

O-422-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3005776  
IN THE NAME OF TRENT SOUND LTD  
FOR REGISTRATION OF THE TRADE MARK



AND OPPOSITION THERETO UNDER NO 400928  
BY ORION MEDIA LTD

## Background

1. On 13 May 2013 Trent Sound Limited (“the applicant”) filed an application under no 3005776 for the trade mark shown on the front cover of this decision for the following services:

### Class 38

Telecommunications services; electronic communication services; radio broadcasting, digital radio broadcasting and television broadcasting services; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means of a global computer network; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; telecommunication of information including web pages, computer programs, text and any other data; providing access to digital music websites on the Internet or other computer network; delivery of digital music by telecommunications; webstreaming being the transmission of data, information and audio-visual data via the Internet or other computer network; news agency services; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus and equipment.

2. Following publication of the application in the *Trade Marks Journal* 2013/06 on 28 June 2013, notice of opposition was filed by Orion Media Ltd (“the opponent”) on a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In support of this ground, the opponent relies on the following trade mark:

Mark	Dates	Specification
2574610 BEACON	Filing date: 10 March 2011  Date of entry in register: 12 August 2011	Class 38: Radio broadcasting services; television broadcasting services; online and digital broadcasting services; providing access to digital web sites on the internet; providing access to MP3 websites on the internet; delivery of radio programmes, digital music and television programmes by telecommunications; web streaming, namely, the transmission of data information and audio-visual data via the internet, computer networks or computer databases; operation of chat rooms.  Class 41: Entertainment services; radio entertainment services; interactive entertainment services provided via the internet or other computer networks; production, presentation, distribution, syndication, networking and rental of television and radio programmes, films, music, sound and video recordings; electronic publication services and provision of on-line electronic publications; providing digital music from the internet; providing digital music from MP3 internet web sites; providing television programmes, radio programmes, films, videos, sound, images or data for download from the internet or other computer networks; organisation of festivals, concerts, shows, sport events, competitions.

3. The opponent puts its case in the following terms:

“The marks are similar because the earlier mark comprises the word Beacon. The mark applied for comprises the words Beacon Radio, the suffix ‘Radio’ being a common descriptive term used in radio broadcasting etc. The prefix is the dominant part of the trade mark Beacon Radio. For this reason the mark applied for is visually, aurally and conceptually similar to the earlier trade mark and is to be registered for goods and services which are identical with or similar to those for which the earlier trade mark is protected, to the extent that there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

4. The applicant filed a counterstatement denying the claims made. It puts its case thus:

“Our defence to the opposition raised by Orion Media is very simple and straightforward. Our application is significantly different from their mark in that the colours used are markedly different and ours differs textually in that theirs is ‘Beacon [+star device]’ whereas ours is for ‘Beacon Radio’. The implication that the words Beacon or Beacon Radio have some intrinsic value to the opponent are not supported by the facts as they no longer use the Beacon [+star device] given that their radio station was re-branded some years ago as FREE RADIO. A comprehensive search of their website has failed to produce and reference to this word, it is our view that they have sought to distance their current brand from this word.

We would argue too that Beacon Radio was never a trading name used by Orion Media, neither was Beacon Radio ever a registered trademark, moreover both Beacon & Beacon Radio were FM/VHF radio stations whereas our service is simply an internet-based online radio station not limited by transmitter geography. We would argue that the global nature of our service, combined with the different words and different use would avoid any listener confusion. Additionally, as the word ‘Beacon [+Star device]’ was only used in the West Midlands it’s unlikely that anyone outside this area would be aware of the name, in which case they can hardly be confused by something they never know in the first place.

Given that Beacon Radio was never trademarked, was never used by Orion Media and is unknown outside a relatively small geographical area, we refute the claims made by the opponent who we believe are simply keen to prevent competition which they perceive may cause them to lose audience share.”

5. Given the respective dates set out above, the trade mark registration relied on by the opponent is an earlier mark within the meaning of the Act. The applicant’s claims as set out in its counterstatement refer to the opponent’s mark as having a star device. As can be seen from the above, the earlier mark has no device. As to the applicant’s claims regarding the use or otherwise of the opponent’s mark, as it had not been registered for five years at the date of filing of the application, it is not subject to the requirement that proof of its use must be shown. That being the case, the opponent is entitled to rely on it for each of the services for which it is registered.

6. Neither party filed evidence. The opponent requested to be heard and the matter came before me on 1 October 2014. The opponent, having filed a skeleton argument, was represented by Mr Huw Evans of Chapman & Co who appeared in person. The applicant, who had filed a short written submission, had given no indication it did not intend to be present and I postponed the start of the hearing for some twenty minutes in case it had been delayed. Nothing further was heard from the applicant.

## Decision

7. The opposition is founded on an objection under section 5(2)(b) of the Act which states:

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

(a) ....

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

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

8. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

## The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) however, it is also possible that, in a particular case, an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.”

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

### **Comparison of the respective services**

10. Despite the applicant’s comments in the counterstatement, the services I have to compare are those as set out in the respective application/registration.

11. The leading authorities on how to determine similarity are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases, the CJEU accepted that all relevant factors should be taken into

account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

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

12. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12], Floyd J stated:

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

13. In relation to complementary goods and services, the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

"82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte*

Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

14. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander Q.C., sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

15. I also bear in mind the comments of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, where it said:

“...goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application...”

By analogy, the same is true of services.

16. For ease of reference, the services to be compared are as follows:

Opponent’s specification	Applicant’s specification
<p>Class 38: Radio broadcasting services; television broadcasting services; online and digital broadcasting services; providing access to digital web sites on the internet; providing access to MP3 websites on the internet; delivery of radio programmes, digital music and television programmes by telecommunications; web streaming, namely, the transmission of data information and audio-visual data via the internet, computer networks or computer databases; operation of chat rooms</p> <p>Class 41: Entertainment services; radio entertainment services; interactive entertainment services provided via the internet or other computer networks; production, presentation, distribution,</p>	<p>Class 38: Telecommunications services; electronic communication services; radio broadcasting, digital radio broadcasting and television broadcasting services; broadcasting over the Internet or other computer network; electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means of a global computer network; electronic mail services; providing access to on-line chat rooms and bulletin boards; operation of chat rooms; web casting services; telecommunication of information including web pages, computer programs, text and any other data; providing access to digital music websites on the Internet or other</p>

<p>syndication, networking and rental of television and radio programmes, films, music, sound and video recordings; electronic publications services and provision of on-line electronic publications; providing digital music from the internet; providing digital music from MP3 internet web sites; providing television programmes, radio programmes, films, videos, sound, images or data for download from the internet or other computer networks; organisation of festivals, concerts, shows, sport events, competitions.</p>	<p>computer network; delivery of digital music by telecommunications; webstreaming being the transmission of data, information and audio-visual data via the Internet or other computer network; news agency services; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus and equipment.</p>
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17. All of the opponent's services within its specification in class 38 are included within the terms *telecommunications services* and *electronic communication services* as appears in the applicant's specification. They are therefore identical services as set out in *Meric*.

18. The applicant's *radio broadcasting, digital radio broadcasting and television broadcasting services* are identical to the opponent's *Radio broadcasting services; television broadcasting services and online and digital broadcasting services*.

19. The applicant's *broadcasting over the Internet or other computer network* are services identical to the opponent's *online and digital broadcasting services*.

20. The applicant's *electronic transmission of streamed and downloadable audio and video files via electronic and communications networks as well as by means of a global computer network* are identical to (at least) *providing access to MP3 websites on the internet; delivery of digital music by telecommunications and web streaming, namely, the transmission of data information and audio-visual data via the internet, computer networks or computer databases*.

21. The applicant's *electronic mail services* are at least highly similar to the opponent's *operation of chat rooms*. Whilst the protocols may differ, they each afford the opportunity for individuals or groups to communicate electronically. *Providing access to on-line chat rooms and bulletin boards; operation of chat rooms* are identical to *operation of chat rooms* as is included in the opponent's specification.

22. The applicant's *web casting services* are included within, and therefore identical to, the opponent's *online digital broadcasting services and web streaming services*.

23. The applicant's *telecommunication of information including web pages, computer programs, text and any other data* are identical to the opponent's *web streaming, namely, the transmission of data information and audio-visual data via the internet, computer networks or computer databases*.

24. The applicant's *providing access to digital music website on the Internet or other computer network; delivery of digital music by telecommunications* are identical to



the opponent's *providing access to digital websites on the internet; providing access to MP3 websites on the internet and delivery of digital music by telecommunications.*

25. The applicant's *webstreaming being the transmission of data, information and audio-visual data via the Internet or other computer network* are identical to the opponent's *web streaming, namely, the transmission of data information and audio-visual data via the internet, computer networks or computer databases.*

26. In respect of the applicant's *news agency services*, I find they are complementary services to the *radio and television broadcasting services* of the opponent. They target the same relevant public, are provided by the same undertakings and through the same distribution channels and have the same ultimate purpose of communication. They are similar services.

27. The applicant's *transmission of written and digital communications* are included within and therefore identical to at least, the opponent's *online and digital broadcasting services and web streaming, namely, the transmission of data information and audio-visual data via the internet, computer networks or computer databases.*

28. Finally, I find that the applicant's *leasing and rental services in connection with telecommunications apparatus and equipment* are complementary to the opponent's *radio and television broadcasting services*. Again, they target the same relevant public, are provided by the same undertakings and through the same distribution channels with the equipment being the vehicle by which the provision of the broadcasting is enabled as part of a single contract. They are similar services.

29. Given that I have found each of the applicant's services in class 38 to be identical or similar to those of the opponent in class 38, I do not intend to go on to compare them with the opponent's services in class 41.

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

30. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties' services and then to determine the manner in which these services are likely to be selected by the average consumer in the course of trade.

31. Each of the services is a telecommunication or broadcasting service. Whilst these services may be purchased by businesses, they will also be bought by members of the general public and it is on the basis of the latter, whose attention is lower, that the matter must be judged (see *Adelphoi Ltd v DC Comics (a general partnership)* BL O/440/13). For most of the services, the purchasing process is likely to involve the visual aspects of the respective marks, however, given that radio broadcasting services are involved, the aural aspects also come into play. The services are such as are fairly specialised but they are widely available from a number of sources and whilst their attention will vary depending on such factors as the scope, nature and extent of the service provided, the relevant consumer is likely to take at least some but not the highest, degree of care over his purchase to ensure the correct content is obtained and in the correct format.

## Comparison of the respective marks

32. For ease of reference, the marks to be compared are:

Opponent's mark	Applicant's mark
BEACON	

33. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

34. As the applicant's mark is presented in the colours red, light blue and navy, the comments of Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) are relevant. As the earlier mark is not limited to colour, the colours in which the applicant's mark appears is not relevant and it will, as per the comments of Mann J, be drained of colour for the purposes of the comparison of the respective marks.

35. The opponent's mark is the word BEACON presented in plain block capitals. As a single word, no part of which is highlighted in any way, it has no distinctive or dominant elements. Its distinctiveness rests in its entirety. The word BEACON is an ordinary dictionary word meaning a person or thing that serves as a guide, inspiration or warning (see e.g. *Collins Online English Dictionary*) and is a mark with an average degree of inherent distinctive character for the services for which it is registered.

36. The applicant's mark consists of the two words beacon and radio presented in lower case with one word above the other. The words are presented on a background which is shaped to follow the outline of the letters but which is otherwise unremarkable and does little more than emphasise the letters themselves. Whilst the letter o of radio is presented with a triangular device within it which makes it reminiscent of a play button, this does not detract from it being seen as a letter o. The word radio is not distinctive for services provided via that medium or using radio waves and thus the distinctiveness of the mark rests in the word beacon.

37. In *Peek & Cloppenburg v OHIM* T-386/07 the General Court stated:

“27...the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue...[S]ince the early mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for.”

38. Normal and fair use of the opponent's mark would include use in a variety of fonts which would reduce the apparent visual differences between the respective marks. The presence in both marks of the word BEACON/beacon leads to obvious points of visual, aural and conceptual similarity between them. On a visual consideration, the degree of similarity is reasonably high. From the aural and conceptual consideration, the marks are very highly similar.

### **Distinctiveness of the earlier mark**

39. I must also assess the distinctive character of the earlier mark which can be appraised only, first, by reference to the services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

40. The opponent has not filed any evidence to show what use it may have made of the earlier mark. I am therefore unable to find that its distinctiveness has been enhanced through use. As indicated above, it is a mark with an average degree of inherent distinctive character.

### **Likelihood of confusion**

41. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind.

42. Earlier in this decision I found:

- The respective services to be either identical or similar;
- The marks are reasonably highly similar from a visual perspective and very highly similar on both an aural and conceptual consideration;
- The relevant consumer is a member of the general public who will take some, but not the highest degree of care over the purchase.

43. Taking all matters into account, I have no hesitation in finding that there is a likelihood of direct confusion in respect of all services of the application.

### **Summary**

44. The opposition brought under section 5(2)(b) succeeds in full.

### **Costs**

45. The opponent having succeeded is entitled to an award of costs in its favour. I take note that the opposition was brought under a single ground, that neither side filed evidence and that the hearing, requested by the opponent, was brief in the extreme but necessitated it to file a skeleton argument. Taking all matters into account, I make the award on the following basis:

46. Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Preparation for and attending a hearing:	£500
<b>Total:</b>	<b>£900</b>

47. I order Trent Sound Limited to pay Orion Media Limited the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 3rd day of October 2014**

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