

BL O-1021-23

TRADE MARKS ACT 1994

IN THE MATTER OF

UK TRADE MARK NO 3495430 IN THE NAME OF
COELLE BEAUPIERRE
IN RESPECT OF THE TRADE MARK:



AND

INVALIDATION THERETO UNDER NO 503428

BY

PENNY STREET TV LIMITED

Background and pleadings

1. On 1 June 2020, Coelle Beaupierre (hereinafter, the proprietor) applied to register the mark shown on the cover page of this decision as a trade mark under no. 3495430. It was subsequently registered for the following services:¹

Class 38

Broadcast of an online music channel.

Class 41

Entertainment services, namely, music.

2. Penny Street TV Limited (hereinafter ‘the applicant’) seeks invalidation of the registration under the provisions of section 47 of the Trade Marks Act 1994 (the Act). It does so on grounds under sections 5(2)(b), 5(3), 5(4)(a), 5(4)(b) and 3(6) of the Act.

3. Under the 5(2)(b) and 5(3) grounds the applicant relies on the following UK registered trade mark:

Mark relied on:	Goods and services relied on:
UKTM: 2638506 CHANNEL U Filed: 16 October 2012 Registered: 01 February 2013	Class 9 Sound and/or visual recordings; enhanced sound and/or visual recordings; interactive sound and/or visual recordings; compact discs; DVDs; digital music (downloadable). Class 38 Communications services; broadcasting services; transmission of music and information; video text, digitised data, teletext and view data services; providing user access to the Internet or to any other communications network including wireless, cable or

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

	<p>satellite; providing communications connections to the Internet or to databases or to any other communications network; providing access to digital music websites on the Internet or any other communications network; delivery of digital music by communications; communication access services; computer-aided transmission of messages and images; transmission of news and current affairs information; chat room services.</p> <p>Class 41 Entertainment services; production of sound and/or visual recordings and entertainment; information services relating to music, entertainment provided on-line from a computer database, from the Internet or any other communications network including wireless, cable or satellite; provision of digital music (not downloadable) from the Internet; provision of digital music (not downloadable) from MP3 websites; production and presentation of quizzes, provision of on-line electronic publications (not downloadable); advisory and consultancy services related to the aforementioned services.</p>
--	--

4. Under the 5(4)(a) ground the applicant relies upon the word sign CHANNEL U and the logo mark:



5. It claims that the signs have been used throughout the UK since 2003, for the same goods and services listed above for the registered word mark 2638506.

5. The applicant confirmed at the hearing that its case under 5(4)(a) relies on residual goodwill in the CHANNEL U signs, based on its use of the sign from 2003 and 2009, when its grime music channel was rebranded.

6. Under the 3(6) ground the applicant submits that the proprietor, a grime music artist who appeared on the applicant's Channel U music channel, has registered an identical logo mark to that owned by the applicant. It submits that, at the time of filing the application, she knew that the Channel U logo and the Earlier Mark were the property and asset of the owners of that business or some other third party and were not hers to appropriate or claim for herself. The applicant confirms that no permission has been given to the proprietor to copy or use the Channel U Logo. The applicant says:

“Furthermore, her comments to third parties, including musical artists contracted to the Applicant's parent and affiliate companies, that she owns the Channel U Music Channel demonstrates an intention to interfere with the Applicant's legitimate business. Such behaviour is dishonest or otherwise falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced businesspersons and amounts to bad faith.”

7. With regard to the applicant's copyright claim under section 5(4)(b), I reproduce it in full, taken from the statement of grounds:

“34. The Channel U Logo is an artistic work pursuant to S. 4 (1) (a) of the Copyright, Designs & Patents Act 1988.

35. The Channel U Logo was created in or about 2003 by or for the Applicant's predecessors in title.

36. The Channel U Logo is a work in which copyright subsists. Exclusive rights therein were acquired by the Applicant in 2018 upon its acquisition of the business in the Channel U music channel.

37. The Contested Mark is an exact reproduction of the Channel U Logo.

38. Such reproduction and the use of the same constitutes an infringement of the Applicant's rights contrary to SS 16-20 of the Copyright, Designs & Patent Act 1988.

39. In the premises use of the Contested Mark was liable to be prevented by virtue of the law of copyright and the Contested Mark should not have been registered pursuant to S. 5 (4) (b) of the Act. It should therefore be declared invalid pursuant to S. 47 (2) (b) and S. 5 (4) (b) of the Act.”

8. The proprietor filed a counterstatement in which she denies the grounds of invalidation. In his skeleton argument and at the hearing Mr Harris, for the applicant, put forward the view that the proprietor had not responded to all of the grounds raised by the applicant and should be deemed to have accepted them. I disagree. The first line of the proprietor’s counterstatement at box 8 of its second TM8 reads:

“I wholeheartedly disagree with the claims brought against me.”

9. The proprietor proceeds to address a few points in particular, but these do not dilute the initial statement that she disputes all of the applicant’s claims and I will proceed on that basis.

10. Both parties filed evidence and skeleton arguments. A hearing was held by video conference on 6 September 2023 at which the applicant was represented by Mr Philip Harris of Counsel, instructed by Lane IP. The proprietor represented herself.

11. Both sides seek an award of costs on the usual tribunal scale, which can be found in tribunal practice notice (TPN) 2/2016.

12. I make this decision having taken full account of all the papers before me and of the submissions made by both parties at the hearing.

13. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions

of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

Evidence

14. The applicant's evidence is contained in two witness statements from Steven Lane of Lane IP. The first is dated 25 July 2022 and has attached exhibits SL1 – SL19. The second is dated 28 November 2022 with exhibits SL20-SL21 attached. Mr Lane is the managing partner at Lane IP, the applicant's representative.

15. The proprietor's evidence takes the form of two witness statements by Coelle Beaupierre. The first is not dated but was received on 25 July 2022. Exhibits numbered 1-3 are attached. The second is dated 1 February 2023 and has six exhibits attached, numbered 1-6. The second witness statement was in fact a request to file additional evidence which the proprietor had no automatic right to file. The request was not made in accordance with the guidance given by the tribunal. However, firstly, since it mostly comprises repeats of previous submissions and some prints from the trade mark register and secondly, since Ms Beaupierre is unrepresented and is defending her trade mark, I decided on balance to allow the additional pages of evidence into the proceedings.

Approach

16. At the hearing, Mr Harris led with the 5(4)(b) ground having identified it as the applicant's lead case, so I will begin with it. The relevant section of the Act reads:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) [...]

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs”.

17. Section 1 of the Copyright, Designs and Patents Act 1988 (“CDPA”) provides for copyright to subsist in original artistic works. Section 4 CDPA further provides:

“4. —Artistic works.

(1) In this Part “artistic work” means—

(a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,

[...]

(2) In this Part—

[...]

“graphic work” includes—

(a) any painting, drawing, diagram, map, chart or plan [...].”

17. Tribunal Practice Notice 1/2010 outlines the requirements which must be met in order to get a valid copyright claim off the ground. The relevant part reads as follows:

“Section 5(4)(b) prohibits the registration of a trade mark if its use in the United Kingdom is liable to be prevented by virtue of an earlier right (other than earlier rights under sections 5(1)-(3) and 5(4)(a)) but ‘in particular by virtue of the law of copyright, design right or registered designs’.

Copyright

The law of copyright in the United Kingdom is governed by the Copyright, Designs and Patents Act 1988 (CDPA). There is a qualification requirement as to the nationality (which extends to domicile/residence) by reference to the author of the copyright work (section 154 of the CDPA) or, alternatively, by reference to the country of first publication (section 155 of the CDPA). The pleadings must identify the author of the work and the manner in which the work meets these nationality based requirements. Furthermore, as copyright is limited in duration, the date at which the work was created must also be provided.

Under the Trade Marks (Relative Grounds) Order 2007 only the proprietor of a right may oppose the registration of a trade mark. The owner (proprietor) of the copyright must, therefore, be identified in the pleadings. The author and the owner may be one and the same, but the position claimed must be clearly stated and if the owner is not the author then the method by which they became the owner should be detailed. It should be noted the first owner of a copyright work is its author unless (in the case of a literary, dramatic, musical or artistic work, or a film) the work is created by an employee in the course of employment (in which case the employer is the first owner of any copyright in the work). This can vary by agreement and the copyright may be assigned to a different party, be it upon creation or later. Any assignment must, though, be in writing for it to be effective (section 90(3) of the CDPA).

The pleadings should set out:

What the work relied on is, including a representation of it.

Who created the work and when it was created.

The nationality of the author (or if the author of the work is a corporate body where the corporate body is incorporated) at the time the work was created.

If domicile/residence of the author is relied upon, where the author was domiciled/resident at the time the work was created.

If the publication of the work is relied on, where the first publication of the work took place and when.

Who the current owner of the work is and, if such a person is not the author, by what method ownership was transferred.

There is no requirement for proof of the above to be filed at the pleadings stage.”²

18. In order for the applicant to succeed it must establish that it is the owner of the claimed prior work. The claimed prior work must meet the qualification requirements of the CDPA and the claimed work must be the result of the author’s own intellectual creation. If the applicant is not the author, then it should show how it derived the rights in the copyright work. Finally, the applicant must show that at the relevant date, namely 1 June 2020, it must have been in a position to prevent the use of the proprietor’s trade mark under the law of copyright.

19. In its initial pleadings, the applicant sought to rely on the Channel U logo, shown below, and claims it is an artistic work under section s.4(1)(a) of the Copyright Designs and Patents Act ("CDPA") and consequently qualifies for copyright protection in the United Kingdom.



20. In its skeleton argument, filed on 31 August 2023, the applicant relied on the evidence of Steven Lane at paragraphs 7-10 of his first witness statement, and accompanying exhibits to “...set out its case on the existence of copyright in the logo, and its acquisition of title therein”.

“7. Channel U was a satellite television channel broadcast in the UK from February 2003. There is now produced and shown to me marked Exhibit SL2 a screenshot of a YouTube video which shows Channel U listed as channel number 467 on the Sky Digital electronic programme guide from Sunday 16 March 2003.

² My emphasis added.

8. Channel U was focused on promoting British grime music, featuring established British grime artists as well as newer breakthrough acts. There is now produced and shown to me marked Exhibit SL3 a printout of the Wikipedia entry and details of Channel U discussing the history of Channel U and the artists featured, which include Tinchy Stryder, Tinie Tempah and Dizee Rascal, all of whom have gone on to have successful music careers

9. Channel U was owned and operated by VIDEO INTERACTIVE TELEVISION PLC until the company entered into liquidation in 2009, and there is now produced and shown to me, marked Exhibit SL4, printouts from the UK companies house which confirm this date of liquidation. Following the liquidation, Channel U was sold to Mushroom TV limited and there is now produced and shown to me, marked Exhibit SL, an archived website extract of the Ofcom 'Television Broadcast Licensing Update March 2009' which confirms that Channel U was renamed Channel AKA and was in the name of the licensee Factor 15 Records Ltd The companies house extract produced and shown to me as Exhibit SL6 states that Factor 15 Records Ltd. was a previous trading name of Mushroom TV limited

10. There is now produced and shown to me, marked Exhibit St7, an archived website extract from the London Gazette confirming that Mushroom Ty Limited entered into liquidation on 22 June 2012. Following the liquidation, Channel AKA was sold to All Around The World Limited and there is now produced and shown to me, marked Exhibit SL8, an archived website extract of the Ofcom Television Broadcast Licensing Update May 2012 which confirms that AATW Limited (All Around the World Limited'), the parent company of the Applicant and subsidiary of UMG, had purchased and taken over Channel AKA."

21. The position in relation to first ownership of a copyright work is set out in section 11 of the CDPA as follows:

"11 First ownership of copyright

(1) The author of a work is the first owner of any copyright in it, subject to the following provisions.

(2) Where a literary, dramatic, musical or artistic work, or a film, is made by an employee in the course of his employment, his employer is the first owner of any copyright in the work subject to any agreement to the contrary.

(3) This section does not apply to Crown copyright or Parliamentary copyright (see section 163 and 165) or to copyright which subsists by virtue of section 168 (copyright of certain international organisations).”

22. In view of the above, the first legal owner of any copyright subsisting in the Channel U logo would be the designer of that logo. No documents have been provided to show who the designer was nor how those rights then passed to the applicant, whether by assignment, by virtue of employment or by any other means.

23. From decisions in cases such as *R. Griggs Group Ltd & Ors v Evans & Ors* [2003] EWHC 2914 (Ch), it is clear that in some circumstances the commissioner of a work may be regarded as the equitable owner of a commissioned work, but in the absence of any evidence to establish who created the work and in what circumstances, I cannot make any findings with regard to ownership of the copyright.

24. The problem for the applicant is that no submissions, statements or evidence have been provided to identify the author of the work relied on by the applicant. Nor has it provided the date or manner of creation of that work or shown how it has come to acquire the rights to the ‘work’ relied on. The paragraphs in Steven Lane’s statement simply outline company acquisition and the current applicant’s predecessors in title. They make no reference to the creation or subsequent transfer of copyright in the contested logo.

25. This is not a claim under the TMA where for some grounds the existence of a registered trade mark is sufficient in and of itself to show that a claimant has the necessary rights to bring an action. Whilst it is clear from the TPN above that it is not necessary to provide inter alia, the creation date and the author’s identity at the

pleadings stage, it is certainly the case that such information must be provided prior to a decision being taken. This is a copyright claim and in order to assess the claim I must be able to identify the author and, if the applicant is not the author, the way in which it acquired the rights from the author and/or first owner.

26. This gives rise to a related problem which is that I cannot establish if the claimed work is the result of the (unknown) author's own intellectual creation, and if so, to what extent that is the case. When I do not know who created the work and in what circumstances it was created, I cannot draw a conclusion on the point.

27. The applicant's copyright claim fails at the first hurdle as it has not provided anything to enable me to establish that it has the necessary ownership of the claimed copyright.

The remaining grounds

28. With regard to the remaining relative grounds the applicant agreed with me at the hearing that its case under 5(4)(a) is based on residual goodwill as, by its own admission, the Channel U mark has not been used consistently since the re-brand of its music channel in 2009. The opponent also submitted that its 5(2) and 5(3) grounds were unlikely to take its case further than the 5(4)(a) ground relied on. This is clearly so, since the opponent's CHANNEL U word mark has not been used in the relevant proof of use period, nor will it be able to show significant reputation in the years from 2009 to the filing date of the application.³

29. In light of the submissions made to me by Mr Harris, I propose to deal next with the opponent's case under sections 47 and 5(4)(a) of the Act and then I will decide the 3(6) claim.

30. The relevant part of section 47 reads:

³ There is some evidence of a one-off revival which I will deal with where appropriate.

“47. - (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground -

(a) ...

or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

31. Section 5(4)(a) of the Act states that:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met...

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

32. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,⁴ Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or

⁴ [1990] RPC 341, HL, page 406.

packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

33. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon;

- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

Relevant date

34. In terms of the relevant date for assessment of this ground, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,⁵ Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:⁶

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

35. The filing date of the contested trade mark is 1 June 2020. There is no claim to earlier use by the proprietor and it is this date which is relevant for my assessment.

⁵ BL O-410-11

⁶ BL O-212-06

Goodwill

36. The first hurdle for the applicant is to show that it had the requisite goodwill at the date of the proprietor's application for the contested mark. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

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

37. The applicant must show that it had goodwill in a business at the relevant date and that the signs relied upon, CHANNEL U and the CHANNEL U logo, are associated with, or distinctive of, that business.

38. Unusually, in this case, there does not seem to be any dispute from the proprietor that the applicant had residual goodwill in the Channel U signs, nor that the 'feeling' the mark gave those in the grime music scene was something she wished to reinstate, by registering the contested Channel U logo mark. At the hearing, Ms Beaupierre said:

*"So, as I was wanting to bring an online channel, not to try and revive anything or to steal anybody's work or to even use past work, I wanted to get fresh artists, may be work with artists from my era who had expertise... So that is why I wanted the logo. It was a sense of the feeling that is attached to the logo and what it means to the general public; I guess you would say the underdog."*⁷

39. It was clear from Ms Beaupierre's submissions to me at the hearing that the applicant's Channel U music channel enabled grime artists to get their music out to

⁷ See page 15 of the hearing transcript.

audiences at a time when it was difficult for them to do that in the mainstream music industry.

40. Despite Ms Beaupierre's submissions regarding the applicant's goodwill, I will consider the applicant's evidence, in brief. The relevant evidence is contained in the first witness statement of Steven Lane and attached exhibits SL1-SL19. It and my conclusions from it follow.

41. Mr Lane is the Managing Partner at the applicant's representative. His statement is dated 25 July 2022. The applicant is a subsidiary of Universal Music Group Limited, whom Mr Lane's company represents. Mr Lane submits the following:

- Channel U was a satellite television channel broadcast in the UK from February 2003.
- It was channel 467 on the Sky Digital programme guide.⁸
- Channel U promoted British grime music. It featured existing and new breakthrough artists. Artists featured on the channel included Dizzee Rascal, Tinchy Stryder and Tinie Tempah.⁹
- In 2009 the channel was renamed 'Channel AKA'.¹⁰

42. Mr Lane describes the channel as follows:

"11. Channel U developed and produced a range of television programmes to be broadcast on the channel, alongside music videos of well-known and up and coming grime artists."

43. Ten prints taken from www.channelu.tv have been provided. They were accessed via Wayback machine and are dated between 16 August 2004 and 20 February 2009.¹¹

⁸ See exhibit SL2 which is a still from a YouTube video dated 16 March 2003.

⁹ See exhibit SL3, a Wikipedia print about the history of Channel U.

¹⁰ See exhibit SL5, an archived extract from Ofcom. 'Television Licensing Update March 2009'.

¹¹ See exhibit SL10.

44. The pages show available content on the 'channelu' webpage at a particular date and include track and video listings, music and video download options, recommended films and programme content such as chart shows and the 'Westwood Show'.

45. The following signs are visible on the pages:



46. Mr Lane submits that, *"Whilst Channel U changed its name to Channel AKA in 2009, the channel continues to be referenced in mainstream UK media."*¹²

47. Examples of later media coverage include:

- 4 June 2018 – Guardian – RIP Channel U: the urban music champion that gave power to the people. The article is written in response to the ending of Channel AKA, which was formerly named Channel U.

"...Its demise coincides with grime's eventual transformation into a mainstream genre. Rappers like Skepta are now regularly plastered across music video channels that once wouldn't air them, and this is perhaps in part what rendered the station redundant: black British music now

¹² See Mr Lane's first witness statement, paragraph 14.

dominates the charts, garners international acclaim and is embedded in British culture to an extent we've never seen before. But all this would have been impossible without Channel U."¹³

- 12 November 2020 – Guardian – A massive game-changer: how Channel U brought grime to satellite TV:

*If you haven't heard of channel U - the defunct UK rap and grime music channel that launched in 2003 in a blaze of anarchic, DIY spirit - it may sound hyperbolic to call it one of the biggest influences on Britain's current music scene. But its importance is undisputed among those who know it, heightened by its success outside of typical mainstream gatekeepers. "It's had a big impact on the people that had nothing and was no one and wasn't a part of the machine," says grime artist D Double E. "Just like You Tube, it didn't matter who you were. It just mattered that you were trying to be creative."*¹⁴

- Music blog, vice.com, Stories of All the Best Channel U Memories from Its 15 Years On-Air, 7 June 2018:

"From its inception in 2003, the channel was essentially the most widely recognised champion of grime and UK rap up until the internet got good enough to make music telly obsolete. It was basically our answer to MTV Base, and gave credence to - if not launched the careers of - artists like Dizzee Rascal, Skepta and Wiley, who are now considered mainstream. It put Lethal Bizzle's "Pow" on one million tinny Motorola Razr speakers at the back of any given bus, it gave us the Hectic Squad, it gave us Mr Wong. It gave us the greatest R&B pop group the UK has ever seen in N-Dubz...

As a result of Channel U's unswerving dedication to UK music grime in particular you could say it made talented, underground voices not just

¹³ See exhibit SL11, page 38.

¹⁴ See exhibit SL11, page 40.

heard, but accepted. Channel U and its 24-hour stream of unashamedly lo-fi music videos (which you could request by voting for them on your phone), went on to define a genre that has done things on its own terms ever since with a few exceptions rejecting major labels and glossy videos for vigorous self-promotion and handheld cameras. Of course, after Channel U bigged up grime, the industry followed suit. In that respect, grime grew in recognition as our generation grew in age, and ended up reflecting how, in the face of rejection from mainstream support, people who grew up in the millennium have had to do things ourselves, or they just wouldn't ever get done.”¹⁵

- 1 June 2018, GRM Daily, WHY CHANNEL U/CHANNEL AKA WAS SO IMPORTANT:

“Channel AKA, formerly known as Channel U, was established in the early noughties and devoted itself to broadcasting the UK's most talented and hard-hitting videos from the grime, rap and hip-hop worlds. When many broadcasters refused to showcase talent from the underground music scene, Channel AKA championed such acts and, in turn, became a pioneering TV channel. News of AKA's closure is one that has shocked many, but also gives us a chance to reflect on the massive impact the channel has had on British culture over the years.”¹⁶

- 15 July 2016 – Celebrating Channel U's Darren Platt: unsung hero of the UK grime scene:

“Channel U was a cultural phenomenon. Before platforms such as SBTU existed, unsigned MCs were on TV, in your living room, and far from the slick gloss of MTV. The productions were crude, often filmed on handheld digital cameras, but it didn't matter: the videos looked and sounded like the music they were showcasing...”

¹⁵ See exhibit SL11, page 43.

¹⁶ See exhibit SL11, page 49.

It spoke to a specific audience - and for a generation of people whose parents might have run inside when they saw a black or asian person on TV - it was still a rare thrill to have a station that not only celebrated working-class immigrant communities, but promoted a genre that people felt was theirs.

That to me is the legacy of Channel U, and what people such as Platt did behind the scenes helped find a prominent place for a genre that would otherwise have been ignored by mainstream culture. Without them, the world would sound different, and nowhere near as good.”¹⁷

48. Mr Lane also draws my attention to ‘a brief one-night return’ of Channel U in 2020. He provides four press articles relating to the event. The first is from mixmag, is dated 28 September 2020, and is titled, “Iconic grime staple channel U is returning to your TV screens.”

“Channel U, the iconic grime TV channel, is returning.

The channel, which coincided with grime's rise and hosted videos by the likes of Lethal Bizzle, Dizzee Rascal, Kano and more, is coming back on November 13.

Iconic videos and classic grime shows will feature once it returns, and it will debut Against All Odds, a film about grime which will feature Ghetts, Jammer, D Double E and more. The film tells the fictional story of MC Active, played by Nico Tyler James, as he looks to make it big as a grime artist.”

49. The second article is taken from NME, dated 22 November 2020, and is titled, ‘Channel U’s return was a celebration of Black British culture – relive the best bits’.

¹⁷ See exhibit SL11, page 51.

“This weekend, iconic TV station Channel U - which gave UK rap a much-needed platform in the 2000s -- returned to screens for one night only as part of the premiere for coming-of-age film Against All Odds. A welcome trip down memory lane for grime fans, the six-hour revival hosted a mixture of explosive performances, familiar faces, beloved shows -- and, of course, classic videos.”

50. The article highlights some of the best moments from the Channel U night, including music videos, interviews and films. It concludes:

“Seeing the Channel U logo brought back good memories

If you were a fan of UK rap and grime in the 2000s it's likely you found comfort in seeing the Channel U logo pop up on your screen. It was like a bat signal for Britain's underground fans, way before the commercial acceptance and mainstream transformations of Stormzy, Skepta and Wretch 32...”

51. The third article is from BBC news, is dated 25 September 2020, and is titled, ‘Grime Station Channel U to return to TV’:

“After 15 years on air, it stopped broadcasting in 2018 – but is now set to return in November.

It will play a selection of old school grime videos and classic shows, as well as the first ever Grime movie and soundtrack Against All Odds, exploring the rise of Grime in the UK.”

52. In the same article, the film’s director, Femi Oyeyiran, says:

“For us as kids, Channel U was the greatest TV channel on Earth, so for us to be able to bring it back is important...It was the first broadcast platform for every MC, and for us as kids, it was the first time we saw these stars on screen.”

53. Mr Lane says of the relaunch event:

“19. The one-night revival was streamed online and broadcast on satellite channel 373 (a channel originally used for Channel U) and featured resurrections of shows which were originally broadcast on Channel U in its original run.”¹⁸

54. He also draws my attention to the applicant’s own website, www.umusic.co.uk, which promoted the revival in the following terms:¹⁹

“To celebrate the early days of grime, the Motown team are bringing back the classic grime go-to Channel U, which will go live on its original satellite channel 373 and streamed live on Link Up TV. Motown UK will premiere the Against All Odds film in full, alongside six full hours of programming, including the return of Ace & Vis’s iconic iLLout Show, new live performances, interviews, a selection of old school grime videos plus fan favourite Asqueezy aka Arnold Jorge.”

55. With regard to residual goodwill, which is the goodwill remaining in a business which has ceased trading under a particular sign, I bear in mind the comments in *Ad Lib Club Limited v Granville*.²⁰ Vice Chancellor Pennycuick stated that:

“It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a

¹⁸ See exhibit SL13.

¹⁹ See exhibit SL14.

²⁰ [1971] FSR 1 (HC).

trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.

In the present case, it is quite true that the plaintiff company has no longer carried on the business of a club, so far as I know, for five years. On the other hand, it is said that the plaintiff company on the evidence continues to be regarded as still possessing goodwill to which this name AD-LIB CLUB is attached. It does, indeed, appear firstly that the defendant must have chosen the name AD-LIB CLUB by reason of the reputation which the plaintiff company's AD-LIB acquired. He has not filed any evidence giving any other reason for the selection of that name and the inference is overwhelming that he has only selected that name because it has a reputation. In the second place, it appears from the newspaper cuttings which have been exhibited that members of the public are likely to regard the new club as a continuation of the plaintiff company's club. The two things are linked up. That is no doubt the reason why the defendant has selected this name."

56. It is clear from the evidence before me that the applicant used the Channel U signs from 2003 to 2009 for an influential music channel. The channel was focussed on UK Grime music and, from the press coverage provided, clearly had a major part to play in the rise of that music genre in mainstream music. It is also clear that the channel launched the careers of some major recording artists such as Tiny Tempah and Dizzee Rascal. In fact, there is no dispute in this case that the proprietor chose to register the contested Channel U sign precisely because of the fond regard in which she and others hold the applicant's Channel U signs. The 'one-night only' relaunch in 2020 also supports my view that there was still sufficient interest in the Channel U signs for the applicant to choose Channel U rather than the later Channel AKA brand with which to promote and stage the 'comeback' event. I find that at the time the proprietor filed her application for the contested Channel U sign, the applicant had sufficient residual goodwill in its Channel U signs to meet the first requirement for getting a 5(4)(a) claim off the ground.

57. The words are used for the most part in a red typeface or in logo form with an enlarged red letter 'U' with the word CHANNEL presented in a smaller size along the left side of the letter U. There is also some use of the words in plain text in descriptions of the channel and its programming, third party discussion of the channel and in press articles. The use shown is such that the goodwill is associated with the words, per se.

Misrepresentation

58. In *Neutrogena Corporation and Another v Golden Limited and Another*, Morritt L.J. stated that:²¹

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]?’

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148*. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175*; and *Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

59. On the subject of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*,²² in which Lord Justice Lloyd commented on the paragraph above as follows:

²¹ [1996] RPC 473

²² [2013] EWCA Civ 590

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the ‘substantial number’ of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

60. The applicant has established that it had the requisite residual goodwill in the Channel U signs for the operation of a music channel. The contested mark is identical to the applicant's logo sign.²³ In terms of distinctiveness, the ‘Channel’ element of the earlier sign describes the nature of the service being a satellite channel. However, in combination with the ‘U’ part of the sign it is perfectly capable of operating as a sign capable of indicating origin. The earlier word sign is at least highly similar to the contested mark, consisting of the same elements, ‘Channel’ and ‘U’.

61. The contested mark is registered for online music channel broadcasting and music entertainment services. I have found the applicant to have goodwill for a music channel accessible online and via television. Clearly these are identical or highly similar services.

62. Consequently, having found the earlier logo sign and the contested mark to be identical (and having also found the contested mark and the earlier word mark to be at least highly similar) and having found the services for which the contested mark is registered and the services for which the applicant's earlier signs have goodwill to also be identical, it is clear that a person aware of the applicant's Channel U music channel would, when encountering the proprietor's identical business under the same sign, conclude that both originate from the same undertaking. In other words, use of the proprietor's mark at the relevant date would have constituted a misrepresentation to a

²³ I note that in the earlier logo sign relied on by the opponent the left side of the large letter U is thicker, this will go unnoticed and does not disturb my view that, in a trade mark sense, these are identical marks.

substantial number of people. In making this finding I bear in mind the comments in *Lumos Skincare* above and consider the relevant public to be the applicant's actual or potential customers.

Damage

63. Having found that the goodwill and misrepresentation limbs of the test have been satisfied in respect of all of the services for which the contested mark is registered, it follows that damage to the applicant's goodwill will arise.

64. In *WS Foster & Son Limited v Brooks Brothers UK Limited*,²⁴ Mr Recorder Iain Purvis QC stated:

“Damage

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

65. I therefore find that use of the proprietor's mark at the relevant date was liable to be restrained under the law of passing off in respect of all of the services for which it is registered.

The cancellation applicant succeeds under sections 47(2)(b) and 5(4)(a) of the Act.

²⁴ [2013] EWPC 18

The claim under section 3(6) of the Act

66. The relevant section reads as follows:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

The relevant caselaw for assessing a claim under this ground can be found in *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 in which the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].
3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives

of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]."

67. I also bear in mind *Alexander Trade Mark*,²⁵ in which the key questions for determination in a claim of bad faith were expressed as:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

68. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929

²⁵ BL O/036/18

(Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

The applicant's bad faith claim

69. The applicant claims that the proprietor registered a trademark identical to its own Channel U logo. The proprietor is a music artist who appeared on Channel U and so clearly knew of it and knew that the logo belonged to the owners of the Channel U business. The applicant confirms that no permission was given to the proprietor to use the applicant's Channel U logo sign and concludes that the proprietor intends to interfere with the applicant's legitimate business.

The proprietor's case

70. The proprietor submits:

"Before I made the purchase, I contacted staff from the old team at Channelu. I spoke with the gentleman who created the logo. He stated the old owner sold the content of the channel, the logo was never bought as the station was rebranded."

71. Ms Beaupierre also submits that as part of her research she checked the trade mark register and found that the applicant's Channel U logo 2389389 was showing the status 'Dead' and that this 'showed the mark was publicly available'.²⁶

72. There are several areas of misunderstanding in the proprietor's approach to registering the contested trade mark and I need to address these before making the final determination on this ground.

²⁶ This trademark was registered and owned by Video Interactive Television Plc, one of the applicant's predecessors in title.

73. A trade mark which has the status 'dead' on the trade mark register is not necessarily 'publicly available'. Residual rights in trade marks can last for many decades depending on the strength of goodwill in the original business. This is clearly the case here, as I have already found above. In addition, a search of the trade mark register is not the last word in deciding what may or not be available as many businesses use signs which are never protected via the trade mark system and may enjoy unregistered rights in those signs.

74. I also note that Ms Beaupierre says in her first witness statement that, "*They purchased the word, I appreciate that, but nike is not nike without the logo*".²⁷ Trade marks are not purchased, they are applied for and fees are charged in order for the registry to carry out the relevant examination of a trade mark application to determine whether or not it is acceptable. A trade mark successfully entered on the register is then subject to an opposition period and if it then succeeds in making it onto the register it still may be subject to applications for invalidation by third parties at any point in its lifetime. It is not simply a case of 'purchasing' a trade mark and that being the end of the matter.

75. Ms Beaupierre claims to have spoken to the original designer of the logo (though his details have not been provided) and made the decision to register the logo as a result of her research. Unfortunately, for the proprietor, the fact that the 'content of the channel was sold' does not mean the rights in the associated signs were freely available, rather they rested with one of the successors in title (ending with the current applicant) who still owns the rights in the Channel U signs. Ms Beaupierre says that the applicant clearly has no intention to use the logo, but that is their business decision to make given that they have residual goodwill in the contested logo.

76. I bear in mind that good faith is presumed unless the contrary is proven and rely on *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2009] RPC 9 (approved by the COA in [2010] RPC 16), in which Arnold J. (as he then was) stated that:

²⁷ See the first witness statement of Coelle Beaupierre.

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

77. I find this to be the case here. Ms Beaupierre has clearly misunderstood the trade mark registration system, which has led her to make erroneous decisions in selecting a brand for her music platform. That said, none of this points away from Ms Beaupierre having acted in good faith. She believed she had acted diligently in trying to find out what had happened to the original Channel U signs and tried to establish where the rights lay and if they were available. In my view, she reached the wrong conclusions on these points and in her understanding of how the trade mark registration system works, but I do not find that this amounts to bad faith on her part.

The applicant’s claim under sections 47 and 3(6) of the Act fail.

78. Since the proprietor, Ms Beaupierre, is unrepresented I will finally deal with two additional points relating to the evidence filed in support of the proprietor’s case.

79. Ms Beaupierre relies on ‘community responses’ on Instagram written, by her followers, as a result of her post to show that she had registered the contested Channel U logo at the UK TM Registry. These responses are complimentary and encouraging of Ms Beaupierre’s plans.²⁸ I have found that Channel U is still fondly remembered by the relevant public. It is not surprising that fans and followers of the proprietor would be pleased to see it return, but this has no bearing on where trade mark rights lie in the contested Channel U trade mark.

80. Ms Beaupierre also draws my attention to company names which include the words ‘Channel U’. Of the examples provided only one is a Channel U company and it is irrelevant to the matter before me. Company names can be much closer to each other than trade marks, they have no relationship to trade marks and do not give trade mark protection. Even if they were relevant, I have no indication of the nature of the company, which may operate in an entirely different field of business and I will say no more about this evidence.

COSTS

81. The applicant has succeeded in invalidating the proprietor’s CHANNEL U trade mark under sections 47 and 5(4)(a) of the Act.

82. Turning to the matter of costs, I have borne in mind that whilst the applicant was unsuccessful in its 3(6) claim, it was a ground reasonably relied on and it succeeded in invalidating the contested trade mark in its entirety. I also bear in mind that Ms Beaupierre filed a small volume of papers and accepted, at the outset, the applicant’s position regarding its music channel business. I award costs on the following basis:

Official fees:	£200
Preparing the notice of cancellation considering the other side’s defence:	£300

²⁸ See exhibit 2 to Coelle Beaupierre’s second witness statement.

Preparing evidence:	£500
Preparation for and attendance at a hearing:	£600
TOTAL	£1600

83. I order Coelle Beaupierre to pay Penny Lane TV Ltd the sum of £1600. These costs should be paid within 21 days of the date of this decision or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 31st day of October 2023

Al Skilton
For the Registrar,
The Comptroller-General