

O-113-14

**TRADE MARKS ACT 1994**

**APPLICATIONS 2569806, 2592328 & 2594260**

**BY YOUVIEW TV LIMITED**

**TO REGISTER FIVE TRADE MARKS CONSISTING OF,**

**OR INCLUDING THE WORDS MY VIEW**

**AND**

**OPPOSITIONS 102058, 103058 & 103075**

**BY G & J HOLDINGS GMBH**

## Background and pleadings

1. These are three oppositions by G + J Holding GmbH to three applications by YouView TV Limited to register five trade marks consisting of, or containing, the words **My View**.

2. The first application under number 2569806 was filed on 21 January 2011. It was for the following series of two marks.

**MyView**  
**My View**

3. The second application under number 2592328 was filed on 24 August 2011 and is for the mark **MyView+**.

4. The third application under number 2594260 was filed on 14 September 2011 and is for the following series of two marks:



5. The list of goods and services for which the applicant wishes to register these marks is as follows:

### **Class 9**

Data recordings including audio, video, still and moving images and text in compressed and uncompressed form for reception on a hybrid broadcast/IPTV audio-visual platform; computer software for use in a hybrid broadcasting/IPTV audio-visual platform for downloading, accessing, storing, reproducing and organising audio, video, still and moving images, data and text in compressed and uncompressed form; electronic instructional and teaching apparatus and instruments for reception on a hybrid broadcast/IPTV audio-visual platform; apparatus for data communications, transmission and reception and access to interactive services over the Internet for reception on a hybrid broadcast/IPTV audio-visual platform; and parts for all the aforesaid goods.

### **Class 38**

Transmission, and reception and other dissemination of audio, video, still and moving images, text and data whether in compressed or uncompressed form and whether in real or delayed time for reception on a hybrid broadcast/IPTV audio-visual platform; television screen based information retrieval services for reception on a hybrid broadcast/IPTV audio-visual platform; interactive services for facilitating the recordal of content on a hybrid broadcast/IPTV audio-visual platform; interactive services for

television viewers facilitating the pre-selection of content on a hybrid broadcast/IPTV audio-visual platform; provision of interactive entertainment services to a hybrid broadcast/IPTV audio-visual platform via television and the Internet; reception, organisation and replay of television, radio, audio, video, still and moving images, text and data whether in compressed or uncompressed form, whether downloadable or non downloadable and whether in real or delayed time for reception on a hybrid broadcast/IPTV audio-visual platform; provision of information and advisory services relating to any of the aforesaid services.

**Class 41**

Provision of interactive and non-interactive television entertainment, interactive and non-interactive to a hybrid broadcast/IPTV audio-visual platform; presentation, distribution, networking, rental of audio, video, still and moving images, text and data whether in compressed or uncompressed form to a hybrid broadcast/IPTV audio-visual platform; provision of information relating to television programmes to a hybrid broadcast/IPTV audio-visual platform; organisation and presentation of competitions, contests, games for reception on a hybrid broadcast/IPTV audio-visual platform; provision of information and advisory services relating to any of the aforesaid services.

6. The opponent opposes the registration of these marks under s.5(2)(b) of the Act on the basis that it is the proprietor of an earlier international trade mark 897928 – **VIEW** - which is protected in the EU in classes 9, 16, 35, 38 and 41 for identical or highly similar goods/services. The applicant's marks are said to be similar to the earlier mark and there exists a likelihood of confusion, including the likelihood of (mis) association.

7. The earlier mark was protected in the EU as of 16 May 2006. However, the procedures for granting protection were not completed until 24 August 2007. As this is less than 5 years prior to the publication of the applicant's marks on various dates in 2011, the proof of use provisions in s.6A of the Act do not apply. Consequently, subject to the outcome of the application described below, the opponent is entitled to rely on the earlier mark for all the goods/services for which it is protected.

8. The applicant denies that there is a likelihood of confusion with the earlier mark.

9. Both sides ask for an award of costs.

10. The oppositions were consolidated. This decision, therefore, covers all three oppositions.

**The procedural history and the hearing**

11. Following the consolidation of the opposition proceedings, the registrar set a timetable for the parties to file evidence and submissions. According to this timetable the opponent's evidence was due on 31 July 2012. On 30 July 2012, the registrar was advised that the parties wished to negotiate a settlement. A stay of proceedings was granted to allow negotiations to take place.

12. On 26 September 2012 the applicant filed an application at the Office for Harmonisation of the Internal Market (Trade Marks and Designs) (“OHIM”) seeking the partial revocation of the opponent’s international registration on grounds of non-use. Nonetheless, the parties continued to negotiate and these opposition proceedings remained stayed.

13. In November 2012, the applicant reduced the list of goods and services for which registration was sought. The parties sought a continuance in the stay of proceedings. The reduction in the list of goods/services did not resolve the oppositions so far as the opponent was concerned. The basis for the stay of these proceedings had by this point become the applicant’s application to OHIM to revoke the protection afforded to the opponent’s international trade mark in the EU. The registrar wrote to the parties on 20 December 2012 pointing out that the date at which the applicant had asked OHIM to revoke the earlier trade mark post dated the filing and publication dates of the opposed UK applications. The outcome of the application for revocation was therefore irrelevant to the outcome of these proceedings. Consequently, the request to extend the stay to await the outcome of the application for revocation at OHIM was rejected and opponent was given until 20 January 2013 to file its evidence/submissions, which it duly did.

14. The applicant was given until 18 March 2013 to file evidence or submissions. On that date the parties sought another stay of proceedings to allow for further negotiations. Following a case management conference on 16 April 2013, a further stay was agreed until 2 September 2013. The registrar then decided that the parties had long enough to negotiate a settlement, resumed the proceedings, and gave the applicant a further two months to file its evidence/submissions. The applicant filed its written submissions on 4 November 2013 and subsequently requested a hearing.

15. On 10 December 2013, the parties were informed that the hearing would take place on 4 February 2014.

16. On 22 January 2014, the applicant’s representatives wrote explaining that an application had been filed at OHIM that same day seeking to invalidate the opponent’s earlier trade mark on grounds of descriptiveness/lack of distinctiveness. The applicant asked for the UK opposition proceedings to be stayed again to await the outcome of the invalidation application at OHIM.

17. The opponent’s representatives replied on 24 January objecting to the stay request because of the lateness of the application, the length of the likely delay to these proceedings, the proximity of the application to the hearing date, and the spurious basis of the application for invalidation.

18. The case was due to be heard by another Hearing Officer, Mr Oliver Morris. He refused to agree to the stay and directed that the matter be determined as a preliminary point at the hearing scheduled for 4 February. He also indicated that he would consider, as an option, making a provisional decision subject to the outcome of the OHIM invalidation proceedings.

19. Due to matters unconnected with this case, I was the hearing officer on 4 February. The applicant was represented by Henry Ward of counsel, instructed by Bristows, and the opponent was represented by Ms Iona Berkeley of counsel, instructed by White and Case LLP.

### **Whether the proceedings should be stayed to await the outcome of the invalidation application at OHIM**

20. Ms Berkeley relied on the arguments previously presented in writing for opposing a stay, and also objected to a decision being made on a provisional basis. Her main arguments were that:

- i) The proceedings have already been much delayed.
- ii) A stay or a provisional decision would add much more delay, possibly another two years before the OHIM invalidation proceedings are determined.
- iii) The OHIM invalidation proceedings could have been brought at any time: the applicant chose to leave it until shortly before the hearing of these oppositions.
- iv) If the OHIM invalidation application had been filed at the start of proceedings, the opponent would not now be facing another long delay.
- v) The decision to file the OHIM application appeared to be tactical and intended to delay the outcome of these proceedings.
- vi) Despite negotiations, the parties have a duty to pursue proceedings without unnecessary delays.
- vii) The grounds of invalidation are spurious, as demonstrated by the fact that if they were well based they would apply equally to the applicant's own mark.
- viii) There is a risk of prejudice through wasted costs: the opponent may wish to file different evidence if the list of goods and services for which the earlier trade mark is protected is cut down as a result of the invalidation application.

21. Mr Berkeley drew my attention to the case of *JCB Trade Mark*<sup>1</sup> in which Ms Amanda Michaels as the Appointed Person refused to stay appeal proceedings to

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<sup>1</sup> BL O/198/03

await the outcome of an application by the applicant to revoke the earlier UK trade mark relied on by the opponent in the opposition proceedings. Ms Berkeley urged me to adopt the same approach. She invited me to make a final decision, whatever the outcome of the oppositions.

22. Mr Ward supported the idea that the registrar should make a provisional decision in the oppositions. He sought to distinguish this case from the position in the *JCB Trade Mark* case. In this connection, Mr Ward pointed out that:

- i) The application for stay here was made before the first instance decision, not on appeal, as in the *JCB Trade Mark* case.
- ii) If the invalidation application had been made earlier, the likelihood is that it would have been stayed for negotiations, as the OHIM revocation proceedings were.
- iii) The opponent had not identified any real prejudice other than delay itself: there was no evidence that the opponent had any business in the UK.
- iv) The making of a provisional decision, if necessary, should avoid the cost of any further hearing in these opposition proceedings, once the outcome of the OHIM invalidation application is known.

23. I decided to proceed on the basis that if these oppositions are successful, my decision will be a provisional one, which will not take effect unless and until the OHIM invalidation application is finally determined. If the OHIM invalidation application fully succeeds then the basis of these oppositions will fall away and only a further short formal decision to that effect will be necessary. If it partly succeeds, then I will issue a final decision after first giving the parties an opportunity to make submissions on the impact of the partial cancellation of the earlier mark on my provisional decision.

24. As things stand, the opposition will succeed. If the opposition had failed on its merits then I would have issued a final decision against the opponent, as Ms Berkeley requested.

25. My reasons for this approach are that:

- i) Although the applicant could re-file a new application to register these marks if its invalidation or revocation applications succeed at OHIM, the resultant loss of priority date would prejudice the applicant to some extent.
- ii) On the other hand, other than delay itself, it was not clear whether the opponent will suffer any real prejudice from the course I have adopted.
- iii) I accept that if the invalidation application is partly successful the parties may need to make further submissions about the impact of the

OHIM decision on these oppositions, but as I have received comprehensive arguments from the opponent on the similarity between all of the parties' respective goods/services, this should not require significant additional arguments (and cost) so far as the opponent is concerned.

- iv) I do not see why the partial invalidation of the earlier mark (if that were to happen) should require the opponent to file additional evidence in these proceedings. Indeed, as the opponent appears to use the earlier mark only in relation to a German paper and on-line magazine, it is not obvious what further evidence it could file that would be relevant to these oppositions.
- v) Although the applicant was very late filing its invalidation application at OHIM, and has not offered a satisfactory explanation for the delay, if that application had been filed earlier the most likely result would have been that the invalidation application would have been stayed for the parties to negotiate.
- vi) Contrary, to the opponent's submission, I do not consider that the application for invalidation is without any merit or prospect of success. The word 'View' plainly had some descriptive capacity in relation goods and services relating to television entertainment and telecommunications services, and goods which show images for the user to 'view'. It is not appropriate for me to predict whether the application made to OHIM will succeed or not, but I am satisfied that it is not a fanciful application.
- vii) It follows that I do not accept that the invalidation application is just a delaying tactic.

26. I gave this decision at the hearing and made it subject to one condition: that the applicant provided an undertaking to pursue the invalidation application at OHIM diligently and without unnecessary delays. I subsequently received a written undertaking from the applicant's representatives to this effect. If it is not complied with it will be open to the opponent to apply for this provisional decision to be made final before the conclusion of the OHIM proceedings.

### **The evidence**

27. As indicated above, only the opponent filed evidence. It takes the form of a witness statement by Marcus Leonard Collins, who is a solicitor at White & Case LLP, which represents the opponent in these proceedings. Mr Collins gives hearsay evidence that the opponent is the owner of the intellectual property rights in a paper and on-line magazine called VIEW, which is apparently quite popular in Germany. It is also sold in various other EU countries, but not in the UK. So far as I can see, there is no suggestion that the magazine has acquired any reputation in the UK. It is not therefore obvious to me what relevance Mr Collins' evidence has to these

proceedings. Ms Berkeley did not rely on it in her skeleton or at the hearing itself. In these circumstances there is no need to say any more about it.

### **The Section 5(2)(b) ground**

28. 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, or 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 goods/services**

29. In the judgement of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

30. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

31. In *YouView Ltd v Total Ltd*<sup>2</sup>, Floyd J. (as he then was) stated:

“...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in

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<sup>2</sup> [2012] EWHC 3158 (Ch) at [12]



question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

32. With regard to lists of services, Jacob J. (as he then was) in *Avnet Incorporated v Isoact Limited*<sup>3</sup> stated that:

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

33. The applicant accepts that all the goods and services in the applications are identical to some of the goods/services covered by the earlier trade mark. Ordinarily that (sensible) concession would avoid the need to look any closer at the level of similarity between the respective goods/services. However, mindful of the opponent’s concern about the possible impact of any partial invalidation of its earlier trade mark on the final decision in these proceedings, I will make a number of more specific findings under this heading.

Applicant’s goods in class 9	Opponent’s goods	Level of similarity	Why
Data recordings including audio, video, still and moving images and text in compressed and uncompressed form for reception on a hybrid broadcast/IPTV audio-visual platform	Magnetic, optical, magneto-optical and electronic image and sound recording carriers and data memories, in particular CD, CD-ROM, CD-I, DVD, floppy disks, video tapes, records and microfilm, all for on and off-line uses.	Identical	The applicant’s goods are subsumed within the description of the opponent’s goods.
	Equipment for receiving, as well as for recording, transmission and reproduction of sound and images; hardware, in particular data processing equipment	Medium level of similarity	The goods are different in their specific purposes and not in competition. However, they are complementary and similar in nature.

<sup>3</sup> [1998] F.S.R. 16

<p>Computer software for use in a hybrid broadcasting/IPTV audio-visual platform for downloading, accessing, storing, reproducing and organising audio, video, still and moving images, data and text in compressed and uncompressed form.</p> <p>Apparatus for data communications, transmission and reception and access to interactive services over the Internet for reception on a hybrid broadcast/IPTV audio-visual platform; and parts for all the aforesaid goods.</p>	<p>Software; data processing programs; computer operating programs.</p> <p>Equipment for receiving, as well as for recording, transmission and reproduction of sound and images; hardware, in particular data processing equipment, computers and computer peripheral devices.</p> <p>Equipment for receiving, as well as for recording, transmission and reproduction of sound and images; hardware, in particular data processing equipment, computers and computer peripheral devices.</p>	<p>Identical</p> <p>Highly similar</p> <p>Identical</p>	<p>The applicant's goods are subsumed within the description of the opponent's goods.</p> <p>The purpose of the goods is very similar and they are complementary goods. Different in nature, so not identical.</p> <p>The applicant's goods are subsumed within the description of the opponent's goods.</p>
<p>Electronic instructional and teaching apparatus and instruments for reception on a hybrid broadcast/IPTV audio-visual platform</p>	<p>Equipment for receiving, as well as for recording, transmission and reproduction of sound and images</p>	<p>Identical</p>	<p>The applicant's goods are subsumed within the description of the opponent's goods.</p>
<p>Applicant's services in class 38</p>	<p>Opponent's services</p>		
<p>Transmission, and reception and other dissemination of audio, video, still and moving images, text and data whether in compressed or uncompressed form and whether in real or delayed time for reception on a hybrid broadcast/IPTV audio-</p>	<p>Services in the field of telecommunications, sending of information to third parties on the Internet, distribution of information on wireless or cable networks, content provider services, namely making available of platforms or</p>	<p>Identical</p>	<p>The applicant's services are subsumed within the description of the opponent's services.</p>

<p>visual platform; television screen based information retrieval services for reception on a hybrid broadcast/IPTV audio-visual platform; interactive services for facilitating the recordal of content on a hybrid broadcast/IPTV audio-visual platform; interactive services for television viewers facilitating the pre-selection of content on a hybrid broadcast/IPTV audio-visual platform; provision of interactive entertainment services to a hybrid broadcast/IPTV audio-visual platform via television and the Internet; reception, organisation and replay of television, radio, audio, video, still and moving images, text and data whether in compressed or uncompressed form, whether downloadable or non downloadable and whether in real or delayed time for reception on a hybrid broadcast/IPTV audio-visual platform; provision of information and advisory services relating to any of the aforesaid services.</p>	<p>Internet information, transmission of radio and (cable) television programmes.</p>		
<p><b>Applicant's services in class 41</b></p>	<p><b>Opponent's services</b></p>		
<p>Provision of interactive and non-interactive television entertainment, interactive and non-interactive to a hybrid broadcast/IPTV audio-visual platform;</p>	<p>Instruction, training, entertainment, radio entertainment and television entertainment.</p>	<p><b>Identical</b></p>	<p>The applicant's services are subsumed within the description of the opponent's services.</p>

<p><i>presentation, distribution, networking, rental of audio, video, still and moving images, text and data whether in compressed or uncompressed form to a hybrid broadcast/IPTV audio-visual platform;</i> provision of information relating to television programmes to a hybrid broadcast/IPTV audio-visual platform.</p>	<p>Services of publishers (except printing); publication and issue of printed matter in printed and electronic form with editorial content and partly advertising content off and online in the field of publishing, included in this class</p>	<p>Medium to high level of similarity</p>	<p>The closest of the applicant's services are italicised opposite. The opponent's services cover online publication of 'printed matter', which is different to the applicant's services of distributing information and data via a hybrid broadcast/IPTV audio-visual platform. The respective services are similar in their purpose: making data available to the public; and somewhat similar in nature, but they are probably not in competition.</p>
<p>Organisation and presentation of competitions, contests, games for reception on a hybrid broadcast/IPTV audio-visual platform; provision of information and advisory services relating to any of the aforesaid services.</p>	<p>Instruction, training, entertainment, radio entertainment and television entertainment.</p> <p>Services of publishers (except printing); publication and issue of printed matter in printed and electronic form with editorial content and partly advertising content off and online in the field of publishing, included in this class.</p>	<p>Identical</p> <p>Low level of similarity</p>	<p>The applicant's services are subsumed within the description of the opponent's services.</p> <p>The opponent's services cover online publication of 'printed matter', which is different to the applicant's services of organising and presenting competitions, contests etc. The respective services are only similar in their purposes at a high level of generality (entertainment): they are somewhat different in nature, and probably not</p>

	Sports and cultural activities.	Identical	in competition.  The applicant's services are organising games, competitions etc. The fact they are for TV reception does not change this. Therefore the applicant's services are subsumed within the description of the opponent's services.
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### The principles to be applied to the assessment of likelihood of confusion

34. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited*,<sup>4</sup> the Court of Appeal approved the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95 [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97 [1999] RPC 117, *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 [2000] E.T.M.R. 723, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Case C-334/05P.

#### 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;

<sup>4</sup> [2012] EWCA Civ 24 para 51 et seq

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Average consumer**

35. 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<sup>5</sup>.

36. The parties appear to agree that the relevant consumer is the general public. More specifically, given that the all the goods and services in the applications are

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<sup>5</sup> *Lloyd Schuhfabrik Meyer, Case C-342/97*

limited for reception or use on a 'hybrid broadcast/IPTV audio-visual platform', the relevant consumer is someone in the market for internet TV. Given the cost of set top boxes or other equipment/subscriptions required to access internet TV, the applicant's goods and services are likely to be selected with an above average level of attention: not the very highest level of attention, but more than usual. I, therefore, accept the applicant's submission on this point and reject the submission made on behalf of the opponent that the relevant average consumer would pay only a normal level of attention when selecting the goods/services at issue.

### **Comparison of the marks**

37. On behalf of the opponent, Ms Berkeley submitted that:

- The earlier mark VIEW would be understood as a noun meaning "what can be seen from a particular point".
- The word View has the same meaning in the applicant's marks.
- The addition of the short word 'My' at the beginning of the applicant's marks is a small difference that would be given little significance by the average consumer and therefore does little to reduce the visual and aural similarities between the marks.
- The addition of the plus symbol in some of the applicant's marks is an even smaller difference and has minimal visual or aural impact.
- In terms of conceptual meaning, all the word 'My' does is to personalise the meaning of View so that the meaning of the applicant's mark is "what I can see from a particular point".
- The earlier mark is registered in standard characters and without limitation of colour, so the minimally stylised font and colour applied to some of the applicant's marks is irrelevant.
- Conjoining My and View into one word makes no difference because MyView is plainly two words pushed together.

38. On behalf of the applicant Mr Ward submitted that:

- The approach advocated on behalf of the opponent is wrong because it starts from the perspective that the applicant's marks are the word VIEW with additions. This does not give sufficient weight to the teaching in the case law that the average consumer tends to view a trade mark as a whole and does not analyse its various details.
- The word MY is at the beginning of the applicant's marks and is not therefore easily overlooked or likely to be lost when the mark is spoken.
- Consumers can easily distinguish between words that end in -view but have different meanings, e.g. Preview and Purview.

- The word VIEW is likely to be seen as a verb in the opponent's mark (as in to view TV) whereas when combined with the word MY the word is likely to be seen as a noun and the applicant's marks as wholes will have the meaning 'my point of view'.

39. I accept that the word 'My' will not be overlooked in the applicant's marks. It changes the look and sound of the applicant's marks as compared to the opponent's mark. Equally, the word 'View', which makes up the whole of the opponent's earlier mark, will not be missed when the applicant's marks are seen or heard.

40. I accept Ms Berkeley's submission that the colour and font of some of the applicant's marks is irrelevant, and the addition of the + symbol in some of the applicant's marks makes minimal visual or aural difference.

41. I therefore assess the level of visual and aural similarity between the marks as 'medium'.

42. In my view, depending on the goods/services for which it is used, the earlier mark is capable of being seen as either a verb or a noun. When used as part of term 'my view', the word View would often be taken as a noun, but when that term is used in relation to TV goods/services, the alternative meaning of VIEW as a verb would also be apparent. It is important not to attribute a higher level of analysis to the average consumer than he or she is likely to undertake when confronted by one or another of these trade marks. The meanings of View as a verb and as a noun are very well known. However much attention the average consumer pays to the selection of the goods/services sold under the marks, he or she has no reason to analyse which of the meanings of the word View is more applicable when that word is used as, or as part of, these trade marks. I, therefore, find that there is a high degree of conceptual similarity between the respective marks.

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

43. The parties were most divided over this issue. On behalf of the opponent, Ms Berkeley submitted that VIEW was highly distinctive for the goods and services covered by the earlier mark. By contrast, on behalf of the applicant, Mr Ward submitted that the earlier mark was descriptive and wholly lacking in distinctive character for goods and services relating to viewing television. This applied to all the goods and services covered by the earlier mark to the extent that they were relevant to the opposition to the applicant's marks.

44. There is no evidence on the point, but I consider that View is descriptive of the intended purpose or another characteristic of television apparatus and television services. This is borne out by very well known uses of "viewer" (the name for a person who watches TV), "viewing figures" (the number of people who view or watch



a particular program), “pay per view” (paying to view or watch a particular program). Even if it not truly descriptive, these very common uses of the word suggest that the word View is lacking in distinctive character for TV related goods/services.

45. This raises a point of law: whether it is open to me to find that the earlier mark has no distinctive character. In the end the parties agreed that such a finding is not open to me. There are mixed national authorities of this point<sup>6</sup>. However, the judgment of the Court of Justice of the European Union (“CJEU”) in *Formula One Licensing BV v OHIM*<sup>7</sup> indicates that a registered trade mark must be considered to have at least a minimum degree of distinctive character. I will examine the likelihood of confusion on this basis.

### **Likelihood of confusion**

46. The question remains whether it is open to me to find that the word View (considered by itself) has no distinctive character in the later mark. Such a finding would rule out the likelihood of confusion because if consumers would not regard that word as distinctive of the goods/services of one undertaking then as a matter of logic they would not be confused by the use of that word as part of the applicant’s marks. In this connection I note that in the paragraphs 42-45 of the *Formula One* case the CJEU found that:

“42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43 However, as the appellant rightly points out, their verification has limits.

44 Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).

45 Such a finding would be detrimental to national trade marks identical to a sign considered as being devoid of distinctive character, as the registration of such a Community trade mark would bring about a situation likely to eliminate the national protection of those marks. Hence, such a finding would not respect the system established by Regulation No 40/94, which is based on

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<sup>6</sup> Compare *Wella Corporation v Alberto-Culver Company* [2011] EWHC 3558 with *Samuel Smith Old Brewery v Philip Lee* [2011] EWHC 1879 at paragraph 82.

<sup>7</sup> Case C-196/11P

the coexistence of Community trade marks and national trade marks as stated by the fifth recital in the preamble to that regulation, given that the validity of an international or national trade mark may be called into question for lack of distinctive character only in cancellation proceedings brought in the Member State concerned by virtue of Article 3(1)(b) of Directives 89/104 and 2008/95.” (emphasis added)

47. I think it is clear from this part of the CJEU’s judgment that, in principle, it is not open to a decision maker to find that a sign (or part of a sign) identical to an earlier registered or protected mark is devoid of any distinctive character because that would amount to an indirect finding that the earlier mark is also devoid of any distinctive character. There may be some exceptions to this general rule. For example, where the earlier mark is inherently descriptive but has been found to have acquired a secondary meaning as a trade mark, the context in which it is used as part of a later complex trade mark may indicate that it retains its original descriptive meaning in the later mark. In that case the recognition that the sign is descriptive as part of the complex mark, and not one of its distinctive elements, may not call into question the validity of the earlier mark. There are no such considerations here because the earlier mark was not registered on the basis of acquired distinctiveness, and VIEW is no more obviously descriptive in the later mark than it is in the earlier mark.

48. I agree with the submission made on behalf of the opponent that the element ‘My’ by itself is low in distinctive character. It is a banal term with little distinguishing power. The combination ‘My View’ may be slightly more distinctive than the sum of its parts. However, I do not think that this will do much to avoid indirect confusion if I assume, as I must, that VIEW alone is distinctive of the opponent’s identical goods and services. This is because, even allowing for an above average level of attention in the selection process and the minimum level of distinctiveness of the earlier mark, there is a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings. That is to say that My View/MyView is a reference to the opponent’s VIEW goods/services.

49. I also accept that the presence of the + symbol in some of the applicant’s marks does nothing to alter the distinctive character of those marks and therefore the likelihood of confusion with the opponent’s mark. I don’t think this approach amounts to dissecting the marks. I have considered the applicant’s marks as wholes, but having done so I conclude (or I am required to assume) that some elements of the marks do more to distinguish the goods/services than others.

50. I therefore provisionally find that there is a likelihood of confusion through association, or indirect confusion as it sometimes called, insofar as the applicant’s marks cover identical goods. Where the respective goods/services are only similar, I find that the weak distinctiveness of the earlier mark is insufficient to give rise to a likelihood of confusion, including the likelihood of association.

51. This means that the success of these oppositions depends on whether the earlier mark remains protected for:

**Class 9**

Magnetic, optical, magneto-optical and electronic image and sound recording carriers and data memories, in particular CD, CD-ROM, CD-I, DVD, floppy disks, video tapes, records and microfilm, all for on and off-line uses; equipment for receiving, as well as for recording, transmission and reproduction of sound and images; hardware, in particular data processing equipment; software; data processing programs; computer operating programs.

**Class 38**

Services in the field of telecommunications, sending of information to third parties on the Internet, distribution of information on wireless or cable networks, content provider services, namely making available of platforms or Internet information, transmission of radio and (cable) television programmes.

**Class 41**

Instruction, training, entertainment, radio entertainment and television entertainment; Sports and cultural activities.

52. I will issue a final decision after the applicant's application to invalidate the earlier mark has been finally determined, or sooner if that application is not prosecuted in line with the applicant's undertaking to this tribunal.

**Costs**

53. I will reserve my decision on costs until I have seen the outcome of the OHIM proceedings. This will be covered in my final decision.

**Appeal**

54. As this decision does not terminate the proceedings or award costs, it cannot be appealed independently of the final decision without the leave of the registrar<sup>8</sup>.

**Dated this 11<sup>th</sup> Day of March 2014**

**Allan James  
For the Registrar**

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<sup>8</sup> See Rule 70 of the Trade Mark Rules 2008