

O-213-11

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND  
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 956090  
IN THE NAME OF  
UTOPIA SOCIAL ENTERPRISES GmbH  
AND THE APPLICATION TO EXTEND PROTECTION IN THE UK TO**

**UTOPIA**

**IN CLASSES 03,09,12,16,25,29,30,32,35,36,38,39,41,42 and 43**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 956090  
BY  
STUART CHAPMAN TRADING AS UTOPIA PRODUCTIONS**

## TRADE MARKS ACT 1994

**IN THE MATTER OF International Registration No.956090**

**In the name of Utopia Social Enterprises GmbH**

**And the application to extend protection in the UK to the trade mark:**

# UTOPIA

**In classes 03, 09, 12, 16, 25, 29, 30, 32, 35, 36, 38, 39, 41, 42 and 43**

**AND IN THE MATTER OF opposition thereto**

**Under no. 956090**

**By Stuart Chapman trading as Utopia Productions**

## BACKGROUND

1. On 9 July 2007, the UK was notified by WIPO of international registration (IR) 956090 (the above mark), in respect of which it had been designated under the relevant provisions of the Madrid Protocol.

2. The designation is in the name of Utopia Social Enterprises GmbH (hereafter USE) and is in respect of goods and services in classes 03, 09, 12, 16, 25, 29, 30, 32, 35, 36, 38, 39, 41, 42 and 43 of the Nice Classification System<sup>1</sup>. However, for the purposes of these proceedings only the following goods and services are relevant :

***Class 09:***

*Digital image carriers and machine-readable data carriers.*

***Class 41:***

*Services of a television studio; television entertainment; production of films and television programs.*

3. The designation was accepted and published on 8 August 2008 in the Trade Marks Journal.

4. On 7 November 2008, Stuart Chapman, trading as Utopia Productions, (hereafter "UP"), filed a notice of opposition claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

5. The opposition is directed at the goods and services as detailed in paragraph 2 above. UP relies on its services in class 41 of its earlier UK trade mark registration detailed below:

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<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

<b>Mark details and relevant dates</b>	<b>Services relied upon</b>
2374676 UTOPIA PRODUCTIONS  Date of application: 7 March 2000  Date of completion of registration procedure: 13 July 2001	Class 41  Film video and music production

6. The mark relied on by UP was registered more than five years prior to the date the IR was published (8 August 2008). Consequently, it is subject to the proof of use regulations<sup>2</sup>. The opponent has made a statement of use in respect of all the services listed in its earlier registration.

7. USE filed a counterstatement, putting the opponent to proof of use of its registered mark in respect of the services it relies upon.

8. Only UP filed evidence and written submissions in lieu of a hearing; neither side requested a hearing, both being content for a decision to be made from the papers on file.

### **Evidence**

9. UP's evidence takes the form of a witness statement by Stuart Chapman, dated 18 August 2010, in which he explains that he has been trading as Utopia Productions since 1992. He states that Utopia Productions is a creative media company whose work includes documentaries, promotional videos, internet virals, post production editing and music production and adds that more recently this has also included computer generated effects and animation. He has included turnover figures from 2003 – 2008 which are broken down as follows:

<b>Year</b>	<b>Sales</b>
2003	£204,315
2004	£192,352
2005	£216,615
2006	£211,278

<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

2007	£196,449
2008	£189,046

10. At exhibit SC2 Mr Chapman provides copies of DVD covers, and the related discs, for an annual series of films (examples are provided for 2003 to 2009) documenting the making of the *Pirelli* calendar. These show the relevant calendar year on the covers and the discs. The mark UTOPIA PRODUCTIONS is visible on the outer edge of the discs. The front of the DVD covers feature 'UTOPIA PRODUCTIONS/PIRELLI TYRES LTD' followed by the relevant copyright date.

11. Exhibit SC3 is made up of numerous invoices dated from 2005 to 2008 inclusive. These are for, inter alia, film shoots (video/film and stills), commercials, website virals, editing and documentary work for the *Channel 4* and *More 4* television channels. Other clients include *Vanity Fair*, *Pepsi* and *Pirelli*, among others. In each case the trade mark is shown at the top of each invoice in the following stylised form:



12. Exhibit SC5 shows the company name UTOPIA PRODUCTIONS LTD listed in several trade directories and on website directories. The company name is also referred to by UP's customers at exhibit SC1 which consists of letters of satisfaction relating to services provided by UP between 1992 and 1995.

13. Exhibit SC6 is made up of two articles from the media. The second of these is an interview with Mr Chapman, on the subject of editing software, from the publication entitled '*Technology and Production*'. The first paragraph of the interview includes reference to him setting up Utopia Productions in 1992. It is dated September 2001.

14. Mr Chapman's statement also contains a number of submissions. I do not intend to detail those here, but I will bear them in mind together with his written submissions provided in lieu of attendance at a hearing.

## **DECISION**

### **Proof of use**

15. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

**“6A Raising of relative grounds in opposition proceedings in case of**

## non-use

(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, ...

...

(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...”

16. Section 100 of the Act is also relevant, which states:

“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.”

17. The contested mark was published on 8 August 2008 and UP’s mark

completed its registration procedure on 13 July 2001. Clearly this is more than five years before the publication date of USE's mark. No claim has been made in respect of proper reasons for non-use so it is necessary for UP to demonstrate that genuine use has been made of its mark during the five years directly preceding this date, namely between the 9 August 2003 and 8 August 2008. The requirements for "genuine use" have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed Person in O-371-09 *SANT AMBROEUS*:

*42. The hearing officer set out most of the key extracts from Ansul and La Mer in his decision, so I shall not reproduce them here. Instead, I try to summarise the "legal learning" that flows from them, adding in references to Silberquelle where relevant:*

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

*(2) The use must be more than merely "token", which means in this context that it must not serve solely to preserve the rights conferred by the registration: Ansul, [36].*

*(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: Ansul, [36]; Silberquelle, [17].*

*(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: Ansul, [37]-[38]; Silberquelle, [18].*

*(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: Ansul, [37].*

*(b) Examples that do not meet this criterion: (i) internal use by the proprietor: Ansul, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle, [20]-[21].*

*(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the*

*goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: Ansul, [38] and [39]; La Mer, [22] - [23].*

*(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: Ansul, [39]; La Mer, [21], [24] and [25].*

18. The services for which UP's earlier mark is registered are 'film video and music production'. At exhibit SC2 UP have provided copies of DVDs created between 2003 and 2009 documenting the creation of the annual Pirelli Calendar. It is clear from the evidence provided that UP is responsible for the creation of the DVDs in their entirety, including the film production and music soundtracks. The DVD covers and the discs themselves clearly show 'UTOPIA PRODUCTIONS' in plain text and are clearly dated. Applying the principles set out above, I consider that this evidence alone is sufficient to illustrate genuine use of the earlier mark in respect of all the services listed. Further evidence illustrates the mark being used in a variant form. In light of my finding in respect to the production of DVDs, I do not consider it necessary to go on to consider if the variant use further supports the claim of genuine use.

## **5(2)(b)**

19. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994, which states:

*"(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."*

20. The leading authorities pertinent to this ground are from the Court of Justice of the European Union (CJEU), namely: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas*

*AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)* C-334/05 P (*LIMONCELLO*).

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*;

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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: *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components: *Sabel BV v Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it: *Sabel BV v Puma AG*;

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2): *Sabel BV v Puma AG*;

(i) further, 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: *Marca Mode CV v Adidas AG and Adidas Benelux BV*;

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked



undertakings, there is a likelihood of confusion within the meaning of the section: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*(hereafter *Canon*);

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components: *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*;

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element: *LIMONCELLO*

### Comparison of goods and services

21. For ease of reference the respective goods and services are listed below:

UP's services	USE's goods and services
<p><b>Class 41</b></p> <p>Film, video and music production</p>	<p><b>Class 9</b></p> <p>Digital image carriers and machine readable data carriers</p> <p><b>Class 41</b></p> <p>Services of a television studio; television entertainment; production of films and television programmes</p>

22. In comparing the respective goods and services, all relevant factors should be considered, as per *Canon* in which the CJEU stated at paragraph 23 of its judgment:

“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.”

23. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*<sup>3</sup> such as the respective trade channels through which the goods or services reach the market.

24. I also bear in mind the guidance in *Gérard Meric v OHIM*, Case T-133/05, in which the General Court (GC) held that goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the application or when the goods designated by the application are included in a more general category designated by the earlier mark.

25. In making a comparison of the respective services, I must not give the specification an overly wide construction.<sup>4</sup> In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade<sup>5</sup>. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>6</sup>.

26. Finally, I must also consider if the respective goods and services are complimentary. In this respect I am guided by the General Court (GC) judgement *Boston Scientific Ltd v OHIM (Trade marks and Designs Case)*, Case T-325/06:

*“82. It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”*

#### USE's Class 9 goods

27. In respect of the USE's goods in Class 9 UP submits:

*“Services provided by the opponent by their nature have to be fixed in some permanent form...it is submitted that ‘digital image carriers’ and ‘machine readable data carriers’ are related goods which cannot be separated from the services”.*

28. In terms of the respective goods and services before me, it is clear that the channels of trade are different. The users of USE's class 9 goods will be the general public whereas the services offered by UP under Class 41 are aimed at professionals, either individuals or companies, seeking *film, video and music*

<sup>3</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>4</sup> *Avnet Inc v Isoact Ltd (Avnet)* [1998] FSR 16

<sup>5</sup> *Ibid*

<sup>6</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 (“*Beautimatic*”)

*production services*. The intended purpose of '*digital image carriers*' and '*machine readable data carriers*', namely the recording/storage of data, is different from '*film, video and music production*' which provides audiovisual media to professionals. They are not in competition with each other and in line with the decision in *Boston Scientific* they are not complimentary. I find that there is no similarity between USE's goods in class 9 and UP's services in class 41. I note that the GC, in T-192/09, *Amen Corner, S.A. v Office for Harmonization in the Internal Market (OHIM)*, has reached the same conclusion when considering similar goods and services.

#### USE's Class 41 services

29. *Production of films* is included in USE's application and is self evidently identical to *film production* in UP's specification. USE's application also includes *production of television programmes*. These are services which would be offered to professionals in the same way as UP's *film, video and music production* services would be. Both share the same broad purpose, namely, providing/creating audiovisual media and both could be provided through the same trade channels. It is not uncommon that a company which produces films may also produce television programmes. These production services are the same but merely relate to adjacent fields of activity. The skills required will involve substantial overlap and as such, it is reasonable to expect the provider of one of these services could also provide the other. Consequently, it is possible that there may be some degree of competition between the services. However, I bear in mind that both co-exist within the broad field of entertainment. Taking all of these factors into account, I find that these services share a high level of similarity.

30. USE's application also includes *services of a television studio*. A television studio is used in the production of entertainment programmes. The services will be provided to professionals as is the case with *film, video and music production* services in UP's specification. The purpose in both cases is the production of audiovisual media which, as discussed above at paragraph 30, could be provided through the same trade channels. I find that these services share a reasonably high level of similarity with *film, video and music production* in UP's specification.

31. USE's *television entertainment* is directed at the general public, whereas the average consumer of UP's *film, video and music production* services will be a commercial customer. The purposes are also different in that the services offered by UP are intended to provide audiovisual media in a business to business transaction while *television entertainment* is intended to provide entertainment to the general public. However, *television entertainment* shares some complementarity with *film, video and music production* in that it may involve the same content as a television entertainment programme and further, because a television programme must be produced before it can serve its function to entertain. There may also be some degree of overlap in trade channels as a provider of entertainment services may also be the producer of such services. Taking all of these factors into account, I find these services share a reasonably high level of similarity.

## The average consumer and nature of purchasing act

32. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods or services. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods or services and the frequency of the purchase.

33. UP concludes that the services offered by both parties are *“likely to be specialist and purchased by commercial or corporate customers.”* I am in agreement on this point in respect of *services of a television studio and production of films and television programmes* offered by USE and *film, video and music production* in UP’s specification which are all complex services which would be provided to professional customers. Such services are bespoke and are likely to be fairly expensive, involving a considerable degree of interaction prior to the final purchasing act. This will result in a higher than average level of attention being paid by the consumer of such services. In respect of USE’s *television entertainment* I do not agree that the average consumer is a commercial or corporate customer. Television entertainment will be provided to the general public and is unlikely to result in an above average level of attention being paid.

## Comparison of marks

The marks to be compared are:

UP’s earlier mark	USE’s mark
UTOPIA PRODUCTIONS	UTOPIA

34. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components,<sup>7</sup> but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

### Distinctive and dominant components

35. UP’s mark consists of the words UTOPIA PRODUCTIONS. I have no hesitation in concluding that the word ‘PRODUCTIONS’ is not distinctive in the context of production services as it merely describes the nature of the services being provided. It is likely to receive little or no attention from the average consumer who, as identified above at paragraph 31, is a professional familiar with production companies. UTOPIA is the distinctive and dominant element. USE’s mark, UTOPIA,

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<sup>7</sup> *Sabel v Puma AG*, para. 23

does not split into separate distinctive and dominant components. It will be viewed as the single word UTOPIA which is its only constituent part.

36. Taking these factors into account I find 'UTOPIA' to be the distinctive and dominant element of UP's mark while USE's mark 'UTOPIA' consists of only one word; consequently, the distinctiveness of the mark rests in that word.

### **Visual and aural comparison**

37. Any similarity between the marks resides in the presence of the word UTOPIA. The only difference is the addition of the word PRODUCTIONS, at the end of UP's mark. Weighing these factors, I consider there to be a reasonably high degree of visual and aural similarity.

### **Conceptual comparison**

38. For a conceptual meaning to be relevant it must be one capable of immediate grasp.<sup>8</sup> Such assessment must, of course, be made from the perspective of the average consumer.

39. UTOPIA is defined as "*an imagined perfect place or state of things.*"<sup>9</sup> This appears to be a normal everyday word which the average consumer is likely to be aware of. Whilst they may not be able to define it in detail it is highly likely that it will be familiar. Even if I am wrong, and the word UTOPIA brings nothing to mind and is considered to be a made up word, this will be the case in respect of both marks, as both have UTOPIA as the dominant and distinctive component.

40. Taking all of these factors into account I consider there to be a reasonably high degree of conceptual similarity.

41. I am required to factor these findings into an assessment of overall similarity. I have found that the marks share a reasonably high degree of visual, aural and conceptual similarity and I find that these combine to result in a reasonably high degree of similarity overall.

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

42. In order to make an overall global assessment of the likelihood of confusion, I must also assess the distinctive character of UP's mark. The distinctive character of a mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public.<sup>10</sup> In determining the distinctive character of a trade mark, it is

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<sup>8</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHMI* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

<sup>9</sup> *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 16 June 2011 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e62679>>

<sup>10</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91

necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings.<sup>11</sup>

43. 'UTOPIA' and 'PRODUCTIONS' have clear dictionary meanings. In relation to services in class 41 the trade mark is neither descriptive nor allusive of the goods. As a consequence the mark enjoys a reasonably high level of inherent distinctive character.

44. I have considered proof of use of UP's mark at paragraph 17 above. Turnover figures indicate business in the region of £1.2M in the period 2003-2008. While this is sufficient to indicate genuine use of the mark in respect of the services relied upon for the purposes of these proceedings, the evidence is silent with regards to the size of the market or the applicant's share of the market specifically. Nevertheless, I believe it is reasonable for me to assume that the market for such services is extremely large and as such, this turnover must be considered small. I am therefore unable to conclude that the distinctive character of the mark has been enhanced through use.

### **Likelihood of confusion**

45. In respect of USE's class 9 goods and UP's services in class 41 I have concluded that there is no similarity. The judgment in *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)* [2005] ETMR 23, tells me that I need go no further as one of the two essential requirements for a finding of likelihood of confusion has not been satisfied. Therefore, **in respect of the applicant's goods in class 9 the opposition fails.** Even if I am wrong and the respective goods share some degree of similarity this will so low as to be insufficient to disturb my finding.

46. I will continue to assess the likelihood of confusion in respect of USE's services in class 41. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has in kept in his mind.<sup>12</sup> I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa.

47. I have found the respective marks to share a reasonably high degree of visual, aural and conceptual similarity resulting in a reasonably high level of similarity overall. I have also identified a reasonably high level of distinctive character in UP's earlier mark. In respect of the services I have concluded that USE's *film production* in class 41 is identical to the same term in UP's specification. The remaining services in USE's application share a reasonably high level of similarity. I have identified the average consumer, in respect of *services of a television studio and production of*

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<sup>11</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585

<sup>12</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

*television programmes*, namely professional/corporate customers requiring production services and have concluded a higher than average level of attention being paid during the purchasing act. With regard to *television entertainment*, I have identified the average consumer as the general public and have concluded that the level of attention paid will be average. However this does not negate a finding of a likelihood of confusion as UP's customers, upon seeing USE's mark used in respect of entertainment, will assume that UP has expanded its services into this field & therefore they will assume the respective services originate from the same or linked undertaking.

48. Taking all the above factors into account, and considering the marks as a whole, I conclude that the similarities between the marks are such that if used on services which are identical or possess a reasonably high level of similarity, there is a likelihood that consumers will be confused into believing that the services provided by the applicant are those of the opponent or provided by some undertaking linked to them. Accordingly, **in respect of the services in class 41 the opposition is successful.**

### **COSTS**

49. As both parties have achieved a degree of success, it is appropriate that both parties bear their own costs. I therefore decline to make an award of costs.

**Dated this 20 day of June 2011**

**Ms Al Skilton  
For the Registrar**