching to the BITESIZE trade mark as of the relevant date. He states that the goods/services provided by the opponent appear to be rather specialised - “ *a new product designed to aid students with GCSE examination revision*” (paragraph 3 of Ms Boulton’s statement; “ *revision guides*” (paragraph 5) and “ *guides designed to be used by students and teachers (in conjunction with corresponding guides available in other media) as teaching and revision aids for GCSE (or in Scotland Standard Grade) courses*”. The applicant submits that, therefore, if the opponent can rely on goodwill it has to be considered to be applicable to a very narrow field of activity.

32. The applicant states that the opponent has not provided him with copies of the exhibits to Ms Boulton’s statement, instead they indicated that “copies of the exhibits are available for inspection on reasonable prior notice”. He states that he has not been provided with copies of any of these exhibits. He states, however, that he believes that the opponent’s trade mark BITESIZE is ordinarily used together with an indication of BBC origin. He states that this has a two fold effect:

- i) it still further removes any valid claim of the opponent to have demonstrated goodwill attaching to BITESIZE per se and
- ii) it still further diminishes any likelihood of the mark BYTESIZE as used by Viacom (such use being entirely absent of any reference to BBC or suchlike) leading to a misrepresentation.

33. The applicant states that there is no evidence of any misrepresentation. The applicant states that there is no evidence that the public have been confused or misled or think that the goods of the applicant are associated with or endorsed by the opponent. He states that in the absence of evidence of misrepresentation or of likelihood of misrepresentation the opposition should be rejected.

34. The applicant states that the evidence of the opponent does not address the matter of damage to his business having regard to the use of BYTESIZE by the applicant. He states that the opposition should be rejected if damage or foreseeable damage has not been established in the evidence of the opponent. He states that he would like to emphasise that in the absence of any evidence as to misrepresentation he cannot see how there can be damage to the business of the opponent.

Decision

Preliminary issue - copying of exhibits by opponent

35. In the submissions of the applicant he states that he has not received copies of the exhibits. The opponent has not responded to this submission. The Office returned the exhibits to the opponent, at his request, to allow them to be copied as he stated that he had not kept a copy. The Office's letter of 21 February to the opponent states:

"I refer to your telephone call to the Registry on 20 February 2001, in which you advised that you had not retained all copies of the Exhibits CJB1- CJB11 which accompanied the Witness Statement by Catherine Jane Boulton filed at the Registry on 8 February 2001. You also advised that Exhibit 1 (in the form of a video) had not been copied to the other party.

I therefore enclose the originals of the Exhibits for you to copy as required....."

36. In an extension time request received on 9 April 2001 the opponent stated inter alia:

"The Opponent's evidence was filed at the Registry direct by the Opponent without taking copies of the exhibits. The Opponent sent a copy of the statement of Catherine Boulton to the agents for the Applicant but it was necessary to obtain from the Registry the original exhibits in order to be in a position to either offer inspection of the same or to copy and serve them on the agents for the Applicant.

Inspection was offered but the agents for the applicant do not want to take up the offer of inspection at this stage because the parties are close to agreement or settlement. Accordingly, inspection has been delayed at the request of the Applicants."

37. I consider that this supports the claim of the applicant that the opponent did not serve the exhibits upon him. Rule 13(7) of The Trade Marks Rules 2000 states:

"Within three months of the date upon which a copy of the counter-statement is sent by the registrar to the person opposing the registration, that person may file such evidence as he may consider necessary to adduce in support of his grounds of opposition and shall send a copy thereof to the applicant."

It is clear that to comply with the timeous filing of evidence the opponent must send a copy of the evidence to the applicant. There is no exception for exhibits which form part of the evidence, they are part and parcel of the evidence. They are there to help substantiate the claims of the opponent. The need to copy all exhibits is emphasised by a Practice Notice that the registrar issued:

"Video tapes exhibited in evidence in inter partes proceedings before the Registrar

It has been the Registrar's practice to accept that video tape material exhibited in evidence before him need only be supplied to the Trade Marks Registry, the other party (or parties) to the proceedings being asked to arrange to view the material (if they wished) at a date and time convenient to them at the premises of the Trade Marks Registry. In the case of

practitioners and parties who are not in close proximity to the Trade Marks Registry's offices in London or Newport this has been a matter of some inconvenience.

Increasingly, the contents of video tape material is of importance in proceedings and it is important, therefore, that the other party (or parties) is in a position to view the content of the video taped material and ascertain its relevance to the proceedings. As it is now technologically much easier than hitherto to copy video tapes, the Registrar has determined and directs that where a party in inter partes proceedings exhibits material in the form of a video tape then that video tape must be copied to the other party (or parties) with, and at the same time as, the evidence in relation to which it is being exhibited. Practitioners will note that Section 45(1) of the Copyright Designs and Patents Act 1998 allows for copying in relation to parliamentary and judicial proceedings.

In addition, whenever information in electronic/magnetic/encoded form is exhibited to evidence filed in inter partes proceedings (as well as that held on video tape) it will be the Registrar's practice to require the copying of the material, e.g. on disc, to the other side.

Unless therefore there are exceptional reasons for not doing so then parties to proceedings must provide the other side with copies of all evidence and exhibits where information is filed in electronic form.”

38. I do not consider that it can be acceptable that the opponent did not copy the exhibits to the applicant but would allow him to inspect them. This does not comply with rule 13(7) which requires him to copy, it does not state can or may be made available to the applicant. It is also to be noted that this is long well established practice of which any practitioner should be aware.

39. As the opponent has failed to comply with rule 13(7) in respect of the exhibits I must consider whether I can consider that the exhibits are before me. I note that when the Office wrote to the applicant advising him of receipt of the evidence the exhibits were specifically referred to in the letter. However, the applicant did not come back and advise at that time that copies had not been served upon him. It could be argued that the applicant did not seem very interested in this failing as he did not raise the issue at the time. Indeed he only raised the matter when putting in his submissions, and has not stated that the exhibits should be ignored. Indeed he does not seem particularly exercised by the failure to copy the exhibits - he only deals with the issue to speculate how the opponent might use the trade mark in conjunction with another element. The Office wrote to the applicant on 13 February 2001 to advise him of the receipt of the evidence. At that time the opponent still had until 26 February 2001 to file evidence and so could have rectified the filing within the time limit. It is also be noted that owing to the long established practice that is referred to above the applicant would have been well aware of the requirement.

40. The opponent should have copied the exhibits. However, the matter was only raised by the applicant at the very last stage of the proceedings - in his submissions. The applicant had plenty of time to raise the matter at an earlier stage. He would also have been aware that as the evidence was very much directed to passing-off how important the exhibits would be, to show actual use of the earlier trade mark. The applicant was also advised that he could inspect the exhibits and so it cannot be considered that the opponent was acting in an underhand manner. The impression I am left with, whether correctly or not, is that he was not particularly concerned by the failure to copy the documents. By referring to this matter at such a late stage it would make any possibility

of remedying the failure of the opponent difficult. **Taking into account when and how the applicant raised the failing I have decided, with some misgivings, that I should take into account the exhibits furnished by the opponent.**

Section 5(4)(a) objection

41. The ground of opposition pursued by the opponent is that of section 5(4)(a) of the Trade Marks Act 1994. The relevant provision read as follows:

5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

In the instant case the relevant rule of law is the law of passing-off

42. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case (1998) 14 RPC 455*. In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341* and *Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 731* is (with footnotes omitted) as follows:

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

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

.....”Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that; “To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

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

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

43. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed". The relevant date is therefore the date of the filing of the application in suit.

44. The applicant has denied that the opponent has established a goodwill in the trade mark BITESIZE. He bases this claim on the time between the first use of the trade mark and the filing of the application in suit and on the presumption that the trade mark is used in conjunction with the house mark of the opponent.

45. Time certainly is often relevant in relation to establishing goodwill, the time that allows the trade mark to be known by the public. However, the exposure of a trade mark to the public could

be through such means that it will be known in a very short space of time. This is especially the case where modern media such as the television and the Internet are used. A goodwill can be established very quickly depending on the nature of the exposure. It is also the case that in certain circumstances the exposure to the trade mark is such that it does not even have to have been used on the goods or services, it could enjoy a goodwill simply from the promotional activities of the owner (*The British Broadcasting Corporation v Talbot Motor Company Ltd* [1981] FSR 228). The opponent sent publicity material out to every secondary school in England, Wales and Northern Ireland. He states that extensive television trailers were broadcast between 30 January and 12 March 1998 and 27 March and 16 April 1998, and he has exhibited various of these trailers. (Unfortunately he does not actually indicate by specific figures what he considers to be extensive.) In January 1998 the first BITESIZE revision guides were published - he does not, however, state how many of the guides were sold as of the relevant date. The opponent also advises that between April 1998 and the relevant date there were approximately 1.375 million hits on the web site. BITESIZE is used in a stylised form with a stylised fish with his jaws open wide, it is also used simpliciter. He exhibits at CJB8 details of the broadcasting of the programmes. In the video evidence the trade mark is referred to orally as BITESIZE. BBC appears on various publications as well as BITESIZE. It is hardly unusual for two trade marks to appear on goods, a house mark and a product mark. The public are well versed in identifying them jointly and severally. In the examples of use furnished by the opponent BITESIZE is certainly the dominant element, the brand identifier. The applicant has attacked the establishment of goodwill on the basis that no independent evidence has been furnished by the opponent. It may have been beneficial to the opponent if such evidence had been furnished. However, it is certainly not a necessity to establish goodwill. The evidence of use can on its own establish goodwill.

46. Taking into account all of the evidence before me I consider that as of the date of the filing of the application in suit the trade mark BITESIZE was acting as a magnet for the opponent's business, that it did enjoy goodwill. It is, however, a goodwill, at the relevant date, that is very much limited to a specific area of activity, the provision of revision courses in relation to GCSE courses.

47. There has been no dispute about the similarity of the respective trade marks. They are phonetically identical. Depending on one's spelling abilities or one's propensity for punning the respective trade marks could readily have the same conceptual associations. I do not think that it can be disputed that the two trade marks are very similar.

48. However, the issue of the similarity does not determine the scope of any deception/confusion. I need to take into the extent of use, both in terms of amount of use and area of use.

In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ states:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services”

In the same case Millet LJ states:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

In *Stringfellow v McCain Foods (G.B.) Ltd.* [1984] RPC 501 Slade L.J. said:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

The further apart the respective goods and/or services are the less likely are the public to be deceived or confused.

49. I also need to consider the distinctiveness of the opponent’s trade mark. There is a large tranche of case law which deals with the issue of distinctiveness of trade marks in relation to passing-off: *Horlicks Malted Milk Co v Summerskill* [1916] 34 RPC 63, *Canadian Shredded Wheat Co. Ltd v Kellogg Co. of Canada Ltd* 55 RPC 125, *McCain International Ltd v Country Fair Foods Ltd* [1981] RPC 69 et alia. The case law has established that the parameters of protection for a mark that is descriptive of the goods are extremely limited, at times non-existent. The video exhibit of the opponent refers to information being represented in bite size chunks. So I am left to consider whether the trade mark of the opponent simply describes the nature of his services and goods. BITESIZE alludes to how the system of revision works but I do not consider that it is an obvious and direct description. Bite size is normally used in relation to food products, I have no evidence before me that it is a term that is used in other spheres generally. Even spelt in the way of the opponent, owing to its Internet use, I consider that there is also a clever punning connotation in relation to bytes. I consider that the trade mark of the opponent although allusive is also arbitrary and can fully fulfill the role of an indicator of origin on a prima facie level.

50. I also note that applicant’s comments as to the difference between the trade marks owing to the absence of BBC from his trade mark. If his trade mark did actually have another trade mark with it, e.g. a house mark, there would certainly be a greater distance between the respective trade marks. It does not. There is nothing in it which clearly states I am not the product of the opponent but the product of the applicant. There is, therefore, nothing in it which would preclude the public from assuming that it is the trade mark of the opponent.

51. The opponent has made claims, presumably to expand his penumbra of protection, to the possibility of use of the trade mark in relation to goods for merchandising purposes. He has put in no evidence of plans for such use and I also note that he has eschewed reference to any relevant case law. It is a simple way of trying to expand a parameter of protection by making claim to a potential merchandising use. It is more difficult to justify the claim. I think it is accepted that the Australian courts have taken a more liberal of view of the position - but the Australian courts certainly require more than a vague and unsubstantiated claim. In the English courts all of the

normally referred to cases are interlocutory and did not go to full trial. In the instant case the opponent bases his claim on the basis that he is regularly involved in product marketing and merchandising as “spin-offs”. This may well be the case, the evidence is silent upon this, but I do not think even if it is that this is relevant. The first question to be considered is whether in relation to the particular field activity in which the opponent has goodwill at the relevant date is there likely to be product merchandising. He has put forward no evidence in relation to this, I am sure that there are other undertakings which produce revision aids for school examinations. The opponent could have submitted evidence to show their use in merchandising, if there had been any. If the merchandising were an argument that he was seriously relying upon he could have produced in evidence licensing agreements. He has not, he has based his claim to attack the entire specification of the application upon a vague and unsupported assertion, without redress to evidence or authority. On a simple evidential level I consider that the opponent has failed to substantiate his attack on the goods encompassed by classes 18 and 25 of the application in suit. If the opponent had put forward something in the way of evidence I consider that he would have also been likely to have foundered upon precedent (*Grundy Television v Startrain* [1988] FSR 581, *Wombles v Wombles Skips* [1977] RPC 99, *Lyngstad v Annabas* [1977] FSR 62 inter alia). The circumstances of *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145 were very different - and it is to be noted that in *Elvis Presley Trade Marks* [1999] RPC 567 Walker LJ held that this case “does not give a green light to extravagant claims based on any unauthorised use of a celebrity’s name, but makes clear the relatively limited scope of the principle on which it proceeds”. It is also noted that *BBC v Celebrity Centre* [1988] 15 I.P.R. 333 was only reported in Australia. I think that the instant case falls into the category of an “extravagant claim”.

52. Taking into account the limited nature of the goodwill of the opponent in terms of the use of his trade mark and the field of activity I consider that the area of deception will be limited to a common field of activity. (I note that the applicant has submitted that there has been no proof of confusion/deception in the market place. As the applicant has not furnished any evidence to show that he has used his trade mark in the market place I consider this submission irrelevant.) The only potential common field of activity lays in the services of the application in suit which I rehearse below:

Radio and television entertainment services; preparation of radio and television programmes; production of films and live entertainment features; production of cinematographic films and TV shows; production of animated motion pictures and television features; services relating to cinema and to television entertainment, and to live entertainment performances and shows; entertainment, education and instruction by or relating to radio and television; film, music, sport, video and theatre entertainment services; production, preparation, presentation, distribution, syndication, networking and rental of television and radio programmes and of films, animated films, and sound and video recordings; services relating to motion picture entertainment, to television entertainment and to live performances and shows; organisation, production and presentation of events for entertainment purposes - class 41

53. Taking into account the limited field of activity and the breadth of the specification of the application in suit I consider that there are areas in the specification which encompass a common field of activity and in relation to which confusion/deception would be likely to arise. These are the areas which specifically identify educational related services or could encompass such an activity. I consider that the removal of *education and instruction by or relating to radio and*

television from the specification and the addition of an exclusion as follows to the end of the specification “*but not including any such services relating to education*” - which would deal with the generalised elements of the specification - would obviate the potential confusion/deception. I consider that this is fair and reasonable to both parties; it leaves the bulk of the application in tact but also removes the general sphere of educational services - although in fact the opponent only had a limited area of interest in these at the relevant date. It clears away a firebreak between the two parties so that they can co-exist in the market place.

54. The applicant has submitted that the opposition fails on the final hurdle for passing-off in that he has not shown that he has or would suffer damage. In a *quia timet* action it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* 56 RPC 429 Goddard L.J. stated:

“But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man’s business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage.

It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage.”

55. The opponent has established goodwill and deception/confusion in relation to certain of the services of the application in suit. Use of the application in suit in relation to these services would injure the right of property of being the opponent’s right to the goodwill of his business. This is the damage that use of the application in suit would be liable to cause. As a *quia timet* case the opponent also has a plethora of potential heads of damage e.g. direct loss of sales, damage by potentially inferior services, injurious association and damage to reputation within the trade.

56. Consequent upon my decision as to the services for which the opposition is sustainable the applicant should file within one month of the expiry of the appeal period from the decision a form TM21 to amend the class 41 specification to the following:

Radio and television entertainment services; preparation of radio and television programmes; production of films and live entertainment features; production of cinematographic films and TV shows; production of animated motion pictures and television features; services relating to cinema and to television entertainment, and to live entertainment performances and shows; entertainment by or relating to radio and television; film, music, sport, video and theatre entertainment services; production, preparation, presentation, distribution, syndication, networking and rental of television and radio programmes and of films, animated films, and sound and video recordings; services relating to motion picture entertainment, to television entertainment and to live performances and shows; organisation, production and presentation

of events for entertainment purposes; but not including any such services relating to education.

57. If no form TM21 is filed the class 41 specification of the application in suit will be refused in its entirety.

58. In the main, the opponent owing to the breadth of his opposition has not been successful. I consider, therefore, that the applicant is entitled to a contribution to his costs. In the event that the class 41 specification is limited as shown above, I order that the opponent pays the applicant the sum of £235 as a contribution towards his costs. In the event that no form TM21 is filed the class 41 specification will be refused in its entirety; in such an event I consider it equitable that neither party should be awarded costs.

59. If there is no appeal, then the appropriate sum is to be paid within one month of the expiry of the period set for filing of the Form TM21. In the event of an appeal then the costs will be payable within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12 day of December 2001

**D.W.Landau
For the Registrar
the Comptroller-General**