

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS CONSISTING OF:**

**(1) TRADE MARK APPLICATION 3040867**

**BY THE BRITISH BROADCASTING CORPORATION**

**TO REGISTER 'BBC RADIO LONDON'**

**AND**

**OPPOSITION 402217 BY RADIO LONDON LIMITED**

**AND**

**(2) APPLICATIONS 500296 & 500297**

**BY THE BRITISH BROADCASTING CORPORATION**

**TO INVALIDATE TRADE MARKS 2314031B & 2353973**

**IN THE NAME OF RADIO LONDON LIMITED**

**AND**

**(3) APPLICATIONS 500292 – 295**

**BY THE BRITISH BROADCASTING CORPORATION**

**TO REVOKE TRADE MARKS 2314031B, 2353973, 2325301 & 2314030**

**IN THE NAME OF RADIO LONDON LIMITED**

**FOR NON-USE**

## Background and pleadings

1. On 5 February 2014, The British Broadcasting Corporation (“the BBC”) applied to register BBC RADIO LONDON as a trade mark for:

### Class 9

Data recordings including audio, video, still and moving images and text; computer software, including software for use in downloading, storing, reproducing and organising audio, video, still and moving images and data; downloadable electronic publications and information; downloadable ring tones and graphics for mobile phones; downloadable graphics for computers; computer, electronic and video games programmes and equipment; mouse mats television and radio signal transmitters and receivers; and parts for all the aforesaid goods.

### Class 16

Printed publications; magazines; books; catalogues; programmes.

### Class 38

Broadcasting; communications and telecommunications; transmission, broadcast, delivery, reception and other dissemination of audio, video, still and moving images, information, text and data whether in real or delayed time, multimedia content, webpages; electronic mail services; interactive broadcasting services; television screen based information, broadcasting and retrieval services; news information and news agency services; rental of radio and television broadcasting facilities; the provision of discussion forums; operating web logs [blogs]; operating message boards; webcasting; provision of information and advisory services relating to any of the aforesaid services.

### Class 41

Provision of entertainment, education, recreation, instruction, tuition and training; production, presentation and distribution of audio, video, still and moving images and data; publishing services (including electronic publishing services); non-downloadable electronic publications; organisation, production and presentation of shows, competitions, games, concerts, exhibitions and events; provision of information and advisory services relating to any of the aforesaid services, including on-line from a database or the Internet.

2. The application was published for opposition purposes on 28 February 2014.

3. On 27 May 2014, Radio London Limited (“RLL”) filed a notice of opposition. The grounds of opposition 402217 are, in summary, that:

- RLL is the owner of earlier trade marks 2314031B, 2353973 & 2325301 which are registered for various goods and services in classes 9, 16, 37, 38, 41 & 42, including ‘installation and maintenance of broadcasting apparatus and equipment’ in class 37, ‘broadcasting services’ in class 38 and ‘radio entertainment services’ in class 41.
- Earlier marks 2314031B and 2353973 consist of the words RADIO LONDON.

- Earlier mark 2325301 consists of the following figurative mark (“the Radio London logo”):



- The earlier marks are similar to the BBC’s mark because they each include (or consist of) the distinctive words RADIO LONDON, and they cover the same or similar goods and services.
- Use of the BBC’s mark in relation to any of the goods/services covered by its application would create a likelihood of confusion amongst the public, including the likelihood of association.
- The earlier marks have a reputation for the services for which they registered in classes 38, 41, 42 and, in the case of 2314031B, class 37. The marks have a long provenance and are known to a substantial proportion of the UK public, particularly those with an interest in radio broadcasts or music.
- Use of the BBC’s mark would, without due cause, take unfair advantage of the reputation of the earlier marks, either through being confused with them and/or by appealing to a “ready-made” section of the public.
- Use of the BBC’s mark would, without due cause, be detrimental to the reputation and/or distinctive character of the earlier marks. In particular, RLL would lose control over the use of the words RADIO LONDON. The fact that radio stations are associated with advertising and sponsorship, whereas the BBC is famously not, is liable to affect the economic behaviour of relevant consumers to the detriment of the earlier marks.
- RLL has used the mark RADIO LONDON throughout the UK since 1999 in relation to, inter alia, ‘pre-recorded media’, ‘clothing’, ‘media restoration services’, ‘installation and maintenance of broadcasting apparatus and equipment’, ‘broadcasting services’, ‘radio entertainment services’, ‘recording, production and mastering of sound and/or video images’ and ‘archiving services’ and acquired a protectable goodwill in the business.
- The BBC’s use of BBC RADIO LONDON would therefore constitute a misrepresentation liable to deceive the public which would damage RLL’s

goodwill and therefore amount to passing off. In this connection, RLL points out that the public have a propensity to shorten the names of radio stations so that, for example, 'BBC Radio 1' is regularly referred to as just 'Radio 1'.

- In the light of the above, the BBC's application should be refused under s.5(2)(b), 5(3) and/or 5(4)(a) of the Act.

4. The BBC filed a counterstatement in which it:

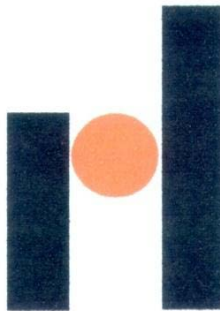
- Denied that RLL's earlier trade marks are similar to the applied-for mark, stating that the words RADIO LONDON are non-distinctive and that 'BBC' is a powerful distinguishing sign.
- Admitted that most of the services covered by class 38 of its own application, and some of the goods and services covered by classes 9 & 41, are similar to the goods and services covered by the earlier marks.
- Denied that the earlier marks have reputations, or that RLL has goodwill under the marks.
- Claimed that the BBC has due cause to use the mark applied for.
- Denied RLL's grounds for opposition and put RLL to proof of its statement of use of the earlier marks in the five year period ending on the date of publication of the opposed mark, i.e. 1 March 2009 to 28 February 2014.

5. Prior to the date of publication of the opposed mark, on 7 February 2014, the BBC had already filed applications to cancel RLL's earlier trade marks. These consist of:

- Applications 500296 and 500297 to invalidate trade marks 2314031B and 2325301, consisting of the words RADIO LONDON, on the basis that those words are descriptive of a characteristic of all the goods and services for which the marks are registered, i.e. goods and services relating to radio entertainment provided in (or about) London. In the alternative, the marks are devoid of any distinctive character for the goods/services for which they are registered. Registration of the marks was therefore contrary to s.3(1)(b) and/or (c) of the Act and they should now be declared invalid under s.47(1).
- Applications 500292, 500294 and 500295 to have trade marks 2314031B, 2353973 & 2325301 (i.e. all the earlier marks on which RLL relies) revoked for non-use under s.46(1)(a) or 46(1)(b) of the Act. As regards the latter, the BBC claims that the marks were not put to genuine use for any of the goods/services for which they are registered in the period 7 February 2009 to

6 February 2014. It asks for the marks to be revoked under s.46(1)(b) from 7 February 2014 or under s.46(1)(a) from 29 April 2011 (for 2314031B), 26 July 2008 (for 2314030), 20 November 2009 (for 2325301) and 5 November 2010 (for 2353973).

- Application 500292 to revoke trade mark 2314030 (“RLL’s device mark”) on the same basis as RLL’s other marks. This trade mark is not relied on by RLL for the purposes of its opposition to the BBC’s trade mark application. It looks like this:



It is registered for a range of goods and services in classes 9, 16,18, 25, 37, 38, 41 & 42.

6. RLL filed counterstatements denying the grounds for revocation and invalidation of its trade marks. In particular, I note that:

- RLL claims to have made genuine use of the trade marks throughout the periods relevant for the purposes of the applications for revocation.
- RLL claims that 2314031B and 2325301 – RADIO LONDON – are valid because the reversal of the words LONDON RADIO alters the normal syntactical juxtaposition of an adjective preceding a noun.
- A search of the UK Trade Mark Register revealed 36 registrations in classes 38 and/or 41 of marks consisting of RADIO plus place name, the majority of which are in the name of the BBC.

7. Both sides seek an award of costs.

### **The evidence**

8. RLL’s evidence takes the form of 4 witness statements by Chris Payne, the Managing Director of the company (with 28 exhibits) and 6 supporting statements from friends and acquaintances of Mr Payne and his wife Mary.

9. The BBC's evidence comes from Mr David Robey, the Editor of BBC Radio 94.9, and Ms Rehana Haq, who is a Trade Mark Attorney in the IP Department at the BBC.

10. I will set out the evidence by reference to the issues that are relevant to the matters I have to determine in these proceedings.

### **RLL's business**

11. It appears that there are three parts to RLL's activities, two of which are interrelated, whereas one part – which appears to be the largest part from a commercial perspective – is a relatively distinct business, albeit with similar roots to the other areas of activity. I cover each of these activities below, starting with the part of the business that appears to be relatively distinct from the rest.

### **RLL's broadcast engineering and technology consultancy services**

12. Mr Payne provides a clear description of the services RLL provides under this heading in his first witness statement, which is as follows:

"I work as a broadcast technology consultant and provide my services under the name of RLL, as well as on occasion sub-contracting work to others. A section advertising these broadcast technology consultancy and engineering services was added to our website in April 2003 and was expanded in February 2005 and has been visible to the present.

In brief, the radio and television design engineering contracts handled by RLL entail discussing with the client and drawing up a specification for the technical transmission or studio areas required. The next stage is providing detailed engineering appraisal of products and equipment that will fulfil the needs of the system.

Design consultancy, cable schedules, infrastructure diagrams, computer software and equipment appraisal, and liaising with suppliers and manufacturers are all very much part of the procedure.

Invariably, RLL is responsible for supervising the final installation and commissioning of the project, along with the handover of final 'as-built' documentation, which often includes training materials.

As a result of my years of expertise in the areas of audio, video, broadcasting engineering and operations, and computer technologies, I have gained an excellent reputation within the broadcasting and related industries for this type of work. I am well-known to radio and television broadcasters, (both technical and non-technical), and manufacturers and

suppliers.”

“ With over 45 years' professional experience in many aspects of radio, TV and satellite broadcasting with major companies, RLL offers all types of technical consultations and has the expertise to complete major projects from start to finish.

As experts in the field of hospital and community radio and short-term licence broadcasts, these web pages offer services relating to every aspect of these activities. Our technical pages include guidance for any organisation planning on launching a new service or updating an existing one. We can provide everything required, from design to advice on transmitter siting, installation and training.

RLL offers services in mastering, remastering and rescuing audio. Musicians, for instance, contact us with sessions they recorded long ago on reel-to-reel tapes that they want transferred to modern formats.

13. Mr Payne says that the RLL device mark and the word mark RADIO LONDON have been used since before November 2005 on outgoing correspondence from RLL, including emails, business cards, invoices and technical and operational documents supplied to customers as part of RLL's business contacts.

14. Mr Payne says that these marks have also appeared prominently on RLL's website since at least 2002. Examples of pages from the website are in evidence<sup>1</sup>. The pages have been obtained from the Wayback machine. They show the marks mentioned in the previous paragraph in use on the website in 2005, 2006 & 2008. The earliest page is dated 5 September 2005. The latest is dated 7 December 2008. They show use of the marks in question in relation to *“Broadcast Consultancy”*, *“Custom Interface Design”* (for broadcast equipment, computers and ‘play-out systems’), *“Recording Services”* in the nature of *“Audio Tape Rescue”<sup>2</sup> and Archiving*, *“Music Editing and CD Mastering”* and *“Alignment CDs”<sup>3</sup>*, *“Broadcast Engineering services”*, *“Off-air logging”<sup>4</sup>*, *“AM and FM Transmitter packages for Community Radio”*, *“LPAM (Low-Power AM) Package for hospitals and Sports Venues”*, which I note included supplying customers with “[RLL's] own CE-Approved transmitter and aerial”. However, there are no pictures of any such equipment bearing the marks at issue. All the broadcasting equipment that is visible on the webpages carries third party marks.

15. Mr Payne implicitly acknowledges that the webpages in evidence are dated from earlier than some of the periods at issue in the non-use proceedings, but says that

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<sup>1</sup> See exhibit CP3

<sup>2</sup> This involves transferring old recordings in other media onto CD, audio files, DAT or Minidisc

<sup>3</sup> These are mentioned on the webpage dated November 2005, but the webpage from June 2006 says that alignment CDs and Minidiscs would be *“for sale very soon”*. Alignment CDs appear to be used to check sound levels for broadcasting purposes.

<sup>4</sup> Logging the output of a radio station

they have remained on the website up to the date of his evidence in 2014, although some have been “*edited and improved*”.

16. Mr Payne provides a list of RLL’s main trading activities in the field of broadcast technology consultancy and engineering<sup>5</sup>. Seventeen activities are listed as occurring between 2009 and 2013. Most are broadcast technology and engineering services, including several media restoration services. I note that one of the services provided between 2009 and 2011 in connection with the ‘Sounds of the Nation’ live music show included “*audio and video media preparation*”. Some of the services listed relate to website design. Oddly, one involves supplying a feature on pirate radio stations for Saga magazine, and another involves supplying a photograph in connection with the 2012 Olympics. I am not sure how either of these count as broadcast technology or engineering services, so the list in question, which is headed ‘main trading activities’, may be the complete list of RLL’s trading activities during the relevant period.

17. Mr Payne provides three exhibits containing invoices for the supply of studio equipment to the BBC (in 2007), for consultancy, design, installation and project engineering services to 7 Waves Community Radio in the Wirral (in 2007, 2008 and 2011) and SIS Outside Broadcasts Ltd and Satellite Information Services Ltd over the period November 2009 and October 2013. The latter are in relation to design, documentation, installation and project management services for the building of satellite TV and audio broadcasting systems and studios. Each of the invoices bears the RADIO LONDON mark and the logo mark registered under 2314030. The total turnover shown on the invoices amounts to around £175k. Most of this turnover was as a result of trade in the period 2009 to 2013.

### **RLL provides a nostalgic platform for the history of the original RADIO LONDON and other offshore radio stations**

18. Mr Payne states that he and his wife Mary launched the website radiolondon.co.uk in 1999<sup>6</sup>. It was devoted to the offshore radio of the 1960s and, in particular, the station known as RADIO LONDON. The original station of that name broadcast from 23<sup>rd</sup> December 1964 to 14<sup>th</sup> August 1967 from a converted second world war minesweeper called MV Galaxy. The station was also known as the ‘Big L’. The station’s weekly chart was called the Fab Forty. By July 1966, the station had over 8m listeners in the UK. It was second only to Radio Caroline, which had nearly 9m listeners. The station was forced to close in 1967 following the passage of an Act which made such broadcasting illegal.

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<sup>5</sup> See CP4

<sup>6</sup> RLL took over the site in 2002



19. Mr Payne says that trade mark 2325301 – the Radio London logo - was used on the website from 2003 onwards (RLL's other three marks having been used on the site from at least 2002).

20. In addition to the information about the RLL's technical services (described above) the website provides news stories relating to the broadcasting and music industry and articles and other information about the offshore radio stations, particularly the original RADIO LONDON, but also RADIO CAROLINE and others. Mr Payne says that there are contributions from the surviving DJs from the sixties, and photo features depicting radio events and reunions, many of which were organised by RLL. There are also articles about RADIO LONDON's ship, MV Galaxy, pages of archive news clipping about offshore radio stations and personal photographs entrusted to RLL for use on the site. There are approximately 50 audio clips that can be downloaded with various articles and news items. The site also includes the Fab Forty play listings from the original RADIO LONDON, which Mr Payne says are a valuable source of information for writers and researchers of Sixties' radio and music history. Since 2007, the site has also included a collection of RADIO CAROLINE charts from the 1960s. In total, the website has 2000 pages. RLL is often asked to provide information for others in relation to the offshore radio stations of the 1960s, particularly the original Radio London<sup>7</sup>.

21. The radiolondon.co.uk website receives hundreds of thousands of 'visits' per year. In 2013 the site received 513k visits from around 185k unique 'hosts', i.e. IP addresses.

22. The website features books, DVDs, magazines and music of interest to Radio London visitors. There are click through facilities to Amazon and other sites where such goods can be bought. The website contains a disclaimer stating that Radio London has no responsibility for these sales. However, RLL's own T-shirts and sweatshirts have been sold since 2004, initially at special events, and from 2005 via the website. Examples of the goods can be seen in exhibit CP13. They show that the RLL device mark registered under 2134030 appears on the front of the products, above the (smaller) words 'www.radiolondon.co.uk'. Mr Payne says that there were 70 purchases of such shirts between 2004 and 2014 at a value of £930. In the 5 year period between February 2009 and 6 February 2014, i.e. the period in which genuine use must be shown to avoid revocation of RLL's marks for clothing, 26 purchases were made at a value of £477. Exhibit CP13 also includes 4 examples of invoices to customers dated between 2005 and 2013. The invoices bear the name RADIO LONDON LTD. I note that 2 of the 4 invoices are addressed to customers in the USA.

<sup>7</sup> CP8 includes a list of approaches made to RLL for input into radio, TV and other works produced by third parties, including the BBC.

23. Mr Payne sums up this aspect of RLL's activities like this:

“As we have shown in our evidence of use of the trade marks, RLL has built up a huge reputation, goodwill and following, providing a nostalgic platform for the history of the original RADIO LONDON and also the other offshore stations. We have become a respected resource of information and expertise in 60s music and history, resulting in the penetration of new markets and trade.”

24. RLL considered extending this aspect of its activities by re-introducing its own radio broadcasts under the name RADIO LONDON. According to Mr Payne, RLL has been trialling internet radio station software for this purpose since January 2012. Mr Payne's second witness statement explains what has been done under this heading like this:

“While initial test broadcasts of RLD were performed in January 2012, RLL has been very careful not to rush our radio station to be available to a wider audience without making sure we had created a good product. Setting-up and operating such a service requires considerable investment of time, which has not been at the company's disposal to the extent that we reached a position where we were ready for launch.

There are companies that provide people with the possibility of more or less instantly running their own internet radio station. However, this was not the manner in which we intended to approach the project, and it would not give us the flexibility of keeping the whole system 'in house'.

Automated radio stations, like many on FM and DAB today, use computer software to manage a database of music, automate the selection of tracks, make sure station idents and adverts go out regularly, etc. Achieving this type of automated play-out requires sophisticated computer software, the acquisition of which can be a formidable investment. Once a specific brand of software is chosen, the station is tied into that workflow, so very careful consideration is needed as to which system to choose.

Since 2012, RLL has been testing a particular computer package that appears to have the potential to be ideal for us. However, more acceptance tests need to be done before it proves to our satisfaction to be as reliable as we would expect.

The matter of cost per listener must be taken into consideration, as described in the explanation about current broadcasting, and media, which is Exhibit CP16 introduced below. Currently our Internet connection is sufficient to cater for a small group of listeners. These are people who also have the radio experience and knowledge to help with the adjustment of the play-out software and music library.

The fact that we have been asking for feedback from others, shows our commitment to getting everything right. We have no intention of offering an

inferior service, which would be an insult to the respected RADIO LONDON brand. RLL needs to reflect a quality of service that our customers would expect to enjoy. We will not waste our time operating a 'station' that consists of a selection of 200 songs from someone's record collection, played at random, on rotation. This is the basic operational system of a large number of internet radio stations, but to us, it is pointless. We are considering carefully the whole music spectrum and programming format that we intend to include in our broadcasts. This all takes time."

25. RLL's evidence includes 6 witness statements covering letters solicited in July 2014 for the purposes of these proceedings. The following extract from the letter from Mr Alan Field, dated 18 July 2014, is sufficient to convey the gist of this evidence.

"At a social gathering in December 2011 Chris and Mary discussed with me, and a number of other friends who were present, the idea of starting an internet radio station. There were lengthy discussions about music policy in particular, and the atmosphere was lively and full of enthusiasm.

In January 2012 Chris approached me, amongst others, to say that he had taken the idea forward. He gave me a link to listen to some test transmissions which he had already begun to broadcast online under the working title "Radio London Digital" and he asked me for my comments, as someone who was familiar with the sound of the original Radio London.

I listened from time to time over a period of a few weeks and emailed Chris various comments concerning the records played, and some technical points about the gaps or overlaps between records, or between records and jingles. Chris continued to adjust the output and asked for further comments.

Sections of the broadcasts consist of records that had been in the Fab 40 charts, mixed with original Radio London jingles, and I feel these recreate the sound and recapture the essence of the original station particularly well.

The broadcasts have continued to this day, and I have continued to listen from time to time and give Chris further feedback, both by email and in conversation when we meet socially. My comments mainly concern musical content and ongoing adjustments to the software settings, particularly in relation to the timing issues I mentioned before."

26. Ms Haq provides evidence on behalf of the BBC setting out the results of some internet research she did into the setting up of an internet radio station. On the basis of her enquiries she says that:

“6. It is very easy to set up an internet radio station to stream live and pre-recorded material. At a very basic level an internet radio station can be set up from home on a PC by using freely available software such as WimAmp at no cost. Usually a server function is also required and again, there is freely available software which can provide this function. Once installed on to a PC, these pieces of software allow content to be streamed online. This is the most basic model of internet broadcasting. Depending on the connectivity of the PC from which the station is being run and the speed at which content is being uploaded, the station could have up to 6, at the very most 9 listeners at any given time.

7. To meet the needs of a bigger audience or to provide a superior quality radio output, an external server would be required and commercial software and/or studio kit would need to be purchased. These additional items would come at a cost. However, this additional expenditure is not mandatory as very many of the free software programmes come with built in studio functionality e.g. Mic, faders, music library functionality and even for those concerned about sound quality the most important piece of technical kit is the Mic which could be purchased at a reasonable cost. However, for those with the resource and with the ambition to make the station available to a large audience, there is scope to spend some money in setting up and running such a service.

8. The only other cost element to this type of radio station is the royalty fee payable to the Performing Rights Society and the PPL in respect of any music that is played on the station. This requires a certain amount of administration on the part of the internet radio station in terms of reporting music usage. To take away some of the administrative burden, PRS offers smaller stations and/or start-ups the option to enter into a small Webcaster licence, the fee for the licence is determined by projections as regards the number of tracks likely to be played every quarter, number of listeners and number of broadcast hours. There is no evidence to suggest that Radio London has such a licence in place or that it has reported any of its usage to either of these entities.”

27. It appears tolerably clear from the evidence that RLL was providing test broadcasts under the name RADIO LONDON from January 2012 onwards to a small group of friends with the radio experience necessary to help RLL to develop the test offering into something that could be broadcast to the public at a later date. This is consistent with an email that Mary Payne sent to a member of the general public called Mike Cole on 23 April 2012. Mr Cole had emailed Mary Payne at radiolondon.co.uk asking what music had been playing that evening before the 8pm news.

Mary Payne's reply<sup>8</sup> stated that:

*"I think you must be listening to BBC London. Radio London is not a currently broadcasting station".*

### **RLL's licensing activities**

28. Mr Payne says that between November 2003 and November 2008, Sanctuary Records Limited used the trade mark RADIO LONDON and the logo shown at paragraph 5 above, in relation to a music CD entitled 'We Love The Pirates: Charting The Big 'L' Fab 40'. RLL found out about this in 2005. After discussion with Sanctuary Records Group, a licence agreement was signed on 14 February 2006 under which Sanctuary Records Group Limited was licensed to use trade marks 2314031C (RADIO LONDON) and 2314030 (the logo shown at paragraph 5 above) in relation to certain music CDs under the title mentioned above<sup>9</sup>. The licence was granted for a one-off fee of £300. The licence covered the 5 year period between 17 November 2003 and 16 November 2008.

29. I note that the licence expired prior to the beginning of the 5 year period in these proceedings which will determine whether any of RLL's marks should be revoked for non-use in relation to CDs in class 9. I also note that trade mark registration 2314031C has expired and is not one of the RADIO LONDON marks at issue in these proceedings.

30. Mr Payne provides examples of the packaging of the CDs in question<sup>10</sup>. I note that RADIO LONDON is shown on the sleeve of the CD painted across the hull of MV Galaxy and in the description "90 Radio London jingles". It is also shown on the inside packaging written across the T-shirts worn by some DJs from the 1960s. In context, this was all referential use of RADIO LONDON in relation to the offshore radio station of the 1960s. It was not trade mark use which indicated that RLL was in any way responsible for the goods. However, I note that the outer cover of the CDs bore RLL's device mark registered under 2314030. There is some doubt in my mind as to whether this was trade mark use either. However, on balance, I accept that this amounted to use of that mark as a trade mark for music CDs, with RLL's consent, between 14 February 2006 (the date of the licence) and 16 November 2008.

31. Mr Payne says that shortly after the registration of trade mark 2325301 (the Radio London logo) in September 2004, RLL was approached by Ron van Woerkum for a licence to use RLL's trade marks. Mr van Woerkum was setting up a 24/7 non-stop internet stream of music from the 1960s to be known as the Oldies Project. The operators of the Oldies Project wanted to play the 'Big L' chart of the corresponding

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<sup>8</sup> See CP19, page 5

<sup>9</sup> See CP9

<sup>10</sup> See CP9

week forty years ago, complete with jingles, and sometimes fragments of the original broadcasts. Mr van Woerkum offered to *“include a jingle referring listeners to [Radio London’s web] site, which can be played during the actual Fab Forty broadcasts”*. There was a further exchange of emails about the way that Radio London would be used on the website that went with the Oldies Project. A copy of these emails, the Oldies Project ‘features’ and ‘disclaimer’ pages from 2004 and the present, and pages from the Oldies Project online ‘Guest Book’ are in evidence<sup>11</sup>. One of the *“OLDIESPROJECT FEATURES”* was *“RADIO LONDON”*. Under this heading it was (and still is) stated that:

*“Broadcasting from the MV Galaxy, anchored off the Essex coast, the English offshore station Radio London (Big L) was on the air from December 1964 to August 1967. The trendsetting music which made it a legend can now be heard again. As a permanent feature, OldiesProject plays every hour at least two songs from the station’s playlist, preceded by a classic Big L jingle”*.

Trade mark 2325301 – the Radio London logo - appeared alongside this entry, and lower on the same page was a link to RLL’s website. The Oldies Project’s website also included a disclaimer page stating as follows:

*“OldiesProject is an independent, privately run, non-commercial audio stream which is no way affiliated with any radio station (past or present) or other entity operating under (or otherwise using) the name ‘Radio London’, ‘Big L’, or any other kind of variation thereof. The Radio London registered logo and the ‘Fab Forty’ information are used with kind permission of Radio London Ltd.*

*The vintage ‘Radio London’ jingles featured on the audio stream are used in accordance with the rules of fair use, for historical purposes only, to identify the music typically played by the former offshore radio station, Radio London (64-67)”*.

It appears that Mr Payne asked for the sentence covering RLL’s ‘permission’ to be extended to cover *“other trade marks”*<sup>12</sup>, but there is no evidence that it was. Nor is there any evidence that RLL received any consideration for granting the Oldies Project a ‘licence’ to use its trade marks.

32. Mr Payne says that he arranged for several of the original Radio London DJs to *“record station identifications and phrases”* which were written by his wife Mary. He says that these were used in all subsequent broadcasts by the Oldies Project of the ‘Fab Forty’ between 2004 and 2014. The Fab Forty broadcasts lasted between 2 and 3 hours depending on the number of ‘climbers’ or new entries in the weekly playlist.

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<sup>11</sup> See CP10. Mr Payne says that the licence agreement is also included in this exhibit, but I could not find anything of that description.

<sup>12</sup> See page 5 of CP10

An example of such a broadcast is in evidence<sup>13</sup>. It shows that when the Fab Forty was broadcast, listeners were told that the Fab Forty charts were available on RLL's website. Further, the introduction to the Fab Forty broadcast mentioned that it was "*brought to you in association with radiolondon.co.uk*". According to Mr Payne, Oldies Project also played the Radio London jingle twice an hour every day in order "*to denote that the next record to be played is in the Big L Fab Forty*".

33. I find that the use of RADIO LONDON and the Radio London logo by the Oldies Project during, and in connection with, its internet radio broadcasts was referential use of the marks in relation to the original 1960s Radio London offshore radio station and the music played on that station. The Oldies Project's acknowledgement on its website that the Radio London logo was used with RLL's permission cannot change the nature of its use of the mark (or of the written words RADIO LONDON). The same applies to the use of RADIO LONDON in the spoken words "*brought to you in association with radiolondon.co.uk*" during the Oldies Project's broadcast of the Fab Forty. In context, this was only an acknowledgement that the historical listing of the original Radio London chart from the corresponding week 40 years before had been supplied by RLL. No one listening to these broadcasts would have understood the words 'Radio London' to have been used to indicate that RLL was responsible for the quality of the Oldies Project's broadcasts of music from the original Radio London's playlists.

34. In any event, there is no evidence about the number of listeners to the Oldies Project. The entries from the 'Guest Book' in evidence show that it had at least 18 listeners based in the UK and others further afield. Admittedly, the number of UK listeners is likely to be higher than the 18 who made entries in the 'Guest Book'. Nevertheless, I find that the number of UK listeners was likely to have been tiny in relation to the market for music radio broadcasts.

### **The BBC's business**

35. The BBC's operation is very well known and there is no need to say much about it here. It is sufficient to mention the following points from Mr Robey's evidence.

- The BBC's local London radio station was known as BBC RADIO LONDON between 1970 and 1989 during which time it had over 1m listeners.
- It subsequently went through several name changes before becoming BBC London 94.9.
- 94.9 is a reference to the FM radio frequency on which the station is broadcast.

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<sup>13</sup> See CP10

- As over 50% of the listeners now use digital radios, the reference to the FM frequency is outdated and the BBC wishes to re-name its station BBC RADIO LONDON.
- Many callers to the station call it BBC LONDON or BBC RADIO LONDON.
- Historically, BBC London has been the only radio station with London in its name (apart from the original offshore Radio London). However, “recently”<sup>14</sup> Mr Robey had become aware of two other stations using RADIO and LONDON in their titles, i.e. FRENCH RADIO LONDON and POLISH RADIO LONDON.
- The BBC has 40 local radio stations and the general rule is that they are called BBC RADIO [place name]. However, there are some exceptions where the usual format would make the title too long or there are third party rights which prevent use of a name based on the usual formulation.
- The BBC sells books and CDs relating to its radio programmes and stations.

### **Existing confusion between the BBC and RLL**

36. Mr Payne claims that there has been confusion between RLL and the BBC. He says that in 2009 RLL set up a ‘Google Alert’ so that it received alerts about new web pages containing the words Radio London. In 2011, RLL became aware of three uses by the BBC of the phrase Radio London. One such use concerned an internal job application description which erroneously described the BBC radio station as ‘Radio London 94.9’. A second use concerned a statement on the website of BBC Sport that a rugby match had commentary by BBC RADIO LONDON. The third use was the name displayed on digital radio receivers when the signal for BBC London 94.9 was received. It was displayed as BBC RADIO LONDON. The BBC accepted that the first two instances were errors and corrected the station name displayed on digital radios to BBC London.

37. According to Mr Payne, RLL has constantly experienced confusion between its name and the radio station BBC London 94.9. So much so that RLL’s website includes a disclaimer stating that there is no connection between it and the BBC.

38. Mr Payne’s evidence includes what he describes as a “*small representative sample*” of emails received from listeners to BBC London 94.9 who mistakenly believed that they were contacting the BBC by emailing RLL via its website.<sup>15</sup> RLL receives weekly and monthly reports showing what those using the internal search facility on its website were searching for. Mr Payne provides some examples of

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<sup>14</sup> This was stated in July 2014

<sup>15</sup> See CP19



these reports<sup>16</sup> from which he says that it is clear that many of the searchers had actually been looking for BBC London 94.9. Mr Payne has broken down these results into those searching for information about offshore radio, music or DJs, BBC London and 'other'. In the most recent report, dated 1 March 2013, Mr Payne classifies 14 out of the 50 searchers as looking for information about offshore radio, 32 as looking for BBC London, and 2 as "*debateable*".<sup>17</sup>

39. Similarly, Mr Payne says that between 2009 and February 2014, RLL became aware of over 40 instances of newspapers, news agencies, websites and journalists incorrectly calling the BBC local radio station BBC RADIO LONDON, or simply RADIO LONDON.

40. Two things are clear from this evidence. Firstly, that a section of the public and the media think that BBC RADIO LONDON is (still) the name of the BBC's local radio station for London. Secondly, that because of this a significant number of enquires meant for the BBC are mis-directed to RLL.

### **The hearing**

41. A hearing was held on 12 February 2015 at which RLL was represented by Ms Denise Mcfarland of Counsel, instructed by Stevens, Hewlett & Perkins, and the BBC was represented by Mr Paul Walsh of Bristows, Solicitors.

### **DECISION**

#### **The BBC's applications to invalidate RLL's 'RADIO LONDON' word marks**

42. I will start by examining the invalidation applications against RLL's registration of the words RADIO LONDON. The registrations cover the following goods and services.

2314031B

Class 9

Computers, computer hardware and software; cards, discs and tapes bearing sound, data and images; parts and fittings for the aforesaid.

Class 16

Writing and drawing instruments; albums, photographs; pens and pencils; manuals, musical notes and scores.

Class 18

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<sup>16</sup> See CP20

<sup>17</sup> I realise that this adds up to 48 rather than 50.

Bags, briefcases, folders, wallets and purses.

**Class 25**

T-shirts, jeans, jumpers, sweatshirts and trousers; jackets, coats, caps and hats; socks and other footwear.

**Class 37**

Media restoration; installation and maintenance of broadcasting apparatus and equipment; installation, maintenance and repair of computer hardware.

**Class 38**

Broadcasting services; transmission of programmes by radio, satellite and cables; telecommunications services; conferencing services, media restoration; provision of real time communications services; all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire.

**Class 41**

Radio entertainment services; production and presentation of radio programmes; organisation of competitions; education and instruction by radio broadcasting; organisation and promotion of entertainment events, quizzes, games and competitions; chats and discussions, via the Internet or between computers; recording, production and mastering of sound and/or video images; archiving services; all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire.

**Class 42**

Design and development of computer hardware and software; computer hardware and software consultancy services; designing, compiling and arranging the setting up of web sites; creating, maintaining and hosting web sites.

**2353973**

**Class 38**

Broadcasting services; transmission of programmes by radio, satellite and cables; telecommunications services; telecommunications services in relation to chats and discussions, via the Internet or between computers; provision of real time telecommunications services.

**Class 41**

Education and entertainment conferencing; recording, production and mastering of sound and/or video images; radio and television entertainment services; production and presentation of radio and television programmes; organisation of competitions; education and instruction by radio and television broadcasting; organisation and promotion of entertainment events, quizzes, games and competitions.

43. It is convenient to examine first the grounds for invalidation in relation to 2353973, which mostly covers radio broadcast services without the complication of the restriction “*all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire*” in the corresponding classes of registration 2314031B.

44. Section 47(1) and section 3(1) of the Act are as follows:

“47 (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

45. The case law under s.3(1)(c) was summarised as follows by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*.<sup>18</sup>

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive

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<sup>18</sup> [2012] EWHC 3074 (Ch)

89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of

any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at

[32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

47. The BBC submits that both RADIO and LONDON are plainly descriptive of radio entertainment and/or broadcast services, and LONDON merely designates the geographical scope of the broadcast or the focus of the radio programme. There is no relevant distinction between ‘London Radio’ and ‘Radio London’. Therefore the mark is *prima facie* descriptive of one or more characteristics of the services.

48. RLL accepts that LONDON RADIO is descriptive. It submits that the *prima facie* distinctiveness of the trade mark resides in the reversal of the words LONDON and RADIO, which is syntactically unusual. It points out that this matter was specifically considered before the registrar accepted the trade mark for registration. Furthermore, RLL says, in effect, that it is a bit rich for the BBC to claim that such marks are non-distinctive for the services at issue when it has registered numerous similar marks of its own for the same services.

49. The mere fact that the registrar considered the arguments now raised by the opponent *ex parte*, prior to the registration of the mark, and decided that the mark was registrable, is not a factor to which I can, or should, attach any weight. This is because in *inter partes* proceedings the registrar must act as an independent tribunal and judge the matter purely on the basis of the arguments and evidence presented in those proceedings. However, s.72 of the Act states that registered trade marks should be treated as *prima facie* valid. This means that the onus is on the BBC to persuade me that RLL’s RADIO LONDON marks are not valid.

50. The BBC’s registration of numerous similar marks for the same services does not prevent the BBC from arguing that RLL’s marks are *prima facie* invalid. The key issue under this heading is whether RLL is correct in submitting that RADIO LONDON is syntactically unusual and easily distinguishable from the descriptive term ‘London radio’.

51. The CJEU first considered the law in this area in the context of the identical provisions of the Community Trade Mark Regulation governing the registration of Community trade marks, in *Procter & Gamble Company v OHIM (Baby-Dry)*<sup>19</sup>. The key passage from the judgment is re-produced below.

“39 The signs and indications referred to in Article 7(1)(c) of Regulation No. 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive

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<sup>19</sup> Case C-383/99P

signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

40 As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

52. In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*<sup>20</sup> (Postkantoor) the CJEU considered a similar question as to whether a new word made up of elements each of which is descriptive of a characteristic of the goods/services is to be regarded as distinctive or non-distinctive. The court’s judgment stated that:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark”.

53. By comparing paragraph 40 of the judgment in *Baby-Dry* with paragraph 99 of the court’s later judgment in *Postkantoor*, it can be seen that the court adjusted the required difference between a descriptive term and a distinctive trade mark composed of individually descriptive elements, from “*any perceptible difference*” between the two signs, to a trade mark which creates “*an impression which is sufficiently far removed from that produced by the simple combination of those [descriptive] elements*”. The court has repeated that formulation of words in subsequent cases<sup>21</sup> and it must now be taken as settled law. Therefore the relevant questions are:

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<sup>20</sup> Case C-363/99

<sup>21</sup> See, for example, *Campina Melkunie*, Case 265/00P

1) Is RADIO LONDON a syntactically unusual way of describing a radio broadcast service focussed on London?

2) If it is, is the difference between RADIO LONDON and LONDON RADIO enough for the former to create an impression on relevant consumers of the services which is sufficiently far removed from that produced by the descriptive term LONDON RADIO so that RADIO LONDON is seen by them as distinctive and not descriptive.

54. In making the second assessment it is not fatal to RLL's case that RADIO LONDON would be seen as allusive, or even highly allusive, of characteristics of the services.

55. I accept RLL's pleading that an adjective normally precedes a noun. Mr Robey's evidence is that two radio stations have recently started using the names POLISH RADIO LONDON and FRENCH RADIO LONDON. However, these signs are slightly different to RADIO LONDON because the words POLISH and FRENCH are used to qualify the word RADIO, thus creating the descriptive indications POLISH RADIO and FRENCH RADIO. LONDON is then used in order to designate the location of the station. Like the other examples of use of 'RADIO plus place name' identified in the evidence, they appear to be used as the names of radio stations rather than as just descriptions of the services (although I accept that the use for the former purpose does not exclude the possibility that they also serve the latter purpose).

56. I regard this as a borderline case but, on balance, I find that the BBC has not shown that RADIO LONDON is a normal way of designating radio broadcast services in, or about, London. Furthermore, I think the syntactical difference between RADIO LONDON and LONDON RADIO is enough for the former to create a sufficiently different impression on relevant consumers (compared to the latter description) for it to be seen as a trade mark rather than a description of radio broadcast and entertainment services. I therefore reject the ground of opposition based on s.47(1) and s.3(1)(c) in relation to these services.

57. The relevant question under s.3(1)(b) is whether RADIO LONDON is capable of distinguishing the radio broadcasting and entertainment services for which it is registered.<sup>22</sup> The mere fact that RADIO LONDON is made up of words which individually describe characteristics of the services does not necessarily mean that it is incapable of distinguishing those services. In *SAT.1 SatellitenFernsehen GmbH v OHIM*<sup>23</sup> the CJEU set aside a judgment of the Court of First Instance upholding OHIM's decision to refuse 'SAT.2' as a Community trade mark. The court stated that:

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<sup>22</sup> *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* Case C-265/09 P

<sup>23</sup> Case C-329/02



“40 Although the way in which the term ‘SAT.2’ is made up is not unusual, in particular as regards the perception which the average consumer may have of services falling within the communications industry, and the juxtaposition of a verbal element such as ‘SAT’ with a digit such as ‘2’, separated by a ‘.’ does not reflect a particularly high degree of inventiveness, those facts are not sufficient to establish that such a word is devoid of distinctive character within the meaning of Article 7(1)(b) of the regulation.

41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.

42 Where a trade mark which does not fall foul of the ground of refusal laid down in Article 7(1)(c) of the regulation is none the less devoid of distinctive character within the meaning of Article 7(1)(b) thereof, the Office must also set out the reasons why it considers that that trade mark is devoid of distinctive character.

43 However, in this case, the Office merely stated in the contested decision that the elements ‘SAT’ and ‘2’ were descriptive and in current usage in the sector of media-related services, without stating in what way the term ‘SAT.2’, taken as a whole, was not capable of distinguishing the services of the appellant from those of other undertakings.

44 The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.”

58. The last point indicates that the frequent use of a particular kind of sign as a trade mark for the goods or services at issue is not sufficient to justify a finding that a mark of that kind is devoid of any distinctive character. If anything, the fact that the relevant public have been shown to recognise signs of a particular kind as being trade marks tends to show that they are capable of distinguishing. Therefore the fact that many local BBC radio stations trade under titles made up of ‘BBC RADIO plus place name’ does not necessarily support the conclusion that RADIO LONDON is *prima facie* incapable of distinguishing.

59. I regard this as a borderline case but, on balance, I find that the BBC has not shown that RADIO LONDON is incapable of distinguishing the services under examination and is therefore devoid of any distinctive character. Consequently, I also reject the ground for invalidation based on s.47(1) and s.3(1)(b) of the Act.

60. If the mark is not descriptive of radio broadcast and entertainment services, it follows that it is not descriptive, by extension, for the other goods and services for which the mark is registered. No other reason has been advanced as to why the mark is descriptive or non-distinctive for any of the other goods and services.

Therefore, I reject the ground for invalidation based on s.47(1) and s.3(1)(b) and (c) of the Act in relation to all the goods and services for which RADIO LONDON is registered under 2353973. It follows that I also reject the application for invalidation of trade mark 2314031B without it being necessary to explain why, if I had come to the opposite view, the geographical references in the list of services in classes 38 and 41 would not have made any difference to the outcome of this application.

61. RLL has not pleaded a case of acquired distinctiveness. There is therefore no need for me consider whether, if I am wrong about the *prima facie* registrability of the mark, it had nevertheless acquired a distinctive character through use prior to the date of the application for invalidation, and consequently whether the registration might be saved by the proviso to s.47(1). It should, however, be clear from my findings below why there would have been very little prospect of such a case succeeding, even if it had been pleaded.

### **The BBC's revocation applications against RLL's marks**

62. Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c).....  
.....

(d).....

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period

but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

63. Section 100 is also relevant, which reads:

“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.”

64. In *Stichting BDO v BDO Unibank, Inc.*<sup>24</sup>, Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

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<sup>24</sup> [2013] F.S.R. 35 (HC)

(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]; *Sunrider* [70]; *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]; *Sunrider*, [70]-[71].

(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]; *Sunrider*, [72]".

65. Although minimal use may qualify as genuine use, the CJEU stated in *Reber Holding GmbH & Co. KG v OHIM*<sup>25</sup> that “not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

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<sup>25</sup> Case C-141/13 P, at paragraph 32 of the judgment.

66. RLL seeks to defend its trade marks for the following goods and services.

2314031B – RADIO LONDON

Class 9	Computers, computer hardware and software; cards, discs and tapes bearing sound, data and images; parts and fittings for the aforesaid.
Class 16	Photographs; manuals.
Class 25	T-shirts, jeans, jumpers, sweatshirts and trousers; jackets, coats, caps and hats; socks and other footwear.
Class 37	Media restoration; installation and maintenance of broadcasting apparatus and equipment; installation, maintenance and repair of computer hardware.
Class 38	Broadcasting services; transmission of programmes by radio, satellite and cables; telecommunications services; media restoration; provision of real time communications services; all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire.
Class 41	Radio entertainment services; production and presentation of radio programmes; organisation and promotion of entertainment events; recording, production and mastering of sound and/or video images; archiving services; all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire.
Class 42	Design and development of computer hardware and software; computer hardware and software consultancy services; designing, compiling and arranging the setting up of web sites; creating, maintaining and hosting web sites.

2353973 - RADIO LONDON & 2325301 - Radio London logo

Class 38	Broadcasting services; transmission of programmes by radio, satellite and cables; telecommunications services; provision of real time telecommunications services.
Class 41	Recording, production and mastering of sound and/or video images; radio and television entertainment services; production and presentation of radio and television programmes; organisation and promotion of entertainment events.

2030314 - RLL's device mark

Class 9	Broadcasting apparatus and equipment; electrical and electronic communications apparatus; apparatus and instruments for transmitting, receiving, recording, manipulating and reproducing data, sound and video images; computers, computer hardware and software; cards, discs and tapes bearing sound, data and images; multimedia apparatus and instruments; parts and fittings for the aforesaid.
Class 16	Guides, posters and photographs.
Class 25	T-shirts, jeans, jumpers, sweatshirts and trousers; jackets, coats, caps and hats; socks and other footwear.
Class 37	Restoration of sound or images; installation and maintenance of broadcasting apparatus and equipment; installation, maintenance and repair of computer hardware
Class 38	Broadcasting services; transmission of programmes by radio, satellite and cables; telecommunications services; provision of real time

	communications services
Class 41	Recording, production and mastering of sound and/or video images; radio entertainment services; production and presentation of radio programmes; organisation and promotion of entertainment events.
Class 42	Design and development of computer hardware and software; computer hardware and software consultancy services; designing, compiling and arranging the setting up of web sites; creating, maintaining and hosting web sites; installation, maintenance and repair of computer software.

67. I find that RLL used the RADIO LONDON mark, and the RLL device mark, in the period 7 February 2009 to 6 February 2014, in relation to the following services.

Class 37	Media restoration; restoration of sound or images; installation and maintenance of broadcasting apparatus and equipment; installation, maintenance and repair of computer hardware for use in relation to broadcasting.
Class 38	Media restoration.
Class 41	Mastering of sound and/or video images.
Class 42	Computer hardware and software consultancy services, all in relation to broadcasting; designing, compiling and arranging the setting up of web sites; creating web sites.

68. Although the scale of the use of the marks in the relevant period is small in comparison to the likely size of the market for such services, I find that it is sufficient to show real commercial exploitation of the RADIO LONDON and RLL device marks in order to maintain a share of the market for such services. I therefore find that there was genuine use of the marks in relation to the services in question during the relevant 5 year period.

69. Operating a website does not, of itself, amount to offering services to the public. Further, in the case of a website providing a “*nostalgic platform*” for fans of offshore radio stations and the music they played, I recognise that the original Radio London is, effectively, the subject of the nostalgia. I find that RLL used RADIO LONDON (on the website, invoices and as part of the term [www.londonradion.co.uk](http://www.londonradion.co.uk)) and the RLL device mark (on the website and on the goods themselves) in the period 7 February 2009 to 6 February 2014 in relation to T-shirts and sweatshirts. Further, the marks were not used merely as a nostalgic reference to the 1960s radio station, but also to identify the commercial origin of the goods.

70. In this connection, I note that in *Colloseum Holdings AG v Levi Strauss & Co.*<sup>26</sup>, the CJEU held that the use of a trade mark with, or as part of, another mark, counts as genuine use of the mark provided it “*continues to be perceived as indicative of the origin of the product at issue*”. I find that the words ‘radiolondon’ as part of the name of RLL’s website on its T-shirts and sweatshirts would continue to be perceived as

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<sup>26</sup> Case C-12/12

an indication of the trade origin of the products. Therefore in addition to the use of the marks in the form in which they are registered, on RLL's website and on invoices for the goods, s.46(2) of the Act means that RLL can also rely on the use of the words RADIO LONDON as affixed to T-shirts and sweatshirts, including those which were exported from the UK. Therefore the evidence of sales of T-shirts to the USA remains relevant for the purpose of establishing genuine use of the marks in the UK.

71. Even taking account of exports of T-shirts bearing the marks, the scale of the use of the marks in the relevant period is tiny in comparison to the market for T-shirts and sweatshirts. However, I see nothing about the use which calls into question whether it was a genuine attempt to conduct a trade in T-shirts and sweatshirts under the marks amongst followers of 1960s music. Therefore, although this is a very borderline case, I find that there was real commercial exploitation of the RADIO LONDON and RLL device marks by RLL in order to create and maintain a market for T-shirts and sweatshirts. Consequently, I find that RLL made genuine use of the marks during the relevant 5 year period .

72. Mr Payne refers in his evidence to *"liaising with suppliers and manufacturers"* and classifies the services provided to 7 Waves Community Radio in 2011 and 2014 as including goods in class 9<sup>27</sup>, but this is not evident from the only relevant invoice in evidence from 2011<sup>28</sup> and Mr Payne's narrative evidence throws no further light on the matter. Mr Payne does refer to the *"supply"* of a photograph in 2012, but it is not clear how RLL's marks were used (or if they were) in relation to this transaction, or even if the photograph was sold (or to whom). This evidence therefore falls well short of establishing any use of RLL's marks in relation to photographs. I find that RLL has not shown any use of any of its marks in the relevant 5 year period in relation to goods in classes 9, 16 or 25, other than T-shirts and sweatshirts.

73. This brings me to the key issue of whether RLL made genuine use of any of its marks in relation to radio broadcasting and radio entertainment services. I have found that RLL was providing test broadcasts under the name RADIO LONDON from January 2012 onwards to a small group of friends. With some hesitation, I accept that this was external use of the mark, but I do not accept that it was use of the mark in relation to a real commercial service, or for the purpose of advertising a forthcoming service to the relevant public. Rather, the purpose of the use was plainly to permit Mr and Mrs Payne's acquaintances to help RLL develop the test offering into something that might be suitable to be broadcast to the public at a later date. I accept that it is not necessary for services to be provided for remuneration in order to qualify as commercial services. However, in the absence of any charge for the services, the commercial basis of the trade must be established through other facts. There is no alternative factual basis in this case for concluding that the use in

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<sup>27</sup> In a table provided as CP4

<sup>28</sup> See CP6, page 7

question was commercial use. Allowing 6-9 friends to listen to some test broadcasts cannot be classified as “*real commercial exploitation*” of the mark. It did not create or maintain a market under the mark amongst the relevant public for radio broadcasting or entertainment services. And even if broadcasting to 6-9 friends count as creating a market of some kind, it is clear on the basis of the *Reber* case that it would not be sufficient by itself to constitute genuine use of the mark during the relevant 5 year period ending on 6 February 2014.

74. At most, the test broadcasts amounted to preparations to commence use of the mark in the future. In different circumstances this might be relevant for the purposes of s.46(3). However, in this case there is no evidence that the test broadcasts led to subsequent genuine use of the mark prior to the date of the applications for revocation, or prior to the slightly later date of the publication of the BBC’s mark, or indeed prior to the date of the hearing in February 2015, more than 3 years after the test broadcasts commenced. For these reasons I find that RLL has not made genuine use of RADIO LONDON (or any of the other marks at issue) in relation to radio broadcasting or radio entertainment services, or any of the other services for which the marks are registered in class 38 and 41, other than the use of RADIO LONDON and the RLL device mark in relation to media restoration and mastering of sound and/or video images (as described above).

75. Earlier I found that the use of RADIO LONDON and the Radio London logo by the Oldies Project during, and in connection with, its internet radio broadcasts between 2004 and 2014 was referential use of the marks in relation to the original 1960s Radio London offshore radio station and the music played on that station. There is no suggestion that RLL purchased the goodwill created by the original Radio London station. RLL’s registration of the marks used by that radio station does not mean that it thereby appropriated the goodwill and reputation of the original radio station. It follows that references to the original radio station cannot be taken as a reference to RLL. I find that the use of the marks shown by the Oldies Project is not consistent with the essential function of a trade mark, which according to the CJEU<sup>29</sup> is:

“... to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality.”

No one looking at, or hearing, the marks at issue in 2004 - 2014 would think that they were being used to distinguish the trade origin of the service provided by the Oldies Project, or that RLL was responsible for the quality of those services. Consequently,

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<sup>29</sup> See Case C-299/99 , *Philips v Remington*, [2003] RPC 2 (at paragraph 37 on page 23)



even if that service qualifies as a real commercial service to radio listeners in the UK, I find that there has been no genuine use of any of RLL's marks in relation to any of the services for which the marks are registered in class 38 and 41, other than the use of RADIO LONDON and the RLL device mark in relation to media restoration and mastering of sound and/or video images (as described above).

76. The consequence of the above findings is that RLL's 2353973 mark - RADIO LONDON - and 2325301 – the Radio London logo – will be revoked completely for non-use. Trade marks 2314031B – RADIO LONDON - and 2314030 - RLL's device mark - will be revoked for non-use, except in relation to the following goods/services.

Trade mark 2314031B

Class 25	T-shirts and sweatshirts
Class 37	Media restoration; installation and maintenance of broadcasting apparatus and equipment; installation, maintenance and repair of computer hardware for use in relation to broadcasting.
Class 38	Media restoration, all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire.
Class 41	Mastering of sound and/or video images, all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire.
Class 42	Computer hardware and software consultancy services, all in relation to broadcasting; designing, compiling and arranging the setting up of web sites; creating web sites.

Trade mark 2314030

Class 25	T-shirts and sweatshirts
Class 37	Restoration of sound or images; installation and maintenance of broadcasting apparatus and equipment; installation, maintenance and repair of computer hardware for use in relation to broadcasting.
Class 41	Mastering of sound and/or video images.
Class 42	Computer hardware and software consultancy services, all in relation to broadcasting; designing, compiling and arranging the setting up of web sites; creating web sites.

77. The marks must be revoked for non-use under s.46(1)(b) with effect from 7 February 2014. However, the BBC asks for the revocations to take effect from earlier dates as a consequence of its applications for revocation under s.46(1)(a). Although there is some suggestion in the evidence that RLL may in the past have offered a product called an alignment CD and a transmitter and aerial package, and provided archiving and off-air logging services, Mr Payne does not state that such goods/services were provided under RLL's marks (as opposed to, for example, RLL supplying equipment bearing third party marks) and there is insufficient particularisation of such use of the marks in the exhibits to Mr Payne's evidence for

me to conclude that RLL made genuine use of any of its marks in relation to such goods/services.

78. On the other hand, I have found that there was use of the RLL device mark between 2006 and November 2008, with RLL's consent, in relation to music CDs.

79. I therefore direct that revocation of RLL's marks, as described above, should take effect from the following dates:

Trade mark 2353973 mark - RADIO LONDON – from 5 November 2010

Trade mark 2325301 – Radio London logo – from 20 November 2009

Trade mark 2314031B – RADIO LONDON – from 29 April 2011

Trade mark 2314030 – RLL's device mark – from 26 July 2008, except in relation to 'discs bearing sound' in class 9, for which the mark is revoked with effect from 7 February 2014.

### **RLL's opposition to the BBC's application to register BBC RADIO LONDON**

80. I will start by examining the ground of opposition under s.5(2)(b) of the Act, which is as follows.

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

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

81. It follows from my decisions to revoke trade marks 2353973 and 2325301, and partially revoke trade mark 2314031B, from dates prior to the filing dates of the BBC's trade mark application, that RLL can no longer rely on those marks for the purposes of this opposition, except for trade mark 2314031B and to the extent that it survived the BBC's application for revocation.

### **The case law**

82. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

### **The principles**

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

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

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

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

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

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

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

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

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

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

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

### Similarity of goods/services

83. The respective goods and services are set out below:

	BBC RADIO LONDON	RADIO LONDON
Class 9	Data recordings including audio, video, still and moving images and text; computer software, including software for use in downloading, storing, reproducing and organising audio, video, still and moving images and data; downloadable electronic publications and information; downloadable ring tones and graphics for mobile phones; downloadable graphics for computers; computer, electronic and video games programmes and equipment; mouse mats; television and radio signal transmitters and receivers; and parts for all the aforesaid goods.	None
Class 16	Printed publications; magazines; books; catalogues; programmes.	None
Class 25	None	T-shirts and sweatshirts
Class 37	None	Media restoration; installation and maintenance of broadcasting apparatus and equipment; installation, maintenance and repair of computer hardware for use in relation to broadcasting.
Class 38	Broadcasting; communications and telecommunications; transmission, broadcast, delivery, reception and other dissemination of audio, video, still and moving images, information, text and data whether in real or delayed time, multimedia content, webpages; electronic mail services; interactive broadcasting services; television screen based information, broadcasting and retrieval services; news information and news agency services; rental of radio and television broadcasting facilities; the provision of discussion forums;	Media restoration, all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire.

	operating web logs [blogs]; operating message boards; webcasting; provision of information and advisory services relating to any of the aforesaid services.	
Class 41	Provision of entertainment, education, recreation, instruction, tuition and training; production, presentation and distribution of audio, video, still and moving images and data; publishing services (including electronic publishing services); non-downloadable electronic publications; organisation, production and presentation of shows, competitions, games, concerts, exhibitions and events; provision of information and advisory services relating to any of the aforesaid services, including on-line from a database or the Internet.	Mastering of sound and/or video images, all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire.
Class 42	None	Computer hardware and software consultancy services, all in relation to broadcasting; designing, compiling and arranging the setting up of web sites; creating web sites.

84. None of the goods/services covered by the BBC's application are identical to any of the remaining goods/services covered by RLL's mark.

85. In *Canon*<sup>30</sup>, the CJEU 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".

86. In *Boston Scientific Ltd v OHIM*<sup>31</sup>, 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".

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<sup>30</sup> Case C-39/97

<sup>31</sup> Case T-325/06

87. The BBC's application covers '*Data recordings including audio, video, still and moving images and text*' in class 9, i.e. media. RLL's mark covers '*media restoration services*'. I note that these services have been classified in classes 37 and 38. However, they cover the same services, i.e. restoring media to a workable condition. This may involve transferring works from one media format to another. I find that the respective goods and services are different in nature: one is a recorded product, the other is a restoration service. The purpose of the goods and services is also different. Recorded data media are usually used for entertainment or educational purposes. By contrast a restoration service is a type of repair service the purpose of which is to restore the goods to good working order (albeit so that they can then provide entertainment or education). The goods and services are not in competition and the methods of use are different. Further, although it might be said that media and media restoration services are complementary in the sense that the restoration service might be important for the use of the media, there is no evidence that the public expect an undertaking responsible for data recordings to also provide media restoration services, or vice versa. I therefore find that these goods/services are dissimilar. If I am wrong about that, the level of similarity between the goods/services is low.

88. The BBC's application also covers '*computer software, including software for use in downloading, storing, reproducing and organising audio, video, still and moving images and data*' in class 9, whereas RLL's mark covers '*Computer.....software consultancy services, all in relation to broadcasting; designing, compiling and arranging the setting up of web sites*' in class 42. Again, the nature of the respective goods and services is different. The method of use of the respective goods and services is also plainly different. However, the purposes may be similar to the extent that both the BBC's '*software*' and RLL's software consultancy are intended to provide technical solutions for broadcasters. Further, the BBC's '*software for use in downloading, storing, reproducing and organising audio, video, still and moving images and data*' may serve a similar purpose to RLL's services for '*designing, compiling and arranging the setting up of web sites*' or be complementary to such services. Overall, I find that there is a medium degree of similarity between these goods and services.

89. The BBC's application also covers '*television and radio signal transmitters and receivers*' in class 9. RLL's mark covers '*installation and maintenance of broadcasting apparatus and equipment*'. Again, the nature of the respective goods and services is different. The method of use of the respective goods and services is also plainly different, as is the purpose of the goods/services. However, these goods and services appear to be complementary in the sense that the service is important to the operation of the goods. Further, they appear to be, at least in part, aimed at the same specialist section of the public, i.e. those involved in broadcasting. Further still, although there is no evidence on the point (beyond the vague reference in RLL's documentary evidence about once having its own aerial and transmitter package), I

consider that the relevant specialist public might believe that the respective goods and services are offered by the same or economically connected undertakings. Overall, I consider there to be a medium level of similarity between the respective goods and services.

90. I see no other potential similarities between any of the BBC's other goods in class 9 and any of the goods or services for which RLL's mark remains registered.

91. I see no potential similarities between any of the BBC's goods in class 16 and any of the goods or services for which RLL's mark remains registered.

92. The BBC's application covers '*rental of radio and television broadcasting facilities*' in class 38. RLL's mark covers '*installation and maintenance of broadcasting apparatus and equipment*' in class 37. The nature of the respective goods and services is different. The method of use of the respective services is also different. However, there may be some competition between them in that a broadcaster may decide to install broadcasting equipment into an existing space or rent broadcasting facilities. Again, these services may be aimed at the same type of specialist consumer. They may also be complementary in the sense that one might rent broadcasting facilities, but also want additional broadcasting equipment installed. There is no evidence on the point, but it seems likely that the relevant public might expect the same undertaking to offer both types of services. Overall, I find that there is a medium degree of similarity between these services.

93. The BBC's other services in class 38 appear to be services offered to the general public. I see no similarities between these services and any of the goods/services for which RLL's mark remains registered.

94. The BBC's application covers '*production, presentation and distribution of audio, video, still and moving images and data*' in class 41 whereas RLL's mark remains registered in that class for '*mastering of sound and/or video images, all provided from locations outside the Greater London area and the counties of Surrey, Essex and Hertfordshire*'. The geographical reference in the list of RLL's services appears to me to be irrelevant, at least for present purposes. This is because the location from which the services are provided has no bearing on the likelihood of confusion, and the BBC's services could be provided from any location in the UK. '*Mastering*' appears to be a service intended to improve the quality of the product experienced by the ultimate customer. The services therefore appear to be complementary to '*production of audio, video, still and moving images and data*' (but not '*presentation and distribution*' of the same). The respective services may be offered on a business-to-business basis to those in the creative industries. I find that the relevant public may consider that one undertaking provides both services. They are therefore complementary in the sense described in the case law. Overall, I find that there is a medium degree of similarity between these services.

95. The BBC's other services in class 41 appear to be services offered to the general public. I see no similarities between these services and any of the goods/services for which RLL's mark remains registered.

### **The relevant public**

96. 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>32</sup>. The relevant public for most of the BBC's goods and services is the general public. The general public will pay an average level of attention when selecting the goods and services concerned. However, the average consumer for the goods and services I have found to be similar to a medium degree to the services for which RLL's mark remains registered, may be a person or business in the market for technical goods or services. Because of the nature of these goods/services, the relevant average consumer is likely to pay an above average level of attention when selecting them.

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

97. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

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

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

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<sup>32</sup> *Lloyd Schuhfabrik Meyer, Case C-342/97*



98. The earlier mark as a whole is not descriptive of the services for which it remains registered. In my view, it has an average degree of distinctive character for those services, including the services I have found to be similar to a medium degree to some of the goods and services covered by the BBC's application. RLL appears to have used the mark for quite some time in relation to broadcast engineering and consultancy services, but the services provided appear to have been provided on a very modest scale and the amount spent on promotion is a) not clear and b) likely to be very modest too. In these circumstances I find that RLL's use of the RADIO LONDON mark has not enhanced its inherent level of distinctiveness.

### **Comparison of the marks**

99. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>33</sup>, that:

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

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

101. The BBC naturally stresses the distinctiveness and distinguishing power of the letters 'BBC'. RLL stresses the fact that the BBC's mark includes the words RADIO LONDON (and in the same order) which make up its mark.

102. The words BBC RADIO LONDON do not form a unit having a different meaning as compared to its components taken separately (*Bimbo*, para. 25). The letters 'BBC' is plainly the BBC's 'house' mark and they appear at the beginning of the mark. There is no denying the distinguishing power of the letters BBC. However, the words RADIO LONDON make a more-than-negligible contribution to the overall impression created by the BBC's composite mark.

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<sup>33</sup> Case C-591/12P

103. The visual and aural similarities and differences between the 2 and 3 word marks are obvious and require no analysis here.

104. Conceptually, the words RADIO and LONDON convey the well known meanings of those words, which is the same in both marks.

105. Overall, I find that there is a medium level of similarity between the marks.

### **Likelihood of confusion**

106. RLL claims that there is already confusion between the parties. Earlier I found that a section of the public and the media think that BBC RADIO LONDON is (still) the name of the BBC's local London radio station and that because of this a significant number of enquires meant for the BBC are mis-directed to RLL. I don't accept that this shows that there is a likelihood of confusion if the BBC's mark is used in relation to the goods/services for which it seeks registration, and RLL's RADIO LONDON mark is used in relation to the services for which it remains registered.

107. However, taking into account the medium level of similarity between the marks, the medium level of similarity between some of the goods/services, the normal level of distinctiveness of the earlier mark in relation to the relevant services, and giving due weight to the above average level of attention that the relevant public are likely to exercise when selecting these goods/services, I find that there is a likelihood of confusion, including the likelihood of (mis) association, if the BBC's mark is used in relation to:

Computer software, including software for use in downloading, storing, reproducing and organising audio, video, still and moving images and data in class 9

Television and radio signal transmitters and receivers in class 9

Rental of radio and television broadcasting facilities in class 38

Production of audio, video, still and moving images and data in class 41.

108. I do not think it likely that there will be any direct confusion. However, despite the undoubted distinguishing power of the BBC house mark, I find that if the BBC's composite mark is used in relation to the goods and services listed in the preceding paragraph, there is a likelihood that the relevant average consumer will believe that the parties are economically connected, for example, in a joint venture.

109. Otherwise, I reject RLL's opposition to the BBC's application under s.5(2)(b) of the Act.

### **The section 5(3) ground of opposition**

110. Section 5(3) states:

“(3) A trade mark which-  
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), 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.”

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

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

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

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

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

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

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

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

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

112. I find that the low scale of use of RADIO LONDON in relation to the goods or services for which it remains registered, and the very limited evidence of promotion of that mark amongst the relevant public in relation to those goods and services, is insufficient to establish that the mark was known to a significant part of the relevant section of the public at the date of the BBC's application. This is consistent with Mr Payne's evidence about the categories of enquiries made using the search facility on RLL's website, very few of which appear to show people looking for technical services.

113. Further, even if I am wrong about the absence of a reputation through RLL's use of RADIO LONDON (and this could only be in relation to the technical services for which the mark remains registered) the relevant public for most of the BBC's goods and services is the general public, who are very unlikely to have come across RLL's mark in relation to broadcasting engineering and consultancy services. The

few goods and services covered by the BBC's application for which the relevant public may be the same as the users of RLL's technical services have been refused under s.5(2)(b). Consequently, use of the BBC's mark for the remaining goods and services covered by the application is unlikely to cause the relevant general public to make the required mental 'link' with RLL's mark. Therefore, even if RLL's RADIO LONDON mark scrapes over the initial hurdle of having the necessary reputation amongst the public in order to qualify for protection under s.5(3), RLL would still be in no better position under s.5(3) than it is under s.5(2)(b).

114. I therefore reject the ground of opposition under s.5(3) to the extent that it covers goods/services which are not already caught by the s.5(2)(b) ground.

### **The passing-off right ground of opposition**

115. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

116. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.”

117. RLL claims to own a protectable goodwill under the mark RADIO LONDON in relation to ‘pre-recorded media’, ‘clothing’, ‘media restoration services’, ‘installation and maintenance of broadcasting apparatus and equipment’, ‘broadcasting services’, ‘transmission of programmes by radio, satellite and cables’, ‘telecommunications services’, ‘provision of real time communications services’, ‘radio entertainment services’, ‘production and presentation of radio programmes’, ‘recording, production and mastering of sound and/or video images’ and ‘archiving services’.

118. There is no evidence of such goodwill in relation to ‘telecommunications services’.

119. There is no evidence that RLL had any goodwill as a trader in pre-recorded media or archiving services at the date of the BBC’s trade mark application (if it ever did).

120. As regards ‘broadcasting services’, ‘transmission of programmes by radio, satellite and cables’, ‘radio entertainment services’, and ‘production and presentation of radio programmes’, my findings of fact in relation to the revocation applications inevitably mean that I reject RLL’s claim to have acquired goodwill under the mark in relation to these services. The reality is that RLL has at no time been a broadcasting radio station and it therefore has no goodwill as such. The use of the RADIO LONDON name by the Oldies Project would have been understood by the listening public as referential use of that name in relation to the original Radio London radio station of the 1960s. Further, even if such use by the Oldies Project was capable of generating any commercial goodwill for RLL, it would have been trivial in scale.

121. RLL appears to believe that by virtue of registering the mark RADIO LONDON it somehow acquired the goodwill and reputation generated by the original offshore radio station. However, this is not so. The residual goodwill and reputation of the 1960s radio station (if it still exists) is a separate legal right. There is no evidence that RLL has acquired title to that right.

122. Ms McFarland reminded me that the law protects small businesses as well as large. In that connection she drew my attention to the judgment of HHJ Birss (as he then was) in *Fayus Inc. & Another v Flying Trade Group Plc*<sup>34</sup>. However, in that case the claimant could show sales of over £400k in the year preceding the legal claim. RLL has not shown that it received any income at all from the supposed use of the RADIO LONDON mark in relation to broadcasting and/or radio entertainment services. In *Hart v Relentless Records*<sup>35</sup>, Jacob J. (as he then was) stated that:

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<sup>34</sup> [2012] EXPCC 43

<sup>35</sup> [2003] FSR 36

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

123. If, contrary to my primary finding, RLL has any goodwill or reputation of its own in relation to ‘broadcasting services’, ‘transmission of programmes by radio, satellite and cables’, ‘radio entertainment services’, and ‘production and presentation of radio programmes’, then it is entirely trivial.

124. In my view, RLL’s evidence of public “confusion” in this area is more consistent with RLL having passed itself off as a BBC radio broadcasting service than the reverse. However, given my findings that RLL possesses no relevant goodwill, there is no need for me to formally examine whether the BBC’s has a concurrent goodwill under the mark RADIO LONDON as a result of its use of those words for 18/19 years. It follows that there is also no need for me to decide whether, as RLL contends, the multiple subsequent name changes of the BBC’s local London radio station amount to the BBC having abandoned any residual goodwill that may still exist under the name in question.

125. I have already considered whether the use of the BBC’s mark would cause confusion as a result of RLL’s earlier RADIO LONDON mark in relation to ‘clothing’, ‘media restoration services’, ‘installation and maintenance of broadcasting apparatus and equipment’ and ‘recording, production and mastering of sound and/or video images’. I acknowledge that there is a possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*<sup>36</sup>, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, applying

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<sup>36</sup> [2012] EWCA (Cave) 1501

the correct test, I find that RLL has no better case under the law of passing-off in relation to its trade in the above named goods/services than it has under s.5(2)(b) of the Trade Marks Act. This is because the BBC's use of the BBC RADIO LONDON in relation to any of the goods/services which have survived the ground of opposition based on s.5(2)(b) would not constitute a misrepresentation to a substantial number of the relevant public.

126. This leaves RLL's claim to own a protectable goodwill under the name RADIO LONDON in relation to 'provision of real time communications services'. I am not sure what this means. If it is intended to cover the operation of RLL's website, then as I have already pointed out, operating a website does not, of itself, generate any commercial goodwill. It is possible that the provision of historical or nostalgic information via a website constitutes a trade of sorts. However, as I noted earlier in this decision, the words RADIO LONDON are referential when used in relation to information about an historical radio station of that name. Further, the section of the public with an interest in historical offshore radio stations is unlikely to think that BBC RADIO LONDON has a relevant connection with any of them. Consequently, the use of that mark by the BBC would not constitute a misrepresentation to the public.

127. I conclude that the opposition under s.5(4)(a) adds nothing to RLL's case under s.5(2)(b).

### **Costs**

128. The consolidation of these cases has reduced the costs associated with filing and considering evidence, written communications, and the hearing.

129. The BBC's two applications for invalidation failed. However, two of the BBC's four applications for revocation, against trade marks 2353973 mark - RADIO LONDON - and 2325301 – the Radio London logo - succeeded in full. I find that the costs implications of these applications cancel each other out.

130. The BBC's other two applications for revocation, against trade marks 2314031B – RADIO LONDON - and 2314030 - RLL's device mark - succeeded in part, but partly failed. RLL initially defended these marks for all the goods/services for which they were registered. I find that the BBC was 75% successful in these applications.

131. RLL's opposition to the BBC's application was partly successful, but mostly failed. I find that the BBC was 85% successful in the opposition.

132. Consequently, the BBC has been more successful overall and is entitled to a contribution towards its costs. I order Radio London Limited to pay the BBC the sum of £2700.



133. This is made up of:

£300 for filing the applications to revoke trade marks 2314031B and 2314030 for non-use

£300 towards the cost of the official filing fees for Forms TM26(N)

£100 for considering RLL's defences

£1500 for considering RLL's evidence and filing evidence of its own

£500 for attending the hearing.

134. Radio London Limited must pay the British Broadcasting Corporation £2700 within 10 days of the end of the period allowed for appeal, or in the event of an appeal, within 10 days of the final conclusion of these proceedings.

**Dated this 25th day of March 2015**

**Allan James  
For the Registrar**