

O/0344/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003492969 AND UK00003708175

BY SEAN DOHERTY

TO REGISTER TRADE MARKS IN CLASSES 38 AND 41

AND IN THE MATTER OF OPPOSITIONS THERETO

UNDER NOS. 600001465 AND 429910

BY WHITE CLIFFS RADIO LTD

AND IN THE MATTER OF APPLICATION NO. UK00003492637

BY WHITE CLIFFS RADIO LTD

TO REGISTER A TRADE MARK IN CLASS 41

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 421430

BY SEAN DOHERTY

## BACKGROUND AND PLEADINGS

1. These proceedings concern three consolidated oppositions, two brought by White Cliffs Radio Ltd (“WCR”) and one brought by Sean Doherty (“SD”).

### SD’s opposition

2. On 22 May 2020, WCR applied to register trade mark number 3492637 (“the 637 Mark”) in the UK, which appears as follows:



The application for the 637 Mark was published on 12 June 2020 and registration is sought for the following services:

Class 41      Radio and television entertainment; Radio and television entertainment services; Radio and television programmes (Production of -); Radio entertainment; Radio entertainment production; Radio entertainment services; Radio production services; Radio programmes (Production of -); Radio programming [scheduling].

3. On 14 September 2020, the application for the 637 Mark was opposed by SD on the basis of section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). SD claims to have used the following sign throughout the UK since 4 February 2017 in relation “to broadcast an internet radio station”:



SD claims that use of the 637 Mark would be contrary to the law of passing off.

4. WCR filed a counterstatement denying the claims made.

#### **WCR's oppositions**

5. On 23 May 2020, SD applied to register trade mark number 3492969 ("the 969 Mark") in the UK, which appears as follows:



The application for the 969 Mark was published for opposition purposes on 12 June 2020 and registration is sought for the following services:

Class 38      Internet radio broadcasting services.

Class 41      Internet radio entertainment services.

6. On 8 October 2021, SD applied to register trade mark number 3708175 (“the 175 Mark”) in the UK, which appears as follows:



The application for the 175 Mark was published on 5 November 2021 and registration is sought for the following services:

Class 38 Internet radio broadcasting services.

Class 41 Internet radio entertainment services; Radio entertainment; Radio entertainment services; Radio programming [scheduling]; Preparation of radio programmes; Production of radio programs; Presentation of radio programmes; Performance of radio programmes; Production of radio programmes.

7. On 9 September 2020 and 5 January 2022 respectively, WCR opposed SD’s applications. The 969 Mark is opposed on the basis of sections 5(1), 5(2)(a) and 5(2)(b) of the Act and the 175 Mark is opposed on the basis of sections 5(1) and 5(2)(b). WCR relies upon the 637 Mark for the purposes of both oppositions and claims that the marks are similar and that the services are identical or similar, meaning that there is a likelihood of confusion.

8. SD filed counterstatements denying the claims made.

### **Representation and proceedings**

9. On 29 October 2021 and 15 September 2022, the proceedings were consolidated pursuant to Rule 62(1)(g) of the Act.

10. Neither party is represented.

11. Both parties filed evidence in chief. Neither party requested a hearing, and only SD filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

12. WCR filed evidence as follows:

- a) The witness statement of John Kemp dated 22 December 2021. Mr Kemp is a Director and Person with significant control of WCR. Mr Kemp's evidence is accompanied by 3 exhibits.
- b) The witness statement of Simon Woodcock dated 23 December 2021. Mr Woodcock is a Director of WCR. Mr Woodcock's evidence is accompanied by 3 exhibits.
- c) The witness statement of Richard Saunders dated 23 December 2021. Mr Saunders is a Director of WCR. Mr Saunders' evidence is accompanied by 3 exhibits.
- d) The witness statement of Christopher Tough dated 24 December 2021. Mr Tough is a Director of WCR. Mr Tough's evidence is accompanied by 4 exhibits.

13. SD filed evidence in the form of his own witness statement dated 20 February 2022. His evidence was accompanied by 14 exhibits.

14. SD also filed submissions in lieu dated 11 January 2023.

15. I have taken the evidence and submissions into consideration in reaching my decision.

## **RELEVANCE OF EU LAW**

16. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **PRELIMINARY POINTS**

17. Background information has been provided, explaining that the parties used to operate White Cliffs Radio together but that, following a period of disquiet, a breakaway group was formed, and the parties went their separate ways. These matters have no bearing on the section 5(1) and 5(2) claims. Whilst this information may have had a bearing on ownership of goodwill, it will not be necessary to deal with this for reasons that will become apparent later in my decision. Consequently, I do not need to deal with these issues any further.

## **DECISION**

18. As the 637 Mark is relied upon as the earlier right in WCR's oppositions, if SD's opposition against the 637 Mark is successful then WCR's oppositions will automatically fail for want of an earlier right. Consequently, I will begin by assessing SD's opposition against the 637 Mark.

### **SD's opposition**

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

“(4) 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, where the condition in subsection (4A) is met,

(aa) [...]

(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.”

20. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

### **Relevant date**

21. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of

the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

22. The prima facie relevant date is the date of the application for the 637 Mark i.e. 22 May 2020. I will begin by assessing the position at this relevant date, returning to consider whether there is an earlier relevant date only if it is necessary to do so.

## **Goodwill**

23. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

24. I note the following from SD's witness evidence:

- a) He states that he has been using the sign relied upon since February 2017 via the online radio station and website [www.whitecliffsradio.com](http://www.whitecliffsradio.com).
- b) He purchased software to enable the running of the radio station on 4 February 2017 and has incurred costs such as for building work, amongst other things.<sup>1</sup>
- c) SD has obtained a licence for the station, since 2017.
- d) A banner displaying the sign was placed at an event called the Martha Trust Party on the Farm in June 2018.<sup>2</sup>

---

<sup>1</sup> Exhibits JS2 and JS7

<sup>2</sup> Exhibit JS9

e) Flyers have been made up which display the sign.<sup>3</sup>

25. There are clearly issues with SD's evidence. None of the information that I would expect to see to establish goodwill has been provided; I have no information about turnover generated per annum, number of listeners, subscribers or advertising and promotional expenditure. I recognise that SD has had flyers made up to promote the sign, but no information is provided about how many of these have been distributed and how widely. There has clearly been advertising at one event in June 2018, but I have no information about how many people attended that event or where it took place.

26. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“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.”

27. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson KC, as the Appointed Person, reviewed the following authorities about the

---

<sup>33</sup> Exhibit JS11

establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

28. Clearly, therefore, it is not enough to show that a party has been operating under a sign; it is necessary to demonstrate the extent to which a party has been trading. Without evidence to demonstrate this, it is impossible to assess whether the party has a small but protectable goodwill (as opposed to a trivial goodwill). Taking SD's evidence as a whole into account, I am not satisfied that he has established the requisite goodwill at the prima facie relevant date.

29. As SD has failed to establish goodwill at the prima facie relevant date, it is not necessary to consider whether WCR has established an earlier relevant date.

30. SD's opposition based upon section 5(4)(a) is dismissed.

### **WCR's oppositions**

31. As SD's opposition against the 637 Mark has failed, WCR is entitled to rely upon that mark for the purposes of its oppositions against the 969 Mark and the 175 Mark. This is because it has an earlier filing date and is, therefore, an earlier right pursuant to section 6 of the Act. The 637 Mark is not yet registered and so it is not subject to proof of use pursuant to section 6A of the Act. WCR can, therefore, rely upon all services identified. I will return to the impact of this upon the status of this decision below.

32. Section 5(1) of the Act reads as follows:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

33. Section 5(2)(a) of the Act reads as follows:

“A trade mark shall not be registered if because –

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

### **Identity of the marks**

34. The marks being identical is a prerequisite of sections 5(1) and 5(2)(a). In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

35. SD submits as follows:

“This is the case as far as the title White Cliffs Radio is concerned they are using an exact copy of my stations name. They have chosen to use a new logo which is not the same as my original logo that I use.”

36. Clearly, the marks in issue are not identical. As SD stated, they contain the identical words White Cliffs Radio. However, the stylisation, backgrounds and devices in each mark differ. WCR’s marks contain the additional wording “listen at www.whitecliffsradio.com”. Further, the 175 Mark contains the additional wording “.com”. Bearing in mind all of these differences, I do not consider the marks to be identical and the oppositions based upon sections 5(1) and 5(2)(a) of the Act fail.

### **Section 5(2)(b) – case law**

37. 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 Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 greater 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 to mind the earlier mark, is not sufficient;

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

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

### **Comparison of services**

38. The competing services are as follows:

<b>WCR's services (the opponent)</b>	<b>SD's services (the applicant)</b>
<p><b>The 637 Mark</b></p> <p><u>Class 41</u></p> <p>Radio and television entertainment; Radio and television entertainment services; Radio and television programmes (Production of -); Radio entertainment; Radio entertainment production; Radio entertainment services; Radio production services; Radio programmes (Production of -); Radio programming [scheduling].</p>	<p><b>The 969 Mark</b></p> <p><u>Class 38</u></p> <p>Internet radio broadcasting services.</p> <p><u>Class 41</u></p> <p>Internet radio entertainment services.</p> <p><b>The 175 Mark</b></p> <p><u>Class 38</u></p> <p>Internet radio broadcasting services.</p> <p><u>Class 41</u></p> <p>Internet radio entertainment services; Radio entertainment; Radio entertainment services; Radio programming [scheduling]; Preparation of radio programmes; Production of radio programs; Presentation of radio programmes; Performance of radio programmes; Production of radio programmes.</p>

39. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

40. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

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

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

41. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

## Class 38

### *Internet radio broadcasting services*

42. This term appears in both the specifications of the 175 Mark and the 969 Mark. It will overlap in trade channels with “radio entertainment production” in the specification of the 637 Mark. This is because the same undertakings that produce radio shows are also likely to be involved in their broadcasting. The users will clearly overlap. The nature and method of use may differ, but the purpose overlaps. I consider these services to be similar to between a medium and high degree.

## Class 41

### *Internet radio entertainment services.*

43. This term appears in both the specifications of the 175 Mark and the 969 Mark. It is identical on the principle outlined in *Meric* to “radio and television entertainment” in the specification of the 637 Mark.

### *Radio entertainment; radio entertainment services*

44. This term in the specification of the 175 Mark is identical on the principle outlined in *Meric* to “radio and television entertainment” in the specification of the 637 Mark.

### *Radio programming [scheduling];*

45. This term in the specification of the 175 Mark appears identically in the specification of the 637 Mark.

### *Production of radio programs; Production of radio programmes.*

46. These terms in the specification of the 175 Mark are self-evidently identical to “radio production services” and “radio programmes (production of -)” in the specification of the 637 Mark.

*Preparation of radio programmes; Presentation of radio programmes; Performance of radio programmes;*

47. These terms in the specification of the 175 Mark are all part of the production of radio programmes. Consequently, I consider them to be identical on the principle outlined in *Meric* to “radio production services” in the specification of the 637 Mark.

### **The average consumer and the nature of the purchasing act**

48. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

49. The average consumer for the services is likely to be either a member of the general public (in the case of radio entertainment services) or a professional user (in the case of production/scheduling services). For the former, the average consumer will take into account factors such as type of music, method of transmission and hosts into account. They are unlikely to attract a high cost (if at all) and will be in reasonably frequent use. I consider that a medium (or average) degree of attention will be paid. For the latter, the services may attract a reasonably high cost and will require considerations of reliability and expertise. In my view, between a medium and high degree of attention is likely to be paid.

50. The services are likely to be selected following perusal of physical signage on advertisements, physical premises or on websites. However, I recognise that some selections may be made aurally. Consequently, I consider that both visual and aural considerations will play an important role.

### **Comparison of trade marks**

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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.”

52. 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 of the marks which are not negligible and therefore contribute to overall impressions created by the marks.

53. The respective trade marks are shown below:

WCR's trade mark (the opponent)	SD's trade marks (the applicant)
 <p data-bbox="363 936 576 976">(the 637 Mark)</p>	 <p data-bbox="762 667 970 707">(the 969 Mark)</p>  <p data-bbox="762 1137 970 1178">(the 175 Mark)</p>

54. The 637 Mark consists of the words WHITE CLIFFS RADIO, presented in title case, with the words WHITE CLIFFS in a slightly bigger font above the word RADIO. These words all appear in a light blue rectangular background, with a series of white devices beneath them, conveying the impression of a bird flying over white cliffs. In my view, it is the words WHITE CLIFFS RADIO which play the greater role in the overall impression of the mark, with the presentational/device elements playing a lesser role. The 969 Mark consists of the words WHITE CLIFFS RADIO presented in title case. The words WHITE CLIFFS appear in a marginally smaller font above the word RADIO. The words are presented on a dark blue rectangular background, with a series of curved lines to the righthand side and a series of dots (in light blue and green) above and below. The words 'listen at [www.whitecliffsradio.com](http://www.whitecliffsradio.com)' appear beneath the larger text in much smaller font. In my view, it is the words WHITE CLIFFS RADIO which play the greater role in the overall impression, with the background, device and listening instructions playing a lesser role. The same is true of the 175 Mark, although

it also contains the additional “.com”. In my view, the words WHITE CLIFFS RADIO .COM play the greater role in the overall impression, with the other elements playing a lesser role. For all three marks, given the descriptiveness of the word RADIO for these services, the fact that .COM will be seen as merely indicating a website and the fact that the additional wording in SD’s trade marks will simply be viewed as listening instructions, I consider the words WHITE CLIFFS to be the most distinctive element of the marks.

55. Visually, the 637 Mark and the 969 Mark overlap to the extent that they both include the words WHITE CLIFFS RADIO. They are also both presented on blue backgrounds, albeit different shades of blue. The devices in the 637 Mark have no counterpart in the 969 Mark and the dot and curved line device in the 969 Mark have no counterpart in the 637 Mark. Further, the additional wording in the 969 Mark is absent in the 637 Mark. Taking all of this into account, I consider the marks to be visually similar to a medium degree. The same applies to the 175 Mark and the 637 Mark, although the additional word “.COM” acts as a further point of difference. I consider the marks to be visually similar to a slightly lower than medium degree.

56. Aurally, the 637 Mark will be pronounced WHITE CLIFFS RADIO. The same words in the 969 Mark will be articulated identically. I note that there are additional words ‘listen at [www.whitecliffsradio.com](http://www.whitecliffsradio.com)’ in the 969 Mark but given their size and instructional nature I consider it unlikely that they will be pronounced. Consequently, I consider the marks to be aurally identical. The same applies to the 175 Mark, but the additional word “.COM” will act as a point of aural difference. I consider them to be aurally similar to a high degree.

57. Conceptually, the words WHITE CLIFFS in the marks convey the message of cliffs of white stone/rock. This will be identical for all three marks. The additional words RADIO and .COM do not convey any distinctive conceptual message; merely the fact that these are radio services and that they are provided online via a .com website (in the case of the 175 Mark). The additional wording listen at [www.whitecliffsradio.com](http://www.whitecliffsradio.com) is not a distinctive point of difference. The curved line device in the 939 Mark and 175 Mark reinforces the idea of radio (appearing to be a reference to sound waves), and the devices in the 637 Mark reinforce the idea of white cliffs. Taking all of this into

account, the only distinctive overlap between the marks is identical, with other points of difference being non-distinctive.

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

58. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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-2779, 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).”

59. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of them.

60. WCR filed evidence. However, it did not provide any turnover figures, listener numbers or total advertising expenditure. It provided no information about the geographical spread of its listeners. The evidence is far from sufficient to establish that the distinctiveness of the mark has been enhanced through use. Consequently, I have only the inherent position to consider. The 637 Mark consists of the words WHITE CLIFFS RADIO in white title case font, on a pale blue background above devices representing a bird flying over white cliffs. In my view, the words WHITE CLIFFS are distinctive to a medium (or average) degree for the services relied upon. The background and devices result in a slightly higher than average degree of distinctiveness when taking the mark as a whole.

### **Likelihood of confusion**

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

62. I have found as follows:

- a) The services are either identical or similar to between a medium and high degree.

- b) The average consumer will be either a member of the general public (who will pay a medium degree of attention) or a professional user (who will pay between a medium and high degree of attention).
- c) The purchasing process will be both visual and aural.
- d) The 637 Mark and the 969 Mark are visually similar to a medium degree.
- e) The 637 Mark and the 175 Mark are visually similar to a slightly lower than medium degree.
- f) The 637 Mark and the 969 Mark are aurally identical.
- g) The 637 Mark and the 175 Mark are aurally identical or similar to a high degree.
- h) The only distinctive conceptual message conveyed by the marks is identical, with any differing conceptual messages conveyed being non-distinctive.
- i) The words WHITE CLIFFS RADIO are inherently distinctive to a medium degree and the 637 Mark as a whole is distinctive to a slightly higher than medium degree.

63. Clearly, where the marks are encountered aurally (given that they are aurally identical or highly similar) there is potential for direct confusion to arise. Even when they are encountered visually, bearing in mind that both marks share the same wording WHITE CLIFFS RADIO, I consider that there is potential for it to be this identical conceptual message which sticks in the mind of the consumer resulting in the marks being mistakenly recalled or misremembered as each other. Consequently, there is direct confusion.

64. Even if I am wrong in that finding, I consider that the similarities between the marks are such that the average consumer would perceive them as originating from the same or economically linked undertakings. The different device/presentational elements will

just be viewed as an alternative mark being used by the WHITE CLIFFS radio station. Consequently, there is a likelihood of indirect confusion.

## **CONCLUSION**

65. The opposition against application number 3492637 is unsuccessful and the application may proceed to registration.

66. The oppositions against application numbers 3492969 and 3708175 are successful and the applications are refused.

## **COSTS**

67. WCR has been successful in all three of the consolidated cases and is, therefore, entitled to a contribution towards its costs. As WCR is unrepresented, it filed a costs proforma outlining the time spent on the proceedings. It claims 90 hours and 30 minutes for preparing its Notice of Defence, 74 hours and 30 minutes for preparing its Notice of Opposition and 7 hours and 30 minutes for considering forms filed by the other party. I note that no time has been claimed for preparing witness evidence, but given the amount of time claimed for preparing the forms in this case it appears that this time has been set out within those figures. I acknowledge that litigants in person will need to spend time familiarising themselves with Registry formalities and procedures, but even factoring that in, the time claimed by WCR is, in my view, excessive.

68. I consider the following number of hours to be reasonable:

- Completing the Notice of Opposition (x2) – 8 hours
- Completing the Counterstatement – 3 hours
- Considering SD's evidence and preparing evidence – 20 hours

**Total: 31 hours**

69. In relation to the hours expended, I note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore award WCR the sum of £589 (31 hours at £19 per hour), plus £200 of official fees, totalling **£789**.

70. I hereby order Sean Doherty to pay White Cliffs Radio Limited the sum of £789. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 6<sup>th</sup> day of April 2023**

**S WILSON**

**For the Registrar**