

O-392-18

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3159450  
BY VIVO INTERNATIONAL LIMITED  
FOR REGISTRATION OF THE TRADE MARK**

**vivo**

**AND OPPOSITION UNDER NO 407110  
BY TiVo BRANDS LLC**

## Background

1) These proceedings were decided, at first instance, in decision BL O-218-17. The decision was subsequently appealed to the Appointed Person who partially overturned the first instance decision (in her decision BL O-176-18) and remitted the case back to the Registry. The hearing officer at first instance categorised the background to the proceedings as follows and I adopt this:

“1. Application no 3159450 stands in the name of Vivo International Limited (“the applicant”) and seeks registration of the trade mark **vivo**. It has a filing date of 14 April 2016 and a priority date of 15 October 2015 based on a Namibian filing NA/T/2015/2253. Registration is sought in respect of the following services:

Class 41

Production and distribution of television shows and movies; production of television programs; provision of non-downloadable films and television programmes via video-on-demand services.

2. Following publication of the application in the *Trade Marks Journal* on 6 May 2016, notice of opposition was filed by TiVo Brands LLC (“the opponent”) based on grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following EU trade mark registrations (“EUTM”):

Mark	Dates	Specification
EUTM 1006014  TiVo	Filing date: 27 November 1998  Priority date: 29 May 1998 (from USA application 75/493408)  Date of entry in register: 1 February 2001	<b>Class 9</b> Computer hardware, software and peripherals for personalized, interactive television programming; televisions; television peripheral remote controls; communication devices; transmitters; receivers and controls, and software for use therewith.  <b>Class 16</b>

		<p>Manuals for use with computer hardware, software and peripherals for personalized, interactive television programming, televisions, television peripheral remote controls, communication devices, transmitters, receivers and controls and software for use therewith.</p> <p><b>Class 35</b> Advertising; business management; business administration; office functions; the promotion and sale of goods and services for others.</p> <p><b>Class 38</b> Telecommunications; subscription television services; transmission of cable television and interactive audio and video services; personalized and interactive television transmission services.</p> <p><b>Class 41</b> Education; providing of training; entertainment; sporting and cultural activities; entertainment services, namely, personalized and interactive entertainment services; online guide to personalised and interactive television programming.</p>
<p>EUTM 8493587</p> <p><b>TIVO</b></p>	<p>Filing date: 17 August 2009</p> <p>Date of entry in register: 17 February 2010</p>	<p><b>Class 9</b> Computer hardware; computer software; computer peripherals; remote controls; apparatus for receiving, transmitting, storing and managing audio, video and other digital media; software for use therewith; digital video recorders; parts and fittings for use with all the aforesaid goods; manuals sold as a unit with all the aforesaid goods; downloadable music, films and television programs.</p> <p><b>Class 38</b></p>

		<p>Telecommunication services; broadcasting services; transmission of video and audio content; providing access to databases and directories via communications networks; transmission of information through communications networks for purposes of programming and operating appliances and electronics; advisory, consultancy, and information services in relation to the aforesaid services.</p> <p><b>Class 41</b> Entertainment and education services; entertainment services in the nature of audio and television programming; providing guides, directories, databases, reviews, ratings and recommendations in the field of entertainment; advisory, consultancy, and information services in relation to the aforesaid services.</p>
--	--	--

3. In respect of its objection under section 5(2)(b) of the Act, the opponent relies on its earlier marks insofar as they are registered for services in classes 38 and 41. In respect of its objection under section 5(3), the opponent relies on all of its goods and services as registered.

4. The applicant filed a counterstatement in which it denies the grounds of opposition.”

2) The opponent was put to proof of use by the applicant and, following consideration of the evidence, the hearing officer concluded that it failed to demonstrate genuine use of any of the goods and services relied upon. At paragraph 34 of her decision, the Appointed Person found the following:

“... I have concluded that the Hearing Officer ought to have found on

the evidence before her that the Opponent had proved use of the earlier mark in relation to some software, namely “Software for personalized, interactive television programming” in Class 9. This seems to me to reflect the scope of the evidence of use for both earlier marks.”

3) As a result, the Appointed Person went on to reach the following conclusion:

“42. As I have found that the earlier marks have been used to some extent, the opposition must be remitted to the UKIPO for another Hearing Officer to consider the merits of the opposition. For the avoidance of doubt, I have not made any finding beyond the simple findings of use set out above, and it will be for the Hearing Officer hearing the opposition to consider whether the evidence proves a reputation for the purposes of the s 5(3) objection.”

4) By an Order, dated 10 April, the Appointed Person remitted the case to the Registry for another hearing officer to consider the merits of the opposition on the basis that the opponent has demonstrated genuine use in respect of the following limited list of Class 9 goods:

*Software for personalized, interactive television programming*

5) The opposition is based upon section 5(2)(b) and section 5(3) grounds, however, the opponent relied only upon its services in Class 38 and Class 41 for the purposes of its ground based upon section 5(2)(b). Consequently, in light of the Appointed Person’s finding that use has been shown in respect of a limited range of Class 9 goods, it follows that the opposition fails, insofar as it is based upon this ground. In response to a letter from the Registry to the parties, dated 19 April 2018, the opponent provided written submissions in lieu of a hearing. No response was received from the applicant. Therefore, I give the following decision in respect of the remaining section 5(3) ground, based upon the papers before me, including the opponent’s written submissions.

## DECISION

6) Section 5(3) of the Act is as follows:

“(3) A trade mark which –

- (a) is identical with or similar to an earlier trade mark,
- (b) (repealed)

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

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

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

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

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

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

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

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

8) The opponent relies upon the two earlier marks TiVo and TIVO. The presentation of the first of these includes alternating capital letter, lower case letter and this introduces a point of difference with the applicant's mark that is not present when comparing the opponent's second mark with the applicant's mark. As a result, the opponent's best case lies with its TIVO mark and if it cannot succeed in respect of this mark it will not succeed for the other. Therefore, for the purposes of this decision, I will only consider the opponent's case based upon its TIVO mark.

### ***Reputation***

9) In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

10) At paragraph 25 of her decision, the Appointed Person stated that she was prepared to accept that there was an agreement between the opponent and Virgin Media (although the details of this agreement are not apparent). I reproduce below, the Appointed Person's deliberations regarding the claimed use in respect of "software":

"31) The Opponent's Class 9 specifications also include software, in both general and more specific terms. The newspaper articles and user manuals exhibited by Mr Bolter give a reasonable picture of some ways in which Virgin Media's customers could use the set-top boxes, for example to record television programmes or a series of programmes. In my view it is self-evident that software will have been required for that purpose. The question is whether that software was sold or supplied under the TiVo mark. Counsel for the Opponent submitted that the manuals exhibited by Mr Bolter proved that the TiVo marks had been used in relation to that software, and I accept that on close inspection it is possible to see that some pages of the manuals show images of on-screen navigation menus which would be displayed to a user, which show the TiVo name as well as Virgin's marks.

32. The Hearing Officer was concerned at paragraph [17] at the lack of any clear

evidence of any sales of software within the relevant period, and she concluded at paragraph [23] that there was no evidence as to how such goods were presented to customers, although such evidence should have been readily available to the Opponent. She was undoubtedly right to be concerned at the lack of specificity in the evidence, and the lack of supporting documentation of the usual kind. However, it seems to me that there was some evidence before the Hearing Officer of use of the mark in relation to software, first, because software will obviously have been necessary to operate the set-top boxes, secondly because the references to a "TiVo box" or box "powered by TiVo" seem to me to be references to the software rather than to the hardware, and lastly because the mark is shown on the menu screens used to operate the set-top box.

33. Mr Rojas explained in his witness statement that Virgin Media had paid significant fees to the Opponent for use of its software, which is consistent with the small parts of the agreements with Virgin which were in his evidence. Unfortunately, it does not seem to me that his evidence adequately proved use of the mark in relation to software, because he did not say that the software was provided under the mark, and the invoices which he exhibited had been redacted to delete the description of the subject of the invoice. Whilst one might guess that the mark was used in relation to the software, use is not proved by 'probabilities or suppositions.' Again, as a result, I consider that the fresh evidence is not of such significance on this point that I should give permission for it to be adduced at this stage.

34. Nevertheless, I have concluded that the Hearing Officer ought to have found on the evidence before her that the Opponent had proved use of the earlier mark in relation to some software, namely "Software for personalized, interactive television programming" in Class 9. This seems to me to reflect the scope of the evidence of use for both earlier marks."

11) In its written submissions, the opponent re-states its position made in the first proceedings before the Registry and refers to paragraphs 64 to 87 of Mr Bolter's witness statement and the accompanying Exhibits 4 to 12. Mr Bolter's relevant statements can be summarised as follows:

- The opponent's TiVo digital video recorder has been made available in the UK (paragraph 79);
- In late 2009, the opponent entered into a partnership with Virgin Media who released its first co-branded product in December 2010 (Paragraph 80). At Exhibit 4 is a copy of an article that appeared in the Guardian newspaper in October 2011 referencing the fact that Virgin spent £10 million "marketing its TiVo set-top box in the last quarter...". It also reports that, at that time, Virgin Media had "3.7 million TV customers";
- By the third quarter of 2011, the number of TiVo customers had quadrupled to 220,000 and by the end of that year, this had grown to 435,000 (paragraph 82 and Exhibit 6 consisting of a further Guardian article, dated February 2012 reporting numerous facts about the Virgin Media business);
- In July 2012, less than 2 years after the launch, the number of subscribers using the TiVo set-top box had risen to a million and by February 2014, this had risen to 2 million (paragraph 83);
- By 2015, the opponent's product had acquired a dominant position in the market (paragraph 84) and at Exhibit 10, an article that appeared in the Yorkshire Post newspaper in May 2015 described Virgin Media's cable TV offering as blowing the others out of the water and identifying it as the UK distributor for TiVo;
- By 25 April 2016 there were 3.7 million TiVo set-top boxes in the UK as referenced in an article that appeared in the Daily Telegraph on that date (Exhibit 11);

12) Whilst the Appointed Person recognised shortcomings in this evidence as identified by the original hearing officer, she went on to state "that there was some evidence before the Hearing Officer of use of the mark in relation to software, first, because

software will obviously have been necessary to operate the set-top boxes, secondly because the references to a “TiVo box” or box “powered by TiVo” seem to me to be references to the software rather than to the hardware, and lastly because the mark is shown on the menu screens used to operate the set-top box”. Taking this into account, together with the existence of the agreement between the opponent and Virgin Media and the evidence relating to the number of Virgin Media’s set-top boxes in use in the UK, I am prepared to accept the submission that the opponent enjoys the necessary reputation required for grounds based upon section 5(3) in respect of its software.

## Link

13) Having established the existence and scope of a reputation, I need to go on to consider the existence of the necessary link. I am mindful of the comments of the CJEU in *Intel* that it is sufficient for the later trade mark to bring the earlier trade mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The CJEU also set out the factors to take into account when considering if the necessary link exists:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
  
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

14) I keep in mind that the level of similarity required for the public to make the necessary link may be less than the level required to create a likelihood of confusion (*Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, paragraph 72). In the current case, the applicant’s mark consists of the word “vivo” that differs from the opponent’s mark “TIVO” in that the first letter is different. They are, therefore, visually similar to a reasonably high degree. Aurally, they consist of the syllables VEE-VO and TEE-VO, respectively. The hard sound TEE created by the letter “T” compared to the softer VEE sound created by the letter “V” is likely to create a noticeable difference between the marks, but because the second syllable is identical, they share a reasonably high level of aural similarity. Conceptually, the applicant’s mark is likely to be recognised as having some meaning. It is a Latin word meaning “in a living thing” and is used in the phrase “in vivo” meaning “taking place in a living organism”<sup>1</sup>. Whilst the consumer may not precisely know its meaning, he is still likely to recognise it as a familiar Latin word. The opponent’s mark, on the other hand, has no meaning and is likely to be perceived as an invented word.

15) The respective goods and services are:

<b>Opponent’s goods</b>	<b>Applicant’s services</b>
<i>Software for personalized, interactive television programming</i>	<i>Production and distribution of television shows and movies; production of television programs; provision of non-downloadable films and television</i>

<sup>1</sup> [https://en.oxforddictionaries.com/definition/in\\_vivo](https://en.oxforddictionaries.com/definition/in_vivo)

	<i>programmes via video-on-demand services</i>
--	--

16) Firstly, I will consider the applicant's *Production and distribution of television shows and movies; production of television programs*. Such services relate to activities of making content and arranging how it will be made available to the general public. These services are normally provided to other businesses and are, therefore, business to business services. The opponent's software, on the other hand, provides the interface between the end consumer and the content provider. Consequently, the respective goods and services are at different points in the delivery chain, targeting different consumers and, therefore, there is little similarity, if any, between them.

17) The applicant's *provision of non-downloadable films and television programmes via video-on-demand services* is more similar to the opponent's goods because there is a complementary relationship between providing content via a video-on-demand service and the software used to deliver such a service. Consequently, the consumer is likely to be exposed to both services and goods when accessing such content with their respective methods of use converging at the point of access to the content. The consumer for both these services and goods is likely to be the same, namely the content viewing general public.

18) In respect of the strength of the reputation of the opponent's mark, there are criticisms aired by both the original hearing officer and the Appointed Person regarding the evidence of use of the mark, but taking all of the factors (summarised in paragraph 11 above), I conclude that the opponent enjoys a strong reputation. Its level of distinctive character is also reasonably high because it is an invented word.

19) Taking account of all of this together with the fact that both marks consist of short words, both being four letters, and that the difference between the marks is the first letter and is not likely to go unnoticed, I find that no link will be made in respect of the applicant's *Production and distribution of television shows and movies; production of*

*television programs*. Whilst similarity of goods and services is not a prerequisite under section 5(3) of the Act, it is, nevertheless, a relevant factor. The distance between the respective goods and services, the different consumers involved and the difference between the respective marks is sufficient that to result in the requisite link not being established in respect to these services.

20) In respect of the applicant's *provision of non-downloadable films and television programmes via video-on-demand services*, here there is a closer relationship with the opponent's goods and the consumers are the same. Consequently, I find that the requisite link is likely to exist. However, because of the different first letter of the respective marks, the impact of which is likely to be greater because of the relatively short nature of both marks will result in the link not being particularly strong, with the applicant's mark doing no more than bringing the opponent's mark to mind.

### **Detriment and unfair advantage**

21) Having established that the requisite link exists in respect of some of the applicant's services, I must consider the case that, as a result of this link, the use of the applicant's mark will result in detriment or unfair advantage.

22) In its statement of grounds, the opponent pleaded that "the connection generated between the respective marks will [...] attract consumers to the Applicant's goods" and this will enable the applicant to take unfair advantage of the distinctive character and repute of the opponent's mark. I do not agree. I have found that the requisite link between the respective marks to be not particularly strong. As a result, I find that the applicant's mark may, at best, bring the opponent's mark to mind. Such a 'bringing to mind' is insufficient to alter the purchasing decisions of the consumer or for the consumer to believe that the respective marks identify services provided by the same or linked undertaking. Consequently, I find that use of the applicant's mark will not lead to it taking unfair advantage of either the distinctive character or repute of the opponent's marks.

23) The opponent's second pleading is that the opponent's reputation can be diminished over time because it has no control over the quality of the applicant's services. For the same reasons as indicated above, I find that the similarity of the marks and the consequential lack of strength of the requisite link will result in the opponent's mark not suffering any detriment to its reputation. Further, Ms Anna Carboni, sitting as the Appointed Person in *Unite The Union v The Unite Group Plc*, Case BL O/219/13, considered whether a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the potential quality of its goods/services was sufficient to found an opposition based on detriment to reputation. At paragraph 46, she concluded that she "can understand how these matters would form part of the relevant context in an infringement case, but I have difficulty with the notion that it should do so in an opposition". Finally, there is no evidence in the current case that the applicant's services are associated in any way with sub-standard quality. I dismiss this limb of the opponent's case.

24) Lastly, the opponent pleaded that use of the applicant's mark "would most certainly cause a diminishing of the distinctive character or repute" of the opponent's marks and result in the ability of its marks to identify its goods being weakened (so-called "dilution"). As with the previous two pleadings, this must fail because of my finding that the link created by the similarity of the marks is not strong enough to bring about such an effect. As a consequence, whilst it can generally be inferred that there may have been a change in the economic behaviour of the relevant consumer (*32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch)), the strength of the link between the marks in the current proceedings is not sufficient to infer that such a change in economic behaviour will occur in this case. In reaching this finding, I keep in mind the comments of the CJEU in *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, and in particular:

"37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from

subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds."

## Summary

25) The opposition fails in its entirety.

## COSTS

26) The applicant played no part in the appeal process and, consequently, I find that it is not appropriate to add further to the cost award made by the hearing officer in paragraph 25 of the original decision. For ease of reference, I reproduce this paragraph below:

"25. The opposition having failed, the applicant is entitled to an award of costs. I make the award on the following basis:

For filing Form TM8 and reviewing the Form TM7:	£200
For reviewing the opponent's evidence and filing written submissions:	£500
<b>Total:</b>	<b>£700"</b>

27) TiVo Brands LLC was ordered to pay Vivo International Limited the sum of £700. In the absence of any appeal against my decision, this sum should be paid within 14 days of the expiry of the appeal period.

**Dated this day of 27<sup>th</sup> June 2018**

**Mark Bryant**  
**For the Registrar,**  
**The Comptroller-General**