

O-414-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3002092  
IN THE NAME OF AMAZING GRACE WORSHIP CENTRE  
IN RESPECT OF THE FOLLOWING TRADE MARK IN CLASS 41:**

**Church's Got Talent**

**AND**

**OPPOSITION THERETO (NO 400791) BY FREMANTLE MEDIA LIMITED AND  
SIMCO LIMITED**

## **The background and the pleadings**

1) The trade mark **Church's Got Talent** was filed by Amazing Grace Worship Centre ("the applicant") on 15 April 2013 and was published for opposition purposes on 7 June 2013 in respect of:

**Class 41:** Art exhibitions; Education courses relating to the travel industry; Information on education; Organization of sport fishing competitions; Career counseling [education]; Computer education training; Computer education training services; Conducting workshops and seminars in art appreciation; Consultancy services relating to the education and training of management and of personnel; Education in the field of art rendered through correspondence courses; Education information services; Education services in the nature of courses at the university level; Information relating to sports education; Organizing community sporting and cultural events; Physical education services; Pre-school education; Sport camps; Television or radio programmes relating to religious and inspirational messages; Arranging of competitions for education or entertainment; Art gallery services; Art gallery services provided on-line via a telecommunications link; Cultural activities; Cultural and sporting activities; Cultural services; Education services; Courses (training-) relating to religious subjects; Educational services relating to religious development; Religious educational services; Religious training; Education (Religious -); Religious education; Gospel choir singing; Entertainment, sporting and cultural activities; Organisation of entertainment and cultural events; Organisation of events for cultural, entertainment and sporting purposes; Organisation of exhibitions for cultural and educational purposes; Providing cultural activities; Sporting and cultural activities; Arranging of competitions for cultural purposes; Arranging of conferences relating to cultural activities; Arranging of conventions for cultural purposes; Arranging of demonstrations for cultural purposes; Arranging of displays for cultural purposes; Arranging of exhibitions for cultural purposes; Arranging of festivals for cultural purposes; Arranging of presentations for cultural purposes; Arranging of seminars relating to cultural activities; Education services related to the arts; Educational services for the dramatic arts; Exhibitions (arranging-) for cultural purposes; Exhibitions (conducting-) for cultural purposes; Exhibitions (organization of-) for cultural or educational purposes; Festivals (organisation of-) for cultural purposes; Fetes (organisation of-) for cultural purposes; Organising events for cultural purposes; Workshops for cultural purposes; Organisation of exhibitions for cultural or educational purposes; Organization of cultural shows; Organization of events for cultural purposes; Organization of shows for cultural purposes; Organizing cultural and arts events; Ticket reservation and booking services for entertainment, sporting and cultural events

2) On 4 September 2013, FremantleMedia Limited and Simco Limited (“the opponents”) jointly opposed registration of the applicant’s mark. The opponents rely on the following four trade marks:

i) UK registration 2487699 for the mark BRITAIN’S GOT TALENT which was filed on 16 May 2008 and entered on the register on 25 June 2010. The mark is registered for a range of goods and services in classes 16, 25, 28, 29, 30 and 41.

ii) UK registrations 2446109A and 2446109B both of which consist of the following series of marks:



The former number was filed on 8 February 2007, entered on the register on 25 June 2010 and is registered for various services in class 41; the latter was filed on 8 February 2007, entered on the register on 1 August 2008 and is registered for various goods in class 9, 16, 25 and 28.

iii) Community trade mark (“CTM”) registration 8385874 for the mark GOT TALENT which was filed on 24 June 2009 and entered on the register on 10 February 2010. The mark is registered for a range of goods and services in classes 9, 38 and 41.

3) All of the above marks constitute earlier marks in accordance with section 6 of the Act. None completed their registration procedures (when they were entered on the register) more than five years before the date on which the applicant’s mark was published; the consequence of this is that none of the earlier marks are subject to the requirement to prove that genuine use has been made of them. The above marks (and signs which correspond to them) are relied upon under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4) The applicant filed a counterstatement stating:

*Our church has no ambitions or intentions to undermine the "Got Talent" or "Britain's Got Talent" format/trademark that Fremantle and Simco own. We simply wish to be able to own and use the "Church's Got Talent" trademark to inspire people and organisation to develop and innovate in Church, Christian and biblical related materials, activities, behaviours and art-forms to glorify and honour Jesus Christ and the God of the bible.*

*We do not believe, and we are convinced, that this registration will not harm the opponent's interest in their "Britain's Got Talent" trademark.*

The applicant put the opponents to proof of use, but as the proof of use provisions do not apply, this request is misconceived.

5) Only the opponents filed evidence. Neither side requested a hearing. The opponents filed written submissions in lieu of a hearing.

### **THE EVIDENCE**

6) The evidence comes from Ms Isabelle Brender, a trade mark manager for FremantleMedia Limited. She gives evidence about the television programme BRITAIN'S GOT TALENT and related merchandising activities. It is abundantly clear from her evidence that the television programme is an extremely popular one in the UK. It has been going since June 2007 and has had 8 series so far, although, series 7 and 8 took place after the applicant filed its mark. The popularity of the show is shown by various viewing figures. For example, for series 6, the average viewing figures constituted audience shares of between 30% and 49% depending of what category of viewer was being considered. Similar figures were achieved for earlier series. The programme is effectively a talent competition with auditions leading to an ultimate winner. Numerous press articles are provided in evidence showing the exposure the programme has received in many high profile publications.

7) The evidence also shows that the programme has been syndicated to other countries, with the word BRITAIN'S replaced with the country of syndication. Furthermore, BRITAIN'S GOT TALENT has been the subject of merchandising (Ms Brender refers to annuals, board games, clothing and bags); some license agreements are put in evidence to support this.

8) Although I have not spent long summarizing the opponents' evidence, this is symptomatic of the fame and reputation of the television programme, fame and reputation I may well have accepted on judicial notice. Even if this were not the sort of fact that could have been accepted on judicial notice, the fame and reputation is beyond doubt when the full content of the evidence is considered.

### **SECTION 5(3) OF THE ACT**

9) Section 5(3)<sup>1</sup> of the Act reads:

“5-(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

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<sup>1</sup> Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01)).

the United Kingdom (or, in the case of Community trade mark, in the European Community) 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.”

## Reputation

10) The earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the Court of Justice of the European Union (“CJEU”) stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

11) As I have already touched upon, BRITAIN’S GOT TALENT is extremely well known. This means that the opponents’ UK registration 2487699 (the plain word mark which I will focus upon in the first instance) meets the reputation test as set out in *Chevy*. However, it does not follow that the mark has a reputation for all its goods and services. Even though merchandising has occurred, there is no evidence as to the extent of sales achieved through the various licensing arrangements. I therefore cannot hold that the opponents possess a specific reputation for the goods covered by registration 2487699. In relation to the class 41 services of the earlier mark, this reads:

Education and entertainment services all relating to television, cinema, radio and theatre; production and presentation of radio and television programmes, films and shows; education by or relating to television and radio; entertainment by or relating to television and radio; organization of competitions (education or entertainment); interactive telephone competitions; publishing; production of cinematographic films, shows, radio programmes and television programmes; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the Internet; organization of shows; rental of sound recordings and of pre-recorded shows, films, radio and television performances; production of video tapes and video discs; radio entertainment; television entertainment; cinema entertainment; theatre entertainment; game shows; television entertainment services involving telephonic audience participation; interactive entertainment for use with a mobile phone; Internet based games; operation of lottery and games of chance; provision of video clips via mobile or computer networks for entertainment and/or educational purposes.

12) The above is clearly wider than the reputation I have described. Bearing the evidence in mind, I hold that the opponents’ reputation extends only to talent

based television entertainment services, something which is covered by a number of the terms (but not all) in the above class 41 list of services.

### **The required link**

13) In addition to having a reputation, a link must be made between the subject trade mark and the earlier mark. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

14) In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“*Intel*”) the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...”

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

### *Similarity of marks*

15) The marks to be compared are **BRITAIN’S GOT TALENT** and **Church’s Got Talent**. The difference in casing is not a factor because notional use of either

mark includes use in both upper and upper/lower case. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. Both marks will be considered as complete phrases, both of which reference that a particular thing BRITAIN/CHURCH has GOT TALENT. There is a self-evident degree of visual and aural similarity between the marks given the common presence at the end of the respective three word marks of the words GOT TALENT. The marks have the same form of construction. It is noteworthy that to meet that same form of construction the Church's Got Talent mark has been coined with an element of grammatical incorrectness. There is a degree of conceptual similarity as both marks refer to the possession of talent, but the things so possessed are different. Overall, there is a reasonable, but not high, level of similarity between the marks.

#### *The services*

16) The services for which the applicant wishes to register its mark are quite diverse, ranging from entertainment events and services (which are identical or highly similar to the opponents' reputed services) to various education services (which do not seem particularly similar to the reputed services) to sporting services and art exhibition services (which, on their face, do not seem particularly similar to the opponent's reputed services, but could have an element of competition, a feature of the opponent's services).

#### *Reputation and distinctive character*

17) Whilst the words BRITAIN'S GOT TALENT are not very distinctive from an inherent perspective, I come to the view that in respect of the reputed services, the resultant reputation is very strong and that the mark, in respect of the reputed services, has become distinctive to virtually the highest possible degree.

#### *Link or not?*

18) I come to the view that the strength of the reputation is such that the use of the applied for mark in relation to any of the applied for services will result in the bringing to mind of the BRITAIN'S GOT TALENT television programme, even if there was no likelihood of confusion between them. Whilst the finding is, of course, stronger in relation to the applied for services which have an entertainment or even a competitive nature, even for services which do not, the fame of the programme is such, and the similarity in structure of the applied for mark to the earlier mark so apparent, that the factors combine to result in the earlier mark being brought to mind. This establishes the requisite link.

## The heads of damage

19) There are three potential heads of damage under section 5(3). They are often referred to as: i) free-riding, ii) dilution, and iii) tarnishing. The three kinds of damage were conveniently summarised by the CJEU in Case C-487/07, *L'Oréal v Bellure*, as follows:

“39. As regards detriment to the distinctive character of the mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).

40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41. As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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.”

### *Free-riding*

20) Based on the evidence before me, I believe it quite clear that the applicant will derive some form of advantage from the opponents’ reputation on account of the similarity between the respective marks. The opponents’ reputation is so great that a member of the relevant public who encounters the applicant’s mark will not only bring the opponents’ mark to mind, they will do so in a way which immediately informs them what the applicant’s services are likely to entail. Because of this, it becomes immediately more attractive and therefore lessens what the applicant will need to do in terms of marketing. Whether this form of advantage is an unfair one can be answered positively on the basis that, in my



view, a fair inference can be made that this was the exact intention of the applicant. Whilst the applicant states in its counterstatement that through its services it wishes to inspire people etc, it has not even claimed that the mark was independently coined without the opponents' mark in mind. Given the strength of the opponents' reputation, I think it highly unlikely that the opponents' mark was not in the applicant's mind. It may have thought that there was nothing wrong in this, but that is not the issue. I conclude that in relation to certain of the applicant's services there is an unfair advantage and the ground of opposition succeeds.

21) I say "certain services" because some of them do not appear to be entertainment based, nor do they appear to have any form of talent based competition. Therefore, I struggle to see what advantage the applicant will derive if its mark were to be used in relation to:

Education courses relating to the travel industry; Information on education; Career counseling [education]; Computer education training; Computer education training services; Education in the field of art rendered through correspondence courses; Consultancy services relating to the education and training of management and of personnel; Education information services; Education services; Exhibitions (organization of-) for educational purposes; Organisation of exhibitions for educational purposes; Education services in the nature of courses at the university level; Information relating to sports education; Physical education services; Pre-school education; Sport camps; Courses (training-) relating to religious subjects; Educational services relating to religious development; Religious educational services; Religious training; Education (Religious -); Religious education; Education services related to the arts; Educational services for the dramatic arts;

22) However, the advantage is clear in relation to the following services as they could potentially be entertainment based or otherwise have some form of competitive angle to nurture talent (in the particular field) in a competitive sense:

Art exhibitions; Art gallery services; Art gallery services provided on-line via a telecommunications link; Organization of sport fishing competitions; Conducting workshops and seminars in art appreciation; Organizing community sporting and cultural events; Television or radio programmes relating to religious and inspirational messages; Arranging of competitions for education or entertainment; Cultural activities; Cultural activities; Cultural services; Entertainment and cultural activities; Organisation of entertainment and cultural events; Gospel choir singing; Organisation of events for cultural, entertainment and sporting purposes; Providing cultural activities; Organization of cultural shows; Organization of events for cultural purposes; Organization of shows for cultural purposes; Organizing cultural and arts events; Arranging of competitions for cultural purposes;

Organising events for cultural purposes; Sporting activities; Organisation of events for sporting purposes; Arranging of conferences relating to cultural activities; Arranging of conventions for cultural purposes; Arranging of demonstrations for cultural purposes; Arranging of displays for cultural purposes; Arranging of exhibitions for cultural purposes; Arranging of presentations for cultural purposes; Arranging of seminars relating to cultural activities; Exhibitions (arranging-) for cultural purposes; Exhibitions (conducting-) for cultural purposes; Workshops for cultural purposes; Exhibitions (organization of-) for cultural purposes; Organisation of exhibitions for cultural purposes; Arranging of festivals for cultural purposes; Festivals (organisation of-) for cultural purposes; Fetes (organisation of-) for cultural purposes; Ticket reservation and booking services for entertainment, sporting and cultural events

**23) In view of this, there is unfair advantage for the second group but not the first.**

#### *Dilution*

24) I do not think the opponents are in any better position here. Whilst there is a strong argument in relation to the services for which I have held an unfair advantage, for the other services I do not see how the use of the applied for mark will make the opponents' mark any less capable of distinguishing the services for which it has a reputation. **The claim succeeds to the same extent as above.**

#### *Tarnishing*

25) In *Red Bull GmbH v Sun Mark Ltd* [2012] EWHC 1929 (Ch) Arnold J stated:

“93 The present state of the law with regard to detriment to the repute of the trade mark is conveniently summarised in Kerly’s Law of Trade Marks and Trade Names (15th edn.) at §9–131 as follows:

“Detrimental effect occurs where the later mark is used for goods or services which provoke a reaction of annoyance or displeasure, whether through their intrinsic nature or because of the unpleasant mental association with the goods for which the earlier mark is reputed: *Ferrero v Kindercare Learning (KINDER CARE/kinder et al)*, Case R-1004/2000, [2005] E.T.M.R. 6 OHIM BoA at para.30. It may also occur when the trade mark applied for is used in an unpleasant, obscene or degrading context, or in a context which is not inherently unpleasant but which process to be incompatible with the earlier trade mark’s image: *Elleni Holding* [2005] E.T.M.R. 51 at para. 43. These cases give rise to the phenomenon of ‘tarnishment’, whereby the reputed mark ceases to convey desirable messages to the public: hence the detriment to its distinctive character.”

26) This is in my view a weak claim. There is nothing inherent in the nature of the opposed services which, if the applied for mark were to be used in relation to them, would have any obvious negative connotations. The applied for mark itself must be borne in mind. To that extent, the use of the word Church's has a clear religious connotation. Whilst not everyone is religious, I doubt that the use of the word will have a negative impact on the reputation of the Britain's Got Talent programme. **The claim fails for all the applied for services.** The other earlier marks place the opponents in no stronger position under section 5(3).

### **SECTION 5(2)(b) OF THE ACT**

27) Section 5(2)(b) of the Act states that:

"5.-(2) A trade mark shall not be registered if because –

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

(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."

28) The CJEU has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases<sup>1</sup>:

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

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

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

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

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

(f) 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 of that mark;

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

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

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

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

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

### **The earlier marks**

29) In relation to the earlier marks, the closest in terms of mark similarity is GOT TALENT *per se*. I will focus on this mark initially, a mark which is registered for:

Entertainment and education services; publishing services; entertainment, education and instruction by or relating to radio and television; production, presentation and rental of television and radio programmes and of films and sound and video recordings; publication, production and rental of educational and instructional materials; entertainment, education and instruction relating to sport; entertainment, education and instruction for

children; organisation of competitions, games, quizzes, fun days, and sporting events; organisation, presentation and production of shows, live performances and audience participation events; provision of games via mobile or computer networks; interactive voice recognition games and competitions; competitions and quizzes provided by telephone and mobile phones; conducting and organising of phone-in competitions; competitions, quizzes and lotteries provided on-line; operation of lottery and games of chance; provision of video clips via mobile and computer networks for entertainment and/or educational purposes.

### **The average consumer**

30) The average consumer is deemed to be reasonably observant and circumspect. Most of the conflicting services are general consumer ones aimed at the public at large which will be selected with an average (but no higher than that) level of care and attention. Some of the services, however, such as educational services, may be more considered, but not of the highest level. In terms of how the various services will be selected, this will be through media such as websites, brochures etc, so the visual impact of the marks will take on more importance, although aural similarity will not be ignored completely.

### **Comparison of services**

31) When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* 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.”

32) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

33) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

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

34) In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

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

35) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “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>2</sup> and that I must also bear in mind that

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<sup>2</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>3</sup>. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he 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) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

36) The earlier mark is registered in respect of various services in class 41, including the terms “education and entertainment services” at large. Such a term covers all types of entertainment and educational activity, in so far as they can be classed as a service in class 41. The bulk of the applied for terms are entertainment or education based. Accordingly, they are to be considered identical. This applies not only to those that expressly use the words “education” or “entertainment” but also those which describe the services as “cultural” as such a term includes entertainment in various forms.

37) There are, though, other applied for terms which do not obviously fall within education and entertainment. These include services such as art exhibitions and various sporting services. In terms of the former, whilst the services may not fall within the expression “entertainment” they are not, in reality, much different because one may go to an art exhibition to entertain oneself in a broader sense. It is an activity that one undertakes for pleasure or personal stimulation, and they may be provided in similar venues as entertainment etc. I consider them to be highly similar. In relation to sporting activities, I note that the earlier mark includes “entertainment .....relating to sport”. Again, there seems, in reality, to be a very fine line between these services and, as such, I consider the services to be highly similar.

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<sup>3</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

## **Comparison of the marks**

38) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

## **Church's Got Talent v GOT TALENT**

39) Despite the jarring quality inherent in the grammatical incorrectness of the applicant's mark, it does not break down into separate components. Neither does GOT TALENT per se in the opponents' mark. The applied for mark is longer than the opponents' mark but the words GOT TALENT are shared by both which introduces a degree of visual and aural similarity. There is of course a visual and aural difference on account of the additional/missing word "Church's". The concepts of both marks include an aspect focusing on the possession of talent so there is some similarity. However, the applied for mark indicates the thing ("Church's") that possesses such talent whilst the opponents mark does not – the opponents' mark could additionally be seen as a question, got talent? Overall, I consider there to a reasonable but not high degree of visual, aural and conceptual similarity.

### **The distinctiveness of the earlier mark**

40) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). As already observed, the opponents' reputation is in BRITAIN'S GOT TALENT not GOT TALENT per se, so the reputation does not assist. From an inherent perspective, it seems to me that the words GOT TALENT per se are low in inherent distinctiveness on account of the allusive message they send, however, they cannot be said to be lack distinctive character at all (as per the judgment of the CJEU in *Formula One Licensing BV v OHIM*).

### **Likelihood of confusion**

41) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.



42) I come to the view that the average consumer, even taking into account imperfect recollection, is unlikely to overlook the subject (“Church’s”) of the applied for mark and will thus not directly confuse the marks in relation to the respective services. However, confusion can be indirect in the sense that the similarities between the marks are put down to the responsible undertakings being the same or being related. Here, in relation to the identical or highly similar services at issue, I believe there is likelihood of such indirect confusion and the applied for mark will be put down as a variant or the earlier mark, or vice versa. This is so notwithstanding the relatively low level of inherent distinctive character in the earlier mark. Simply adding the subject of the thing that has GOT TALENT does not do enough to avoid confusion. **The opposition succeeds under section 5(2)(b) on the basis of the GOT TALENT mark in relation to all of the applied for services.**

43) I do not consider it necessary to make any specific findings in relation to the other earlier marks. The opponent has already succeeded and I do not consider it would be in any better position with regard to the other marks on account of i) the further difference between the marks (the addition of Britain’s), ii) that although the other earlier marks would benefit from enhanced distinctiveness this is limited to only some of the services covered by them, and iii) the reputation does not show any form of pattern of exchanging “Britain’s” for something else (the syndication point is borne in mind but such syndication is outside of the UK).

#### **Other ground of opposition**

44) Given the findings I have already made, the effect of which is that the opposition has already succeeded under two grounds, I do not consider it necessary to probe the third and final ground of opposition.

#### **Costs**

45) The opponents have succeeded and are entitled to a contribution toward their costs. My assessment is as follows:

*Preparing a statement and considering the other side’s statement - £300*

*Opposition fee - £200*

*Filing and considering evidence - £800*

*Preparing written submissions - £500*

***Total - £1800***

46) I hereby order Amazing Grace Worship Centre to pay FremantleMedia Limited and Simco Limited the sum of £1800 within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 30th day of September 2014**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**

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<sup>i</sup> The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).