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Neutral Citation Number: [2014] EWHC 185 (Ch)

Case No: HC 12B02393

**IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
INTELLECTUAL PROPERTY**

Rolls Building
7 Rolls Buildings
Fetter Lane
London, EC4A 1NL
7/02/2014

B e f o r e :

**MR ROGER WYAND QC
(sitting as a Deputy High Court Judge)**

Between:

↗COMIC↘ ENTERPRISES LIMITED Claimant

- and -

TWENTIETH CENTURY FOX FILM CORPORATION Defendant

**Douglas Campbell (instructed by Wragges LLP) for the Claimant
Simon Malynicz and Stuart Baran (instructed by Simmons & Simmons LLP) for the Defendant
Hearing dates: 17th, 18th, 19th, 22nd and 23rd July 2013**

HTML VERSION OF JUDGMENT

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Mr ROGER WYAND QC:*Introduction*

1. This is an action for infringement of United Kingdom registered trade mark no. 2200698 and for passing off. The Claimant, **Comic** Enterprises Limited, is a small to medium sized enterprise and it runs a number of live entertainment venues in the United Kingdom which are used primarily for providing stand-up comedy although they are also used for other forms of entertainment including live music. Its venues, together with the date it started trading at each venue are: Birmingham (1994), Cardiff (2001), Oxford (April 2010) and Nottingham (September 2010). It has always offered comedy at its venues and it has offered live music since 2002 at Birmingham, since 2004 at Cardiff and since 2010 at Nottingham.



2. The registered trade mark is a series of two marks. They are both device marks which include the words "The Glee Club". The words are presented in a representation of a cone of light from a spotlight. The two marks are identical save that the first in the series is stated to be claimed in the colours red, black and white whereas the second is represented in black and white with no claim to colour. I shall deal with the significance of the colours below. This is the representation of the trade mark:
3. The passing off claim goes wider than the registered trade mark in that it relies on the unregistered marks "Glee Club", "Glee" and "the Glee Club" without the device. The Claimant registered the domain name www.lee.co.uk in 1998.
4. The trade mark, ("the Mark") was filed on 19 June 1999 and was registered on 20 April 2001. It is registered in respect of classes 25 and 41 for the following goods and services:

Class 25

Articles of outer clothing; articles of sports clothing; footwear; shirts; shorts; T-shirts; socks; sweatshirts; sweaters; headgear; scarves; jackets; braces; wrist bands; tracksuits; ties; belts.

Class 41

Entertainment services; comedy services; night-club and cabaret entertainment; music

hall and orchestra services; show production services; provision of live and recorded music; dancing; amusement arcades; provision of recreational facilities; organisation of contests and competitions; production and/or presentation of radio and television programmes, live shows, displays, films and of sound and video recordings; booking agency services; rental of radio and television programmes, films and of sound and video recordings; publication services; consultancy, advisory and information services relating to the aforesaid services.

5. The Defendant, Twentieth Century Fox Film Corporation ("Fox") is the well known media company. It is responsible^[1] for a television series entitled **glee**^[2] which is produced in America. It is currently in its fourth season. The first programme, the pilot episode, was broadcast in the United Kingdom in December 2009. Seasons 1 and 2 were broadcast on E4, series 3 and series 4 on Sky. The series has been very successful and has achieved high ratings in the UK.
6. **glee** is about an American high school singing club at the fictional William McKinley High School in the town of Lima, Ohio. The series follows a group of characters most of whom are members of, or are otherwise involved in, their school singing club called "New Directions". New Directions competes against other clubs in other schools. The series touches on a variety of social messages and issues relating to relationships, sexuality, race and physical disability.
7. Songs performed in the programmes, and album compilations thereof, have been sold in the United Kingdom, including via the iTunes Store. There have been two world concert tours, the second of which included performances in the UK at the Manchester Evening News Arena and the O2 Arena. These featured cast members in character performing musical numbers from the TV series. There have also been DVDs of the concert tour. The Defendant has also licensed a range of merchandise, including clothing, linked to the programme and the concert tour and bearing the word **glee**. This merchandise was sold at the venues.
8. The Claimant says that all these activities, when carried out in the United Kingdom, infringe the Mark and pass off the Defendant's show and associated products as being associated in the course of trade with the Claimant. The Defendant denies infringement and passing off and counterclaims for partial invalidity and partial revocation of the Mark.
9. Although not in issue in these proceedings, the Defendant has a Community Trade Mark registration for "GLEE" in, inter alia, Class 41 for "*Entertainment services in the nature of television series featuring comedy and musical comedy*".

A preliminary point

10. As a preliminary matter the Claimant objected to certain evidence that had been served by the Defendant directed to the issue of the use and meaning of the words "Glee Club". There were two distinct types of evidence being put forward. The first type was witnesses giving factual evidence as to the existence of several societies which had used or are using the word "glee" as part of their name and of their personal knowledge of the meaning of the word "glee". The second was evidence from an expert, Dr Kilgarriff. Dr Kilgarriff is an expert in, as he puts it, "researching the behaviour of words" (i.e. how words have been used over time and what meaning(s) words have).
11. So far as the first group of witnesses was concerned Mr Campbell objected to them on the basis that their evidence could not be of assistance since they were merely individuals with their own knowledge and views and could not be put forward as representative of the views and knowledge of the public. They had been selected by means of a witness collection exercise which had not been disclosed. Mr Campbell relied on the two Court of Appeal judgments in the *Interflora v Marks & Spencer* litigation, *Interflora I* [2012] EWCA Civ 1501 and *Interflora II* [2013] EWCA Civ 319.

12. On behalf of the Defendant, Mr Malynicz submitted that the judgments in the *Interflora* cases could be distinguished from the present case. In *Interflora*, the issue was whether the average consumer was likely to be confused. Lewison LJ, who gave the judgment of the court in both cases, made it clear that for evidence to be relevant to this issue it had to be capable of being representative of the average consumer's reaction. The only exception would be evidence of actual confusion. For the evidence to be representative, it was necessary to look at any witness collection exercise and to examine the sample of the public.
13. In this case, Mr Malynicz sought to rely on the witnesses to establish that "Glee Club" was a term that was in use in the United Kingdom. He sought to base an attack on the validity of the registration of the Claimant's trade mark on the fact that "Glee Club" is descriptive of a particular type of singing club. This type of evidence, he said, did not need to be representative. It was straightforward evidence of fact and did not depend upon the representativeness of the witnesses.
14. I agree with Mr Malynicz with the exception of the evidence which is typified by one paragraph in the witness statement of Catherine Ruth Ingram Smith where she states her opinion that the term "Glee Club" is a generic term that has an ordinary dictionary meaning. I indicated to counsel that I did not intend to place any weight on that paragraph or similar paragraphs in the other witness statements where the witness expressed his or her opinion on the status of the term. Otherwise, I was prepared to let that evidence in.
15. So far as the evidence of Dr Kilgarriff is concerned, Mr Campbell objected to it on the basis that his evidence is expert evidence which requires the leave of the court before it can be adduced and no such leave had been sought in this case. Although Dr Kilgarriff expressly states in paragraph 3 of his witness statement that he was instructed not to provide expert evidence he is, Mr Campbell submitted, using his skill and training. He gives evidence of "various searches I performed in relation to the word glee in order to demonstrate usage." Mr Campbell points to the fact that Dr Kilgarriff has carried out his searches using various databases, some of which would be unknown to the average person. He has, Mr Campbell says, used his judgment as to which sources of information to take. He suggests that, although Dr Kilgarriff has not expressed an opinion (which would clearly be expert evidence if he did), that Mr Malynicz would express the opinion based on the evidence of Dr Kilgarriff's evidence.
16. Mr Campbell relied on the case of *Fenton v Arcadia* [2013] EWHC 1945 (Ch) where Birss J excluded the evidence of a music industry consultant whose job it was to study fans. He gave evidence as to the expectation of fans that High Street retailers of standing sell official merchandise. Here, Mr Campbell submitted, we have comparable evidence being given by Dr Kilgarriff and it should be excluded for the same reason.
17. In *Fenton v Arcadia*, Birss J set out a passage from the judgment of Lewison J (as he then was) in *02 v Hutchison* [2006] EWHC 601 (Ch):

16. In *02 v Hutchison* [2006] EWHC 601 (Ch) Lewison J (as he then was) was asked to consider evidence about a survey by an employee of a market research company, and rule whether it was expert evidence. He said as follows:

"9. The identification of what is or is not expert evidence is difficult to formulate. I think that in most cases one knows expert evidence when one sees it but to try and formulate an overall test would I think be an impossibility.

10. I have been referred to the decision of Hobhouse J. in *The Torenia* [1983] 2 Lloyd's Rep. 210, in which he gave a ruling on the question of admissibility of certain evidence

at 232 and following. Hobhouse J. analysed the evidence in this way at 233:

'First, evidence is adduced which can be described as direct factual evidence which bears directly on the facts of the case. Second, there is opinion evidence which is given with regard to those facts as they have been proved; and then, thirdly, there is evidence which might be described as factual, which is used to support or contradict the opinion evidence. This is evidence which is commonly given by experts because in giving their expert evidence they rely upon their expertise and their experience, and they do refer to that experience in their evidence. So an expert may say what he has observed in other cases and what they have taught him for the evaluation of the facts of a particular case. So also experts give evidence about experiments which they have carried out in the past or which they have carried out for the purposes of their evidence in the particular case in question'.

11. The two submissions which Hobhouse J. had to consider were, on the one hand, that any factual evidence given by somebody who happens to be an expert is to be treated as evidence of fact; and, on the other hand, that if factual evidence is relevant only to the expert opinion of the experts, then it must be treated as expert evidence and expert evidence alone. Hobhouse J. preferred the latter of these two submissions."

17. There are three things to note from the passage to which I have just referred. First, it is impossible to formulate an overall test. Second, in addition to opinion evidence, factual evidence given by an expert can also be expert evidence. Third, I note the reference to the reliance on the expertise of the person giving the evidence.

18. Mr Malynicz describes the evidence of Dr Kilgarriff as "dictionary evidence on steroids". He points to two parts of Dr Kilgarriff's evidence that he says would be useful to me in this case. First, he says, there is an indication as to frequency of use which he says shows a stratospheric increase in 2012 of first letter upper case "Glee". Second, he points to the evidence giving examples of use in context. This he says is to replace the type of evidence one often gets in a case of this sort, of vast quantities of printouts taken from the internet showing how a word or sign is being used. This he says is actually a cost saving exercise. He also referred to the fact that the Claimant had received the evidence some 8 weeks before trial and had not objected to it until shortly before trial. Mr Malynicz submitted that any objection should have been raised earlier and it was now too late.

19. On this last point of timing Birss J made the following comment in *Fenton v Arcadia*, where the objection to the particular evidence was taken before trial:

8. Mr. Hobbs' submissions essentially are these. First, he says this is the correct time to take this objection, i.e. in advance of trial. He refers to the Chancery Guide of January 2013, para.4. I will say now that I accept that submission. The clear purpose of the Guide and the paragraph I have referred to is to aim to have disputes like this resolved in advance of trial so that whatever needs to be done about it before trial can be done.

20. I allowed the evidence of Dr Kilgarriff in *de bene esse*, indicating that I would make a decision on its admissibility in this judgment. Since the evidence had been served almost 2 months prior to the objection being raised and the evidence was already in the agreed trial bundles, I was prepared to allow it in whilst reserving my judgment as to its admissibility. It seemed to me to be more of a waste of time to hear full argument on its status and usefulness on the first day of trial as a separate issue than to deal with it in the course of submission after the evidence has been heard. In the event, Mr Campbell did not wish to cross-examine Dr Kilgarriff so he was not called. The only reference to Dr Kilgarriff's evidence in Mr Malynicz's closing submissions was to his reporting of the relevant entries

in the OED.

21. I believe that Dr Kilgarriff's evidence as to dictionary references is not expert evidence and is admissible. However, his evidence as to further searches in databases that people without his expertise would not be aware of is, in my opinion, within the ambit of the second and third categories identified in the passage of Birss J's judgment set out above. This evidence is effectively expert evidence in that there are implied expressions of opinion lying behind the facts stated. This evidence should not have been adduced without the express permission of the court. Having looked at it, I found it of no assistance in any event. As I have said, Mr Malynicz did not refer to it in closing and I have not relied on it in reaching my judgment.

The Claimant's witnesses

22. **Mr Tughan** Mr Tughan was the Claimant's main witness. He is the Director and sole share-holder of the Claimant. Mr Tughan gave evidence of the history of the Claimant company and the development of its business. He gave evidence as to when he first became aware of the Defendant's television programme and explained why it was that some 3 years passed before the Claimant started this action. He gave evidence about his growing concern at his perception of increasing confusion with the public and his efforts to obtain evidence of such confusion. He was cross-examined concerning these efforts and there was some suggestion that he had offered free tickets to obtain the evidence. He was criticised for having exaggerated his claim to damages in this case and for having continued with this action although at an earlier stage he had said that his company could not afford to continue with the action if it were transferred to the High Court, which it was.
23. I found Mr Tughan to be an honest witness. I find that there was nothing wrong or underhand about the way he obtained evidence from members of the public and I reject all the criticisms of his conduct.
24. **Sarah Shaw** Sarah Shaw is the Account Director of m360 Limited, a marketing, digital and design agency which was employed by the Claimant in about June 2010 to provide a marketing plan for the Claimant's launch of its Nottingham venue later that year. She gave evidence as to how she and her team were of the opinion that there would be confusion between the Claimant's venue and the Defendant's television programme. They addressed that problem in their advertising programme by using the slogans "You don't need your TV" and "We're Glee and were not on TV". In cross-examination she accepted that the reason she first associated the Claimant's business with the Defendant's television show was the single word "Glee" on the front, and every following page, of the brief she had been given and that she had never heard of the Claimant's business before she read the brief. She accepted that by the time she had finished reading the brief she had realised that there was no connection between the Claimant and the Defendant's show. This was hardly surprising because it was explained in the brief.
25. Two colleagues of Sarah Shaw, **Mark Ashmore** and **Shane Robert Jones** gave evidence by witness statement and were not cross-examined. Their evidence did not add anything of substance to the evidence of Sarah Shaw.
26. **Parina Bhathawalla** Parina Bhathawalla is one of three members of the public who were called to give evidence. Parina Bhathawalla is a fan of the Defendant's television programme. She and her fiancé saw an advertisement for a special offer on tickets for the Claimant's show and she believed that it was something to do with the TV programme. The advertisement had the word "glee" in lower script, but in large size letters, on a red curtain backdrop behind a person with a microphone in hand on a stage. The Claimant's registered trade mark was in the lower left hand corner of the advertisement. It was only when she telephoned to book and asked what the connection with the television programme was that she was made aware of the fact that there was no connection. She

went to the show anyway.

27. **Tracey Jones** Tracey Jones is another of the members of the public called to give evidence. She gave evidence by video link and was cross-examined. Tracey Jones was aware of the Claimant's business in Cardiff for about ten years before she saw a trailer for the Defendant's television programme. This was in 2010. When she saw the trailer she assumed that it was connected with the Claimant's business. Tracey Jones is an active "tweeter". In 2012 she saw a tweet referencing this action. That reminded her that she had been confused by the trailer and she tweeted about it. This was picked up by Mr Tughan who contacted her and asked her to give evidence about her confusion.
28. It is suggested by the Defendant that Tracey Jones' evidence should be treated with caution. She was cross-examined about how many tweets she makes and as to the content of them and was unable to recall even recent tweets. This, it was suggested, made her recollection of being confused some three years ago unreliable. Having seen Tracey Jones on the video link I found her evidence entirely credible. She was not recalling a tweet that she had sent, she was recalling being confused. She is now a follower of the television programme and knows that there is no connection with the Claimant's business, but she clearly remembers being confused.
29. **Stewart Thorpe** Stewart Thorpe is the third member of the public called to give evidence. He had been told by his brother that he was going to take him to the Nottingham Glee Club (one of the Claimant's venues) for a birthday present. Stewart Thorpe had never heard of the Claimant but had watched one episode of the Defendant's television programme. He had assumed that the Nottingham Glee Club was something to do with the television programme. His brother had assured him that it was nothing to do with the programme but he was not entirely re-assured and tweeted his concerns. This was picked up by Mr Tughan who contacted him and asked him to give evidence. Mr Tughan offered him free tickets to the Glee Club but he never took him up on the offer. This offer of free tickets was relied on by Mr Malynicz in the cross-examination of Mr Tughan when he suggested that Mr Tughan's efforts to obtain evidence for this case involved methods that tainted the evidence. As stated above, I found nothing improper about the way that Mr Tughan collected evidence for this case.
30. **Thomas Rose** Thomas Rose is a music promoter at the Claimant working primarily at the Nottingham Glee Club. He gave evidence by witness statement and was not cross-examined. Mr Rose was first involved with the Claimant when he was attending meetings to assist with setting up the Nottingham Glee Club and advising on what needed to be achieved to make it a serious music venue. He gave evidence about the reputation of the Nottingham Glee Club in the field of live music. He also gave evidence of instances he had heard of people linking the Nottingham venue with the Defendant's television series, including the incident referred to below involving Jonathan Handle.
31. **Jonathan Handle** Jonathan Handle is the Managing Director of Westbury Music Ltd, an independent publisher of contemporary British music. He gave evidence by a witness statement and was not called for cross-examination. He stated that he had a conversation with Thomas Rose in July 2012. He said that Mr Rose had told him that he was now working for "The Glee Club" or words to that effect. Mr Handle said that at that time he had not previously been aware of The Glee Club and these words immediately brought to mind the television show "Glee" which he knew of but had never seen. Mr Handle said that he raised his eyebrows and said "Really?" and Mr Rose said "No, not that one!"
32. **Joe Norris** Joe Norris is a partner of Off the Kerb Productions, a managerial consultancy and production and promotion company that mainly works with comedians. He gave evidence by witness statement and was not called for cross-examination. He gave evidence of his knowledge of the Claimant and its business and its reputation as "one of the best day-in-day-out comedy venues in the country".

33. **Markus Sargeant** Markus Sargeant is a music promoter employed by the Claimant. He gave evidence by witness statement and was not called for cross-examination. He gave evidence of the music shows put on by the Claimant at its Birmingham venue starting in 2002 and then in the Cardiff and Nottingham venues. He also gave evidence of the reputation that the Claimant has acquired in the music field with artists, music agencies and promoters and also with music fans. He referred to the use of the brand "Glee" and "Glee Club" in connection with the live music.
34. **Robin Morgan** Robin Morgan is employed by the Claimant as the bar manager at the Cardiff Glee Club. He gave evidence by witness statement and was not called for cross-examination. He gave evidence that he had encountered several incidents when customers at the Glee Club had mistakenly believed that it was in some way connected or associated with the Defendant's TV show. In particular he stated that he had spoken to a Mr Phillip Golmulka, a customer at the club. Mr Golmulka was on a stag do having been brought to the Glee Club in Cardiff by some friends and he asked whether the club was anything to do with the TV show and whether it was going to be a "singing and dancing" type of night. Mr Morgan explained that it was a comedy show and obtained Mr Golmulka's name and email address which he sent to Mr Tughan. Mr Morgan said that in his experience, people he talks to often think that the Glee Club is linked to the TV show.
35. **George Fernon** George Fernon is an employee of C B Operations Limited which runs a bar and nightclub called Wahoo, which is in the downstairs section of the Oxford Glee Club. He gave evidence by witness statement and was not cross-examined. Mr Fernon is the Assistant Manager of Wahoo. He says that the Oxford Glee Club does not put on music shows but that it does have a DJ who plays music for customers to dance to once the comedy show ends. It then becomes effectively, the upstairs of the nightclub. He describes the Glee Club branding on the premises. He also refers to incidents when customers in Wahoo have asked him whether the Glee Club is related to the TV show. He also tells of tourists taking pictures of the Glee Club signs outside the premises.
36. **Bradley Seagrave** Bradley Seagrave has been employed as the general manager of the Nottingham Glee Club since it opened in 2010. He gave evidence by witness statement and was not cross-examined. He stated that when he advertised for staff he received applications which referred to the TV show saying that the applicant was a fan of it. He also gave evidence of a number of instances of people passing by or queuing to get in asking whether it was anything to do with the TV show. He also saw a group of 5 or 6 standing under the Glee Club sign on one occasion singing "Don't stop believing" which is a song commonly associated with the TV show.
37. **Adam Jarenko** Adam Jarenko is an employee of the Claimant. He gave evidence by witness statement and was not cross-examined. He worked the floor during show nights at the Birmingham Glee Club from September 2006 until around April 2010. From May 2010 he divided his time between the Birmingham head office and working as a manager of the Oxford club. In February he stopped working at Oxford and started working full time at the Birmingham club. He described the signage at the Oxford club. He stated that he had been asked on several occasions by customers of the bar/nightclub below the club whether the Glee Club was anything to do with the TV show. He also recalled seeing people laughing at the club's sign and mocking it. He got the impression that this was because they thought it was something to do with the TV show. He also saw people taking pictures of each other which he believed to be because they thought it was something to do with the TV show. He stated that about 9 months after opening the Oxford club Mark Tughan told him that they wanted to change the sign outside the club. They decided to add the words "comedy club est. 1994" to try to distinguish the club from the TV show.
38. **Peter Mortimore** Peter Mortimore is an employee of C B Operations Limited, formerly Cavendish Bars Trading Limited and is the manager of the Wahoo bar and nightclub below the Oxford Glee Club venue. He gave evidence by witness statement and was not cross-examined. As manager he is responsible for the venue and its staff, including the staff working in the Glee Club. He stated that

Wahoo opened on 1 April 2010 and the Glee Club, which has a separate entrance and is separately signed as the Glee Club, opened on 14 April of the same year. He recalls receiving a lot of queries from Wahoo customers asking whether the Glee Club was affiliated with the TV show.

39. **Andrew Robinson** Andrew Robinson is a comedian who has performed at the Glee Club on several occasions since it first opened in Birmingham in 1994. He gave evidence by witness statement and was not cross-examined. He stated that he has performed regularly at the Glee Club across all its venues. He gave evidence that he saw three young girls outside the Nottingham venue singing "Don't stop believing" and taking pictures of each other in front of the Glee Club sign outside the venue. They were also making "L" signs with their hands which he knew to be associated with the TV show.
40. **Alexander Jackson** Alexander Jackson is an employee of the Claimant with a special focus on the Glee Club's presence on the social networking sites Twitter and Facebook. He gave evidence by witness statement and was not called for cross-examination. Mr Jackson gave evidence about the Claimant's presence on social network sites. He stated that on Facebook the Claimant uses avatars which have "the Glee Club" in a cone like the Marks and with wording underneath referring to "Live Comedy Club" for Oxford and "Live Comedy & Music" for Birmingham, Cardiff and Nottingham. He gave evidence of the marketing that the Claimant does through the social network sites. He gave examples of tweets which he believed showed people were being confused between the Claimant and the Defendant's TV show. Mr Jackson went to various Fresher Fairs where he believed that students were spurning offers of free tickets to the Claimant's Nottingham venue because they thought it was something to do with the TV show.
41. **Duncan Burns** Duncan Burns is the marketing director of the Claimant. He gave evidence by witness statement and was not cross-examined. He gave evidence concerning the launch of the Oxford and Nottingham venues. He was aware of the TV show at the time of the launch of those two venues. He was responsible for producing the brief to the marketing agencies which was sent out to m360 among others. He stated that it was not until the two marketing agencies independently promoted concepts addressing the TV show that he thought the TV show may have a tangible impact on the Claimant's business. He also gave evidence about the reaction of students at Fresher Fairs similar to that given by Mr Jackson. Mr Burns also gave evidence of promotional activities carried out by the Claimant.
42. **Paul Herron** Mr Herron is a freelance Digital Strategist working for D4 Brand Communications Limited in Sheffield. He gave evidence by witness statement and was not cross-examined. He stated that he and Mr Williams from D4 met Mr Tughan in July 2011 to discuss the Claimant's concerns about what the Glee TV series was doing to the Glee Club. Mr Herron said that he could understand why people were believing that there was a link between the two. He said that he advised Mr Tughan that any association with the TV series would cause significant and lasting damage to the comedy club and advised re-branding the Glee Club.

The Defendant's witnesses

43. **Joseph Earley** Joseph Earley is Chief Operating Officer for Fox Broadcasting Company, the division of the Defendant responsible for Broadcasting the television series "glee" complained of in this action. He gave evidence about the television programme, the concert tour, merchandising activities and branding. I found him to be a straightforward witness. He was asked questions outside his area of knowledge and, understandably, could not answer them.
44. **Nicholas Wilks** Nicholas Wilks is Master of Music at Winchester College. He gave evidence about the Winchester College choral society which is named "Glee Club" and is not prefaced by the definite article or the name of the College. It was formed in 1864. He stated that it has over 100 members and gives two concerts each year. It performs choral works including recent performances of Britten's War Requiem and the Verdi Requiem. He gave evidence that, to him, the phrase "glee club" normally

means a group of people singing glees or partsongs. He was cross-examined as to how he was contacted by the Defendant's solicitor and the history of Glee Club at Winchester College.

45. **Catherine Smith** Catherine Smith is the Archivist at Charterhouse School. She gave evidence of the history of Charterhouse Glee Club which was founded in about 1873 but fell into abeyance after 1894. She reported finding references to House Glee Competitions up to 1929. She stated that a musical society called "Glee Club" was revived recently at Charterhouse with its first performance in spring 2012. She was cross-examined about how she was contacted to give evidence and about how she had obtained the information about the Glee Club history from the school archives. She stated that she thought that the Glee Club formed in 2012 had been inspired by the TV series.
46. **Stewart Rayment** Stewart Rayment is an intellectual property consultant and a member of the Liberal Democrat Party and is an organiser of the Liberal Democrat Glee Club ("the Glee Club"). He gave evidence about the Glee Club stating that his knowledge of it dated back to about 1969. He described how the Glee Club developed from an informal get together around a piano at the original Liberal Party conferences to a larger, more formal affair on the last evening of the Liberal Democrat Party conference with about 500-600 people attending. He stated that he had noticed the advertisement of the Claimant's trade mark application in the Trade Marks Journal in 2001 and had considered opposing it but decided not to as it was a device mark and wasn't prepared to spend the money required to oppose it formally. He was cross-examined about his interest in attacking the Claimant's trade mark registration now and it was suggested to him that he had an interest in the Defendant succeeding in attacking the Claimant's registration. He denied that that was his reason for giving evidence in this case.
47. **John Vargas** John Vargas is a retired school master and former deputy headmaster at Harrow School. He gave evidence about an inter-house singing competition at Harrow School called "Glees and Twelves" which has taken place since at least 1898. He was cross-examined about how he was contacted to give evidence and as to his sources for the history of glee singing at Harrow School. He accepted that, so far as he knew, there was no reference to a Glee Club at the school.
48. **Mark Pearson** Mark Pearson is Senior Vice President of Brand Management and Strategy for Twentieth Century Fox Television, the division of Twentieth Century Fox Film Corporation responsible for the production of the television series "glee". He gave evidence about the merchandising and marketing with respect to the live Glee tour, which took place in the United Kingdom between June 22 2011 and June 30 2011. He gave examples of the advertising material for the tour and stated that all of the promotional activities included reference to the glee television series and was specifically targeted to fans of the television series. He exhibited images of some of the promotional merchandise produced for the tour. Mr Pearson was cross-examined by video link about the targeting of the advertising material and the link to the TV series.
49. **Nicola Redpath** Nicola Redpath is the Customer Experience Manager at the UK television broadcaster British Sky Broadcasting ("BSkyB"). She gave evidence in her witness statement that she had run a report on the 26th April 2013 to look at the complaints and enquiries B SkyB had received in relation to the television programme "glee". The report showed no complaints had been received and she stated that her colleagues told her that the only enquiries they have received in relation to "glee" were concerned with scheduling and the release date for the next series. She also stated that B SkyB had not received any OFCOM reports relating to glee. When she went into the witness box she gave evidence that she had become aware of one complaint in relation to "glee" after her witness statement had been submitted. The complaint related to the way in which the issue of bulimia had been treated in an episode of "glee". She was cross-examined about the search carried out for complaints and was unable to account for the lack of complaints which conflicted with her statement that her colleagues had told her that they received enquiries about scheduling and release dates. Ms Redpath was a straightforward witness trying her best to help the court however it appeared that the search for

complaints had not been carried out in a very satisfactory way.

50. **Gillian Hay** Gillian Hay was formerly the Head of Acquisitions at the UK television broadcaster, Channel 4 Television Corporation, responsible for sourcing, selecting and acquiring non-commissioned content. She gave evidence of complaints received in relation to Channel 4's broadcasting of "glee" on its E4 channel. She produced a copy of complaints logged in relation to "glee" by Channel 4. She confirmed that Channel 4 had never received any complaints which mention "the glee club", "**Comic Enterprises**" or "CEL". She was cross-examined in particular about complaints received by Channel 4 about the broadcasting of an episode of "glee" in which a Gary Glitter song was played.
51. **Richard Cameron** Richard Cameron is a playwright for theatre, television and radio. He gave evidence concerning the creation by him of the play "The Glee Club" which premiered at the Bush Theatre in 2002 before transferring to the Duchess Theatre in London's West End before a national tour and adaptation as a radio play for BBC Radio 4. He stated that he had discovered a booklet written by a miner which had a chapter about "The Edlington Glee Singers" and this gave him the idea for his play. He also said that he is sometimes asked if his play is connected to the TV series. He was cross-examined as to his choice to use "Glee Club" rather than "Glee Singers" and his description of "Glee Club" as being quirky. He accepted that people who asked him if his play is connected to the TV series did so because of the name.
52. **Ian Brennan** Ian Brennan is a freelance television writer, actor, producer and director contracted by Twentieth Century Fox Film Corporation to be an executive producer for the television series "glee". He gave evidence as to the common usage of the word "glee" and the phrase "glee club" in the United States. He was the person mainly responsible for the creation of the series and sets out the history of the selection of the name. Mr Brennan was cross-examined by video link concerning his use of the term "Glee Club" in his witness statement in preference to the term "Show Choir" which has been used to describe the same thing in numerous other articles.
53. **Caitlin Hood** Caitlin Hood is Vice President of Social Media for Fox Broadcasting Company. She gave evidence by witness statement and was not cross-examined. Ms Hood gave evidence about social media marketing for the "glee" series. She stated that the Fox dedicated account teams from the external media agencies responsible for moderating content on the Glee Facebook Page have not seen any comments on the Glee Facebook Page related to **Comic Enterprises Limited** or to its comedy clubs in the United Kingdom.
54. **Stephen Homer** Stephen Homer is the Senior Vice President of UK at the live entertainment company Live Nation UK. He gave evidence by witness statement. He was on holiday at the time of the trial and a Civil Evidence Act Notice was served in respect of his evidence. He gave evidence about the "Glee Live! In Concert!" tour in the United Kingdom. He said that there were only three complaints about the tour: two in relation to a customer's inability to see and one in relation to unavailability of tickets.
55. **Stephanie Koeckler** Stephanie Koeckler is the Senior Vice President for Europe, Middle East and Africa for Twentieth Century Fox Consumer Products which is the division of Twentieth Century Fox Film Corporation responsible for licensing the production of Glee merchandising items worldwide. She gave evidence of the merchandising process used by Fox in general and the specific details relating to "glee". She gave a list of licensees and produced pictures of some of the licensed products. She identified certain consistent or repeated characteristics as follows:

- i) Clear and prominent use of GLEE in lower case letters in a sans serif font;
- ii) Prominent use of the word GLEEK (a word combining GLEE and

GEEK);

iii) Strong primary colours, particularly red and yellow;

iv) For merchandising during the first season, the "L for loser", and for the second season, an open mouth; and

v) Use of images of characters from the series.

Ms Koeckler also gave a list of the major retailers through whom licensed merchandise has been sold in the United Kingdom. She stated that none of the licensees has ever raised any concern about potential conflict with the Claimant. She gave evidence of the results of internet searches carried out by the Defendant's solicitors using search terms such as "glee club uk" and "glee club school uk".

56. Ms Koeckler was cross-examined about her evidence which was largely facts that were not within her direct knowledge.

The Scope of the registration

57. Mr Malynicz raised various issues as to the scope of the trade mark registration and its validity. I shall deal with these before considering the question of infringement.

58. The first issue is the effect of the claim to colours in respect of one of the two marks in the series and the effect of that claim on the scope of protection afforded to the registration.

59. The first of the two marks in the series claimed the colours red, black and white. On the electronic version of the Register there is a heading "Mark Description/Limitation:" and next to this it says: "LIMITATION: The applicant claims the colours red, black and white as an element of the first mark in the series." It is unclear from this as to whether it is a **claim** to those colours or the mark is **limited** to those colours.

60. This is an important distinction. Section 13 of the Trade Marks Act 1994 provides in material part as follows:

s.13 "An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may:

(a) ...

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

*And where the registration of a trade mark is subject to a disclaimer or limitation, **the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.**"*

(emphasis added)

61. As Jacob LJ held in *Phones4U* at [60] to [70], the effect of a limitation is that it is simply not an infringement of this mark to use the same words or devices in other colours. This is not merely a factor that goes into the assessment of a likelihood of confusion but is a limit on the rights of the trade mark proprietor even before one gets to that assessment. In the case of a claim, if the colours used by the alleged infringer are different from those claimed then it is a question of comparing the two signs in their different colours and assessing the likelihood of confusion.

62. Because of the confusing way in which this mark is described on the Register it was agreed that the parties would write to Mr Alan James, Acting Divisional Director, Trade Marks and Designs. Mr James responded commendably promptly. His reply makes it clear that this mark is not limited to the three colours but that there is merely a claim to the mark in those colours:

"The registration in question should contain only a colour claim relating to the first mark in the series of two. The word LIMITATION should not be included in the data field for this trade mark. The colour claim was all that appeared on the register up until 31 March 2013 when the register was transferred to a new electronic system. Investigation of your enquiry has revealed that the way we migrated data to the new system resulted in some colour claims being incorrectly qualified by the word LIMITATION.

"A colour claim is not a limitation of rights under s.13 of the Trade Marks Act 1994. Rather it is a description of the mark simply confirming that the colours shown are intended to form part of the subject matter of the trade mark (as opposed to incidental of colour as used to happen from time to time when applications were filed on paper). This clarification was required by Rule 5 of the Trade Mark Rules 1994 as amended by the Trade Mark (Amendment) Rules 1998, SI 1998/925, which applied at the time of the application in question, but which is no longer required."

63. This is not the end of the matter since Mr Malynicz had an argument about the effect of a series where one of the series is in colour and the other is not, even where there is no limitation to those colours as opposed to a claim to those colours.

64. By section 41(2) of the Trade Marks Act 1994:

"A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matter of a non-distinctive character not substantially affecting the identity of the trade mark."

65. Monochrome trade marks cover all colours. The Defendant is prepared to accept for the purposes of this action that the two marks are properly registered as a series. It says as a consequence of this that, effectively, the colour claim applies to both versions of the mark. The monochrome mark includes a variant that is identical to the coloured version and any other colours, it is argued, are different in a way that does affect the identity of the trade mark.

66. The effect of this is that the two marks are identical and there is no point in having them registered as a series. There may be cases where there are differences of a non-distinctive character, but where, as here, the only potential differences are the colours there is little scope for differences of a non-distinctive character.

67. In support of this argument Mr Malynicz referred me to a number of decisions by the Appointed Person. I set out below the relevant paragraphs of his skeleton argument:

92. In *Logica plc's Trade Mark Application* (0/068/03), Professor Ruth Annand, sitting as the Appointed Person, traced the background to section 41 of the Trade Marks Act 1994, noting that it is not permissible to interpret these provisions in a manner that is incompatible with, or defeats the intentions behind, the substantive law framework of the Directive. She also compared the provisions with section 46(2), relating to genuine use of distinctively similar marks. Those do correspond with the Directive, namely

10(2)(a) of the Directive.

93. In *Digeo Broadband Inc's Application* (0/305/03) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, also compared the provisions against the use provisions in section 46(2), concluding at paragraph 4:

"... that marks can be distinctively similar [under section 46(2)] without necessarily satisfying the statutory requirements for registration as a series under section 41(2)]"

94. Mr Hobbs QC developed the point in *Gateway Inc's Application* (0/322/03), adding at [20]

"I consider that the identity of a mark resides in its specific individuality, assessed according to the way in which it would be perceived and remembered by the average consumer of the goods or services concerned. The average consumer is for that purpose taken to be reasonably well-informed and reasonably observant and circumspect. Marks presented for registration as a series must each be assessed from that perspective when they are being compared for the purpose of determining whether they satisfy the requirements of section 41(2) ... The need for comparison of the marks inter se is clear. The intensity of the examination that may be needed in order to arrive at a conclusion on the acceptability of a series application can be seen from the decision issued under the parallel provisions of the Trade Marks Act 1955 (Cth) in *Re Application by Johnson and Johnson* (1993) 28 IPR 167.

Round observations as to the general nature or common characteristics of the marks in issue are seldom, if ever, likely to be sufficient. **The statute calls for a finding that all visual, aural and conceptual differences are insubstantial in terms of their effect upon the identity of the reiterated trade mark.**" (emphasis added)

95. In *Sony Ericsson* (0/138/06), Richard Arnold QC (as he then was) sitting as the Appointed Person, approved the approaches of Prof Annand and Mr Hobbs QC as set out above, further pointing out that a number of provisions of the 1994 Act made specific reference to "a [or the] trade mark" **in the singular**, including the concluding words of section 41(2) itself. Mr Arnold QC noted that in *Sieckmann v Deutsches Patent- und Markenamt* (Case C-273/00) [\[2003\] RPC 38](#) at [53] the CJEU had said that:

"... in order to fulfill its role as a registered trade mark a sign must always be perceived unambiguously and in the same way so that the mark is guaranteed as an indication of origin."

96. Mr Arnold QC noted that the CJEU had subsequently reinforced this point in *Heidelberger Bauchemie GmbH* (Case C-49/02) [2004] ETMR 99.

97. At [19] Mr Arnold QC stated:

"Only if the differences between the marks presented for registration are insubstantial in terms of their effect upon the identity of **the** trade mark do they qualify as a series. **It follows that a series consists of a number of different manifestations of what is in essence the same trade mark**"

(emphasis added)

98. He went on to hold in order to constitute a series, the marks must satisfy the "double identity" test in *LTJ Diffusion v Sadas* (Case C-291/00) [2003] FSR 34. At [22], he said:

"It would be consistent with this interpretation of the Directive to permit registration of a series of marks which were identical to each other in this sense. **If the differences between the marks are so insignificant that those differences may go unnoticed by an average consumer, then the marks are functionally identical to each other and provide what is in essence a single point of comparison for the question "identical or not?"** when judging any question of alleged conflict under sections 5(1) or 10(1) of the 1994 Act. By contrast, it would in my judgment not be consistent with the Directive to permit registration of a series of marks which were not identical to each other in this sense."

99. At [23] Mr Arnold QC gave an example of two marks which would be regarded as functionally identical and which could therefore be registered as a series, namely:-

MERKINS LODGEMENT CENTRE

MERKINS LODGMENT CENTRE

100. At [24], in a passage of particular relevance to the current case, Mr Arnold QC added:

"For the avoidance of doubt, I should explain that the "single point of comparison" to which I have referred may be pitched at a greater or lesser degree of generality according to context.

Thus if the mark is a pure word mark, then it will embrace a variety of different typographical presentations of that word. **If the mark is a device mark represented in monochrome with no colour claim or limit, then it will embrace reproductions of that device in a variety of colours.** The position is otherwise if the mark is a word in a particular script or a device in a specific colour or combination of colours.

(emphasis added)

101. Applying the above guidance to the current case, it seems that, according to the approach in *Sony Ericsson*^[3], CEL's marks are properly registered as a series under section 41(2) because, although the first mark is a mark in colour, the second mark is in monochrome. Because the

monochrome mark means that it is properly to be regarded as being registered in all possible colours (see the discussion of Jacob LJ in *Phones4U Ltd & Ors v Phone4u.co.uk Internet Ltd & Ors* [2007] RPC 5 at [49]ff, and of Kitchin LJ in *Specsavers v Asda* [2012] FSR 19 at [96]) that means that the red/black/white mark is identical to it.

102. However, even if the two marks are validly registered as a series that is not the end of the matter. A point not considered in *Sony Ericsson* or the other cases is that one still has to consider how to compare the earlier mark **as a single mark** against the signs in issue.

103. No doubt CEL will seek to rely on the broadest mark, the monochrome mark, arguing that catches all of Fox's uses of *Glee* in whatever colour they are.

104. In Fox's submission, that would be the wrong approach. The starting point must be that, because they are a series, one cannot ignore either mark. Notionally one has to arrive at a mark which, in some sense, represents them both, a mark which **"is"** them both, as the case law cited above shows.

105. Only a red/black/white mark can do that, because only a red/black/white mark is the same as both marks in the series (exactly the same as the first mark and functionally identical to the second).

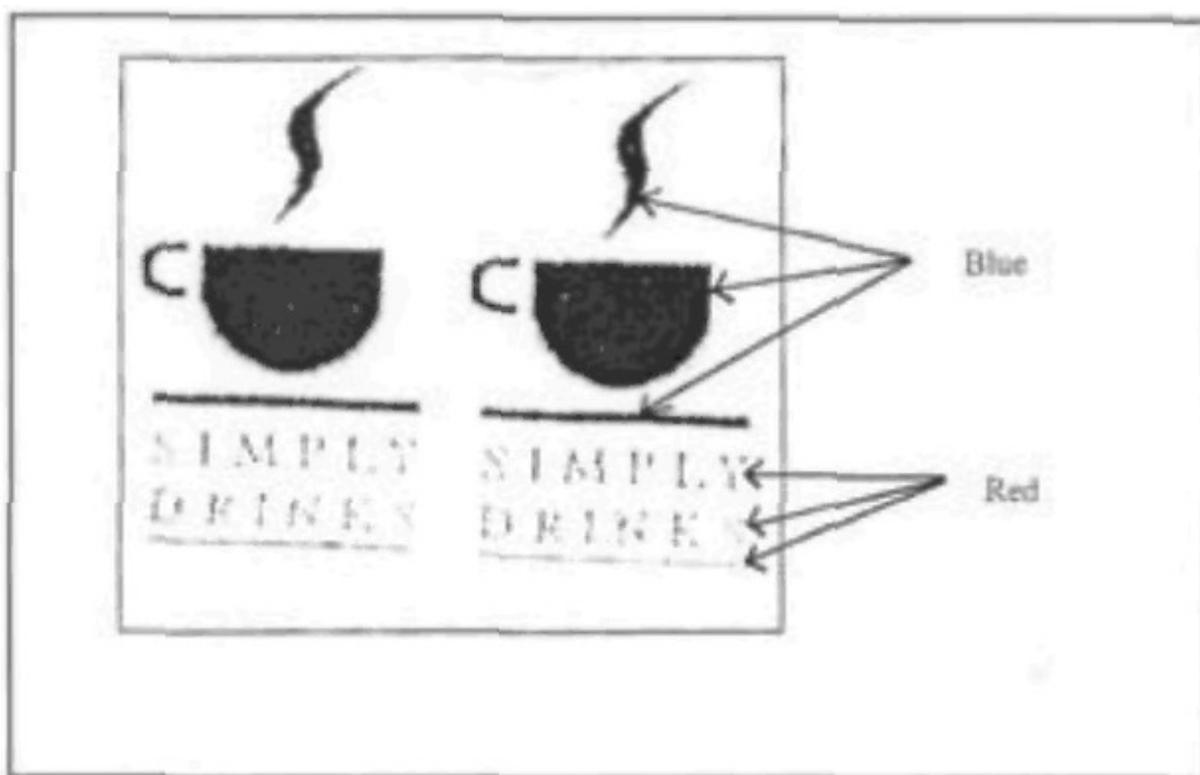
68. Mr Campbell countered by referring to the UK Intellectual Property Office Manual of Trade Marks Practice where it deals with series marks and, particularly the section that deals with colours.

2.7 Colour marks:

acceptable:

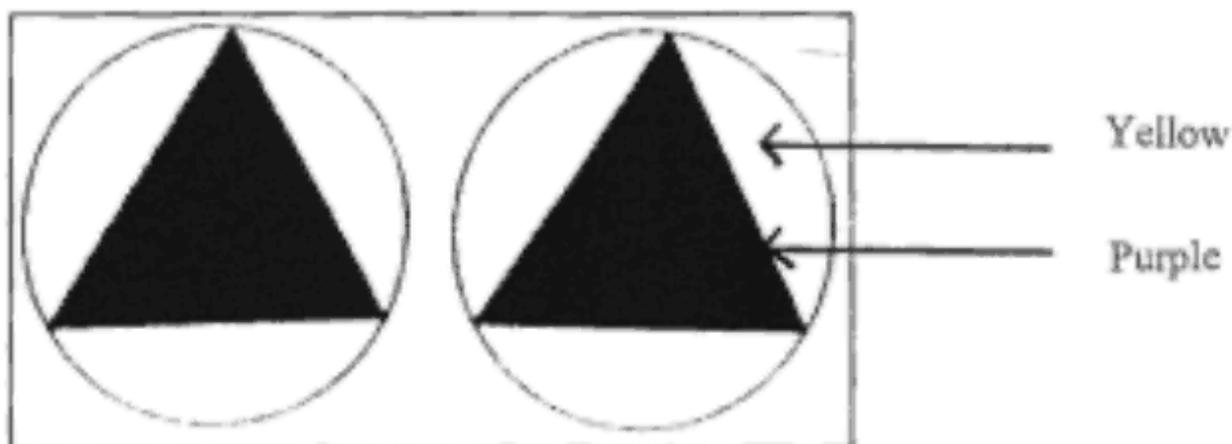
The second mark in the series is shown in the colours blue and red.

(Class 30) Coffee, tea, cocoa, sugar; rice; tapioca; sago; artificial coffee.



Although the second mark is limited to the colours blue and red, the colours add little to the material particulars of the second mark. The colours are non-distinctive *per se* and their presence or absence does not substantially affect the visual identity of the second mark. These marks are a series.

unacceptable:



The second mark in the series is shown in the colours purple and yellow.

(Class 1) Chemical preparations and substances.

Although the essential shape of the marks is the same, the first mark is merely a black and white representation of a triangle set within a circle, whereas the material particulars of the second mark includes colour, which in this case accounts for a significant part of the distinctive character of the second mark. The identity of the second mark is therefore substantially different to the first and the marks are not a series. The addition of colour combinations to simple geometric shapes will often have a substantial effect on the identity of the marks. The same applies when different colour combinations are applied to the same simple geometric shape.

69. Mr Campbell submitted that this was a case on all fours with the first example given in the Manual. I agree. However, that is only a guidance on practice within the IPO and is not necessarily correct in

law.

70. The Manual represents a common sense approach to the registration of series marks. I accept that Mr Arnold QC (as he then was) is correct in stating that to comply with the Directive, the marks in a series "*must provide what is in essence a single point of comparison*". I do not accept that that requires the marks to be visually identical. It is well established as Mr Arnold QC also stated that: "*If the mark is a device mark represented in monochrome with no colour claim or limit, then it will embrace reproductions of that device in a variety of colours*" If the registration was not for a series mark but was for a single mark, being the monochrome version, that would not fall foul of the requirement for a single point of comparison. I do not see why adding a further mark to the monochrome version, where that further mark is totally subsumed within the monochrome version, changes the position. In any event, if the colours are non-distinctive *per se* and their presence or absence does not substantially affect the visual identity of the mark, then I believe that the two marks are correctly registered as a series mark.
71. In the present case, I do not see the colour combination as being a part of the distinctiveness of the registered trade mark. The distinctive characteristics of the two marks, being the words and device, are identical.
72. I would just add that if Mr Malynicz is correct and the two marks are to be treated as comprising the lowest common denominator, i.e. both claiming the colour combination of red, black and white, then this could be infringed by a sign incorporating a different combination of colours but having the same impression of contrast.
73. Mr Malynicz accepted, for the purposes of this case, that the mark was correctly registered as a series. I believe that he was correct to do so. There is no ground of attack which provides for the invalidation of a trade mark because it has been improperly registered as a series. All the cases cited by Mr Malynicz as to the registrability of series marks are, as they must be, appeals from the UK IPO during the prosecution stage of trade mark applications.

Non-Use

74. The next issue raised by Mr Malynicz is the partial revocation of the registration for non-use under section 46 of the Trade Marks Act 1994
75. Section 46(1) of the Trade Mark Act provides as follows:

46. - (1) 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 nonuse;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- (d) that in consequence of the use made of it by the proprietor or

with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

76. In addition, there are provisions relating to partial revocation at s. 46(5), as follows:

(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.

77. In *BDO (Stichting BDO v BDO Unibank)* [2013] EWHC 418 (Ch) at [51], Arnold J quoted and approved a list of principles extracted from the CJEU authorities, which govern the requirement for genuine use, provided by Anna Carboni, sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42]. Arnold J added references to the *Sunrider* case, which were not included in the decision in *SANT AMBROEUS*. The learned judge's list is:

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

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].

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].

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].

Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: Ansul, [37].

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].

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].

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]

78. There are two more points to be satisfied. First, to be vulnerable to a non-use attack, the Mark must have been actually on the register of trade marks for at least 5 years. That is the case here. Second, the onus is on the proprietor of the registration to establish use.

79. Mr Malynicz relies on the following passage from his cross-examination of Mr Tughan as his starting point that there must be at least revocation in part:

14 Q. I understand that. Even at that stage although you were
15 extremely fortunate in having the mark on the register, you
16 got it, you got that wider protection, you acknowledged, as
17 did your attorney, that the mark went wider than what you
18 actually provided?

19 A. Yes.

80. Of course, that does not, of itself, make out the objection raised. Mr Tughan's (or indeed, his attorney's) view as to the width of the protection obtained is irrelevant. It is necessary to look in detail at the specification of the registration and the evidence of use that has been put forward by the Claimant. The Mark is registered in both Class 25 and Class 41.

81. Looking first at the specification for Class 25, the Mark is registered for:

"Articles of outer clothing; articles of sports clothing; footwear; shirts; shorts; T-shirts; socks; sweatshirts; sweaters; headgear; scarves; jackets; braces; wrist bands; tracksuits; ties; belts."

82. The only goods within Class 25 that the Claimant claims to have sold bearing the Mark are T-shirts. I have seen "artwork approval forms" showing a T-shirt which has the Mark on the left (from the wearer's point of view) top of the front. Underneath are the words "Brilliant comedy, incredible music" in large letters over two lines and underneath in smaller letters "Birmingham • Cardiff • Nottingham • Oxford" and underneath that in the same size lettering "glee.co.uk". Mr Tughan was cross-examined about sales of these T-shirts.

13 MR. MALYNICZ: You can look in either. Bundle A, tab 2, page 26.

14 (To the witness) In your third witness statement, you refer to
15 the fact, as you put it, that you have used the mark in
16 relation to clothing. I want to suggest to you that that is
17 not correct. You have not used the mark in relation to
18 clothing, or there is no evidence of that in this case. Do
19 you agree with that?

20 A. We always attempted to sell some T-shirts, that is about as
21 far as it has gone.

22 Q. You never actually sold?

23 A. No, we have sold some.

24 Q. When you say "attempted", these were T-shirts bearing the logo
25 of the mark?

1 TUGHAN - MALYNICZ

2 A. Yes.

3 Q. These were merchandise effectively?

4 A. Yes.

5 Q. They were T-shirts basically for people who might be in the
6 venue who wanted something to take home?

7 A. Yes, and anybody else who might know or think they might be an
8 interesting brand.

9 Q. Sell them or give them away?

10 A. Sell them.

11 Q. Were these worn by staff?

12 A. I think they have only been worn by staff for the purposes of
13 photography, no they have not been worn by staff. We have an
14 e-bay shop and we occasionally put some up for sale. Some
15 times they sell and sometimes that I do not.

16 Q. Are you aware of the relevant dates when did you make these
17 sales, alleged sales?

18 A. I think we might have sold some way back in the 90s and we
19 have sold a few in the last few years. It has been an on/off
20 experience.

21 Q. How many are you talking about?

22 A. In total over the 19 years, probably less than 20.

83. During the subsequent cross-examination, Mr Tughan referred to making sales of a couple of T-shirts on eBay in the last couple of years. No disclosure had been given in respect of these sales and Mr Tughan was asked to produce documentary evidence of these sales. The day before the end of the trial he produced a document showing five buyers on eBay between 2007 and 2011 without any details of what they bought.

84. Taking this evidence together with the clearly promotional wording on the front of the T-shirts I do not accept that this was genuine use sufficient to prevent the Mark from being revoked in respect of the specification of goods in Class 25. It seems clear that, although the T-shirts were being sold, this was purely in order to promote the Claimant's business as a venue and not aimed at creating or maintaining an outlet for the goods. Insofar as the registration covers Class 25 goods it must be revoked.

85. So far as Class 41 is concerned the specification is:

"Entertainment services; comedy services; night-club and cabaret entertainment; music hall and orchestra services; show production services; provision of live and recorded music; dancing; amusement arcades; provision of recreational facilities; organisation of contests and competitions; production and/or presentation of radio and television programmes, live shows, displays, films and of sound and video recordings; booking agency services; rental of radio and television programmes, films and of sound and video recordings; publication services; consultancy, advisory and information services relating to the aforesaid services."

86. The Defendant accepts that the Claimant has provided, under the Mark, the following services that are within the specification of the registration under Class 41 and submits that the specification should be revoked in respect of all other services:

a) Arranging of live stand-up comedy shows;

- b) Discotheque services, nightclub and cabaret entertainment;
- c) Provision of facilities for live stand-up comedy and live bands; and
- d) Arranging performances by live bands.

87. The Claimant says that it has provided services under the Mark as indicated by the representation of the existing classification with those services the Claimant accepts that it has not provided under the mark being struck through:

"Entertainment services; comedy services; night-club and cabaret entertainment; music hall and orchestra services; show production services; provision of live and recorded music; dancing; ~~amusement arcades;~~ provision of recreational facilities; organisation of contests and competitions; production and/or presentation of ~~radio and television programmes;~~ live shows, displays, ~~films~~ and of sound ~~and video~~ recordings; ~~booking agency services;~~ rental of ~~radio and television programmes,~~ ~~films~~ and of sound and video recordings; publication services; consultancy, advisory and information services relating to the aforesaid services."

88. Taking each of the remaining services I set out below the parties respective positions and my conclusions as to the use made. I shall then make an overall assessment of the scope of the specification this use justifies.

Entertainment services

The Claimant admits that this classification is broad enough to cover a wide range of types of entertainment that no single organisation could legitimately claim to carry on business in every single form of entertainment. However, it claims that entertainment services is a fair description of what the Claimant does and that all of the services covered by the term are linked by the notion of entertainment and it is arbitrary to draw distinctions between them.

The Defendant's case is that this is an implausibly broad term that includes all manner of services entirely unlike anything the Claimant has done. It relies on the cross-examination of Mr Tughan where he accepted that the classification goes wider than the services the Claimant actually provides.

Conclusion: The Claimant has used the Mark in relation to some entertainment services.

Comedy services

This is the core of the Claimant's business.

The Defendant accepts that the Claimant has offered comedy entertainment but points out that this is all live and not recorded. It suggests that this should be limited to "live comedy services".

Conclusion: The Claimant has used the Mark in relation to live comedy entertainment. *Nightclub and cabaret entertainment*

The Defendant accepts that the Claimant has used the Mark for these services.

Music hall and orchestra services

Mr Tughan's evidence is that the Claimant puts on over 100 music events each year across Birmingham, Cardiff and Nottingham covering the musical genres singer-songwriters, jazz, blues, soul and world roots music. It also hires out its venues to outside promoters. He produces an article

from Music Week in 2007 which comments: "*The Glee Club has quietly forged a name for itself on the live music circuit by specialising in intimate gigs from a series of achingly credible singer songwriters.*" It goes on to praise the seating policy and the staff.

The Defendant dismisses this evidence as "*simple assertions of having carried out work with agents/promoters and the staging of musical events*". It says that there is no proof of use of the Mark in relation to any of these services. It also says that "*simply working with a musical agent and/or putting on a musical event of some sort does not amount to the provision of music hall and/or orchestra services*".

Conclusion: The Claimant has used the Mark in relation to the provision of music hall services.

Show production services

The Claimant's evidence mostly relates to shows that were arranged after the relevant date. There are documents relating to the V Festival in 2011 at which the Claimant provided comedy in a tent.

The Defendant says that providing comedy in a tent is not show production services. It also says that photographs show use of marks in forms different to the registered mark. It does appear that the backdrop in the tent has just the word "glee" in white on a red background with no device. However, there is the use of the device mark in yellow and green on a running order sheet and a stretched version of the Mark in red, black and white on the outside of the tent.

Conclusion: The Claimant has not used the Mark in relation to the provision of show production services.

Provision of live and recorded music

The Claimant's evidence is that they put on live music and discotheque evenings at their venues.

The Defendant concedes that the Claimant has used its registered mark in respect of the provision of live bands and discotheques but says that the specification as it stands is too wide and should be limited to the provision of live bands and discotheques.

Conclusion: The Claimant has used the Mark in relation to the provision of live and recorded music. This has been in respect of a wide range of genres of music and performers.

Dancing

Mr Tughan gives evidence that he became a franchisee for Ceroc dancing and used the Birmingham venue as the location for a weekly dance class and used to advertise it under the Glee Club. He stopped this activity in 2009 so it was active during the relevant period.

The Defendant suggests that this was merely the provision of a space in which others would come and learn to Ceroc-dance and was not the provision of dancing services.

Conclusion: The Claimant has used the Mark in respect of dancing services by providing lessons in Ceroc dancing from its premises.

Provision of recreational facilities

The Claimant relies upon the provision of the live comedy acts venue and the provision of the comedy tent at the V Festival.

The Defendant submits that this is merely the provision of facilities for live stand-up comedy and live

bands.

Conclusion: The Claimant has used the Mark in respect of the provision of facilities for comedy and music entertainment.

Organisation of contests and competitions

The Claimant has provided evidence that it has hosted the BBC Comedy Awards.

The Defendant submits this is mere hosting and not organisation of the contest.

Conclusion: The Claimant has not used the Mark in respect of organisation of contests and competitions.

Production and/or presentation of live shows, displays and of sound recordings

The Claimant relies on its presentation of live comedy shows and discotheques. It also relies on providing its premises for the recording of TV and radio shows. It has also put on live burlesque evenings.

The Defendant admits that the Claimant has provided presentations of live bands and live stand-up comedy but says that there is no evidence of displays, nor of production or presentation of sound recordings.

Conclusion: The Claimant has used the Mark in respect of the production and presentation of live shows and displays and the presentation of sound recordings.

The Claimant's evidence shows that it has produced flyers and brochures advertising its shows and has sent out newsletters, although not within the relevant period.

The Defendant submits that this is not the provision of publication services since there is no customer of these services. They are merely activities promoting the Claimant's business.

Conclusion: The Claimant has not used the Mark in respect of publication services.

Consultancy, advisory and information services relating to the aforesaid services

The Claimant relies on evidence of two examples of providing advice.

The Defendant points out that both examples are outside the relevant period.

Conclusion: The Claimant has not used the mark in relation to consultancy, advisory and information services relating to the aforesaid services.

89. I now need to decide what specification of goods is appropriate, having regard to the use that I have found the Claimant to have made under the Mark.
90. The European approach is as set out in *Reckitt Benckiser v OHIM (ALADDIN)* (Case T-126/03 and was followed in the *Aleris* case (T-353/12):

18 Moreover, pursuant to the case-law, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods

or services for which the trade mark has actually been used belong (Case T126/03 *Reckitt Benckiser (España) v OHIM - Aladin (ALADIN)* [2005] [ECR II-2861](#), paragraph 45, and Case T256/04 *Mundipharma v OHIM - Altana Pharma (RESPICUR)* [2007] [ECR II-449](#), paragraph 23).

19 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. In that regard, it should be observed that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories (*ALADIN*, paragraph 46).

91. In *Mundipharma v OHIM* (Case T-256/04), the GCEU held that the consumers' approach is fundamental in considering definitions of sub-categories of goods or services:

"29 The Court notes in this respect that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a sub-category of goods or services."

92. Arnold J in *BDO* summarised the law:

55. In *NIRVANA Trade Mark* (BL 0/262/06), when sitting as the Appointed Person, I reviewed the decisions of the English courts in *MINERVA Trade Mark* [2000] FSR 734, *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] [RPC 17](#), *DaimlerChrysler AG v Alavi* [2001] [RPC 42](#), *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] [EWCA Civ 1828](#), [2003] [RPC 32](#), *West v Fuller Smith & Turner plc* [2003] [EWCA Civ 48](#), [2003] [FSR 44](#), *Associated Newspapers Ltd v Express Newspapers* [2003] [EWHC 1322](#), [2003] [FSR 51](#) and *ANIMAL Trade Mark* [2003] [EWHC 1589](#), [2004] [FSR 19](#). I concluded at [57] that these were broadly consistent with *ALADIN*, but that to the extent there was a difference I was bounded by the English authorities. I went on:

"58. I derive the following propositions from the case law reviewed above:

(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

59. I would add a point which in my judgment is implicit in most of the decisions, although not explicit, which is that it is for the tribunal to frame a fair specification and not the parties. This is not to say, however, that the tribunal is either obliged or entitled to ignore considerations of procedural justice and efficiency: see the observations of Advocate General Sharpston in Case C-239/05 *BVBA Management, Training & Consultancy v Benelux-Merkenbureau* [2006] ECR I-1458 at [62]-[68]. ..."

56. In *EXTREME Trade Mark* [2008] RPC 2, again sitting as the Appointed Person, I considered the decision of the CFI in Case T-256/04 *Mundipharma AG v OHIM* [2007] ECR II-449 and continued as follows:

"54 Although at first blush this suggests an approach which is somewhat different to that laid down by the English authorities considered in *NIRVANA*, I consider that the difference is smaller than might appear. The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used. Likewise, paragraph [29] of *Mundipharma* indicates that the

matter is to be approached from the consumer's perspective.

55 To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J. in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch), [2004] FSR 19 is to be preferred to the slightly less generous approach of Pumfrey J. in *DaimlerChrysler AG v Alavi* [2001] RPC 42."

57. In *Daimler AG v Sany Group Co Ltd* [2009] EWHC 1003 (Ch), [2009] ETMR 58 Geoffrey Hobbs QC sitting as a Deputy High Court Judge summarised the correct approach at [10] as follows:

"... the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify. ..."

58. As Mr Hobbs added when sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Ltd v Gima (UK) Ltd* (BL 0/345/10) at 11:

"For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

93. I must therefore make a value judgment as to what is a "fair" specification in the light of the use that the Claimant has made of the Mark and putting myself in the position of the average consumer of the services in question. As a preliminary point, I believe that "entertainment services" is too broad. In particular, it would appear to encompass practically all of the other services within the existing specification. I believe that a fair specification would be:

Live comedy services; nightclub and cabaret entertainment; music hall services; provision of live and recorded music; dancing; provision of facilities for comedy and music entertainment; production and presentation of live shows and displays and the presentation of sound recordings.

94. Accordingly, I will revoke the registration in part to accord with that specification. I will hear argument in due course as to the date from which such partial revocation will take place.

Invalidity

95. The Defendant seeks partial invalidity of the registration pursuant to section 47(1) of the Trade Marks Act on the ground that it was registered in breach of section 3(1)(c) which provides:

The following shall not be registered -(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 or production of goods or of rendering of services, or other characteristics of goods or services.

96. The Defendant objects that the words "glee club" are descriptive and has adduced evidence to show that the words are and have been used in the United Kingdom to indicate the activities of a type of singing club and that glee club appears in English dictionaries.
97. The evidence has established that there are some "Glee Clubs" currently in existence in the United Kingdom and that they use those words in their title. It has not shown that this is a term that is known or understood by more than a very small section of the public. The majority of uses have been in respect of choral societies at a few traditional public schools in the United Kingdom, namely Winchester College, Harrow School and Charterhouse. There is also the Liberal Democrat Glee Club. There is no consensus amongst those who are aware of the term as to its precise meaning. This does not matter so far as the Defendant's case is concerned following the decision of the European Court in the *Doublemint* case (C-191/01) if at least one of its possible meanings designates a characteristic of the goods or services concerned.
98. The Claimant seeks to counter this attack in three ways. First, it points to the wording of the section which states that it applies where the trade mark consists "exclusively" of the descriptive sign. Here, it says, the trade mark is a composite which includes the spotlight device as well as the words "the glee club". The Defendant counters by referring to the UKIPO's initial refusal of the application for registration which stated: "*because the mark consists of the words "THE GLEE CLUB" and a non-distinctive device of a spotlight, the whole being devoid of any distinctive character for e.g. goods/services provided in relation to Glee Club activities such as singing etc.*" I do not accept that the device component of the Mark can be said to be devoid of any distinctive character. The Trade Marks Act (and the Directive from which it flows) does not set out a minimum level of distinctiveness for the part of the trade mark that is not descriptive. Accordingly, I reject this ground of invalidity. In case I am wrong, I shall consider the other points raised by the Claimant in defence of the registration.
99. The second counter is that the use of the term is obscure and not known to most people in the United Kingdom. That is in accordance with my finding on the evidence but is it enough to avoid this objection? The Defendant submitted that it does not actually matter if the descriptive indication is in use at the date of application for the mark. The only question was whether it could suitably be used. It also submitted that even if some or most people do not see a mark as descriptive, that would not preclude there being a public interest in avoiding registration of it so that others can use it descriptively without being on the end of lawsuits and the fact that the phrase may have been more popular in the past only goes to the issue of whether it is reasonably foreseeable that it is likely to be used again in the future.
100. The Defendant is correct to say that it does not actually matter if the descriptive indication is in use at the date of application for the mark. However, the descriptive indication must have some meaning to a significant portion of the public for it to fall foul of section 3(1)(c). Although *Doublemint* makes it clear that the objection is not avoided if there is more than one meaning but one of those meanings is descriptive, it does not follow that a term which would have no meaning to the vast majority of people is unregistrable merely because it is descriptive to a tiny minority of people and could become descriptive to a wider public. There are many words that have been in common parlance in the past but which have no meaning to the public now. There is no public interest in preserving those words on the basis that they may be used again in the future and be descriptive. The test is foreseeability and it is the foreseeability taking into account the relevant public. The Defendant submits that the test is not from the perspective of the UK population at large, but from the perspective of the particular

consumer in question and this is the average consumers of choral singing. Even accepting this, the Defendant's evidence does not establish the reaction of the average consumer of choral singing but rather the reaction of a small selected group of people with specialist knowledge. I find that the objection fails on this second ground also.

101. The third counter put forward by the Claimant is the proviso to section 3(1):

Provided that, a trade mark shall not be refused registration by virtue of paragraph ... (c) ... 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.

102. There is a similar proviso to section 47 (1), the section under which the counterclaim for invalidity is brought which allows the proprietor of a mark attacked on this ground to rely on use after the date of registration ("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"). This proviso was not pleaded.

103. It was put to Mr Tughan in cross-examination that throughout the life and use of the Mark he has been confronted with intermittent examples of people saying that 'glee club' is a generic term for an after school musical club. He answered that they could probably be counted on one hand. The specific examples put to Mr Tughan were sparked by a report of these proceedings. It would seem highly likely that the awareness of the meaning of 'glee club' was due to people's familiarity with the Defendant's series. I believe that the scale of the Claimant's use of the Mark was sufficient for the Mark to have acquired a distinctive character by the date of the application for registration and even more so by the date of the Defendant's challenge to the validity of the Registration in this action.

104. Accordingly, I find the Claimant's Mark validly registered for the limited specification of services I have set out above.

Infringement

105. The Claimant alleges infringement under both section 10(2)(b) and 10(3):

10 (2) A person infringes a registered trade mark if he uses in the course of trade a sign where because-

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered

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

...

10 (3) A person infringes a registered trade mark if he uses in the course of trade in relation to goods or services, a sign which is identical with or similar to the trade mark, where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

106. I shall consider infringement under section 10(2)(b) first.

Infringement under section 10(2)(b)

107. The manner in which the requirement of a likelihood of confusion in Article 5(1)(b) of the Directive and Article 9(1)(b) of the Regulation, and the corresponding provisions concerning relative grounds of objection to registration in both the Directive and the Regulation, should be interpreted and applied has been considered by the Court of Justice of the European Union in a considerable number of decisions, and in particular the leading cases of Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4861, Case C-3/03 *Matrazen Concord GmbH v Office for Harmonisation in the Internal Market* [2004] ECR I-3657, Case C-120/04 *Medion AG v Thomson Sales Germany & Austria GmbH* [2005] ECR I-8551 and Case C-334/05 *Office for Harmonisation in the Internal Market v Shaker de L. Laudato & C SAS* [2007] ECR I- 4529
108. The Trade Marks Registry has adopted a standard summary of the principles established by these authorities. There are a number of slightly different versions of the summary. The most accurate version, and the one which was cited with approval by Kitchin LJ in *Spec savers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24, [2012] FSR 19 at [52], is as follows:

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 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; and

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

109. First, it is necessary to compare the sign used by the Defendant with the Mark as registered. The sign is the word "glee" in lower case in one colour on a background of another colour. The sign is used in a range of different colours both for the lettering and for the background. Examples of some of the uses given in evidence by Mr Earley are set out below:



110. Visually the lettering is similar but not identical. The words "the" and "club" are not present and neither is the spotlight device. The colours used are not the same as the colours claimed in the representation of the Mark which includes a colour claim but there is frequent use of shades of red on a yellow background. The word "glee" is the most prominent feature in both the Mark and the sign.

111. Conceptually the Mark suggests a club whereas the sign does not. Once you have seen an episode of the Defendant's series you will appreciate that the story is about a club.

112. Aurally the Mark and sign are similar although the Mark will be spoken as The Glee Club whereas the sign will be referred to simply as Glee.

113. The Defendant has used the sign in relation to a number of things, the majority of which are:

- i) The television series;
- ii) A live show based on the television series;
- iii) DVDs of the different episodes of the series;
- iv) Merchandise, particularly items of clothing.

114. A picture of the clothing merchandise is set out below and, as can be seen, it also features the word "glee" in lower case in a similar script and in a range of colours:



115. I have come to the conclusion that, objectively, there is similarity between the Mark and sign but that it is not of the highest order. The next issue though is the reaction of the "average consumer". Who is the average consumer in this case?

116. In *Interflora v Marks & Spencer* Arnold J considered the meaning of "average consumer in trade mark law as propounded by the CJEU (and previously the ECJ):

194. It is well established that many questions in European trade mark law are to be assessed from the perspective of the "average consumer" of the relevant goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.

195. The first reference to the "average consumer" in the case law of the CJEU appears to have been in Case-51/93 *Meyhui v Schott Zwiesel Glaswerke* [1994] ECR I-3874, a case concerning the interpretation of Council Directive 69/493/EEC of 15 December 1969 on the approximation of the law of the Member States relating to crystal glass, at [18]. The concept of the "average consumer" was imported into trade mark law, specifically with respect to the assessment of likelihood of confusion, by the Court of Justice in *SABEL* at [23]. (The Court of Justice was anticipated by the English courts, however, as long ago as 1866, when Lord Cranworth LC said in a passing case that the question was whether "ordinary purchasers,

purchasing with ordinary caution, are likely to be misled" (*Seixo v Provezende* (1865-66) LR 1 Ch App 192 at 196). Indeed, in the first substantial English decision under the 1994 Act, Jacob J used the very term "average consumer" (*British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 300.)

196. In Case C-470/93 *Verein gegen Unwesen in Handel und Gewerbe Köln eV v Mars GmbH* [1995] ECR I-1923, a case concerning the interpretation of Article 30 of the EC Treaty (as it then was), the Court of Justice referred at [24] to "reasonably circumspect consumers".

197. In Case C-210/96 *Gut Springenheide GmbH v Oberkreisdirektor des Kreises Steinfurt - Amt für Lebensmittelüberwachung* [1998] ECR I-4657, a case concerning the interpretation of Council Regulation 1907/90/EEC of 26 June 1990 on certain marketing standards for eggs, the Court of Justice brought these two concepts together and articulated for the first time the average consumer test which it has subsequently repeated on many occasions (emphasis added):

"30. There have been several cases in which the Court of Justice has had to consider whether a description, trade mark or promotional text is misleading under the provisions of the Treaty or of secondary legislation. Whenever the evidence and information before it seemed sufficient and the solution clear, it has settled the issue itself rather than leaving the final decision for the national court (see, in particular, Case C-362/88 *GB-/A/A/0-BM* [1990] ECR I-667; Case C-238/89 *Pall* [1990] ECR I-4827; Case C-126/91 *Yves Rocher* [1993] ECR I-2361; Case C-315/92 *Verband Sozialer Wettbewerb* [1994] ECR I-317; Case C-456/93 *Langguth* [1995] ECR I-1737; and Case C-470/93 *Mars* [1995] ECR I-1923).

31 In those cases, in order to determine whether the description, trade mark or promotional description or statement in question was liable to mislead the purchaser, the Court took into account the *presumed expectations of an average consumer who is reasonably well-informed and reasonably observant and circumspect*, without ordering an expert's report or commissioning a consumer research poll.

32 So, national courts ought, in general, to be able to assess, on the same conditions, any misleading effect of a description or statement designed to promote sales."

198. It is clear from this that the Court was saying that a national court should determine whether a description, trade mark or promotional statement was liable to mislead by considering the matter from the perspective of "an average consumer who is reasonably well-informed and reasonably observant and circumspect". In general, it was not necessary to have expert evidence or consumer research for that purpose.

117. He then reviewed various other cases and concluded:

203. It can be seen from this review of the Court of Justice's early case law in this field that, even as it was propounding the average consumer test, the Court held that (a) a trade mark may be distinctive only to a proportion of the relevant class of persons, (b) there is a likelihood of confusion if there is a risk that the public might believe that the goods or services come from the same or economically-linked undertakings and (c) it is relevant for the national court to consider whether the description, trade mark or promotional statement in issue is liable to mislead or confuse a significant proportion of the relevant class of persons. Nothing in the Court's subsequent case law suggests that it has changed its mind on any of these points.

118. He then considered further European cases and went on:

208. Against this background, a number of points are common ground between the parties. First, the average consumer is, as Lewison LJ put it in *Interflora (CA I)* at [44] and [73], a "legal construct".

209. Secondly, the average consumer provides what the EU legislature has described in recital (18) of the Unfair Commercial Practices Directive as a "benchmark". As counsel for M & S put it, the test is a "normative" one. By assessing matters from the perspective of a consumer who is reasonably well-informed and reasonably observant and circumspect, confusion on the part of those who are ill-informed or unobservant is discounted.

210. Thirdly, as Lewison LJ stressed in *Interflora (CA I)* at [45]-[56], in a case concerning ordinary consumer goods and services, the court is able to put itself into the position of the average consumer without requiring expert evidence or a consumer survey. As Chadwick LJ said in *BACH and BACH FLOWER REMEDIES Trade Marks* [2000] RPC 513 at [41], in a passage which Lewison LJ emphasised in *Interflora (CA I)* at [41]-[43]:

"The task for the court is to inform itself, by evidence, of the matters of which a reasonably well informed and reasonably observant and circumspect consumer of the products would know; and then, treating itself as competent to evaluate the effect which those matters would have on the mind of such a person with that knowledge, ask the [relevant] question".

211. Fourthly, the average consumer test is not a statistical test in the sense that, if the issue is likelihood of confusion, the court is not trying to decide whether a statistical majority of the relevant class of persons is likely to be confused.

212. There is nevertheless a significant dispute between the parties with regard to the average consumer (and the reasonably well-informed and reasonably observant internet user, as to whom see below). Counsel for M & S submitted that the effect of the Court of Justice's case law is to create a single meaning rule in European trade mark law, that is to say, a rule that the use of a sign in context is deemed to convey a single meaning in law even if it is in fact understood by different people in different ways. Accordingly, he submitted that it is impermissible for the court to consider whether a significant proportion of the relevant class of persons is likely to be confused when determining an issue as to infringement. Counsel for Interflora

disputed that there is a single meaning rule in European trade mark law. He submitted that consideration of whether a significant proportion of the relevant class of persons is likely to be confused is not merely permissible, but positively required by the Court of Justice's case law. I shall consider this question in two stages. At this stage, I shall consider the position with regard to the average consumer test generally in European trade mark law. Below, I shall consider whether the position is any different in the case of the reasonably well-informed and reasonably observant internet user confronted with keyword advertising.

213. In my judgment there is in general no single meaning rule in European trade mark law. My reasons are as follows.

214. First, it is settled law that a trade mark may acquire distinctive character for the purposes of registration if it is distinctive to a significant proportion of the relevant class of persons: see in particular the passages from *Windsurfing* and *Philips* quoted above.

215. Secondly, as a matter of logic, it follows that it is necessary to consider the impact of an allegedly infringing sign upon the proportion of the relevant class of persons to whom the trade mark is distinctive. This must be so whether one is considering whether the use of the sign affects, or is liable to affect, the origin function of the trade mark under Article 5(1)(a)/Article 9(1)(a), whether there is a likelihood of confusion under Article 5(1)(b)/Article 9(1)(b) or whether there is a "link" and consequent harm under Article 5(2)/Article 9(1)(c).

216. Thirdly, as a matter of principle, it should be sufficient for a finding of infringement of a trade mark that a significant proportion of the relevant class of persons is likely to be confused. That is both damaging to the trade mark proprietor and contrary to the public interest.

217. Fourthly, I am aware of no decision of the CJEU which supports the proposition that there is a single meaning rule in European trade mark law. By contrast, there is ample authority which supports the opposite proposition. In addition to the cases cited in paragraphs 200-202 above, I would particularly mention three of the cases in which the Court of Justice developed its doctrine that infringement under Article 5(1)(a)/Article 9(1)(a) requires an adverse effect on the functions of the trade mark.

218. In *Arsenal* the Court of Justice held that Mr Reed's use of the sign Arsenal was liable to jeopardise the trade mark's guarantee of origin. In this context it stated (emphasis added):

"56. Having regard to the presentation of the word 'Arsenal' on the goods at issue in the main proceedings and the other secondary markings on them (see paragraph 39 above), the use of that sign is such as to create the impression that there is a material link in the course of trade between the goods concerned and the trade mark proprietor.

57. That conclusion is not affected by the presence on Mr Reed's stall of the notice stating that the goods at issue in the main

proceedings are not official Arsenal FC products (see paragraph 17 above). Even on the assumption that such a notice may be relied on by a third party as a defence to an action for trade mark infringement, *there is a clear possibility in the present case that some consumers*, in particular if they come across the goods after they have been sold by Mr Reed and taken away from the stall where the notice appears, *may* interpret the sign as designating Arsenal FC as the undertaking of origin of the goods."

219. In *Anheuser-Busch* the Court of Justice, having addressed the requirements for liability under Article 5(1) of the Directive, went on to address the "own name" defence under Article 6(1)(a) of the Directive, which is subject to the proviso that the defendant's use of the sign is in accordance with honest practices in industrial or commercial matters. In that context, the Court stated at [83] (emphasis added):

"In assessing whether the condition of honest practice is satisfied, account must be taken first of the extent to which the use of the third party's trade name is understood by the relevant public, *or at least a significant section of that public*, as indicating a link between the third party's goods and the trade-mark proprietor or a person authorised to use the trade mark, and secondly of the extent to which the third party ought to have been aware of that. Another factor to be taken into account when making the assessment is whether the trade mark concerned enjoys a certain reputation in the Member State in which it is registered and its protection is sought, from which the third party might profit in selling his goods."

The Court of Justice repeated this in *Celine* at [34].

220. Fifthly, it is clear from the case law of the Court of Justice surveyed above that the average consumer test applies in a number of different areas of unfair competition law (using that term in a broad sense). As with trade marks, so too in the neighbouring fields of unfair commercial practices and misleading and comparative advertising, the case law does not support the existence of a single meaning rule, but contradicts it: see in particular the cases cited in paragraphs 197-199 and 205-207 above.

221. Sixthly, I am not aware of any textbook or academic commentary which supports the existence of a single meaning rule in trade mark law. Nor am I aware of any authority from the superior courts of the other Member States to support the existence of such a rule.

222. Seventhly, I am aware of no domestic authority which supports the proposition that there is a single meaning rule in trade mark law. It is beyond dispute that English trade mark law prior to implementation of the Directive did not have a single meaning rule. Nor does English passing off law have such a rule. While it is possible that trade mark law may have changed as a result of implementation of the Directive and its interpretation by the CJEU, the only case in which this question has been directly addressed prior to the present one is *Hasbro Inc v 123 Nahrungsmittel GmbH* [2011] EWHC 199 (Ch),

[2011] ETMR 25, where Floyd J (as he then was) accepted Mr Hobbs QC's own submission that there was no such rule:

"169. The overall assessment must be performed through the eyes of the 'average consumer', see, for example, *Koninklijke Philips Electronics BV v Remington Consumer Products Ltd* (C-299/99) [2002] ECR I-5475; [2002] ETMR 81 at [65]. Yet, as the above citation from *Lloyd* recognises, a mark can possess distinctive character if only a proportion of the relevant public recognises that the mark means that the goods originate from a particular undertaking. The proportion of the relevant public which identifies the mark as denoting origin is a factor which the court must take into account in assessing distinctiveness. But it follows from this that the existence of a proportion of the relevant public who have not heard of the mark, or do not regard it as identifying the goods of a particular undertaking is not necessarily destructive of validity.

170. Mr Hobbs also submitted that there is no 'single meaning rule' in trade marks of the kind that there was once thought to be, but there is no longer, in the law of malicious falsehood: see *Ajinomoto Sweeteners Europe SAS v Asda Stores Ltd* [2010] EWCA Civ 609; [2010] FSR 30. He relied on two decisions of General Court: *Icebreaker Ltd v Office for Harmonisation I the Internal Market (Trade Marks and Designs) (OHIM)* (I-112/09) [2010] E.T.M.R. 66 and *Travel Service AS v Office for Harmonisation I the Internal Market (Trade Marks and Designs) (OHIM)* (T-72/08), judgment of September 13, 2010, not yet reported, both of which concerned relative grounds. The latter case shows that the Court was prepared to take into account conceptual similarity 'as regards that part of the relevant public which understands English' - see [57]. Those cases do not have a direct bearing on whether a mark can be distinctive to some and merely descriptive to others, but do indicate that a segmented approach is permissible."

223. The only authority I am aware of which comes anywhere near to supporting the existence of a single meaning rule is the following passage from the judgment of Lewison LJ in *Interflora (CA I)*:

"33. I should also refer to *Reed Executive Plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] ETMR 56; [2004] RPC 40. In the course of his judgment in that case Jacob LJ (with whom Auld and Rix LJ agreed) said (at [82]):

'Next the ordinary consumer test. The ECJ actually uses the phrase "average consumer" (e.g. *Lloyd* paras [25] and [26]). The notion here is conceptually different from the "substantial proportion of the public" test applied in passing off (see e.g. *Neutrogena Corp v Golden Ltd* [1996] RPC 473). The "average consumer" is a notional individual whereas the substantial proportion test

involves a statistical assessment, necessarily crude. But in the end I think they come to the same thing. For if a "substantial proportion" of the relevant consumers are likely to be confused, so will the notional average consumer and vice versa. Whichever approach one uses, one is essentially doing the same thing—forming an overall ("global") assessment as to whether there is likely to be significant consumer confusion. It is essentially a value judgment to be drawn from all the circumstances. Further conceptual over-elaboration is apt to obscure this and is accordingly unhelpful. It may be observed that both approaches guard against too "nanny" a view of protection—to confuse only the careless or stupid is not enough.'

34. I agree entirely that the average consumer (in trade mark infringement) is conceptually different from the substantial proportion of the public test (in passing off). What I find difficult to accept is that they come to the same thing. If most consumers are not confused, how can it be said that the average consumer is? I do not think that this particular paragraph of Jacob LJ's judgment is part of the ratio of the case and, with the greatest of respect, despite Jacob LJ's vast experience of such cases I question it. In some cases the result will no doubt be the same however, the question is approached; but I do not think that it is inevitable.

35. There is, of course, no doubt that a valid survey can be an accurate diagnostic or predictive tool. They are used daily to sample public opinion on a variety of different topics. For example, they are used to gauge support for rival candidates in an election and to predict the eventual result. Suppose that a valid survey shows that in an election 49 per cent of the electorate support candidate A and 51 per cent support candidate B. It would be possible to say on the strength of such a survey that B will win the election. It would also be possible to say that a substantial proportion of the electorate will vote for candidate A. But what a survey does not, I think, tell you is: for whom will the *average* voter vote? In cases where acquired distinctiveness of a mark is in issue a survey may accurately identify that proportion of the relevant public which recognises the mark as a badge of trade origin. It will then be for the fact finding tribunal, with the aid of such a survey, to decide whether a significant proportion of the relevant public identify goods as originating from a particular undertaking because of the mark: see *Windsurfing Chiemsee Produktions-und- Vertriebs GmbH v Boots-und-Segelzubehor* (C-108/97) [1999] ECR I-2779; [1999] [ETMR 585](#) at [52], [53].

36. In our case the question is whether M & S's advertisement

would enable a reasonably well-informed and reasonably observant internet user to grasp without undue difficulty that Interflora and M & S were independent. This, as the Court of Justice has emphasised is not a question of counting heads, but is a qualitative assessment. The fact that some internet users might have had difficulty in grasping that Interflora and M & S were independent is not sufficient for a finding of infringement. If, by analogy with *Neutrogena* and *Chocosuisse*, the court were to conclude that most internet users would have grasped that, but that some would not, I cannot see that the court would be any closer to answering the legal question."

224. In my judgment this passage does not support the existence of a single meaning rule for the following reasons. First, nowhere in this passage does Lewison LJ say that there is a single meaning rule. Secondly, given that the single meaning rule which exists in English defamation law is widely regarded as anomalous, that the Court of Appeal forcibly ejected the single meaning rule from the English law of malicious falsehood in *Ajinomoto Sweeteners Europe SAS v Asda Stores Ltd* [2010] EWCA Civ 609. [2010] FSR 30 (thereby bringing that part of English unfair competition law into line with the Court of Justice's jurisprudence in that field) and that there is no such rule in passing off, it would be very surprising if Lewison LJ had intended to adopt such a rule unless it was clearly required by the case law of the Court of Justice. Thirdly, Lewison LJ expressly accepts that a trade mark is distinctive if a significant proportion of the relevant public identify goods as originating from a particular undertaking because of the mark. Thus he accepts that there is no single meaning rule in the context of validity. As I have said, that is logically inconsistent with a single meaning rule when one comes to infringement. Fourthly, the reason why it is not necessarily sufficient for a finding of infringement that "some" consumers may be confused is that, as noted above, confusion on the part of the ill-informed or unobservant must be discounted. That is a rule about the standard to be applied, not a rule requiring the determination of a single meaning. If a significant proportion of the relevant class of consumers is confused, then it is likely that confusion extends beyond those who are ill-informed or unobservant. Fifthly, Lewison LJ does not refer to many of the authorities discussed above, no doubt because they were not cited. Nor does he discuss the nature of the test for the assessment of likelihood of confusion laid down by the Court of Justice. The legislative criterion is that "there exists a likelihood of confusion on the part of the public". As noted above, the Court of Justice has held that "the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion". This is not a binary question: is the average consumer confused or is the average consumer not confused? Rather, it requires an assessment of whether it is likely that there is, or will be, confusion, applying the standard of perspicacity of the average consumer. It is clear from the case law that this does not mean likely in the sense of more probable than not. Rather, it means sufficiently likely to warrant the court's intervention. The fact that many consumers of whom the average consumer is representative would not be confused does not mean that the question whether there is a likelihood of confusion is to be answered in the negative if a significant

number would be confused.

119. From this I deduce that the average consumer in this case is someone who watches the Defendant's TV show and who is aware of the Claimant's business. They will be reasonably well informed and reasonably observant and circumspect. What evidence do I have that will shed any light on the likely reaction of such an average consumer?
120. There is one example of a "consumer" of the TV show being already familiar with the Claimant's business, namely Tracey Jones. Her evidence was that she assumed a connection between the TV show and the Claimant's business when she saw a trailer for the TV show. Her evidence was not shaken in cross-examination. She came across as being reasonably well informed and reasonably observant and circumspect. The average consumer is not a real person but is an artificial construct and it would be wrong to equate Tracey Jones with the artificial construct. Nevertheless, her evidence suggested that it was possible that the average consumer might be confused.
121. Tracey Jones was the only witness who gave this sort of evidence and it would be wrong to form a view of the likely reaction of the average consumer on the evidence of this one real individual. The Claimant was fortunate to have obtained the evidence of Tracey Jones. It was fortuitous in that she did not complain but her recollection of her confusion was triggered by seeing a tweet about this action. It would be unlikely for someone in her position to complain. If she had been dissatisfied on seeing the TV show, which she was not, she would, presumably, merely have watched a different programme.
122. The Claimant did not carry out a survey to support its argument of a likelihood of confusion but such evidence is not necessary and, in the light of the judgment of Lewison LJ in the two Interflora interlocutory appeals concerning the admission of survey evidence, unlikely to be of use.
123. The evidence before me included several examples, albeit generally second hand, of people who knew of the TV show and, on seeing, or hearing of, the Claimant's business, believed that the Claimant's business was connected with the TV show. This is evidence of what I may call "wrong way round" confusion. How does that help?
124. What I have to decide in this case is whether, having regard to the similarity of the Mark and the sign and the similarity of the respective businesses, there is a likelihood of confusion. I believe that this evidence shows that there is such a likelihood. In doing so, it provides support to the Tracey Jones evidence.
125. I believe that this evidence taken as a whole shows that there is a likelihood of confusion and the fact that the Claimant can only produce evidence of one person who was actually confused into believing that the Defendant's TV show was connected with the Claimant's shows does not negate this. Furthermore, this conclusion accords with my own view on seeing the Mark and the sign used on such similar entertainment services. It is not necessary for infringement of a registered trade mark to show that there is "right way round confusion". All that is required is a likelihood of confusion.
126. Mr Malynicz cautions against taking into account this wrong way round confusion. He says that the relevant date that I am concerned with is December 2009/January 2010 when the TV ads and the pilot for the first series were aired. He says that people who give evidence about their reactions when they see the sign after that date when the series has been extremely successful and when they are extremely well aware of it, cannot shed light on whether in December 2009/January 2010, someone who is an average consumer of the registered services would connect the Mark and sign when they encounter the sign when it is used in context. I disagree. It is when the sign has been used on a substantial scale that one will get evidence of the likely reaction of the public. If the Defendant has been using its sign on a large scale for a couple of years and there is no evidence of confusion, I am

sure that the Defendant would be relying heavily on that lack of confusion.

127. I am satisfied that the Defendant has infringed the Mark under section 10(2) of the Trade Marks Act.

128. The other cause of action relied upon by the Claimant is infringement under section 10(3) of the Trade Marks Act which provides as follows:

Infringement under section 10(3)

129. I have already held that the Mark and the Defendant's sign are similar. I have also held that the Mark has a reputation since I have held that it had acquired distinctiveness at the date of the application for registration. More use had been made of it after the date of registration and before the Defendant started its activities complained of and the reputation of the Mark would have grown during that period.

130. The next requirement for infringement under section 10(3) is that the use of the sign would call the Mark to the mind of the average consumer. There are obvious similarities between the Mark and the sign and I have held above that there is a likelihood of confusion between them. If I am wrong in that, nevertheless the similarities are such that the one would necessarily call to mind the other and this is borne out by the evidence. This requirement is established.

131. The Claimant does not allege the taking of unfair advantage by the Defendant's use of the sign and it is clear on the evidence that it is right not to do so. Instead the Claimant relies on "*the use being without due cause ...is detrimental to the distinctive character or the repute of the trade mark*", often referred to as dilution or blurring.

132. Is the Defendant's use "without due cause"? I have held that the use is likely to cause confusion. If that is so, the use is without due cause. The Defendant argues that the "due cause" defence is "a receptacle for a defence of fair competition" and emphasises that the court should adopt a contextual approach to the comparison of the Mark with the sign as used.

133. I would agree to this approach but I do not believe that it helps the Defendant in this case if the other requirements for infringement are made out. I do not see any objective justification for the Defendant's use of the sign if it causes confusion with the Mark or, even if it does not cause confusion, if it damages the Mark.

134. Does the use of the sign cause damage to the distinctive character or repute of the Mark? The evidence establishes that it does. The evidence relating to the reaction of potential customers of the Claimant shows that they are put off attending the Claimant's shows. This will apply generally to people who have not heard of, or at least do not know, the Claimant's business. However, they are clearly potential customers, for instance students at Freshers' Fairs or people being taken by friends. Because of the difference in the underlying theme of the TV show from the Claimant's comedy shows, the Claimant's customers are put off if they think that there is a connection with the TV show.

135. It was submitted by Mr Malynicz for the Defendant that there was no evidence of a change in the economic behaviour of the Claimant's customers as required by the Court of Justice in the *Intel* case, C-252/07. He pointed out that Mr Tughan had attempted to support an allegation of damage by reference to the turnover of the two most recently established venues, Nottingham and Oxford. As Mr Malynicz pointed out, Cardiff and Birmingham had continued to increase and even the other two clubs had increased, although not as much. He also pointed to the fact that the Nottingham and Oxford venues had been "debranded" to some extent, making much greater use of the mark *Glee* at Nottingham and *The Glee* at Oxford.

136. Mr Campbell responded by relying on the *Environmental Manufacturing (Wolf Head)* case, in the

General Court T-570/10 where the Court said:

52 Accordingly, the proprietor of the earlier mark must adduce prima facie evidence of a future risk, which is not hypothetical, of detriment (SPA-FINDERS, cited above in paragraph 26, paragraph 40). Such a finding may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case (Case T-181/05 Citigroup and *Citibank v OHIM - Citi (CITI)* [2008] ECR II-669, paragraph 78).

53 It cannot, however, be required that, in addition to those elements, the proprietor of the earlier mark must show an additional effect, caused by the introduction of the later mark, on the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered. Such a condition is not set out in Article 8(5) of Regulation No 207/2009 or in *Intel Corporation*, cited above in paragraph 27.

54 So far as concerns paragraph 77 of *Intel Corporation*, cited above in paragraph 27, it is apparent from the choice of words 'it follows' and from the structure of paragraph 81 of that judgment that the change in the economic behaviour of the consumer, to which the applicant refers in support of its claim, is established if the proprietor of the earlier mark has shown, in accordance with paragraph 76 of *Intel Corporation*, that the mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark.

137. However, the *Wolf Head* case was under appeal at the time of the trial in this action, there having already been an oral hearing, and the judgment of the CJEU came out in November and both Mr Malynicz and Mr Campbell put in written submissions based on the new judgment. Mr Malynicz relied particularly on the following paragraphs:

34 According to the Court's case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35 Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words '[i]t follows that', immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36 The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of

detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

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.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39 The General Court found, at paragraph 62 of the judgment under appeal, that 'the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark'.

40 However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41 Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42 Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43 None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'.

138. Mr Campbell submitted that the criticism by the CJEU of the General Court's decision he had relied on was that it had relied solely on subjective elements such as consumer's perceptions to deduce the objective condition as to a change in economic behaviour or the average consumer. Here, he submitted, I have objective evidence of the difficulties of establishing the two new venues.
139. I agree with Mr Malynicz's criticism of this evidence. It is very difficult to attempt to assess the effect caused by something like the Defendant's activities on what is an increasing turnover. Would the turnover have increased more in the absence of the Defendant's activities? Who can tell?
140. However, in this case I have more objective evidence of consumers' reaction to the Defendant's activities in the evidence I have referred to above about potential customers being discouraged

because they believe that there is a link. That reaction shows that potential customers are changing their economic behaviour and that the Claimant's Mark is suffering detriment through the swamping by the Defendant's use of the sign. I am reinforced in this view by the reaction of the marketing company m360 Limited as described by Sarah Shaw, Mark Ashmore and Shane Robert Jones. From a marketing point of view they saw the Defendant's TV show as being a real threat to the Claimant's Mark which had to be addressed in their marketing programme. It is not necessary for a Claimant under section 10(3) to produce evidence quantifying a change in economic behaviour. All that is needed is objective evidence that there is or will be such a change.

141. The Claimant's case on detriment to the distinctive character and repute of the Mark is made out.

142. The Defendant relies on a defence under section 11(2)(b). It claims that its use of the word "glee" is and has been descriptive as the title of its TV series about a glee club. The issue is whether the Defendant's use is of "an *indication ... concerning characteristics of goods or services* " that is "*in accordance with honest practices in industrial or commercial matters*

143. The Defendant points out that even where a mark does not fall to be invalidated for descriptiveness, that mark may still be used descriptively by a defendant in a way that is honest, such that the section 11(2)(b) defence will be available relying on the case of *Matratzen v Hukla*, Case C-421/04, where the European Court approved the following comments by the Advocate-General in that case:

61. Second, even if a trade mark owner can successfully invoke his right under Article 5(1) of the directive by virtue of Article 6(1)(b) thereof that right does not in any event entitle him to prohibit a third party from using in the course of trade indications concerning, inter alia, the 'kind', 'quality' or 'other characteristics' of the goods concerned, provided that he uses them in accordance with 'honest practices in industrial or commercial matters'.

144. The Defendant also submitted, correctly, that a sign may be used as a brand/mark, but also be descriptive/indicative for the purposes of the section 11(2)(b) defence.

145. On the facts of this case and the failure of the invalidation attack, I do not believe that the title of the TV show would be understood by the average consumer to be a description of the kind, quality or other characteristics of the TV show. In any event, I have found that there is a likelihood of confusion and that the Defendant's use causes dilution and tarnishing. Continued use of the sign in such circumstances cannot be in accordance with honest practices in industrial or commercial matters.

146. The Defendant has infringed the Mark under section 10(3)

Passing Off

147. An essential element of the tort of passing off is that the use of the sign by the Defendant must result in a misrepresentation. I have held above that the Mark and the sign are confusingly similar. However, the only evidence of misrepresentation is that of Tracey Jones. The rest of the evidence is what I have termed "wrong way round" confusion. That is, evidence of people believing that the Claimant's venues are connected with the Defendant's TV show. Whilst it is true that confusion the "right way round" may well never come to the attention of the parties, I am not convinced that such confusion is sufficiently likely to be said to cause damage to the Claimant. The damage suffered by the Claimant is caused by its venues being confused with the Defendant's TV show and its potential customers being put off. That is not passing off.

148. I find that the passing off case fails for this reason.

Note 1 The Defendant company is part of a large group of companies and the acts complained of may have been

done by various companies within the group. No issue turns on this as the Defendant has accepted that any remedies sought would be effective if granted against the Defendant. [\[Back\]](#)

Note 2 All promotional material and screen titles use the word in lower case. [\[Back\]](#)

Note 3 In this regard, Fox is prepared (for the purposes of this trial only) to accept that the series is properly registered as a series within section 41(2) and further that allowing registration of series marks is compatible with EU law. However Fox hereby reserves its position for any appeal in relation to the validity of the Mark in accordance with *Sieckmann* and with *Dyson v Registrar of Trade Marks* (Case C-321/03) [\[2007\] RPC 27](#). [\[Back\]](#)

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