

**O/279/17**

**TRADE MARKS ACT 1994**

**APPLICATION No. 3140097 BY CURB MEDIA LIMITED**

**TO REGISTER A TRADE MARK IN CLASSES 35, 38 & 41**

**AND**

**OPPOSITION No. 406305 BY GROUPE CANAL +**

## **Background and pleadings**

1. This is an opposition by Groupe Canal + (“the opponent”) to an application filed on 10<sup>th</sup> December 2015 (“the relevant date”) by Curb Media Limited (“the applicant”) to register the trade mark shown below (“the contested mark”).



2. The contested mark was published in the Trade Marks Journal on 25<sup>th</sup> December 2015. The list of goods/services is currently as follows.

### **Class 35**

Advertising; business management; business administration; office functions; the bringing together, for the benefit of others, of a variety of goods, gifts and decorative items, namely music and films (as CDs, DVDs and all other formats, including electronic formats and electronic downloadable formats) toys, cards, playing cards, books, publications, perfumes, cosmetics, toiletries, enabling consumers to conveniently view and purchase those goods in a general merchandise shop or in a department store as well as via a mail order catalogue, Internet website or via telecommunication.

### **Class 38**

Telecommunications; electronic delivery of images, photographs, art, graphic images, and graphic design, clip art, news images, illustrations, digital animation, video clips, film footage and audio data via a global computer network and other computer networks; providing online directory information services also featuring hyperlinks to other websites; providing access to various media, namely digital websites, stock photography, archival photographs, art, clip art, news images, digital animation, video clips, film footage, illustrations, graphic designs, audio data, via an interactive computer database; providing access to an interactive online computer database in the

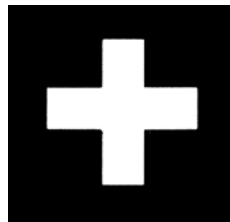
fields of visual media, graphic images and graphic designs, photography, illustrations, film/video footage, digital content, websites, digital vouchers, interactive digital content; providing access to various media, namely digital media, digital newspapers, publications, stock photography, archival photographs, art, clip art, news images, digital animation, video clips, film footage, illustrations, graphic designs, and audio data, via an interactive computer database. Broadcasting of radio and television programmes, dissemination of news; broadcasting of radio and television programmes, radio and television broadcasting; by all means, including by cable and satellite; interactive communications by global telecommunication networks (the Internet), data transmission by cable, transmission of sound and images by satellite; telecommunications including online information on data or other information, images, graphics, sound and/or audiovisual material via computers and communications networks, television subscriptions via the Internet, television and telephone.

#### **Class 41**

Arrangement of conventions for recreational purposes; arranging and conducting competitions; arranging for ticket reservations for shows and other entertainment events; arranging of music performances; book rental; booking agency and reservation services for cinema, concert and theatre tickets; casino services and competitions provided by means of the internet; electronic library services for the supply of electronic information, including archive information, in the form of electronic texts, audio and/or video information and data; electronic publications; entertainment provided via the internet; entertainment services provided on-line from a computer database or the internet; exhibition services for entertainment purposes; foreign language education services; hire of books; hire of films, video recordings, music, audiovisual media; information relating to entertainment and education, provided on-line from a computer database or the internet; interactive entertainment and competition services all provided over a global computer network or the internet; internet games (non-downloadable); internet lottery; motion picture and video rental services; on-line entertainment; on-line library services namely, providing electronic library services which feature

newspapers, magazines, photographs and pictures via an on-line computer network; on-line publication of electronic books and journals; organising of exhibitions for entertainment purposes; photographic library services; musical performances, musical videos, related film clips, photographs, and other multimedia materials provided via a website; providing digital music from the internet; providing electronic publications; providing musical sound recordings for consumer use via wireless devices and the global computer network; publication of electronic books and journals on-line; rental of audio books and audio recordings; ring tones provided from the internet; all of the foregoing being provided either offline, or by way of a centralised or decentralized network.

3. The opposition is based on the opponent's earlier international trade mark 1025864, which was protected in the EU on 2<sup>nd</sup> December 2010. The mark is shown below.



4. The opponent claims that the earlier trade mark was put to genuine use in the EU in the 5 year period ending on the date of publication of the contested mark in relation to the following registered goods/services.

Class 9: Set-top boxes; apparatus and instruments for recording, transmitting, reproducing, storing, [ ... ]decrypting[ ... ] sound or images; communication and telecommunication apparatus; audiovisual, telecommunication, telematic, television and remote-controlled appliances and instruments; electronic agendas; computer peripheral devices; apparatus for scrambling signals and for descrambling signals[ ... ]; digital terminals; card readers; simultaneous programming and television channel selection devices; electronic guides for tv

[ ... ] programmes; apparatus and instruments for television programme selection and programming; interactive television apparatus and instruments; software (recorded programs).

Class 35: Arranging of audiovisual programme [ ... ] subscriptions for others; subscription services to a television channel;

Class 38: Telecommunication services; communications via [ ... ] computer terminals, television; communications via telephone or visiophone, by personal video player, by videophone, by interactive videography via videophone; television broadcasting; information transmission services via data communication networks; sending of [ ... ] images, videos [ ... ]; teletransmission; television broadcasts [ ... ]; programme broadcasting by satellite, cable, via computer networks (especially via the Internet), via wireless networks; broadcasting [ ... ] audiovisual, cinematographic and multimedia programmes texts and/or images (still or moving) and/or sounds musical or not, ringtones) for interactive or other use; electronic display services (telecommunications); rental of telecommunication equipment; communications (transmission) over an open global computer network (the Internet) or a closed network (intranets); online downloading services for films and other audio and audiovisual programmes; services transmitting television programmes and selections of channels; services for transmitting and receiving video images via the Internet by means of a computer or a mobile telephone; providing access to Web sites on the Internet containing digital music or any audiovisual work; provision of access to a computer network; providing connections to telecommunication services, to Internet services and to databases; services to provide access to the Internet (Internet service providers); providing access to telecommunications infrastructures;

Class 41: Entertainment; [ ... ] television entertainment on any media namely television set, computer, [ ... ] computer networks, the Internet; production of shows, films, television films, televised broadcasts, reports, debates, video recordings [ ... ]; rental of [ ... ] films; rental of motion pictures; rental of [ ... ] set-

top boxes, [ ... ] video apparatus[ ... ]; production of[ ... ] audiovisual [ ] programmes; editing and publishing of texts (other than advertising texts), multimedia, [ ] video media (interactive discs, compact discs, storage discs); publication[ ... ] of books and texts (other than advertising texts); rental of set-top boxes and all kinds of audiovisual apparatus and instruments.

Class 42: Design (development) of interactive programs; computer formatting of texts and/or images, fixed for interactive or other use.

5. The opponent claims that these services are identical, or at least similar, to the services covered by the contested mark, that the respective marks are similar and that there is a likelihood of confusion on the part of the public.

6. The opponent also claims that the earlier mark has a reputation in the EU in relation to the goods/services for which it has been used and that use of the contested mark would, without due cause, take unfair advantage of, and/or be detrimental to, the reputation and distinctive character of the earlier mark.

7. The opponent therefore asks for the contested mark to be refused registration on the basis of s.5(2)(b) and/or s.5(3) of the Trade Marks Act 1994 ("the Act").

8. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of the claimed use and reputation of the earlier mark.

9. Both sides seek an award of costs.

### **Case management**

10. On 6<sup>th</sup> July 2016, the opponent was given two months to file evidence in support of its case. On 1<sup>st</sup> September 2016 the opponent sought a two months extension of time in which to file its evidence. By way of justification, the opponent cited the burden of proving that the earlier mark had a reputation in the EU. The opponent was provisionally allowed a one month extension to 6<sup>th</sup> October 2016. The opponent appears to have made good progress on the collection of its evidence because on

13<sup>th</sup> September 2016 it wrote to the registrar advising that the evidence was nearly complete. However, the opponent's representatives had by then realised that the evidence ran to 3289 pages, which far exceeded the 300 page limit set out in Tribunal Practice Notice 1/2015. This meant that leave was required to file the proposed quantity of evidence. The opponent sought such leave.

11. A case management conference ("CMC") was held on 30<sup>th</sup> September 2016. The opponent was represented by Mr Burton of D Young & Co and the applicant by Ms Trebble of Dollymores. Following the CMC I wrote to Mr Burton (copied to Ms Trebble) in these terms.

"At the case management conference earlier today you advised that the opponent had used the earlier EU mark in France, Luxembourg, Belgium and the UK and had promoted it through around 6 different marketing channels. I drew the parties' attention to the judgments of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 (use in the EU) and *Iron & Smith kft v Unilever NV*, Case C-125/14 (reputation and link for the purposes of s.5(3)).

Having regard to:

- (i) The opponent's request dated 13<sup>th</sup> September 2016 for leave to file 3289 pages of evidence in chief, and
- (ii) The opponent's letter of 20<sup>th</sup> September 2016 providing a high level description of the evidence,

I direct that:

(i) The evidence of use including press articles, marketing and advertising materials in the EU, proposed to be filed as exhibits GC1, GC2, GC5, GC6, GC8 & GC11, be limited to 350 pages OR comply with the following requirements:

- (a) The evidence should be representative and proportionate, meaning that there should not be more than 5 instances of the earlier mark being promoted through the same marketing channel, in the same country, in relation to the same goods/services (accepting that a greater degree of repetition may be

unavoidable where the instances show use in relation to the same goods/services AND other goods/services).

(b) Each instance of promotion of the mark covered by this material should be marked up to indicate which goods or services it covers.

(ii) The proposed inclusion of two examples of use of the mark in product manuals in GC3 should be limited to one.

(iii) The evidence relating to the use of the earlier mark as part of a family of marks (GC9) should not be filed because it cannot be relevant to an opposition based on just one earlier mark. The most helpful evidence will show use of the earlier mark on its own, but use with other signs may also constitute genuine use of the earlier mark where it meets the requirement set out in *Colloseum Holdings AG v Levi Strauss & Co.*, CJEU, Case C-12/12, at para 35. This is not a separate issue to showing use/reputation of the earlier mark and should be borne in mind when submitting evidence under the other headings.

(iv) The evidence of email marketing campaigns and advertising leaflets proposed to be filed under GC10 and GC13 should be representative and limited to 150 pages. If there are multiple instances of the same thing from different years, the witness may indicate that an example from a (relevant) year is representative of further examples used in the same way in other (relevant) years.

(v) All the exhibited material should be limited to showing use of the earlier mark in the period December 2010 to December 2015.

(vi) The opponent's evidence should be filed in acceptable form by 7th November 2016."

12. On 27<sup>th</sup> October 2016 the opponent filed a witness statement by Clement Hellich-Praquin, the Corporate General Counsel of Canal +, along with 15 exhibits amounting to 496 pages of evidence in total. The opponent sought an order that the evidence be kept confidential.

13. The applicant was given until 28<sup>th</sup> December 2016 to file evidence or submissions in response to the opponent's evidence. On 19<sup>th</sup> December 2016 it sought an extension of time of 2 months in which to do so. By way of justification, the



applicant cited the volume of the opponent's evidence and the difficulty of arranging a meeting with its client to discuss the matter.

14. The request was provisionally rejected on the grounds that the reasons given appeared insufficient. A second CMC was held on 11<sup>th</sup> January 2017. The applicant was again represented by Ms Trebble. The opponent was represented by Ms Oliver of D Young & Co. The opponent did not object to the applicant being given an extension. Therefore, despite my doubts as to its merits, I allowed the applicant a one month extension of time to file its evidence.

15. The applicant's evidence was filed on 27<sup>th</sup> January 2017. It consisted of a short witness statement by Mr Trebble herself along with 2 exhibits. In short, this showed the results of searches of the UK and EU trade mark registers that revealed some registrations of trade marks based upon a + symbol, and a couple more consisting of the word PLUS. It could have taken no more than a couple of hours to produce this evidence. One wonders why the applicant required three months to do so.

### **The hearing**

16. The opponent's representatives filed 25 pages of written arguments alongside the opponent's evidence. It later requested a substantive hearing to make oral submissions too. This was held on 8<sup>th</sup> May 2017. Christopher Hall appeared as counsel for the applicant. Jonathan Moss appeared as counsel for the opponent.

17. Mr Hall pointed out that the opponent's evidence included numerous exhibits in French and with no translation into English. He invited me to strike out the evidence or require translations under Rule 82 of the Trade Mark Rules 2008. Mr Moss clarified that the opponent did not intend to rely on anything written in French. He intended to rely on the exhibits in French only for what could be discerned visually by an English speaker and to the extent that they supported what Mr Hellich-Praquin said (in English) in his witness statement. I noted that the applicant had not asked for translations of any of the opponent's evidence prior to the hearing. Taking account of Mr Moss's clarification of the purpose of the exhibits in French, I declined to strike them out or to require translations.

18. It became apparent at the hearing that the opponent's request for a confidentiality order covering its evidence had not been resolved. Mr Moss accepted that the blanket order sought was far too sweeping. He agreed that the opponent would subsequently identify in writing the specific evidence it wished to remain confidential from the public. I subsequently received a letter from the opponent's representatives which identified the sensitive material as the number of subscribers owning certain decoders bearing the mark (or a variant of it) by April 2015 and the number of such decoders manufactured in France by September 2015. An order for confidentiality has since been made covering this information.

### **Proof of use**

19. Section 6A of the Act is as follows.

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

- (4) For these purposes -
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
  - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

20. The applicant has put the opponent to proof of use of the earlier mark. The opponent’s case under s.5(2) and s.5(3) therefore depends upon it showing genuine use of the earlier mark in relation to the goods/services set out in paragraph 4 above. I will therefore examine first whether Mr Hellich-Praquin’s evidence establishes qualifying use of the earlier mark in the period 26<sup>th</sup> December 2010 to 25<sup>th</sup> December 2015 (“the relevant period”). I have read and considered all the evidence. Therefore, if I do not mention a particular piece of evidence it does not mean that I have not considered it. However, the following analysis of the evidence and facts is sufficient for the purpose of explaining my decision.

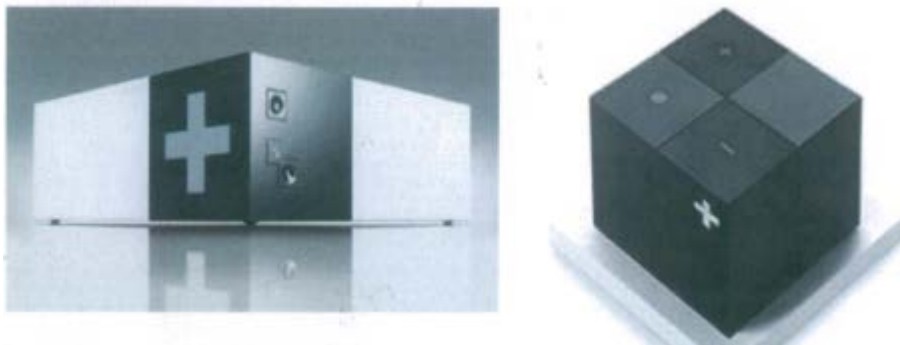
21. The opponent is a television broadcaster based in France. According to Mr Hellich-Praquin, the earlier mark is used as part of the branding for opponent’s TV broadcasting services, in particular as part of the branding for the different channels offered to the public.<sup>1</sup> The branding used by the opponent looks like this.

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<sup>1</sup> See exhibits GC8-13



22. Mr Hellich-Praquin says that the earlier mark was used in France in relation to the opponent's decoders and related TV subscription services. He provides pictures of the first and second versions of the opponent's decoders, which were provided during the relevant period. They look like this.



23. The decoder shown on the right featured in the instruction manual provided to the opponent's customers in France from April 2015.<sup>2</sup> The TV service associated with this decoder is called 'Le Cube'.

24. Mr Hellich-Praquin provides a statement from Jerome Seror, the opponent's Marketing Director, which shows that by April 2015 there were over [REDACTED] million subscribers to the opponent's TV services using the first form of its decoder, although some of these were based in French speaking overseas territories and in Africa.<sup>3</sup>

25. According to Mr Hellich-Praquin, the opponent launched a TV programming mobile application in France in 2011 which provided access to its TV channels. The

<sup>2</sup> See GC3, which is French language instruction manual

<sup>3</sup> See GC4

'app' was originally called 'Canal Touch' but was renamed 'MyCanal' in December 2013. The 'app' was available in France during the relevant period from websites such as Google Store and iTunes. The icon used to identify the 'app' on computer screens corresponded to the earlier trade mark.<sup>4</sup> Mr Hellich-Praquin points out that press articles confirm that the 'app' was downloaded a million times in 2013 alone.<sup>5</sup> In fact (some of) the articles from 2013 state that the 'app' had been downloaded a million times since it was launched in 2011. One of the articles attributes this figure to information provided by the opponent.

26. Mr Hellich-Praquin states that in addition to broadcasting third party produced programmes, the opponent produces and broadcasts its own programmes and films for the viewing public in France. He mentions two TV programmes that were broadcast on the opponent's Cuisine + channel and two films that were shown on the Cine + channel, all in 2012/13. He says that the opponent also worked with third parties to produce four further films in 2011/12, which were released on DVD and paperback books. Exhibit GC14 is said to contain "*copies of booklets, press releases, articles and book and DVD covers*" which bear this out. It is difficult to make out what some of the documents in GC14 are. Some of them provide support for Mr Hellich-Praquin's claim that the opponent broadcast one of the TV programmes which he says was self-produced (called Coup de jeune en cuisine) on the Cuisine + channel (where the + corresponds to the earlier mark) and that two of the films he mentions (called Enfin La Fin and Aujourd'Hui) were broadcast on Cine + (where the + again corresponds to the earlier mark) during the relevant period. I cannot establish anything more from the materials provided. This is partly because they are in French and partly because the witness does not clearly identify what each of the documents is.

27. As regards use of the earlier mark outside France, Mr Hellich-Praquin provides an extract from the website archive called Wayback Machine showing that the Belgian website telepro.be, which appears to be a TV listings site, contained a page showing the Cuisine + composite mark shown in paragraph 21. The pages in evidence date from September 2014 and March 2015. Mr Hellich-Praquin says that

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<sup>4</sup> See GC7

<sup>5</sup> See GC8

similar use of the mark on the Belgian website took place throughout the relevant period. However, he offers no further evidence or explanation about the availability of the opponent's TV services in Belgium. In particular, he offers no evidence of any subscribers to the opponent's services in that country.

28. Exhibit GC10 to Mr Hellich-Praquin's statement consists of three company brochures from 2013/14. Mr Hellich-Praquin points out that two of the brochures are in English "*and therefore specifically directed at the UK public.*" However, the brochures themselves identify the opponent as the "*leading pay-TV company in France*" (emphasis added). The description of the company's international activities in the brochure covers French speaking overseas territories, but does not mention the UK (or Belgium). The only other EU country identified in the brochures is Poland, where the opponent is described as being "*a leader in Polish Television.*" In this connection, I can see one instance of the use of this mark in relation to the Polish TV services.<sup>6</sup>



This is from the 2013 company brochure. However, the same page from the 2014 brochure shows a different mark used in relation to the opponent's Polish TV services. Mr Hellich-Praquin himself says nothing at all about use of the earlier mark in Poland.

29. Mr Hellich-Praquin says that exhibit GC6 to his statement consists of "*samples of various press articles, in-store and on-line advertising and social media use which highlight extensive and continuous use and references to [the earlier mark] between 2010-2015 in France, Belgium, Luxembourg and the UK.*" The exhibit has 107 pages. All but two of them are in French. These pages confirm use of the marks shown in paragraphs 21 and 22 above in France. Mr Hellich-Praquin does not identify which of the uses are said to have been in Belgium or Luxembourg. There is

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<sup>6</sup> See page 292 of the evidence

nothing which I can see which obviously shows use of the earlier mark in either of these territories.

30. Mr Hellich-Praquin states that the opponent's launch of the Canal + (later 'MyCanal') downloadable 'app' was well publicised in France and in the UK. He exhibits "*various press articles*" in support of this claim.<sup>7</sup> There are 6 articles in English, all from 2013. One of them shows a composite CANAL + mark which arguably includes the earlier mark. The other 5 articles in English do not show the earlier mark at all. Two of the articles are from a Julian Glover in "Europe/London". Like all these articles, they are about the launch of the opponent's 'apps'. It is not entirely clear where Julian Glover's articles appeared, but it may have been on the website broadbandtvnews.com. Julian Glover is claimed to be available on various social media sites and to have followed "*the media world for over 20 years with a focus on the UK and the Nordic markets, HD, 3D and connected TV Technologies.*" The focus of the articles appears to be on the innovative aspects of the opponent's new 'apps'. Two more of the English language articles in exhibit GC8 appear to be targeted at an international or US trade audience. It is not clear where the remaining two English language articles were posted or who they aimed at, including the article that arguably shows a version of the earlier mark.

### The case law

31. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*,<sup>8</sup> Arnold J. summarised the case law on genuine use of trade marks like this:

"I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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<sup>7</sup> See GC8

<sup>8</sup> [2016] EWHC 52

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the



characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

32. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Therefore the burden is on the opponent to show what use has been made of the earlier mark.

33. In *Awareness Limited v Plymouth City Council*,<sup>9</sup> Mr Daniel Alexander Q.C., as the Appointed Person, set out the correct approach to the assessment of evidence of use in the light of s.100 of the Act. He said that:

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<sup>9</sup> Case BL O/230/13

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

- and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

#### Findings on proof of use

34. Bearing this guidance in mind, I find that the opponent has established use in France of the composite marks shown in paragraphs 21, of the mark shown in paragraph 22, and of the icon for the ‘app’ described in paragraph 25.

35. The next question is whether these uses count as use of the earlier mark. Counsel for the applicant appeared to accept that the use of the icon for the opponent's 'app' was use of the registered mark. However, he submitted that the use of the mark on the decoders shown in paragraph 22 above did not constitute use of the earlier mark or use of a mark *in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered*. As I understood the submission, this was because the mark shown on the second version of the opponent's decoders had a greater proportion of black to white than the registered mark, which reduced the emphasis on the cross. I reject this submission. The distinctive character of the registered mark, a white or light cross on a contrasting black or dark background, is clearly present in the mark shown in paragraph 22 above. This is particularly the case when the mark is applied to the first version of the decoder (shown on the left), but also applies to the application of the mark to the second version of the decoder (shown on the right). I therefore find that these uses constitutes use of the registered mark.

36. Turning to the opponent's use of composite marks, in *Colloseum Holdings AG v Levi Strauss & Co.*<sup>10</sup>, the CJEU found that:

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its

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<sup>10</sup> Case C-12/12

independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

37. Counsel for the applicant submitted that the use of the earlier mark in combination with words, such as CINE or RUGBY, altered the character of the earlier mark. This was because the earlier mark on its own would convey to the average consumer the idea of a Swiss flag, or a medical symbol, or 'addition'. However, when viewed together with words the mark denoted only the non-distinctive idea of 'addition'. I accept that the earlier mark would be understood by UK consumers as a Swiss flag, if it were used in the colours red and white. I also accept that the significance of the mark would be reduced to a merely descriptive message of 'plus' or 'addition' if the mark followed words like RUGBY. But this is not

the only type of composite use of the mark in evidence. The evidence also shows use of the mark preceding descriptive words where its significance does not appear to be limited to simply the descriptive message of 'plus' or 'addition'. Taken together with the evidence of use of the mark as registered (or in an acceptable variation) on decoders and as the icon for the opponent's mobile devices 'app', I find that use of the mark in combination with descriptive words like RUGBY and not so descriptive words (to an English speaker) such as CINE, would continue to be perceived as indicative of commercial origin. I therefore find that all three types of use relied on by the opponent qualify as use of the earlier mark.

38. When I asked him to specify the goods/services covered by the use shown in the evidence counsel for the opponent identified (in broad terms):

Class 9: Set top boxes

Class 35: Subscription services to a TV channel

Class 38: TV Broadcasting services and services for providing access to TV content via mobile applications

Class 41: TV entertainment; production of shows, films etc.

Class 42: Development of interactive computer programs, i.e. the opponent's 'apps'

39. There is no evidence that the opponent trades in decoders (set top boxes). There are no sales figures and Mr Hellich-Praquin says nothing about the subscribers to the opponent's TV services acquiring ownership of the decoders used to access the service. In these circumstances I regard the evidence as showing use of the earlier mark on decoders, but mainly 'in relation to' the opponent's TV broadcasting and entertainment services. Additionally, I am prepared to infer that subscriptions to the opponent's services cover the rental of the decoder necessary to receive and reproduce the opponent's broadcast material.

40. The opponent plainly provided TV broadcasting and entertainment services during the relevant period and, on my findings, did so under the earlier mark.

41. I find that use of the earlier mark in relation to the opponent's 'apps' qualifies as use in relation to TV programme broadcasting via computer networks and wireless networks.

42. I have no doubt that the opponent produced TV, films and TV shows etc. during the relevant period, but I find the evidence insufficient to show that it did so under the earlier mark. The highpoint of the opponent's evidence in this respect is the evidence of shows and films that it produced (or collaborated with others to produce) having been broadcast under a composite mark including the earlier mark. However, even putting to one side the relative paucity of such evidence, I do not think the evidence goes further than showing that the mark was used in relation to TV broadcasting and entertainment services. There is insufficient evidence to establish that the mark was also being used to identify the producer of the films/shows. To put it another way, if the shows/films in question had been produced by third parties, I am not satisfied that use of the mark shown in the evidence would have looked any different to users of the opponent's services.

43. Use of the mark in relation to the opponent's downloadable 'apps' clearly does not count as use of the mark in relation to interactive computer programming services. This is because the opponent's 'apps' are pre-written downloadable software, whereas programming services in class 42 are services for obtaining new or tailored software, i.e. bespoke programming.

44. Finally, I am asked to decide if the evidence shows use of the opponent's mark in relation to *subscription services to a television channel* in class 35. I have found that the opponent has used the earlier mark in relation to TV broadcasting and entertainment services provided to its subscribers in France. I am struggling to identify what other service is covered by *subscription services to a television channel* in class 35. Counsel for the opponent suggested that the service in class 35 was around arranging subscriptions and the means to collect them. That seems to me to be part and parcel of selling TV broadcasting and entertainment services. It is little different to accepting and arranging payments for goods and services via direct debit. If it is a service to users, it appears to be a financial service of the kind normally classified in class 36, not a business service of the kind normally classified

in class 35. On the footing that this is the service covered by *subscription services to a television channel*, I accept that there has been use of the earlier mark in relation to these services too.

45. All of the established use of the earlier trade mark is in France. Counsel for the applicant submitted that the use shown was insufficient to constitute genuine use of a mark protected throughout the EU. In *Leno Merken BV v Hagelkruis Beheer BV*,<sup>11</sup> the CJEU addressed this issue and stating that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

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<sup>11</sup> Case C-149/11

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

46. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:



“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark,

was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

47. The General Court restated its interpretation of *Leno Marken in TVR Automotive Ltd v OHIM*.<sup>12</sup> This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark).

Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of a EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of a EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the European Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown

48. I am satisfied that there has been substantial use of the earlier mark in France throughout the relevant period.

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<sup>12</sup> Case T-398/13 at paragraph 57 of the judgment

49. The mark has been used as a trade mark, albeit frequently alongside descriptive branding.

50. TV services are often geographically targeted depending on the language of the programmes broadcast. The opponent's mark is clearly aimed at French speaking consumers who are naturally most numerous in France. This reflects the focus, or at least the main focus, of the opponent's services.

51. Taking all these matters into account, I find that the opponent's use of the earlier mark in France qualifies as genuine use of the mark in the EU.

#### A fair specification?

52. There remains the question of an appropriate notional specification for the purposes of this opposition. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,<sup>13</sup> Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

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<sup>13</sup> [2016] EWHC 3103 (Ch)

consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

53. Approaching the matter with this guidance in mind, I find that the opponent's services would fairly be described by an average consumer as follows.

Class 35: Subscription services to a television channel.

Class 38: Television broadcasting; TV programme broadcasting by satellite, cable, via computer networks (especially via the Internet), via wireless networks; rental of telecommunication equipment; online downloading services for films and other audiovisual programmes; services transmitting television programmes and selections of channels.

Class 41: Television entertainment on any media namely television set, computer, computer networks, the Internet; rental of set-top boxes.

**Section 5(2)(b)**

54. Sections 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of services

55. The respective services are set out below.

Applicant's services	Opponent's services
Class 35: Advertising; business management; business administration; office functions; the bringing together, for the benefit of others, of a variety of goods, gifts and decorative items, namely music and films (as CDs, DVDs and all other formats, including electronic formats and electronic downloadable formats) toys, cards, playing cards, books, publications, perfumes, cosmetics, toiletries, enabling consumers to conveniently view and purchase those goods in a general merchandise shop or in a department store as well as via a mail order catalogue, Internet website or via telecommunication.	Class 35: Subscription services to a television channel.

*Class 38: Telecommunications; electronic delivery of images, photographs, art, graphic images, and graphic design, clip art, news images, illustrations, digital animation, video clips, film footage and audio data via a global computer network and other computer networks; providing online directory information services also featuring hyperlinks to other websites; providing access to various media, namely digital websites, stock photography, archival photographs, art, clip art, news images, digital animation, video clips, film footage, illustrations, graphic designs, audio data, via an interactive computer database; providing access to an interactive online computer database in the fields of visual media, graphic images and graphic designs, photography, illustrations, film/video footage, digital content, websites, digital vouchers, interactive digital content; providing access to various media, namely digital media, digital newspapers, publications, stock photography, archival photographs, art, clip art, news images, digital animation, video clips, film footage, illustrations, graphic designs, and audio data, via an interactive computer database. Broadcasting of radio and television programmes, dissemination of news; broadcasting of radio and television programmes, radio and television broadcasting; by all means, including by cable and satellite; interactive communications by global telecommunication networks (the Internet), data transmission by cable, transmission of sound and images by satellite; telecommunications including online information on data or other information, images, graphics, sound and/or audiovisual material via computers and*

Class 38: Television broadcasting; TV programme broadcasting by satellite, cable, via computer networks (especially via the Internet), via wireless networks; rental of telecommunication equipment; online downloading services for films and other audiovisual programmes; services transmitting television programmes and selections of channels.

*communications networks, television subscriptions via the Internet, television and telephone.*

Class 41: Arrangement of conventions for recreational purposes; arranging and conducting competitions; arranging for ticket reservations for shows and other entertainment events; arranging of music performances; book rental; booking agency and reservation services for cinema, concert and theatre tickets; casino services and competitions provided by means of the internet; *electronic library services for the supply of electronic information, including archive information, in the form of electronic texts, audio and/or video information and data; electronic publications; entertainment provided via the internet; entertainment services provided on-line from a computer database or the internet; exhibition services for entertainment purposes; foreign language education services; hire of books; hire of films, video recordings, music, audiovisual media; information relating to entertainment and education, provided on-line from a computer database or the internet; interactive entertainment and competition services all provided over a global computer network or the internet; internet games (non-downloadable); internet lottery; motion picture and video rental services; on-line entertainment; on-line library services namely, providing electronic library services which feature newspapers, magazines, photographs and pictures via an on-line computer network; on-line publication of electronic books and journals; organising of exhibitions for entertainment purposes; photographic library services; musical performances,*

Class 41: Television entertainment on any media namely television set, computer, computer networks, the Internet; rental of set-top boxes.

<p><i>musical videos, related film clips, photographs, and other multimedia materials provided via a website; providing digital music from the internet; providing electronic publications; providing musical sound recordings for consumer use via wireless devices and the global computer network; publication of electronic books and journals on-line; rental of audio books and audio recordings; ring tones provided from the internet; all of the foregoing being provided either offline, or by way of a centralised or decentralized network.</i></p>	
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56. Some of the applicant's services are manifestly identical to the services in class 38 covered by the opponent's earlier mark, i.e. *Broadcasting of ....television programmes, dissemination of news; broadcasting of ... television programmes, ....television broadcasting; by all means, including by cable and satellite.* Furthermore, although they are listed in different classes, the applicant's *television subscriptions via the Internet, television and telephone* services are plainly identical to the opponent's *subscription services to a television channel* in class 35 (whatever the true nature of these 'services' is).

57. In *Gérard Meric v OHIM*,<sup>14</sup> the General Court stated that:

"29. ....the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM-Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

The same must apply to services.

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<sup>14</sup> Case T- 133/05



58. Therefore some of the general descriptions of services in classes 38 and 41 of the application must be considered identical to the services covered by the earlier mark because they include those services, i.e. *Telecommunications; electronic delivery of images, photographs, art, graphic images, and graphic design, clip art, news images, illustrations, digital animation, video clips, film footage and audio data via a global computer network and other computer networks and interactive communications by global telecommunication networks (the Internet), data transmission by cable, transmission of sound and images by satellite; telecommunications including online information on data or other information, images, graphics, sound and/or audiovisual material via computers and communications networks* in class 38 cover the opponent's services in that class. Similarly, the applicant's *on-line entertainment; entertainment provided via the internet; entertainment services provided on-line from a computer database or the internet* includes the opponent's TV services in class 41.

59. In the judgment of the CJEU in *Canon*,<sup>15</sup> the court stated that:

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

60. Applying this guidance I find that the following services are self-evidently similar because they are similar in nature, purpose, method of use or are in competition.

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<sup>15</sup> Case C-39/97 at paragraph 23 of its judgment

Application	Earlier mark
<p data-bbox="188 253 778 1440"> <b>Class 38</b>  <i>Providing access to various media, namely digital websites, stock photography, archival photographs, art, clip art, news images, digital animation, video clips, film footage, illustrations, graphic designs, audio data, via an interactive computer database; providing access to an interactive online computer database in the fields of visual media, graphic images and graphic designs, photography, illustrations, film/video footage, digital content, websites, digital vouchers, interactive digital content; providing access to various media, namely digital media, digital newspapers, publications, stock photography, archival photographs, art, clip art, news images, digital animation, video clips, film footage, illustrations, graphic designs, and audio data, via an interactive computer database.</i> </p> <p data-bbox="188 1518 778 1715"> <i>Broadcasting of radio programmes, broadcasting of radio programmes, radio broadcasting; by all means, including by cable and satellite.</i> </p> <p data-bbox="188 1794 778 1991"> <b>Class 41</b>  <i>Electronic library services for the supply of electronic information, including archive information, in the form of</i> </p>	<p data-bbox="810 309 1345 398"> <i>Online downloading services for films and other audiovisual programmes.</i> </p> <p data-bbox="810 584 1366 725"> <i>Television entertainment on any media namely television set, computer, computer networks, the Internet.</i> </p> <p data-bbox="810 1518 1150 1552"> <i>Television broadcasting</i> </p> <p data-bbox="810 1850 1345 1939"> <i>Online downloading services for films and other audiovisual programmes.</i> </p>

*electronic texts, audio and/or video information and data; electronic publications;*

*Hire of films, video recordings, music, audiovisual media; information relating to entertainment and education, provided on-line from a computer database or the internet; interactive entertainment and competition services all provided over a global computer network or the internet.*

*Motion picture and video rental services; on-line library services namely, providing electronic library services which feature newspapers, magazines, photographs and pictures via an on-line computer network.*

*Photographic library services; musical performances, musical videos, related film clips, photographs, and other multimedia materials provided via a website.*

*Providing digital music from the internet; providing electronic publications; providing musical sound recordings for consumer use via wireless devices and the global computer network; rental of audio recordings; all of the foregoing being provided either offline, or by way of a centralised or decentralized network.*

*Television entertainment on any media namely television set, computer, computer networks, the Internet. Online downloading services for films and other audiovisual programmes.*

*Television entertainment on any media namely television set, computer, computer networks, the Internet. Online downloading services for films and other audiovisual programmes.*

*Television entertainment on any media namely television set, computer, computer networks, the Internet. Online downloading services for films and other audiovisual programmes.*

*Television entertainment on any media namely television set, computer, computer networks, the Internet. Online downloading services for films and other audiovisual programmes.*

61. This means that all the applicant's services in classes 38 and 41 shown in italics in the table in paragraph 55 above must be considered identical or similar to the services for which the earlier mark is entitled to protection.

62. In *Commercy AG, v OHIM*,<sup>16</sup> the General Court pointed out that:

“43. .... for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

Thus where the similarity between the respective services is not self-evident, the opponent must show how, and in which respects, they are similar. Although the opponent provided arguments in its written submissions as to the identity between the respective services, it did so on the basis of the services listed in the opponent's earlier registration. It would have been more helpful if the opponent had focussed its submissions on the services it could realistically expect to be supported by the proof of use. As a result, I have not found the opponent's submissions to be particularly helpful. It follows that where I have not found any self-evident similarity between the services, I must find them dissimilar. This covers all the applicant's services in class 35 and those services shown in standard font (i.e. not italics) in classes 38 and 41 in the table in paragraph 55 above.

63. As establishing some similarity between the services is essential to an opposition based on s.5(2)(b) of the Act, it follows that the opposition under s.5(2)(b) fails in relation to the services shown in standard font in the table shown in paragraph 55 above.

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<sup>16</sup> Case T-316/07

## Global comparison - case law

64. 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 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

#### Average consumer and selection process

65. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.<sup>17</sup>

66. The average consumer for the identical or similar services identified in paragraph 55 above is likely to be a member of the general public or a person working in the

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<sup>17</sup> CJEU, Case C-342/97

media. In either case such a person is likely to pay a normal degree of attention when selecting the services at issue.

67. I would expect the selection to be based primarily on visual means, such as from brochures, TV listings, internet advertisements etc., but aural means may also play some part, e.g. word of mouth recommendations.

#### The distinctive character of the earlier mark

68. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>18</sup> the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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<sup>18</sup> Case C-342/97

69. Considering first the inherent distinctiveness of the earlier mark, counsel for the applicant submitted that a cross device *per se* has little or no distinctive character in relation to the services for which the earlier mark is entitled to protection. This is because a cross is a very simple everyday sign and is often used in a non-trade mark sense in connection with the marketing of services. Indeed my attention was drawn to the following example from the opponent's evidence in which it uses a cross in this way.



70. Although there is no requirement that a sign must be original or inventive in order to have distinctive character, the EUIPO and the EU General Court appear to take the view that very simple everyday signs may be devoid of distinctiveness because, at least *prima facie*, they are simply not sufficiently striking or memorable enough to operate as trade marks.<sup>19</sup> A cross is without doubt a very simple everyday sign. Added to which is the likelihood that, for the reason given by the applicant's counsel, consumers in this field are accustomed to seeing a cross used in a non-trade mark sense in the context of marketing TV services. I therefore accept the applicant's submission that a cross device *per se* is *prima facie* lacking in distinctiveness in relation to the services for which the earlier mark is entitled to protection.

71. The earlier mark is not just a cross, but a white or light coloured cross on a contrasting black or dark background. I accept that this gives the mark as a whole a degree of inherent distinctiveness, but in my judgment the earlier mark has only a low level of inherent distinctiveness.<sup>20</sup>

<sup>19</sup> See, for example, *JOOP! GmbH v OHIM*, Case T-75/08, where the General Court held that a representation of an exclamation mark was devoid of any distinctive character.

<sup>20</sup> The earlier mark as a whole must be regarded as having at least a minimum level of distinctiveness: *Formula One Licensing BV v OHIM*, Case C-196/11P, CJEU.



72. The opponent's case is that the earlier mark has become more distinctive, indeed highly distinctive, through use in the EU. However, there is virtually no evidence of any use of the mark in the UK. Nor is there any evidence from which it could safely be inferred that average UK consumers would have become familiar with the earlier mark as a result of its use in France. The ultimate question I am addressing is whether there is a likelihood of confusion amongst relevant average consumers in the UK. In these circumstances, I find it difficult to see how an enhanced level of distinctiveness of the earlier mark in France could increase the likelihood of confusion amongst UK consumers of the services at issue.

73. At the hearing, counsel for the opponent protested that narrowing the focus to the distinctiveness of the earlier mark in the UK was somehow inconsistent with the unitary nature of EU trade marks. I do not accept this. EU trade marks are enforceable throughout the EU, but the extent to which they are enforceable depends, in part, upon the level of distinctiveness of the mark to EU consumers. So, for example, an EU mark consisting of a word which is mostly descriptive in (say) German, may be entitled to a narrower scope of protection in German speaking areas of the EU compared to other parts where the word is more highly distinctive. A similar point arose in *China Construction Bank Corporation v Groupement Des Cartes Bancaires*.<sup>21</sup> In that case Mr Ian Purvis QC, as the Appointed Person, dealt with it like this on appeal.

“30. The Hearing Officer accepted that there had been significant use of the device mark in continental Europe, but not in the United Kingdom. He therefore concluded that the mark did not have an ‘enhanced distinctive character’ in the United Kingdom such as might increase the likelihood of confusion.

31. The Opponent contends that this was an error of law. Mr Bartlett submits that the Hearing Officer was bound to take into account the reputation of the mark in Europe (and in particular France) when considering the likelihood of confusion under s5(2). In this respect he cited the decision in *Pago*

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<sup>21</sup> BL O/281/14

International GmbH v Tirolmilch Registrierte Genossenschaft mbH (C-301/07). In that case, which concerned the extended protection granted to marks with a reputation under Article 9(1)(c) of the Trade Mark Regulation, it was held by the CJEU that knowledge of a CTM by a *significant part of the public concerned/in a substantial part of the territory of the Community* was sufficient to enjoy the benefit of Article 9(1)(c). Even a reputation within a single territory could suffice (and on the facts of that case a reputation within the state of Austria did suffice). On that basis, Mr Bartlett contended that since the Opponent was relying on a Community Trade Mark, the Hearing Officer was wrong to refuse to take into account its substantial reputation in France.

32. I consider that Mr Bartlett's submission is wrong. It mixes up the question of reputation of a Community Trade Mark under Article 9(1)(c) with the question which is before this tribunal, namely the likelihood of confusion under s5(2) of the Trade Marks Act.

33. The 'reputation' being considered by the CJEU in *Pago* was the condition provided by the Regulation before a mark could claim the extended protection provided by Article 9(1)(c) (that is to say the right to prohibit use of signs even where there is no confusion). We are not concerned in this case with any such condition. We are concerned with s5(2) of the Trade Marks Act 1994, and the single question whether there would a likelihood of confusion between the marks amongst average consumers of the goods or services in question in the United Kingdom/ The 'reputation' of the earlier mark may be taken into account as a factor which may increase its distinctive character and therefore increase the risk of confusion – see *Sabel v Puma* [1998] RPC 199. However, since the only question to be asked is whether there is a likelihood of confusion amongst consumers in the United Kingdom, a reputation (and therefore enhanced distinctive character) amongst consumers outside the United Kingdom will by definition be entirely irrelevant.

34. I therefore do not consider that the Hearing Officer made any error on the question of enhanced distinctiveness under s5(2)."

74. Therefore, even assuming that the earlier mark has become more distinctive through use in the French speaking parts of the EU, I find it irrelevant to this opposition. I find that the earlier mark has only a low degree of distinctiveness to relevant UK consumers.

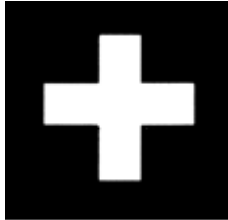

Comparison of marks

75. The CJEU stated in *Bimbo SA v OHIM*<sup>22</sup> that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

76. The respective trade marks are shown below:

	
Earlier trade mark	Contested trade mark

77. Visually, the marks are similar to the extent that the central feature of the marks is a cross device. However, the presentation of this feature differs considerably. In the earlier mark the crossed lines are relatively thick and shown in white or a light colour on a black or dark square background. The crossed lines in the contested mark are noticeably thinner than in the earlier mark and shown in black on a white

<sup>22</sup> See paragraph 34 of the judgment in Case C-591/12P

background, i.e. the colour contrast is reversed. This might not make any difference where the central feature of the mark has a normal or high level distinctiveness. For example, a black device of a griffin on a white background has the same distinctive character as a white device of a griffin on a black background. However, reversing the colour contrast makes quite an impact where the central feature of the mark is a very basic geometrical sign, such as a cross. To use an analogy, the public understand that a white cross on a red background is the Swiss flag, but a yellow cross on a blue background is likely to be seen as the Swedish flag. The opponent appears to recognise that colour contrast and the presence/absence of a square background matters because it does not rely on use of the sign Canal + (i.e. a black cross on an indeterminate white background) as use of the earlier mark.

78. Additionally, the cross in the contested mark is shown within brackets. In my experience it is unusual to see a cross presented in this fashion. Therefore, the brackets will make a far from negligible contribution to the overall impression the contested mark makes on average consumers of the services at issue.

79. Overall I find that there is a moderate degree of visual similarity between the marks.

80. As these are visual marks, which the consumer is unlikely to verbalise, it would be artificial to examine the aural similarity between them.

81. Although the earlier mark might remind some consumers of a flag (depending on the colours used), neither mark as a whole has any clear and immediately graspable concept beyond the general idea of a cross or plus sign. There is therefore a certain conceptual similarity between the marks, but the 'concept' in question is a relatively non-distinctive one.

## Likelihood of confusion

82. Counsel for the applicant relied on the decision of Mr Geoffrey Hobbs QC in *Torremar Trade Mark*<sup>23</sup> as support for the proposition that the marks must be distinctively similar in order to create a likelihood of confusion. The editors of Kerly's Law of Trade Marks and Trade Names 15<sup>th</sup> edition make a similar point at paragraph 9-094. They say that if the common element is non-distinctive then this will tend to decrease the likelihood of confusion. That appears to me to be consistent with the CJEU's judgment in *L'Oréal SA v OHIM*,<sup>24</sup> where the court warned against giving decisive weight to the level of distinctiveness of the common element(s) of the marks in the global appreciation of the likelihood of confusion. I therefore accept that the relatively low level of distinctiveness of the common element between the marks at issue – the cross or plus sign – is a factor which decreases (without necessarily eliminating) the likelihood of confusion.

83. On the other hand, some of the services covered by the marks are identical and this increases the likelihood of confusion, at least as far as those services are concerned.

84. I come then to the level of overall similarity between the marks. As I noted earlier, these are essentially visual marks and the overall level of visual similarity between them is only moderate. Given the relatively weak level of distinctiveness of a plus or cross sign *per se*, I do not consider that, even where the services are identical, the level of visual similarity and/or the level of conceptual similarity between the marks is sufficient to create a likelihood of confusion, including the likelihood of association. It follows that there is no likelihood of confusion where the respective services are merely similar.

85. In reaching this finding I have considered the likelihood of confusion through imperfect recollection of one or other of the marks. However, I find that overall impressions that these marks will make on average consumers of the services at issue is sufficiently different so as to make imperfect recollection unlikely.

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<sup>23</sup> [2003] RPC 4

<sup>24</sup> Case C-235/05 P, at paragraph 45. See also *Gateway Inc. v OHIM*, Case C-57/08P.

86. I have also considered the likelihood of indirect confusion, i.e. that consumers will recognise that they are different marks but think that the common element – the cross or plus sign – signifies that they are variant marks likely to be used by the same undertaking or economically related undertakings. However, given the relatively low level of distinctiveness of a cross or plus sign in relation to the services at issue, I do not consider this likely either.

87. I have attached no weight to the applicant's evidence of other undertakings applying to register various cross type devices or the word PLUS as trade marks for various goods/services. This tells me nothing about the distinctiveness of the earlier mark in the market place in relation to the services for which the earlier mark is entitled to protection. This evidence is therefore irrelevant.

### **Section 5(3)**

88. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

89. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in

such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

### Reputation

90. Earlier I found that the earlier mark had been used on a substantial scale in France. The use of the earlier mark in France may also have been apparent to relevant consumers in other French speaking areas of the EU, such as parts of Belgium.

91. An EU trade mark may, in appropriate circumstances, acquire a qualifying reputation in the EU as a result of its use in a part of the EU corresponding to the territory of a single Member State.<sup>25</sup>

92. Counsel for the opponent submitted that the earlier mark “*is one of Europe’s most recognisable marks.*” I agree with Counsel for the applicant that this is going much further than the evidence. However, I accept that the earlier mark had a qualifying reputation at the relevant date in France, and possibly the French

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<sup>25</sup> *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, the CJEU



speaking parts of Belgium,<sup>26</sup> and that this is sufficient to constitute a qualifying reputation for TV broadcasting and TV entertainment services in the EU.

93. In terms of the strength of the reputation, I consider the earlier mark to have a relatively modest reputation in the EU. This is because (a) the reputation appears to be concentrated in a relatively small area of the EU, and (b) the earlier mark does not appear to be the primary mark used to distinguish the opponent's services: this appears to be the word mark CANAL. Consequently, the earlier mark is likely to have a lower level of reputation than if it were the principal mark used to distinguish the opponent's services.

### Link

94. I acknowledge that the level of similarity required for the public to make a link between the marks may be less than the level of similarity required to create a likelihood of confusion.<sup>27</sup>

95. However, it will be harder to show that the relevant UK public will make a link between the marks where the earlier mark has little or no reputation in the UK. In *Iron & Smith kft v Unilever NV*<sup>28</sup> the CJEU held that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of

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<sup>26</sup> Genuine use and reputation are different legal concepts. A mark may have a reputation in a part of the EU in which it has not been put to genuine use. See *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, at paragraphs 52 and 53.

<sup>27</sup> See, in *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, CJEU.

<sup>28</sup> Case C-125/14

that provision or, failing that, a serious risk that such injury may occur in the future.”

96. It is apparent from the court’s judgment that the description “*a commercially significant part of that public is familiar with* [the earlier] *mark*” is intended to cover a lesser, but still significant, degree of recognition of the EUTM in the Member State where the same or a similar trade mark has been applied for by another party. This is confirmed by other language versions of the CJEU’s judgment. The French version says that a “*commercially non-negligible*” part of the relevant public in the Member State must be aware of the earlier CTM (now EUTM) and make a link with the later national trade mark.

97. In my judgment, the opponent’s evidence establishes virtually no exposure of the earlier mark in the UK and none at all to consumers of the goods/services covered by the contested mark. Even if I were to take account of UK consumers who may have encountered the earlier mark whilst in France or Belgium, I would have crossed the line between a reasonable inference and mere speculation in order to find that the earlier mark had more than a negligible reputation amongst relevant UK consumers.

98. I therefore find that the opponent has not shown that UK consumers of the parties’ services were likely, at the relevant date, to make any link between the contested mark and earlier mark. It follows that use of the contested mark would not take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

99. Counsel for the opponent implied that its evidence might have been stronger if it had been allowed to file the 3289 pages of evidence originally proposed. However, the opponent has at all times been professionally represented, and I specifically drew the representatives’ attention to the CJEU’s judgment in *Iron & Smith* prior to the filing of the opponent’s evidence. In these circumstances it must be assumed that the opponent filed the best evidence available to it. I do not therefore accept the implication that the paucity of evidence of use showing use or reputation of the earlier mark in the UK is connected to the case management directions.

100. As counsel for the opponent pointed out, the applicant has not filed any evidence explaining why it adopted the contested mark or that it has due cause to use it. On another occasion these may have been significant omissions. However, these matters only become material once the opponent has established a *prima facie* case under s.5(3). For the reasons given above, I find that it has failed to do so.

101. The opposition under s.5(3) therefore fails.

## **Outcome**

102. The opposition fails.

## **Costs**

103. The applicant has been successful and is entitled to a contribution towards its costs. Counsel for the applicant asked for costs off the scale on the grounds that the opponent filed around 500 pages *“of untranslated, largely apparently irrelevant material, without adopting the suggestions of the Hearing Officer as regards presentation (for example, failing to mark up the evidence to indicate which goods or services it covered – see direction (i)(b) of the CMC order).”*

104. In fact the directions I issued following the CMC gave the opponent two options. These were that:

“The evidence of use including press articles, marketing and advertising materials in the EU, proposed to be filed as exhibits GC1, GC2, GC5, GC6, GC8 & GC11, be limited to 350 pages OR comply with the following requirements.”

Directions (i)(a) and (b) therefore only applied if the opponent persisted in its request to file more than 350 pages of press articles, marketing and advertising materials. Exhibits GC1, GC2, GC5, GC6, GC8 & GC11 as filed amount to fewer than 350 pages. Therefore direction (i)(b) did not apply. This is not to say that it would not have been helpful if the opponent had indicated the goods or services for which the

individual pages of these exhibits were claimed to show use of the earlier mark. However, in failing to do so the opponent was not strictly in breach of the directions. Therefore, this is a not a matter for which it can be penalised in costs.

105. That does not prevent the applicant from making the general point that the opponent's unfocussed evidence wasted costs. I have carefully considered this, but I do not find the opponent's behaviour in this respect sufficiently unreasonable so as to justify awarding off scale compensatory costs. I will, however, use the flexibility within the published scale<sup>29</sup> to compensate the applicant to a greater extent than usual for the amount of time spent examining the opponent's evidence.

106. In the circumstances I award the applicant the sum of £3500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and filing a counterstatement - £300

Considering the opponent's evidence - £1800

Filing the applicant's evidence – nil

Taking part in the CMC - £200

Attending the hearing and filing a skeleton argument - £1200

I therefore order Groupe Canal + to pay Curb Media Limited the sum of £3500. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 8<sup>th</sup> day of June 2017**

**Allan James  
For the Registrar**

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<sup>29</sup> Per Tribunal Practice Notice 2/2016