

O/1031/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3705532
IN THE NAME OF SIMON WEINSTEIN
TO REGISTER THE FOLLOWING TRADE MARK:

MUSIKISS

IN CLASSES 35, 41 & 45

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 434706
BY BAUER RADIO LIMITED

Background and pleadings

1. On 15 November 2013,¹ Simon Weinstein (“the applicant”) applied to register the trade mark **MUSIKISS** in the UK, under number 3705532 (“the applicant’s mark”). Details of the application were published for opposition purposes on 1 April 2022. Registration is sought for the following services:

Class 35: Advertising, including online, in particular advertisements, for others; employment agencies, in particular in connection with music or for those interested in music; retail and wholesale services including online retail services and online wholesale services, of goods and services in the music sector; compilation, gathering, management and providing of data (for others) (including via databases searchable online or via apps).

Class 41: Organising, coordination and provision of recreational events; booking of events; performance of music, song, (short) films, radio and television programmes and cultural programmes; ticket reservation and advance sale for events.

Class 45: Social services, namely arranging groups sharing interests and dating via social networks.

2. On 1 July 2022, Bauer Radio Limited (“the opponent”) opposed the application in full under ss.5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application with the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The applicant’s EUTM number 12317616 was filed at the EUIPO on 15 November 2013, whereas its UK application was filed on 30 September 2021. Accordingly, the UK application was given the same filing date as its EUTM.

3. For the purposes of its claim under s.5(2)(b), the opponent relies upon the following trade marks:

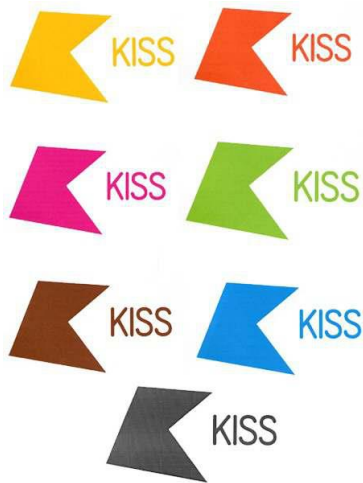
(i) **KISS, KISS 100** (series of two)

UK registration no. 2202542B

Filing date: 9 July 1999

Registration date: 24 November 2000

("the opponent's first mark")



(ii) (series of seven)

UK registration no. 2430834

Filing date: 24 August 2006

Registration date: 17 October 2008

("the opponent's second mark")

(iii) **KISSMAS**

UK registration no. 2606157

Filing date: 5 January 2012

Registration date: 13 April 2012

("the opponent's third mark")

(iv) **KISSFMUK.COM**

UK registration no. 2620478

Filing date: 9 May 2012

Registration date: 2 November 2012

("the opponent's fourth mark")

(v) **KISS, kiss** (series of two)

UK registration no. 3022390

Filing date: 17 September 2013

Registration date: 28 February 2014

("the opponent's fifth mark")

(vi) **KISSTORY**

UK registration no. 2606153

Filing date: 5 January 2012

Registration date: 13 April 2012

("the opponent's sixth mark")

(vii) **KISSALICIOUS**

UK registration no. 262194

Filing date: 22 May 2012

Registration date: 14 September 2012

("the opponent's seventh mark")

4. The opponent's marks stand registered for a range of goods and services in classes 9, 16, 25, 35, 38, 41, 42 and 45.

5. Each of the opponent's marks qualifies as an 'earlier trade mark' in accordance with s.6 of the Act. As the opponent's first and second marks had been registered for more than five years at the filing date of the applicant's mark, they are subject to the use requirements specified in s.6A of the Act. The opponent's other marks had not been registered for five years at the filing date of the applicant's mark. Consequently, the opponent does not need to show that they have been used.

6. Under s.5(2)(b), the opponent relies upon the goods and services outlined in Annex A. It contends that these are identical or similar to the applicant's services. Moreover, it argues that the applicant's mark is similar to each of its marks. Based upon these

factors, the opponent submits that there is a likelihood of confusion, including the likelihood of association.

7. Turning to s.5(3), the opponent claims that its first, fifth and sixth marks have a reputation for the services set out in Annex B, which broadly consist of radio broadcasting and entertainment services. The opponent submits that its reputation in the marks is such that use of the applicant's mark would, without due cause, take unfair advantage of, and be detrimental to, the distinctive character and repute of its marks.

8. As for s.5(4)(a), the opponent claims that it has goodwill in its business in relation to which it has used the signs **KISS** and **KISSTORY** throughout the UK since 1990 and 2002, respectively. The services for which the signs are said to have been used are set out at Annex C. Again, these broadly cover radio broadcasting and entertainment services. The opponent argues that use of the applicant's mark would constitute passing off.

9. The applicant filed a counterstatement, denying the grounds of opposition. The applicant also indicated that it would require the opponent to provide proof of use of its first and second marks.

10. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 21 February 2024. The opponent was represented by Georgina Messenger of Counsel, instructed by Boulton Wade Tennant LLP. The applicant was represented by Aaron Wood of Brandsmiths S.L. Limited.

Relevance of EU law

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, s.6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

12. The opponent's evidence is given in the witness statement of Steven Parkinson and 11 exhibits (1-11). Mr Parkinson is Chief Strategic Partnerships and Events Officer of the opponent. He provides evidence as to the opponent's use of its marks/signs.

13. The applicant's evidence is given in the witness statements of Aaron Wood, along with two exhibits (ARW1-ARW2), and Simon Weinstein, together with 12 exhibits (SW1-SW12). Mr Wood is the applicant's professional representative. His evidence covers the adoption of digital radio receivers by the public and methods of calculating listener statistics. Mr Weinstein is the applicant. He provides evidence relating to the opponent's activities, as well as those of third parties.

14. The opponent filed evidence in reply in the form of a witness statement from Peter Davies. Mr Davies is Chief of Staff of the opponent. His evidence focuses on the history of 'KISS' and its revenue, the calculation of listener statistics and the third parties referred to by Mr Weinstein.

Proof of use

15. The relevant statutory provisions are as follows:

"6A – (1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. Section 100 of the Act is also relevant, which states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17. Pursuant to the above provisions, the relevant period for assessing whether, or the extent to which, there has been genuine use of the opponent’s marks is the five-year period ending with the filing date of the applicant’s mark, i.e. 16 November 2008 to 15 November 2013.

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and

services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

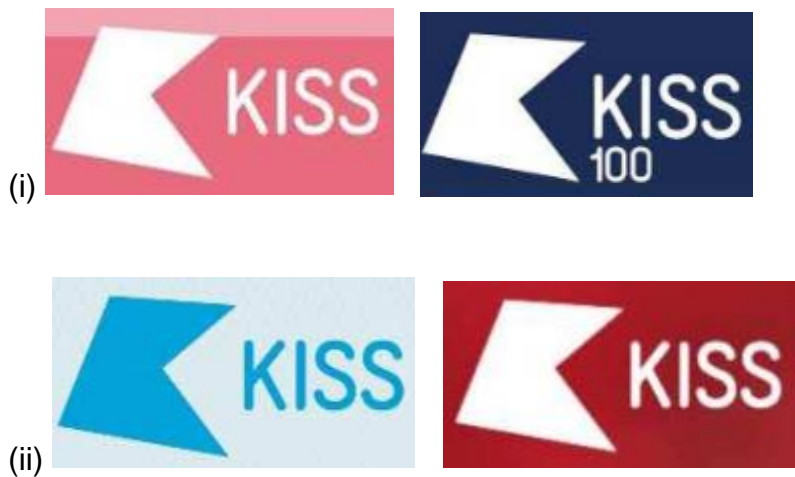
19. Mr Parkinson says that the opponent is part of Bauer Media Group (“BMG”), which operates over 120 radio stations. BMG purchased the ‘KISS’ radio station in 2007. An unspecified document entitled “The KISS Journey” suggests that the station had a reach of 3.78million in 2010, rising to 4.7million in 2014, based upon the average for the calendar year.² Also provided is a printout of the “Kiss (UK radio station)” entry from Wikipedia.³ It describes ‘KISS’ as a UK radio station broadcasting on FM and National DAB. However, as far as I understand it, Wikipedia is a community-based encyclopaedia that any user can contribute to or edit. This means that the content may be unverified. As such, I place no weight on the contents of the printout. This is

² Exhibit 2

³ Exhibit 2

particularly the case, given that Mr Parkinson does not attest to accuracy of the information in the printout.

20. Printouts from the opponent's websites, obtained via the Wayback Machine, have been provided.⁴ The printouts from totalkiss.com from within the relevant period are dated between 7 June 2009 and 15 June 2011. The printouts of kissfmuk.com from within the relevant period are dated between 4 March 2012 and 4 September 2013. Both websites had a function to listen to the station live. There is use of the plain word 'KISS' and, to a lesser extent, 'KISS 100' throughout the printouts. The figurative marks shown at (i) and (ii) below also feature in the printouts from totalkiss.com and kissfmuk.com, respectively.



21. Mr Parkinson says that annual independent surveys of radio programme listeners are conducted by the Radio Joint Audience Research Limited ("RAJAR"). He has provided several survey results from RAJAR, from which the following listenership information for 'Kiss FM' can be extracted:⁵

⁴ Exhibit 3

⁵ Exhibit 6

Period ending ⁶	Weekly reach ⁷		Total hours ⁸	Total share ⁹
20 September 2009	3,537,000	7%	19,488,000	1.9%
19 September 2010	4,041,000	8%	22,381,000	2.1%
18 September 2011	4,143,000	8%	21,397,000	2.0%
16 September 2012	4,355,000	8%	23,360,000	2.3%
31 March 2013	4,119,000	8%	21,169,000	2.0%
23 June 2013	4,354,000	8%	22,194,000	2.1%
15 September 2013	5,074,000	10%	25,727,000	2.5%
15 December 2013	5,036,000	9%	26,905,000	2.6%

22. At the hearing, Mr Wood submitted that the RAJAR figures are flawed because they are estimates based upon small sample sizes. Mr Wood contended that they are not a solid basis on which to estimate listenership. Whilst I bear in mind that the figures are somewhat limited because they are estimates,¹⁰ I do not consider that a reasonable basis to attribute them no weight at all. A printout from RAJAR’s website confirms that it is the official body in charge of measuring radio audiences in the UK; it was set up in 1992 to operate a single system for the UK radio industry.¹¹ In an article dated 6 June 2011, *BBC News* described RAJAR as the biggest media survey in the UK.¹² It appears that, albeit with limitations, they are likely to have been the best figures available to the opponent.

23. Mr Parkinson says that the opponent has invested significant time and money into the promotion of ‘KISS’, including by adverts and across social media. Examples of what are described as “adverts, promo videos and social media platforms which show the ‘KISS’ mark” have been provided.¹³ These comprise:

⁶ Although the reports are introduced as quarterly summaries, the survey periods for the ‘KISS’ figures cover six-monthly periods.

⁷ The number and percentage of the UK adult population who listen to a station for at least five minutes in the course of an average week.

⁸ The overall number of hours of adults listening to a station in the UK in an average week.

⁹ Share of total listening time, defined as the percentage of total listening time accounted for by a station in the UK in an average week.

¹⁰ For instance, the evidence suggests that around 100,000 people complete the survey diary every year, and around 20,000 people per quarter.

¹¹ Exhibit 5

¹² Exhibit ARW2

¹³ Exhibit 7

(i) An advert for the radio station featuring the KISS/KISS 100 figurative mark. The image file appears to have been created on 2 November 2011.

(ii) A photograph of an advert featuring the KISS 100 figurative mark displayed in what could be a train or underground station. The photograph appears to have been taken on 10 February 2012.

(iii) Still images of a promotional video for the station's breakfast show. The word 'KISS' in plain word and figurative formats can be seen throughout. The video is undated, albeit that the file is named "Kiss Bfast TV ad May12 – final".

(iv) Still images of a promotional video for the station. The word 'KISS' in plain word and figurative formats can be seen throughout. The video is undated and the images appear to have been captured in July 2015.

(v) A printout of the station's YouTube page, which has over 46,000 subscribers. The word 'KISS' is clearly visible in both plain word and figurative formats. The printout is undated.

(vi) Still images of five YouTube videos from the station dated between 20 October 2011 and 4 July 2013. I note that the highest views for a video was over 800,000 (October 2011) and the lowest was around 6,000 (February 2012). The station's page has around 277,000 subscribers. It is not clear when the images were obtained.

24. Mr Parkinson says that the opponent also provides advertising services to third parties by selling advertising slots during radio programmes and running promotional campaigns with them. Various press articles have been provided in support of this.¹⁴ Some predate the relevant period and some only refer to the opponent's activities, i.e. Bauer, rather than 'KISS'. Nevertheless, I note that, in December 2008, it was announced that Cobra Beer would receive 400 20-second advert slots on music channels owned by Bauer, including 'KISS'. In 2009, Orange UK announced a 4-week

¹⁴ Exhibit 8

sponsorship programme on 'KISS 100'. In 2010, it was announced that Coca-Cola would be rolling out a campaign for Diet Coke, which included a "tie-up" with 'KISS'. Moreover, in 2011, a partnership was planned with Bacardi to sponsor segments on 'KISS'. I note the radio contract agreement, dated 22 July 2010, between Bauer and a third party. I note that 'KISS' appears in the pricing list for airtime. Also included is an agreement between Bauer and a third party about a promotional campaign commencing in 2012. The fee was around £500,000. However, the campaign was to be conducted across multiple platforms and Bauer brands, not just 'KISS'. Neither agreement is signed/executed. Mr Parkinson says that the opponent has been part of sponsorship deals which have further promoted 'KISS' and third parties. I note that, in 2010, Bauer, Cancer Research and ASOS launched a campaign (which was to be promoted on 'KISS') and Phones4U signed a year-long partnership with 'KISS'.¹⁵ A partnership with O2 is also mentioned in the evidence, but this only relates to Bauer, i.e. not 'KISS'.

25. I note that 'KISS' radio station received press coverage in UK outlets during the relevant period, including, for example, *The Independent* (2012) and *The Guardian* (2009 and 2013).¹⁶ As for awards, 'KISS' received an award for Best Branded Content at the Arqiva Commercial Radio Awards in 2011; awards for Best Use of Branded Content, Breakfast Show of the Year and Station Programmer of the Year in the Sony Radio Academy Awards in 2012; and an award for Best Breakfast Show of the Year at the Arqiva Commercial Radio Awards in 2013.¹⁷

26. Mr Weinstein has provided evidence which, he says, shows that 'KISS' radio is local, rather than national, in nature. This consists of:

- (i) A printout from BMG's website which categorises 'KISS' as "LOCAL RADIO".¹⁸ The printout is undated, but the copyright is given as 2015.

¹⁵ Exhibit 9

¹⁶ Exhibit 11

¹⁷ Exhibit 10

¹⁸ Exhibit SW1

(ii) Printouts from BMG's website showing its "audience finder" tool for advertisers.¹⁹ 'KISS' is suggested when the results are filtered for London, South West/Wales and East Anglia, but not for other regions of the UK or when only National (Digital) is selected. The data is said to be based on RAJAR results from Q1 of 2014.

(iii) A printout from kissfmuk.com from May 2014.²⁰ This says that 'KISS' is broadcast on FM across London, the East of England and the West. It also includes references to Ofcom's localness guidelines.

(iv) Printouts of Ofcom's localness guidelines dated 11 May 2021.²¹ The guidelines are for how to meet legal requirements for local commercial radio stations to provide an appropriate number of programmes that are locally made or include local material.

(v) A copy of Ofcom's Communications Market Report dated 1 August 2013.²² 'KISS' is in the top 10 radio services in Cardiff and London, but not Birmingham, Belfast, Edinburgh, Glasgow, Manchester, Leeds or Newcastle.

(vi) An article from Ofcom regarding its approval of the opponent's request to change the format of 'KISS 100' (Greater London), 'KISS 101' (Severn Estuary) and 'KISS 105' (East of England) on 13 December 2010.²³ This removed the requirement to broadcast local content. Ofcom's decision was reported on by *RadioToday* on 16 December 2010.

27. In response, Mr Davies says that the opponent's predecessor in title was awarded an FM London licence in 1989 which covered 12.4million adults. Mr Davies highlights that, from March 2004, 'KISS' was surveyed as a national station by RAJAR. By 2006, after local DAB transmitters had been launched in the early 2000s, 'KISS' was carried in 29 out of the 36 DAB areas, covering all the major population centres. He states

¹⁹ Exhibits SW2-SW4

²⁰ Exhibit SW5

²¹ Exhibit SW6

²² Exhibit SW6

²³ Exhibit SW7

that, during the relevant period, 'KISS' was also available across the UK via the station's website, as well as on Freeview digital television. In 2006, he says that the opponent's predecessor in title acquired regional FM stations for South Wales/West of England and the East of England. These were subject to local programming. Mr Davies states that the DAB version of 'KISS' in those areas carried the local programme, but the national service continued to be carried in all other DAB areas. The station was moved from the local DAB transmitters to the national ones in 2013, after Ofcom removed the requirement for local programming. This ensured access for 91% of the UK population.

28. I consider Mr Davies' response adequately addresses Mr Weinstein's evidence. It appears that the station was bound by Ofcom's localness guidelines in certain regions at the beginning of the relevant period, but then permission was granted by Ofcom for these to be removed. Even before this, it appears that 'KISS' was carried on the vast majority of DAB areas in the UK. I do not consider it to be determinative that BMG's website lists 'KISS' as a local radio station or its audience finder only shows 'KISS' for certain regions, that kissfmuk.com referenced the localness guidelines, or that 'KISS' was not in the top 10 radio services in certain areas of the UK. None of this proves that 'KISS' was not available in certain areas of the UK during the relevant period. Even if it was proven, that would not automatically preclude a finding of genuine use. The assessment must, of course, consider the territorial scope of use, but it is not a requirement for a mark to be used across the entirety of the UK. For example, use in London, the southwest of England, Wales and East Anglia could be sufficient.

29. I note that Mr Davies provided revenue figures for 'KISS' in his statement. At the hearing, Mr Wood contended that these should be disregarded, since they were not provided in response to anything in the applicant's evidence. Firstly, I note that, as highlighted by Ms Messenger, this issue was raised for the first time in Mr Wood's skeleton argument. It is common in proceedings before the Tribunal for a party to raise issues with the sufficiency of the other party's evidence at the hearing stage. Moreover, the onus is, of course, on the party which bears the evidential burden. However, this is not a criticism of whether the figures are sufficient in the context of proof of use. Rather, it goes to the admissibility of the evidence itself. Where a party appears to have avoided criticising the evidence during the written procedure, only to

unveil an extensive attack after the evidence rounds have closed, there is potential for unfairness. Mr Wood's critique was not unveiled until mere days before the hearing. Although it is not extensive, it is significant in that it criticises the admissibility of Mr Davies' evidence. I do not consider it fair for the applicant to only seek to raise this issue at such a late stage in proceedings; it could have been mentioned sooner.²⁴ That way, the situation could have been easily regularised prior to the hearing. Ms Messenger also submitted that the figures were provided in response to Mr Weinstein's evidence about 'KISS' only being shown on BMG's website for advertising purposes in certain regions of the UK; that it goes to the scale of the 'KISS' operation. In this connection, there is at least an arguable link back to the applicant's evidence. In light of all this, I do not consider it appropriate to ignore the revenue figures.²⁵

30. The revenue figures provided by Mr Davies are as follows:

Financial year	2009	2010	2011	2012	2013
Advertising revenue	947,000	1,091,000	798,000	838,000	656,000
Airtime revenue	16,130,000	14,344,000	16,077,000	18,053,000	16,376,000
Events revenue	307,000	500,000	450,000	458,000	421,000
Commercial revenue	974,000	795,000	1,075,000	1,226,000	1,194,000
Total	18,358,000	16,729,000	18,400,000	20,575,000	18,555,000

²⁴ I acknowledge that Mr Davies' statement was filed as evidence in reply and, therefore, the applicant did not have an automatic opportunity to raise issues about its admissibility in its own evidence. However, Mr Davies' statement was filed on 27 July 2023, several months before the hearing. Therefore, the applicant had ample opportunity to raise issues with it before the proceedings got to the hearing stage.

²⁵ I should add that, for reasons that will become apparent during the course of this decision, nothing turns on whether the revenue figures are included.

Form of the marks

31. The opponent's first mark is in word-only format and can be nominally used in any standard typeface. 'KISS'/'KISS 100' in plain font can be seen throughout the evidence, such as on the opponent's websites. This clearly use of the mark as registered. Moving on to the figurative marks shown in evidence, Mr Wood contended that they should not be taken to be acceptable variant use of the opponent's first mark. I disagree. This is because use of a mark encompasses both its independent use and its use as part of another mark or in conjunction with that other mark; the word 'KISS'/'KISS 100' would still be perceived as the indicator of origin in the evidenced marks.²⁶

32. The opponent's second mark is figurative and encompasses the word 'KISS' and a shape device. These marks, albeit not in the same colours as registered in the series, appear in the evidence. I consider this to be acceptable variant use of the opponent's second mark. This is because changing the colour of the word and device or presenting these elements in white on a single colour background does not alter the distinctive character of the mark.²⁷

Sufficient use

33. The evidence is not without its limitations. For example, the revenue figures and categories thereof have not been adequately explained and the listener figures are essentially estimates. Moreover, no details of the amounts spent on promoting the opponent's marks have been provided and there are issues with the documentary evidence going to advertising. The image file and photograph of the adverts were created/taken during the relevant period, but there is no evidence as to where or when they were displayed, for how long, or how many members of the public would have encountered them. Likewise, although at least one of the promotional videos may have been created in the relevant period, no information is given as to where they were shown, when or how many times they were viewed in that period. The printout of the

²⁶ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

²⁷ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

station's YouTube page is undated and, therefore, cannot be relied upon as showing the position during the relevant period. Some of the sponsorship deals and advertising relate to Bauer, not either of the opponent's marks.

34. Nevertheless, an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole.²⁸ The evidence shows that the opponent's marks were displayed on the opponent's websites throughout the relevant period. The websites appear to have incorporated a listening function. Furthermore, the official RAJAR figures show that the 'KISS' station had an (estimated) weekly reach of around 3.5-5million listeners in several six-month periods during the relevant period, amounting to an estimated 7-9% of the radio listening adult population. The figures also show that the station had around 2% of the total listening time in each of those surveys. Even bearing in mind their limitations, the RAJAR figures clearly indicate that a radio station was in operation during the relevant period. The evidence points to a national station available to access across the UK. Advertising was run with several large brands during the relevant period, such as Cobra, Orange and Coca-Cola. 'KISS' also featured in articles from major UK press outlets and won industry awards during the relevant period. Taking all of this into account, I am satisfied that the opponent has demonstrated genuine use of its first and second marks.

Fair specification

35. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

²⁸ *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

36. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), at paragraph 47, Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of

protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

37. At the hearing, Ms Messenger stated that the opponent was now only relying on the following services under s.5(2)(b), more goods and services having originally been included for this purpose in the opponent’s notice of opposition:

The opponent’s first mark

Class 38: Transmission and broadcasting of radio programmes, radio telecommunication services.

Class 41: Entertainment and instruction by radio and television;²⁹ production, presentation and syndication of programmes, sound and video recordings for broadcast; production and presentation of shows; arranging of musical events.

The opponent’s second mark

Class 35: Advertising, marketing and promotion services; provision of advertising, marketing and promotional services on-line from computer databases or the Internet (including web sites); provision of advertising for accessing via communication and computer networks, including the Internet and web sites; compilation of advertisements, compilation of advertisements for use as web pages on the Internet.

Class 38: Radio broadcasting.

²⁹ Although Ms Messenger outlined *entertainment, education and instruction by radio and television*, the opponent’s Form TM7 did not include “education” when stating which goods or services covered by this mark were relied upon for the opposition. However, for reasons that will become clear, nothing turns on this.

Class 41: Organisation of radio entertainment services;³⁰ production of radio programmes and radio programming production services.

38. Ms Messenger submitted that it was not credible for the applicant to suggest that use had not been proved for these services, stating that they are the very core of the opponent's 'KISS' music business. Whilst Mr Wood contended that the evidence is not sufficient to demonstrate genuine use, he also stated that what had been shown in the evidence was, essentially, a radio channel.

39. Mr Parkinson describes 'KISS' as a radio station. This is also borne out in the documentary evidence. There was a listen live function on the opponent's websites during the relevant period and independent surveys of radio listeners in the UK have been provided. 'KISS' was referred to as a radio station in UK press outlets and received awards for its radio operation. The evidence from Ofcom and Mr Davies' narrative also clearly shows that 'KISS' was a radio station. Whilst the revenue figures are limited in that it is not entirely clear what each category is, one is described as "airtime revenue" (totalling around £80million during the relevant period), which is more likely than not to have been generated through the core operation of a radio station. On the basis of the evidence, I have no doubt that the opponent's marks were put to genuine use in relation to the operation of a radio station. The opponent may rely upon *entertainment by radio* in class 41 of its first mark and *organisation of radio entertainment services* in class 41 of its second mark.

40. The overall evidential picture establishes that 'KISS' is a radio station which plays music for entertainment purposes. There is no evidence of any of its content being educational or instructive in nature. As such, the opponent may not rely upon *instruction by radio* in class 41 of its first mark.

41. Although the opponent may have created and produced its own content for broadcast on its own station, there is no evidence that it provided such activities as a

³⁰ This term was not expressly referred to in the opponent's Form TM7, though I consider it falls within the wider term *radio entertainment services*.

service to other undertakings under the 'KISS' marks. On this basis, I do not consider that genuine use has been established in relation to *production, presentation and syndication of programmes, sound and video recordings for broadcast; production and presentation of shows* in class 41 of the opponent's first mark or *production of radio programmes and radio programming production services* in class 41 of its second mark.

42. There is also a distinct lack of evidence of any services being provided in relation to television. All the evidence goes to 'KISS' being a radio station. Therefore, genuine use has not been demonstrated in relation to *entertainment and instruction by television* in class 41 of the opponent's first mark.

43. To my mind, there is no evidence of any musical events being arranged under 'KISS' during the relevant period. The only reference to events is in the revenue figures. There is no documentary evidence showing, or any narrative explaining, what the events were, when they were held, how many events have been arranged, or how many attendees they had. The opponent may not rely upon *arranging of musical events* in class 41 of its first mark.

44. Turning to the services identified in class 38, there can be no doubt that a radio station's content needs to be broadcast. However, 'KISS' carried the opponent's own content. There is no evidence of any broadcasting (or other telecommunications) services being provided to third parties under the 'KISS' marks. For example, there is no evidence of other undertakings using 'KISS' telecommunications infrastructure to broadcast their content. On this basis, I find that the opponent may not rely upon *transmission and broadcasting of radio programmes, radio telecommunication services* in class 38 of its first mark or *radio broadcasting* in class 38 of its second mark.

45. That leaves the services in class 35 of the opponent's second mark. As outlined above, there is evidence relevant to advertising services. However, many of the articles relate to services being provided by BMG. Some activities were not specific to 'KISS' and included BMG's other stations. Moreover, although some of the agreements indicate that they involve, for instance, the sale of advertising slots on

'KISS', that is not the same as advertising services being provided to third parties under the marks, i.e. it is not indicative of an attempt to create or maintain a market for advertising services under the 'KISS' marks. It was a means by which BMG offered advertising services under other marks (for example, 'Bauer' or 'Bauer Media'). I appreciate that the revenue figures include "advertising revenue" and that they are not insignificant sums. In addition, there is some evidence of third-party sponsorship or partnerships being entered into specifically with the station (such as, for example, Diet Coke). Nevertheless, it is my view that the evidence relating to advertising services strictly under the 'KISS' marks is insufficiently solid to support a finding of genuine use. I find, therefore, that the services in class 35 of the opponent's second mark may not be relied upon for the purposes of its claim under this ground.

46. As a result of my findings above, I conclude that fair specifications for the opponent's first and second marks are *entertainment by radio* and *organisation of radio entertainment services* (both class 41), respectively.

Section 5(2)(b)

Legislation and case law

47. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

48. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

49. The opponent relies upon particular goods and services of each of its marks to oppose particular services of the applicant's mark. Some of the respective goods and services, such as, for example, *advertising, including online, in particular advertisements, for others* (of the application) and *advertising, marketing and promotion services* (of the opponent's third, fourth, sixth and seventh marks) are clearly identical. Therefore, I will proceed on the basis that all the goods and services at issue are identical. If the opposition fails, even where the goods and services are identical, it follows that it will also fail where the goods and service are only similar.

The average consumer and the nature of the purchasing act

50. As the case law indicates, I must determine who the average consumer is for the parties' goods and services and the manner in which they are likely to select those goods and services. The average consumer has been described in these terms:³¹

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

51. The goods and services at issue in these proceedings are varied. Some, such as retail services, entertainment services and ticketing services, for instance, are available to the general public. Others, such as, for example, advertising and wholesale services, are more likely to be purchased by businesses.

52. For the general public, on average the cost of the goods and services is likely to be relatively inexpensive. They may also be purchased relatively frequently. However, they are not merely casual purchases. For example, the general public will consider the range of goods on offer when selecting retail services, the content when selecting undertakings offering films, radio or television, and the type, cost and location of the events on offer under the ticketing services. Overall, I find that the general public is likely to demonstrate a medium level of attention during the purchasing process. The goods are typically purchased from retail outlets, their online equivalents or 'app stores'. The services are likely to be selected after viewing frontage on the high street or information on websites. As such, it is my view that visual considerations will dominate the purchasing process. However, I do not exclude aural considerations

³¹ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

entirely, as the general public may receive word-of-mouth recommendations or discuss the goods and services with sales assistants.

53. As for business users, the goods and services may be more expensive. However, overall, they are not likely to be extremely expensive. These consumers may also purchase the goods and services relatively frequently. During the purchasing process, business users are likely to consider the needs of the business and will be alive to the potentially negative consequences of an incorrect selection. In addition, business users will consider other factors specific to the particular good or service. For example, they are likely to consider reach and quality when selecting advertising services and the range of goods and stock levels when selecting wholesale services. Taking all of this into account, I find that business users will exhibit a higher than medium (though certainly not the highest) level of attention during the purchasing process. These consumers are likely to purchase the goods and services from retailers/suppliers or direct from the provider, after viewing information on the internet or in brochures. Therefore, the purchasing process is likely to be predominantly visual in nature. However, I do not discount that there may be an aural component to the purchasing process, since the selection process may involve discussions with the provider.

Distinctive character of the earlier marks

54. In *Lloyd Schuhfabrik Meyer*, the Court of Justice of the European Union (“CJEU”) stated that:

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

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

55. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

Inherent characteristics

56. The opponent’s first mark is a series of two word-only marks: ‘KISS’ and ‘KISS 100’. The word ‘KISS’ is defined as a touch with one’s lips.³² Considering the services for which genuine use has been established, the number ‘100’ may be seen as a reference to the radio channel’s frequency. Alternatively, it may simply be seen as a number, with no meaning outside of its existence as such. The word ‘KISS’ neither describes nor alludes to the services relied upon, though it is an ordinary dictionary word. As the number ‘100’ has no material impact on the distinctiveness of the second mark in the series, I find that the opponent’s first mark possesses a medium level of inherent distinctive character.

³² <https://dictionary.cambridge.org/dictionary/english/kiss>

57. The opponent's second mark is a series of seven figurative marks. Each consists of the word 'KISS' presented alongside a geometric shape. The marks in the series are identical, save for their use of different colours. The distinctiveness of the mark largely rests in the word 'KISS'. The device also contributes to the distinctiveness of the mark, but to a much lesser extent. Overall, I find that the opponent's second mark also possesses a medium level of inherent distinctive character.

58. The opponent's third mark is in word-only format and consists of the word 'KISSMAS'. It appears to be an invented word. However, notwithstanding the established principle that consumers normally perceive a trade mark as a whole, consumers will break down the mark into verbal elements which suggest a concrete meaning or resemble words known to them.³³ Relevant consumers will recognise the word 'KISS' at the beginning of the mark, with the effect that the mark as a whole alludes to a touch with one's lips. In totality, given the overall sound of the mark and the inclusion of the letters 'MAS', it may be seen as a portmanteau of the words 'KISS' and 'CHRISTMAS'. Overall, I find that this mark has between a medium and high level of inherent distinctiveness.

59. The opponent's fourth mark consists of the plain word 'KISSFMUK.COM'. It is my view that the '.COM' element will be seen as indicating a website address, whereas the 'KISSFMUK' element is likely to be broken down into 'KISS', 'FM' and 'UK'. In totality, the mark is likely to be seen as referring to the website of a UK FM radio station named 'KISS'. The 'KISS' element is most distinctive of these elements. Overall, the mark does not describe or allude to the goods and services relied upon. It has a medium level of inherent distinctive character.

60. The opponent's fifth mark is a series of two word-only marks: 'KISS' and 'kiss'. The capitalisation makes no difference to the distinctiveness of the marks in the series. The word will be understood in accordance with the aforementioned meaning. I find that the opponent's fifth mark possesses a medium level of inherent distinctive character.

³³ *Usinor SA v OHIM*, Case T-189/05

61. The opponent's sixth mark consists of the plain word 'KISSTORY'. This appears to be an invented word. Again, consumers will break down the mark into verbal elements which suggest a concrete meaning or resemble words known to them. It is my view that relevant consumers will recognise the word 'KISS' at the beginning of the mark, with the effect that the mark as a whole alludes to a touch with one's lips. In totality, it may be seen as a portmanteau of the words 'KISS' and 'STORY' or 'KISS' and 'HISTORY'. Overall, I find that the opponent's sixth mark has between a medium and high level of inherent distinctiveness.

62. The opponent's seventh mark is a word-only mark comprising the word 'KISSALICIOUS'. This is also an invented word. However, consumers will recognise the word 'KISS' at the beginning of the mark, with the effect that the mark as a whole alludes to a touch with one's lips. The mark, as a whole, may be seen as a portmanteau of the words 'KISS' and 'DELICIOUS'. Overall, the mark has between a medium and high level of inherent distinctive character.

Enhanced distinctive character

63. At the hearing, Ms Messenger contended that the distinctive character of the opponent's first, fifth and sixth marks has been enhanced through use.

64. I have already considered the opponent's evidence relating to its first mark. My previous assessment also applies to the opponent's fifth mark since it, too, consists of the word 'KISS'/'kiss'. In addition to the evidence from between 16 November 2008 and 15 November 2013, I note that Mr Parkinson says that the 'KISS' mark was first used as early as 1990. The "KISS Journey" document suggests that 'KISS' was granted an FM licence in 1990.³⁴ It also says that 'KISS' reached 1.45million by 2000 and 2.31million by 2005. There are also additional printouts from totalkiss.com, dated 14 December 2006 and 6 June 2008; the word 'KISS' is clearly visible, as is a 'listen live' function. There is also evidence about a 'tie-up' between Coca-Cola and Kiss FM

³⁴ Exhibit 3

in an article dated 21 October 2008.³⁵ Moreover, there are additional figures from RAJAR which are relevant to the present assessment, namely:³⁶

Period ending	Weekly reach		Total hours	Total share
18 September 2005	2,369,000	5%	11,510,000	1.1%
17 September 2006	2,888,000	6%	16,272,000	1.5%
16 September 2007	3,095,000	6%	17,252,000	1.7%
14 September 2008	3,198,000	6%	18,410,000	1.8%

65. Combining the above with my comments on genuine use, I note that ‘KISS’ was displayed on the opponent’s websites in 2006, 2008 and in the five years preceding the relevant date, along with a ‘listen live’ function. The RAJAR figures suggest that, between 2005 and the relevant date, ‘KISS’ had a weekly reach of between 5% to 10% and a total share of between 1.1% to 2.6% of the radio listening adult population. In the context of a large, competitive market, these are not insignificant estimated shares. The evidence points to a national station available to access across the UK for several years before the relevant date, with a licence initially obtained in 1990. Advertising was run with several large brands in 2008 and during the five years preceding the relevant date. ‘KISS’ featured in several UK press articles before the relevant date and won industry awards. Although the evidence is not without its limitations, I find that the distinctiveness of the opponent’s first and fifth marks had been enhanced to between a medium and high level at the relevant date in respect of *entertainment by radio* and *radio entertainment services provided via a website*, respectively.

66. As for the opponent’s sixth mark, Mr Parkinson says that ‘KISSTORY’ was launched as a radio programme on ‘KISS’ in 2002, becoming a full-time radio programme in 2013. The “KISS Journey” document says that the ‘KISSTORY’ channel launched in 2013.³⁷ The word ‘KISSTORY’ appears next to the ‘listen live’ button in the printout from kissfm.com dated 1 June 2013; there are also links named “Buy KISSTORY Tickets” and “KISSTORY in Ibiza!” in the printouts dated 6 March 2013

³⁵ Exhibit 8

³⁶ Exhibit 6

³⁷ Exhibit 2

and 8 June 2012, respectively.³⁸ I note that 'KISSTORY' appears in further printouts from the website. However, they cannot be relied upon as showing the position at the relevant date because they are from 2015. The same is true of the extracts from kisstory.kissfmuk.com/live and theo2.co.uk/events.³⁹ 'KISSTORY' was mentioned in an article in *The Guardian* on 28 October 2013 and what appears to be a press release dated 17 May 2013.⁴⁰ The following RAJAR figures are relevant to the 'KISSTORY' channel:⁴¹

Quarter ending	Weekly reach		Total hours	Total share
15 September 2013	854,000	2%	3,296,000	0.3%
15 December 2013	927,000	2%	4,077,000	0.4%

67. No turnover figures specific to 'KISSTORY' have been provided and there is a distinct lack of information regarding amounts expended on promoting the mark in the UK. None of the evidence provided by Mr Parkinson relating to promotional activities, commercial partnerships, sponsorship deals or awards goes to the 'KISSTORY' mark. The RAJAR figures for this channel cover a period of around six months leading up to the relevant date and, although not insignificant, suggest a very small estimated share of the commercial radio market. 'KISSTORY' was mentioned in a press release and by one national press outlet around that same six-month period. The dedicated channel was only established in 2013 (the year in which the relevant date falls) and the evidence from before then – including any which could support Mr Parkinson's narrative that 'KISSTORY' was a programme on 'KISS' since 2002 – is extremely limited. The mark featured on the opponent's website a total of three times between 8 June 2012 and 1 June 2013. I am not satisfied that the evidence establishes that the inherent distinctiveness of the opponent's sixth mark had been enhanced through use at the relevant date.

³⁸ Exhibit 3

³⁹ Exhibit 4

⁴⁰ Exhibit 11

⁴¹ Exhibit 6

Comparison of trade marks

68. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo* that:

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

69. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

70. The competing marks are shown at paragraphs 1 and 3.

Overall impressions

71. The opponent's first mark is a series of two word-only marks: 'KISS' and 'KISS 100'. The overall impression of the first mark of the series lies in the word 'KISS', there being no other elements. The word 'KISS' dominates the overall impression of the second mark in the series, whilst the number '100' plays a much lesser role.

72. The opponent's second mark is a series of seven figurative marks comprising the word 'KISS' and a geometric shape. The marks in the series differ only in the colour

used. As the eye is naturally drawn to elements of marks that can be read,⁴² the word 'KISS' is most dominant in the overall impression. The device, whilst still contributing, plays a lesser role.

73. The opponent's third, sixth and seventh marks consist of the plain words 'KISSMAS', 'KISSTORY' and 'KISSALICIOUS', respectively. The overall impression of each mark lies in each of these words.

74. The opponent's fourth mark comprises the word 'KISSFMUK.COM'. As outlined above, this is likely to be perceived as containing four elements: 'KISS', 'FM', 'UK' and '.COM'. The word 'KISS' appears at the beginning of the mark, a position which tends to have most impact,⁴³ and is the most distinctive. Therefore, it is most dominant in the overall impression. The other elements will be perceived as indicating an FM radio station, a geographical location and a top-level domain. Therefore, they play lesser roles in the overall impression.

75. The opponent's fifth mark is a series of two word-only marks: 'KISS' and 'kiss'. The different capitalisation makes no difference to the overall impression of the marks in the series, which lies in the word 'KISS'/'kiss'.

76. The applicant's mark is in word-only format and consists of the word 'MUSIKISS'. As there are no other elements, the overall impression lies in the word itself.

Visual comparisons

The opponent's first and fifth marks and the applicant's mark

77. The competing marks are visually similar insofar as they share the letters 'KISS'. This is the only/dominant element of the opponent marks and is entirely reproduced in the applicant's mark. They differ in that the shared letters are preceded by the additional letters 'MUSI' in the applicant's mark. Bearing in mind my assessment of

⁴² *Wassen International Ltd v OHIM*, Case T-312/03

⁴³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

the overall impressions, I find that there is between a low and medium degree of visual similarity between the marks. I acknowledge that the second mark in the opponent's first series also includes the number '100'. However, given that this plays a much lesser role in the overall impression of that mark, the competing marks remain visually similar to between a low and medium degree.

The opponent's second mark and the applicant's mark

78. The competing marks are visually similar in that they share the letters 'KISS'. This element dominates the overall impression of the opponent's mark. However, the letters form part of a singular word in the applicant's marks and are preceded by the additional letters 'MUSI'. Moreover, the opponent's mark contains a device. Given that the registration of word-only marks provides protection for use of the words in any colour,⁴⁴ I do not consider the difference created by the use of colour in the opponent's mark to be significant. Overall, I find that there is a low degree of visual similarity between the competing marks.

The opponent's third, fourth, sixth and seventh marks and the applicant's mark

79. The competing marks are all visually similar because of the shared letters 'KISS'. The competing marks differ in that these letters appear in different positions (at the beginning of the opponent's marks and at the end of the applicant's mark). The other strings in the competing marks also differ, i.e. 'MUSI' in the applicant's mark and 'MAS', 'FMUK.COM', 'TORY' and 'ALICIOUS' in the opponent's marks. Weighing the similarities against the differences, I find that the competing marks are visually similar to a low degree.

⁴⁴ *LA Superquímica, SA v EUIPO*, Case T-24/17

Aural comparisons

The opponent's first, second and fifth marks and the applicant's mark

80. Consumers will make no attempt to articulate the device in the opponent's second mark. As such, all the opponent's marks under consideration will be pronounced as "KISS". This is the third syllable in the applicant's mark. However, the applicant's mark begins with two syllables that have no counterparts in the opponent's marks. Overall, I find that there is between a low and medium degree of aural similarity between the competing marks. Again, I appreciate that the second mark in the opponent's first series has additional matter, namely the number '100', which may or may not be articulated. Even where it is articulated, because it plays a much lesser role in the overall impression of the mark, I remain of the view that the competing marks are aurally similar to between a low and medium degree.

The opponent's third, fourth, sixth and seventh marks and the applicant's mark

81. The competing marks are aurally similar because they all share the syllable "KISS". They differ in that the shared syllable appears in different positions (at the end of the applicant's mark but at the beginning of the opponent's marks). Further, the competing marks all have different additional syllables. It is my view that, whilst the opponent's marks are not all the same, each is aurally similar to the applicant's mark to a low degree.

Conceptual comparisons

The opponent's first, second and fifth marks and the applicant's mark

82. The opponent's marks all convey the concept of a touch by one's lips. The device in the opponent's second mark does not carry any particular meaning, aside from it being a shape. The number '100' in the second mark of the opponent's first series may not provide any real concept. Alternatively, it may be seen as a reference to a radio channel's frequency. Either way, neither the device nor the number materially impacts the meaning conveyed by the marks. The applicant's mark is an invented word.

Although I am not convinced that all consumers will identify the word 'KISS' in the mark, it is possible that a significant proportion of consumers will. This will result in the mark alluding to the same meaning conveyed by the opponent's marks. As these consumers represent the opponent's best case, I will proceed on the basis of their perceptions. In such circumstances, the shared concept of 'KISS' acts as a point of conceptual similarity.

The opponent's third, sixth and seventh marks and the applicant's mark

83. The competing marks all allude to a touch by one's lips within different invented words. Again, this acts as a point of conceptual similarity.

The opponent's fourth mark and the applicant's mark

84. The combination of the identifiable elements 'KISS', 'FM', 'UK' and '.COM' in the opponent's mark results in an overall concept of a reference to the website of a UK FM radio station named 'KISS'. The applicant's mark alludes to the meaning of 'KISS'. Although, overall, the competing marks arguably convey different concepts, I accept that the presence of the shared word may result in a degree of overlap. If that is the case, it will be to no more than a low degree.

Likelihood of confusion

85. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

86. Confusion can be direct or indirect. In Ms Messenger's skeleton argument, she conceded that there is unlikely to be direct confusion between the competing marks, a type of confusion which involves the average consumer mistaking one mark for the other. At the hearing, she confirmed that the opponent was no longer pursuing direct confusion. Therefore, I need only consider whether there is a likelihood of indirect confusion.

87. Indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

88. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁴⁵ I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.⁴⁶ It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.⁴⁷

89. In its notice of opposition, the opponent argued that the likelihood of indirect confusion was increased because of its family of ‘KISS’ marks. However, at the hearing, Ms Messenger confirmed that the opponent was no longer pursuing this line of argument. As such, this will not factor into my assessment.

90. I also note that, in his witness statement, Mr Weinstein refers to a third-party radio station which uses the letters ‘KIS-’, a Freeview television channel called ‘KISS ME TV’, and other “Kiss-branded internet radio stations”. He does not explain what this evidence is intended to show. Mr Wood’s skeleton argument only makes passing reference to such matters and no submissions were made on them at the hearing. I can only presume that the applicant, in referring to these third parties, was intending

⁴⁵ As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

⁴⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

⁴⁷ See the Court of Appeal’s comments in *Liverpool Gin Distillery*, paragraph 13.

to argue that other undertakings are using the word 'KISS' (or similar) in their trade marks, with the effect that the likelihood of confusion is reduced. I note that the evidence consists of the following:

(i) An article from *The Guardian*, dated 9 December 2004, about Ofcom deciding that Easy 1035 was allowed to rename itself as Kismat Asian Talk Radio.⁴⁸

(ii) Printouts from the register of trade marks regarding a 'KISMAT RADIO' registration which was filed in 2009.⁴⁹

(iii) An article from *RadioToday*, dated 4 April 2013, about Kismat Radio beginning coverage of the Indian Premier League.⁵⁰

(iv) An Ofcom article about Kismat Asian Talk Radio's change of format on 25 November 2004.⁵¹

(v) RAJAR's survey results for the period ending 15 December 2013.⁵² This shows Kismat Radio's results above those of 'KISS' in the alphabetical list.

(vi) Freeview guides for Winter 2013/2014 and Summer 2015.⁵³ Within this, 'KISS' is listed under radio stations, whilst a channel called 'Kiss Me TV' is listed under text services.

(vii) Printouts from Ofcom's website showing 'Kiss Me TV' being licensed in August 2013 and May 2015.⁵⁴

⁴⁸ Exhibit SW8

⁴⁹ Exhibit SW9

⁵⁰ Exhibit SW10

⁵¹ Exhibit SW10

⁵² Exhibit SW10

⁵³ Exhibit SW11

⁵⁴ Exhibit SW11

(viii) Printouts from Amazon UK showing search results for “kiss radio”.⁵⁵ It shows what appear to be radio software applications for a ‘Kiss-FM’, covering several frequencies, from a third party. The applications are from 21 March 2011, 21 October 2013, 24 October 2013 and 12 March 2014.

(ix) Printouts from kissfmeurope.com and kissfm-ireland.com, showing the websites of (potentially) two ‘KISS’ branded Irish radio stations.⁵⁶ The printouts are undated, themselves, but have been labelled in the evidence as being from 1 July 2014.

91. Firstly, I do not consider the evidence about Kismat Radio to be relevant to the question of whether there is a likelihood of confusion between the applicant’s mark and any of the opponent’s marks. The common letters between the marks at issue are ‘KISS’. Kismat Radio does not use this string. Rather, the letters ‘Kis’ appear at the beginning of an entirely different word. Moreover, although ‘Kiss Me TV’ appears to have been in operation at the relevant date, I do not consider the mere existence of this channel to be compelling evidence that consumers were accustomed to differentiating between it and the opponent’s marks. This is particularly the case, given that they offer different services and, for example, appear under different sections of the Freeview guides. As for the third-party ‘KISS’ radio stations, I note that two of these are Irish radio stations. Therefore, they do not assist the applicant in establishing how the average consumer in the UK would view the competing marks. In any event, I am not persuaded that the mere existence of apps or websites establishes that consumers were accustomed to differentiating between the third-party stations and that of the opponent. There is nothing which demonstrates that these stations have traded alongside the opponent’s over an extended period of time, such as listener, website visitor or app download figures. In addition, the printouts of the websites are from after the relevant date. In light of all this, Mr Weinstein’s evidence will not factor into my assessment.

⁵⁵ Exhibit SW12

⁵⁶ Exhibit SW12

92. Earlier in this decision, having proceeded on the basis that the parties' respective goods and services were identical, I concluded that:

- Relevant consumers of the goods and services are likely to include members of the general public and business users, the former demonstrating a medium level of attention and the latter a higher than medium level of attention.
- The purchasing process is predominantly visual in nature, though aural considerations have not been excluded.
- The opponent's first, second, fourth and fifth marks possess a medium level of inherent distinctive character.
- The opponent's third, sixth and seventh marks possess between a medium and high level of inherent distinctive character.
- The distinctive character of the opponent's first and fifth marks has been enhanced through use to between a medium and high level.
- The word 'KISS' dominates the overall impression of the opponent's first, second, fourth and fifth marks, whilst the other elements (the number '100', the device and colours, and the words 'FM', 'UK' and '.COM') play lesser roles.
- The overall impression of the opponent's third, sixth and seventh marks lies in the words 'KISSMAS', 'KISSTORY' and 'KISSALICIOUS'.
- The overall impression of the applicant's mark is dominated by the word (and only element) 'MUSIKISS'.
- The opponent's first and fifth marks and the applicant's mark are visually and aurally similar to between a low and medium degree.

- The opponent's second mark and the applicant's mark are visually similar to a low degree and aurally similar to a between a low and medium degree.
- The opponent's third, sixth and seventh marks and the applicant's mark are visually and aurally similar to a low degree.
- The opponent's fourth mark and the applicant's mark are visually and aurally similar to a low degree.
- All the competing marks share the concept associated with the word 'KISS'.

The opponent's first, second and fifth marks and the applicant's mark

93. At the hearing, Ms Messenger submitted that the applicant's mark simply adds a non-distinctive element 'MUSI' to the opponent's first, second and fifth marks, as would be expected in a sub-brand or brand extension. Applying the case law principles, and considering all the above factors, I do not believe that consumers would assume a commercial association or a licencing agreement between the parties, or sponsorship on the part of the opponent, merely because of the four shared letters. Although the word 'KISS' in the opponent's marks is distinctive to at least a medium level, and these letters are reproduced in the applicant's mark, there is no sharing of an independent distinctive element which could give rise to indirect confusion; the letters 'KISS' form part of a longer, invented word in the applicant's mark, whereas it is presented as a single, recognisable word in the opponent's marks. Although the applicant's mark as a whole may allude to the meaning of 'KISS', I do not consider that consumers would split it into two separate elements 'MUSI' and 'KISS'. Moreover, I disagree that the difference created by the additional letters 'MUSI' is a simple addition of a non-distinctive element. There is no evidence that the letters 'MUSI' are synonymous with the word 'MUSIC' or that consumers are accustomed to perceiving them as a prefix describing something that is music related. Further, the differences are not consistent with any logical brand extensions with which consumers would be familiar. Although adding or removing a decorative device or the number '100' may be, I can see no reason why an undertaking would add the letters 'MUSI' to the beginning of a known

word, resulting in an invented word and a different mark. Whilst I acknowledge that the categories of indirect confusion identified in *L.A. Sugar* are not exhaustive, I can see no other basis for concluding that consumers, even paying no more than a medium level of attention, would assume an economic connection between the parties. Taking all of this into account, I find that there is no likelihood of indirect confusion, even in relation to identical goods and services.

The opponent's third, fourth, sixth and seventh marks and the applicant's mark

94. In respect of these marks, Ms Messenger submitted that the applicant's mark simply changes one element in a way that is logical and consistent with a brand extension. Again, applying the case law principles, and bearing in mind all the above factors, I do not believe that consumers would assume a commercial association or a licencing agreement between the parties, or sponsorship on the part of the opponent, merely because of the four shared letters. Firstly, none of the opponent's marks is strikingly distinctive and neither is the common string 'KISS'. In any event, consumers would have no reason to dissect the marks and separate these letters from their respective wholes. Again, there is no sharing of an independent distinctive element which could give rise to indirect confusion. Furthermore, I do not consider the differences between the competing marks to be simple additions or removals of non-distinctive elements, and they are not consistent with any logical brand extensions that would be familiar to consumers. I can see no reason why an undertaking would take the words 'KISSMAS', 'KISSTORY', 'KISSALICIOUS' or 'KISSFMUK.COM', remove all but the first four letters and add four different letters, resulting in a different mark. This is particularly the case, given the different position in the competing marks in which the shared letters appear and that there is no obvious explanation for replacing 'MAS', 'TORY', 'ALICIOUS' or 'FMUK.COM' with 'MUSI'. Although I acknowledge that the categories of indirect confusion identified in *L.A. Sugar* are not exhaustive, I can see no basis for concluding that consumers, even those exhibiting no more than a medium level of attentiveness, would assume an economic connection between the parties. In light of all this, I find that there is no likelihood of indirect confusion, even in relation to identical goods and services.

Conclusion

95. The opponent's claim under s.5(2)(b) is dismissed.

Section 5(3)

Legislation and case law

96. Section 5(3) of the Act states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

97. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

98. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs

particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV*, paragraph 40.

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

99. The conditions of s.5(3) are cumulative. Firstly, the opponent must show that its first, fifth and sixth marks are similar to the applicant's mark. Secondly, the opponent must show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the opponent must establish that the public will make a link between the marks, in the sense of its marks being brought to mind by the applicant's mark. Fourthly, assuming the foregoing conditions have been met, s.5(3) requires that one or more types of damage claimed by the opponent will occur. It is not necessary for the purposes of s.5(3) that the services are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

100. The relevant date for the assessment under this ground is the filing date of the applicant's mark, that being 15 November 2013.

101. In his skeleton argument, Mr Wood contended that the opponent's case on s.5(3) should be "summarily dismissed". At the hearing, he expanded on this line of argument, submitting that this was because there is no allegation of a subjective intent to take advantage and that an objective effect thereof is not sufficient without

something more. Unsurprisingly, this was resisted by Ms Messenger. For reasons that will become clear, it is not necessary to deal with this point to any significant extent. However, for the avoidance of doubt, in considering the opponent's pleadings in line with the relevant case law,⁵⁷ I do not agree that the opponent's case should be struck out under the Tribunal's inherent jurisdiction on this basis. In short, it is my view that the opponent's pleaded case of unfair advantage in the form of "free-riding" is sufficient to allow the opponent's claim to proceed.

Reputation

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

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

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

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

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

⁵⁷ See, for example, *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, *Claridges Hotel Limited v Claridge Candles Limited and Anor* [2019] EWHC 2003 (IPEC), *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) and *Red Bull GmbH V Monster Energy Company* [2022] EWHC 2155 (Ch).

103. I have already assessed the opponent's evidence. For the same reasons as given in my discussion under enhanced distinctive character, I am unable to conclude that the opponent's sixth mark had a qualifying reputation in the UK at the relevant date. I am satisfied that the opponent's first and fifth marks in the UK at the relevant date in respect of *entertainment by radio* and *radio entertainment services provided via a website*, respectively. This is for the reasons outlined at paragraph 65. However, on the basis of the evidence before me, I can only conclude that this reputation was moderate at best.

Link

104. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take into account all relevant factors. The factors are identified in *Intel* at paragraph 42. I take each of these in turn.

The degree of similarity between the conflicting marks

105. I have found that the applicant's mark and the opponent's first and fifth marks are visually, aurally and conceptually similar to a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public⁵⁸

106. The nature, intended purpose and method of use of *advertising* [...] in class 35 of the applicant's mark and the reputed services is different. Some providers of radio entertainment services (such as commercial radio stations) may also offer advertising services; this may lead to a degree of overlap in trade channels. However, the respective services are likely to have different users. This is because the reputed services will be accessed through a radio or an online equivalent by the general public,

⁵⁸ In considering the degree of closeness or dissimilarity between the services, I bear in mind the relevant factors outlined in *Canon*, Case C-39/97 and *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, as well as the principles on complementarity set out in, *inter alia*, *Boston Scientific Ltd v OHIM*, Case T-325/06.

whereas advertisers will be engaged directly by other businesses. There is no competition between the services. Further, they are not important or indispensable to each other and, as such, they are not complementary. Notwithstanding the limited overlap in trade channels, I find that the respective services are dissimilar, overall.

107. The nature, intended purpose and method of use of the applied-for *employment agencies* [...] and the reputed services is different. They are also likely to reach the market through different trade channels; the reputed services will be accessed through a radio or online equivalent, whereas employment agencies will be engaged directly through physical premises or websites. The services are not in competition. Neither are they complementary since they are not important or indispensable to one another. The respective services may share users insofar as members of the general public may listen to the radio and seek employment opportunities. However, overall, I find that the respective services are dissimilar.

108. The reputed services and the applicant's *retail and wholesale services* [...] have a different nature, intended purpose and method of use. I do not consider it typical for providers of radio entertainment services to also provide retail or wholesale services, even in relation to goods in the music sector, and there is no evidence before me to that effect. The services are usually accessed through different outlets; the entertainment services via radio or an online equivalent and retail/wholesale services via physical stores or websites. The services are not in competition. Neither are they complementary, since they are not important or indispensable to each other. They are likely to share users at a very high level; members of the general public are likely to listen to the radio and use retail services. Taking all of this into account, I find that the respective services are dissimilar.

109. I also consider that the reputed services and the applied-for *compilation, gathering, management and providing of data* [...] have a different nature, purpose and method of use. The respective services are not in competition. There is no evidence that it is typical for the respective services to be provided by the same undertakings. In the absence of such evidence, I consider it more likely that they will be provided by different undertakings and reach the market through different trade channels. The respective services are not important or indispensable to one another

and, therefore, are not complementary. They are also likely to have different users. The applied-for services are likely to be sought by businesses, whereas radio entertainment is likely to be sought by the general public. Overall, I find that the respective services are dissimilar.

110. *Performance of [...] radio [...] programmes [...]* in class 41 of the applicant's mark is another way of describing radio entertainment services. They are identical to the reputed services. If that is not correct, they remain highly similar, given the clear overlaps in nature, intended purpose, method of use, trade channels and users, as well as them being in direct competition.

111. *Performance of music, song, (short) films, [...] television programmes and cultural programmes* overlap in nature and intended purpose with the reputed services, since they both involve the delivery of media content for entertainment purposes. There is no evidence that undertakings offering radio entertainment also offer these other types of entertainment. I do not consider this to be typical. For instance, radio DJs do not typically *perform* the music; rather, they select and play a recording. The respective services are likely to reach the market through different trade channels. Users are likely to overlap and there may be an element of competition, whereby an individual could choose to listen to the radio or watch a short film for their entertainment. The services are not complementary. Overall, I find that there is a medium degree of similarity between the respective services.

112. *Organising, coordination and provision of recreational event; booking of events; ticket reservation and advance sale for events* and the reputed services have a different nature, intended purpose and method of use. There is no evidence that these services are provided by the same undertakings as those who provide radio entertainment services. It is my view that the respective services are likely to reach the market through different trade channels by distinct undertakings. There is no material competition between the services. Neither are they complementary. Users are likely to overlap, since members of the general public may listen to the radio and purchase tickets for events. However, taking all the above into account, I find that the respective services are dissimilar.

113. Turning to the applicant's services in class 45, these consist of creating groups for shared interests and dating. The nature of these services and the reputed services differs, as do their intended purpose and method of use. There is no evidence which establishes that it is typical in trade for the respective services to be provided by the same undertakings. In the absence of such evidence, I do not consider it to be so. There is no competition between the respective services and, given that they are not important or indispensable to the use of one another, they are not complementary. Users may overlap to the extent that radio listeners may access social networking groups. However, overall, I find that the respective services are dissimilar.

114. As for the relevant section of the public, I broadly adopt my comments at paragraphs 51-53. The relevant public may be a member of the general public or business user, the former demonstrating a medium level of attention and the latter slightly higher. The purchasing process for both is likely to be predominantly visual, though aural considerations are not excluded.

The strength of the earlier mark's reputation

115. I have found that the opponent's first and fifth marks have a moderate reputation at best.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

116. I have found that the opponent's first and fifth marks possess a medium level of inherent distinctive character. I have also found that the distinctive character of these marks had been enhanced to between a medium and high level at the relevant date.

Whether there is a likelihood of confusion

117. I have found that there is no likelihood of confusion between the opponent's marks and the applicant's mark on the basis of identical (goods and) services. I acknowledge that the provisions of s.5(3) offer additional protection which takes into account the repute and distinctiveness of earlier trade marks. However, in the

circumstances, I do not believe that the relevant public would be caused to believe that the user of the applicant's mark is economically connected to the user of the opponent's marks. This is the case for the identical and similar services, but even more so where the services are dissimilar (albeit that services are not required to be similar under this ground).

Conclusions on link

118. I acknowledge that the opponent's marks have a reputation that the distinctive character of the marks has been enhanced through use. Moreover, I accept that the opponent's mark (aside from the number '100' in the second mark of the opponent's first series) is entirely reproduced at the end of the applicant's mark, leading to a medium degree of visual, aural and conceptual similarity between the competing marks. Nevertheless, it is my view that the opponent's marks will not be called to mind by the applicant's mark. To my mind, the difference created by the additional letters 'MUSI' is too great and the reputation shown in the evidence is not strong enough. Although the competing marks have four letters in common, leading to the applicant's mark alluding to the same meaning conveyed by the opponent's mark, those letters are subsumed within the longer, invented word 'MUSIKISS' in the applicant's mark, rather than a standalone, dictionary word in the opponent's marks. The former will not be dissected into separate elements; it would, instead, be perceived as a whole. As such, I see there being no risk of the opponent's mark being brought to mind by the applicant's mark, even in relation to identical services. If the opponent's mark is brought to mind, it is my view that such a link will be too fleeting to result in any damage arising.

Conclusion

119. The opponent's claim under s.5(3) is dismissed.

Section 5(4)(a)

Legislation and case law

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

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

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

(aa) [...]

(b) [...]

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

121. Subsection (4A) of s.5 states:

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

122. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely

goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

123. 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”.

124. There being no evidence that the applicant’s mark was used before its filing date or the earliest claimed use of the opponent’s signs, the relevant date for assessing this ground of opposition is the filing date of the applicant’s mark, namely 15 November 2013.⁵⁹

Goodwill

125. The first hurdle for the opponent is to show that it had the necessary goodwill resulting from the trading activity relied on under its signs at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a

⁵⁹ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, paragraph 43.

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.”

126. I have already found that the evidence filed by the opponent is sufficient to support a finding that a registration identical to the opponent’s ‘KISS’ sign was put to genuine use in the UK in the five-year period preceding the relevant date. I have also found that the distinctive character of that mark had been enhanced through use at the relevant date. For reasons that have already been explained, I am satisfied that the opponent had accrued a moderate goodwill in relation to its business in radio entertainment services at the relevant date. I am also satisfied that the ‘KISS’ sign is distinctive of that goodwill. For reasons previously outlined, I do not consider the evidence sufficient for that finding to be extended to any of the other services relied upon. I also do not consider the ‘KISSTORY’ sign to have been distinctive of that goodwill at the relevant date.

Misrepresentation

127. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ stated that:

“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.”

And later in the same judgment:

“[...] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

128. In *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, Lewison LJ cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, considering the Court of Appeal's later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.⁶⁰ This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

129. I have already found that there is no likelihood of confusion between the applicant's mark and a registered mark identical to the opponent's 'KISS' sign. For the same reasons given at paragraphs 93 and 94, I do not consider that a substantial number of members of the relevant public would be misled into purchasing the applicant's services in the mistaken belief that they were the services of the opponent.

⁶⁰ Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

Conclusion

130. The opponent's claim under s.5(4)(a) is dismissed.

Overall outcome

131. The opposition under ss.5(2)(b), 5(3) and 5(4)(a) of the Act has failed. Subject to any appeal against my decision, the applicant's mark will proceed to registration in the UK.

Costs

132. The applicant has succeeded and is, therefore, entitled to a contribution towards its costs. At the hearing, Mr Wood invited me in such circumstances to depart from the usual scale because of the way in which the opponent has run its case. In Mr Wood's view, the opponent's pleaded case was deficient. In addition, he submitted that there was a repeated narrowing of the case from the pleadings stage onwards, meaning that the applicant was only able to fully appreciate the case against it at the hearing stage. Mr Wood submitted that, due to the opponent's conduct, a significant amount of additional work was required in these proceedings.

133. Mr Wood referred to the fact that related proceedings commenced before the EUIPO in May 2014. In his view, the opponent had nearly 10 years to prepare evidence and consider its case carefully. Despite this, Mr Wood submitted that the goods and services relied upon for the opponent's case under ss.5(2)(b), 5(3) and 5(4)(a) were limited in the opponent's letter of 7 September 2023 (and subsequent amended statement of grounds filed on 26 September 2023). Although Mr Wood expressed that the limitation was helpful, he stated that the timing of the limitation (after the evidence rounds had concluded) meant that the applicant had been forced to review all the evidence in the context of the opponent's initial broader claims as to use, reputation and goodwill. Mr Wood also submitted that the evidence demonstrates that the opponent's assertion of a reputation in many of the originally pleaded goods and services was unsupported. Given the opponent had a significant period in which to refine its case and develop its evidence, he argued that this was unreasonable.

134. In addition, Mr Wood submitted that no explanation was given in the opponent's statement of grounds as to which goods and/or services relied upon were said to be identical or similar to those of the applicant. He said that this issue was raised in the applicant's counterstatement, but the opponent neglected to properly particularise its case. In Mr Wood's view, the consequence of this was that the opponent's case remained unclear at the point of submitting skeleton arguments in advance of the hearing. He reiterated that the opponent had already run a case before the EUIPO and had already had reason to consider its best and arguable case. In this context, Mr Wood submitted that the opponent leaving its case unclear was abusive.

135. For the opponent, Ms Messenger submitted that there is no basis for off-scale costs. She stated that there has been no abusive or unreasonable behaviour. On Mr Wood's points about the narrowing of the opponent's case coming after the filing of evidence, she submitted that the evidence was not affected by the amendments that were later made. For instance, it was not the case that large parts of the evidence were rendered irrelevant by the opponent's amendments; she said that the evidence would have been the same in any event. As for Mr Wood's allegation that the opponent's case was not made clear because it had not addressed the similarity between the parties' goods and services in its evidence, Ms Messenger submitted that this was not a matter for the evidence. Rather, it is a matter for submission and, as is usual in proceedings before the Tribunal, the statement of grounds was expanded on in detail in her skeleton argument.

136. Rule 67 of the Trade Marks Rules 2008 provides:

“The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid.”

137. Tribunal Practice Notice (“TPN”) 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. The TPN stipulates that costs off the scale are available “to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour”. The opponent has not argued that

the applicant has breached any rules or utilised delaying tactics. The matter at issue is whether the timing of the narrowing of the opponent's case and the alleged lack of particularisation with respect to identity/similarity between the parties' goods and services should be considered unreasonable behaviour. Having considered the applicant's conduct in these proceedings, it is my view that off-scale costs are not appropriate in this instance.

138. It is my view that the opponent's pleaded case in these proceedings was somewhat complex. It relied upon seven trade marks, each of which being used to oppose certain applied-for services. However, in its statement of grounds, the opponent listed which goods and services covered by its first and second marks were relied upon and which of the applicant's services it claimed were identical or similar. Although it was not set out exactly which terms were in direct conflict, the lists of goods and services specified in the relevant boxes of the Form TM7 under these marks were not particularly lengthy. Whilst it certainly would have been helpful to have had a single document showing the conflicts in an itemised fashion, I consider the pleaded case on similarity between the goods and services to have been sufficiently clear for the purposes of the applicant understanding that part of the case against it.

139. I appreciate that for the opponent's remaining marks, "all goods and services" was ticked in the form. The particular conflicts being claimed were less clear. Of course, it is for the opponent in opposition proceedings to put forward the combinations of goods or services on which it relies upon for similarity. It can be unfair on trade mark applicants if they do not have a proper opportunity to address points on the similarity between the goods and services; the opponent leaving its detailed case on similarity until the hearing stage is not desirable. In my view, the claimed conflicts between the specifications of these marks and the applicant's mark ought to have been set out at least as clearly as the others. However, I do not consider that the opponent's failure to do so amounts to an abuse of process or unreasonable behaviour. The opponent's specifications cover a limited number of classes and, whilst the lists of goods and services are longer than those specified for the first and second marks, there are some obvious overlaps between the parties' respective specifications. On balance, I consider the pleadings to have been sufficiently particularised for the purposes of the applicant's understanding.

140. As for the opponent limiting its case, the narrowing the issues in proceedings before this Tribunal is to be encouraged wherever practicable and appropriate. Whilst parties should seek to do so at the earliest possible stage, I do not consider that the opponent leaving it until the evidence had been filed is demonstrative of an abuse of process or otherwise unreasonable behaviour. One can appreciate that an opponent may review its case based upon the evidence they were able to file and decide which parts of it are strongest or most sustainable and which parts should be dropped. It is true that an applicant is likely to have already reviewed the evidence at that point and perhaps compiled its own evidence based upon the broader claims. Some time and effort involved in doing so may be wasted. A clear example would be where evidence and legal arguments have been filed by an applicant on the basis of the later dropped elements of the case. However, in this instance, the opponent's evidence is focused on its commercial radio operation. Reliance on services related to this, such as radio entertainment services, was not dropped when it limited its case. There is no evidence going to the various other goods and services originally relied upon. In these circumstances, it is not obvious that the limiting of the opponent's case would have rendered any material amount of time or effort on the applicant's part to have been wasted or that it created any additional work. On Mr Wood's point about the opponent's claimed reputation, it is my view that parties should make sensible, supportable claims as to reputation. However, it is open to a party at pleadings stage to bring the case it wishes to. Whether or not a reputation will be proven will be borne out in the evidence. Again, the opponent's evidence was focused on its commercial radio operation. Its claim as to reputation in respect of other services was not successful, but that does not automatically mean that it was unreasonable or abusive to claim it in its pleadings.

141. I should add that I have not been persuaded otherwise by Mr Wood's reference to prior proceedings between the parties before the EUIPO. It may be that the opponent had already opposed the EU trade mark from which the filing date of the applicant's mark derives. It may also be that the opponent relied on equivalent grounds in those proceedings and filed similar evidence. I have not had sight of any decisions from the EUIPO, the papers on which they were founded, the earlier rights that were relied upon or the pleadings that were made. In any event, even if a party had brought a case against a mark in one jurisdiction, that does not mean that it is bound to bring the same case in a different jurisdiction, even if that mark is identical to the one

previously opposed. It does not limit the scope of what case a party can plead and it is not demonstrably unreasonable to later bring a different case.

142. The relevant scale is that published in TPN 2/2016.⁶¹ While I have found that the opponent's conduct does not justify off-scale costs, I consider it appropriate to make an uplifted award of costs in the applicant's favour in respect of its preparation for the hearing. This is because, although not to an unreasonable or abusive extent, the opponent's case on identity/similarity between the parties' goods and services should have been more clearly particularised. I can appreciate that Mr Wood may have spent more time than was necessary preparing for various combinations of goods and services being used by the opponent in this regard. Ms Messenger's skeleton argument contained a detailed (and very helpful) list of where identity/similarity was being claimed, but Mr Wood is unlikely to have had sight of this until after he had already prepared his own skeleton argument. In the circumstances, I award costs on the following basis:

Considering the opponent's statement and preparing a counterstatement	£400
Considering the opponent's evidence and preparing evidence	£700
Preparing for and attending a hearing	£1,000
Total	£2,100

⁶¹ The proceedings having commenced after 1 July 2016 but before 1 February 2023.

143. I order Bauer Radio Limited to pay Simon Weinstein the sum of £2,100. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 31st day of October 2024

**James Hopkins
For the Registrar**

Annex A

Services of the first earlier mark relied upon under s.5(2)(b)	Services of the applicant's mark opposed under s.5(2)(b)
<p>Class 38: Transmission and broadcasting of radio programmes, radio telecommunication services.</p> <p>Class 41: Entertainment and instruction by radio and television; audio and video recording services; production, presentation and syndication of programmes, sound and video recordings for broadcast; production and presentation of shows; organisation of competitions; arranging of musical events; advisory services relating to all the aforesaid goods.</p>	<p>Class 35: Employment agencies, in particular in connection with music or for those interested in music; retail and wholesale services including online retail services and online wholesale services, of goods and services in the music sector.</p> <p>Class 41: Organising, coordination and provision of recreational events; booking of events; performance of music, song, (short) films, radio and television programmes and cultural programmes; ticket reservation and advance sale for events.</p>
Goods and services of the second earlier mark relied upon under s.5(2)(b)	Services of the applicant's mark opposed under s.5(2)(b)
<p>Class 9: Publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including websites); electronic publications, multi-media recordings and publications; audio and visual recordings.</p> <p>Class 35: Advertising, marketing and promotion services; provision of advertising, marketing and promotional</p>	<p>Class 35: Advertising, including online, in particular advertisements, for others; employment agencies, in particular in connection with music or for those interested in music; retail and wholesale services including online retail services and online wholesale services, of goods and services in the music sector; compilation, gathering, management and providing of data (for others)</p>

<p>services on-line from computer databases or the Internet (including web sites); provision of advertising for accessing via communication and computer networks, including the Internet and web sites; compilation of advertisements, compilation of advertisements for use as web pages on the Internet.</p> <p>Class 38: Telecommunication services; communication services; broadcasting services; radio broadcasting.</p> <p>Class 41: Organisation of competition and awards; arranging and conducting competitions; arranging and conducting events; organisation of events for entertainment purposes; radio entertainment services; production of radio programmes and radio programming production services.</p>	<p>(including via databases searchable online or via apps).</p> <p>Class 41: Organising, coordination and provision of recreational events; booking of events; performance of music, song, (short) films, radio and television programmes and cultural programmes; ticket reservation and advance sale for events.</p>
<p>Services of the third earlier mark relied upon under s.5(2)(b)</p>	<p>Services of the applicant's mark opposed under s.5(2)(b)</p>
<p>Class 35: Advertising, marketing and promotion services; provision of advertising, marketing and promotional services provided by means of radio and television broadcasting including internet radio broadcasting; provision of advertising, marketing and promotional services on-line from computer databases or the Internet (including web</p>	<p>Class 35: Advertising, including online, in particular advertisements, for others; employment agencies, in particular in connection with music or for those interested in music; retail and wholesale services including online retail services and online wholesale services, of goods and services in the music sector; compilation, gathering, management</p>

<p>sites); provision of advertising for accessing via communication and computer networks, including the Internet and web sites; compilation of advertisements, compilation of advertisements for use as web pages on the Internet; arranging, conducting and production of business exhibitions, shows and events.</p> <p>Class 38: Telecommunication services; communication services; broadcasting services; television programming; radio broadcasting; wireless transmission and broadcasting of television programmes; broadcasting of cable television programmes; broadcasting of cable television; video subscription television and radio broadcasting and transmission; computer network communications; transmission and reception of data and information, namely SMS messaging services namely sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; message collection and transmission services; transmission, broadcasts, reception and processing of sound, data or images by computer, cable, electronic mail, television or satellite means; receiving and exchanging information, messages,</p>	<p>and providing of data (for others) (including via databases searchable online or via apps).</p> <p>Class 41: Organising, coordination and provision of recreational events; booking of events; performance of music, song, (short) films, radio and television programmes and cultural programmes; ticket reservation and advance sale for events.</p>
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text, sound, images and data; electronic mail services; satellite transmission; teletext services; pay per view television transmission services; video on demand transmissions; rental, leasing or hire of apparatus, installations or components for use in the provision of the aforementioned services; advisory and consultancy services relating to the aforementioned services; pod casting; digital downloads; webcasting.

Class 41: Organisation of competition and awards; arranging and conducting competitions; arranging and conducting award ceremonies; presentation of awards for achievement; education and training services; arranging and conducting courses, conferences, exhibitions, events and seminars; organising, conducting, production of shows, events, displays, and parties; organisation of events for cultural, entertainment and sporting purposes; organisation of competitions; organisation of sporting competitions and sports events; television entertainment services; production and distribution of television programmes; radio entertainment services; production of radio programmes and radio programming; interactive information relating to education, entertainment,

<p>sporting and cultural activities provided on-line from computer databases or the Internet; provision of information relating to education, entertainment, sporting and cultural activities for accessing via communication and computer networks production services; publishing services; publication of printed matter, periodical publications, printed publications, books and magazines; publication of printed matter.</p>	
<p>Goods and services of the fourth earlier mark relied upon under s.5(2)(b)</p>	<p>Services of the applicant's mark opposed under s.5(2)(b)</p>
<p>Class 9: Computer software; computer programs; computer software development tools; computer software for use as an application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; computer software; software and software applications to enable transmission, access, organization, and management of text messaging, instant messaging, online blog journals, text, web links, and images via the Internet and other communications networks etc; software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or</p>	<p>Class 35: Advertising, including online, in particular advertisements, for others; employment agencies, in particular in connection with music or for those interested in music; retail and wholesale services including online retail services and online wholesale services, of goods and services in the music sector; compilation, gathering, management and providing of data (for others) (including via databases searchable online or via apps).</p> <p>Class 41: Organising, coordination and provision of recreational events; booking of events; performance of music, song, (short) films, radio and television programmes and cultural programmes;</p>

<p>otherwise providing electronic media or information over the Internet or other communications networks.</p> <p>Class 16: Printed matter, printed publications, magazines, journals; periodical publications; newspapers; books; newsletters; guides; printed programmes; tickets; stationery; diaries, calendars, note books, address books, writing implements; pens, pencils.</p> <p>Class 35: Advertising, marketing and promotion services; provision of advertising, marketing and promotional services on-line from computer databases or the Internet (including web sites); provision of advertising for accessing via communication and computer networks, including the Internet and web sites; promotional services on behalf of others; promotional services in the form of online entertainment and education; promotional services in the form of sharing of multimedia content via the Internet and other computer and communications networks; compilation of data bases of information, including text, electronic documents, databases, graphics and audio visual information, via computer and communication networks; classified advertising services;</p>	<p>ticket reservation and advance sale for events.</p> <p>Class 45: Social services, namely arranging groups sharing interests and dating via social networks.</p>
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recruitment services; advertising services; online advertising and marketing services; business data analysis; promotional services; business networking.

Class 38: Telecommunication services; communication services; broadcasting services; television programming; radio broadcasting; wireless transmission and broadcasting of television programmes; broadcasting of cable television programmes; broadcasting of cable television; video subscription television and radio broadcasting and transmission; computer network communications; transmission and reception of data and information, namely SMS messaging services namely sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; message collection and transmission services; transmission, broadcasts, broadcasting services, namely, uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network; webcasting services; providing a video sharing portal; electronic communication services; providing online forums, chat

rooms, journals, blogs, and lists servers for the transmission of messages, comments and multimedia content among users; transmission of electronic media, multimedia content, videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet and other computer and communications networks; providing online community forums for users to post, search, watch, share, critique, rate, and comment on videos, and other multimedia content; providing digital program distribution of audio and video broadcasts over a global computer network; providing a video sharing portal for entertainment and education purposes reception and processing of sound, data or images by computer, cable, electronic mail, television or satellite means; receiving and exchanging information, messages, text, sound, images and data; electronic mail services; satellite transmission; teletext services; pay per view television transmission services; video on demand transmissions; rental, leasing or hire of apparatus, installations or components for use in the provision of the aforementioned services; advisory and consultancy services relating to the aforementioned services; pod casting; webcasting digital downloads.

Class 41: Entertainment services, namely, providing multimedia content or information over the Internet and (or) other communications network; entertainment services; educational services; entertainment and educational services featuring electronic media, multimedia content, videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and related information via computer and communications networks; entertainment and educational services; digital video, audio and multimedia entertainment publishing services; publishing services; publication of printed matter, periodical publications, printed publications, books and magazines; publication of printed matter; organisation of competition and awards; arranging and conducting competitions; arranging and conducting award ceremonies; presentation of awards for achievement; education and training services; education services for providing electronic media or information over the Internet or other communications network; arranging and conducting courses, conferences, exhibitions, events and seminars; organising, conducting, production of shows, events, displays, and parties;

organisation of events for cultural, entertainment and sporting purposes; organisation of competitions; organisation of sporting competitions and sports events; television entertainment services; production and distribution of television programmes; radio entertainment services; radio broadcasting services; production of radio programmes and radio programming production services.

Class 42: Application provider services (ASP); providing access to non-downloadable software; providing access to non-downloadable software to enable uploading, downloading, capturing, posting, showing, editing, playing, streaming, viewing, previewing, displaying, tagging, blogging, sharing, manipulating, distributing, publishing, reproducing, or otherwise providing electronic media, multimedia content, videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet and other computer and communications networks; providing access to non-downloadable software to enable sharing of multimedia content and comments among users; providing access to non-downloadable software to enable content providers to track

<p>multimedia content; hosting multimedia content for others; hosting multimedia entertainment and educational content for others; computer services; computer services relating to creating virtual communities for registered users to organise groups and events, participate in discussions, and engage in social, business and community networking; computer services to facilitate uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic media or information over communication networks.</p> <p>Class 45: Social introduction, networking and dating services; dating agency services; agency services for arranging personal introductions; dating services provided through social networking; personal introduction services provided through social networking; introduction and social networking services; social networking services provided over the internet.</p>	
<p>Goods and services of the fifth earlier mark relied upon under s.5(2)(b)</p>	<p>Services of the applicant's mark opposed under s.5(2)(b)</p>
<p>Class 9: Downloadable application software; downloadable mobile application software for mobile devices; downloadable mobile application software phones and tablets; computer</p>	<p>Class 35: Employment agencies, in particular in connection with music or for those interested in music; retail and wholesale services including online retail services and online wholesale services,</p>

<p>software for use as an application programming interface (API).</p> <p>Class 41: Providing use of software applications through a website; Entertainment services provided via a website; radio entertainment services provided via a website; competitions provided via a website; provision of information relating to entertainment, sporting and cultural activities for accessing by means of software applications; provision of music and music entertainment for accessing by means of software applications; provision of radio broadcasts for accessing by means of software applications; provision of radio entertainment services for accessing by means of software applications; provision of competitions for accessing by means of software applications.</p>	<p>of goods and services in the music sector.</p> <p>Class 41: Organising, coordination and provision of recreational events; booking of events; performance of music, song, (short) films, radio and television programmes and cultural programmes; ticket reservation and advance sale for events.</p> <p>Class 45: Social services, namely arranging groups sharing interests and dating via social networks.</p>
<p>Goods and services of the sixth earlier mark relied upon under s.5(2)(b)</p>	<p>Services of the applicant's mark opposed under s.5(2)(b)</p>
<p>Class 9: Data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; pre-recorded videos; CDs; CDI's, CD-ROMs; discs, cassettes and other data carriers pre-recorded video tapes and cassettes;</p>	<p>Class 35: Advertising, including online, in particular advertisements, for others; employment agencies, in particular in connection with music or for those interested in music; retail and wholesale services including online retail services</p>

digital music (downloadable) provided from the internet; digital music (downloadable) provided from the internet.

Class 35: Advertising, marketing and promotion services; provision of advertising, marketing and promotional services provided by means of radio and television broadcasting including internet radio broadcasting; provision of advertising, marketing and promotional services on-line from computer databases or the Internet (including web sites); provision of advertising for accessing via communication and computer networks, including the Internet and web sites; compilation of advertisements, compilation of advertisements for use as web pages on the Internet; arranging, conducting and production of business exhibitions, shows and events.

Class 38: Telecommunication services; communication services; broadcasting services; television programming; radio broadcasting; wireless transmission and broadcasting of television programmes; broadcasting of cable television programmes; broadcasting of cable television; video subscription television and radio broadcasting and

and online wholesale services, of goods and services in the music sector; compilation, gathering, management and providing of data (for others) (including via databases searchable online or via apps).

Class 41: Organising, coordination and provision of recreational events; booking of events; performance of music, song, (short) films, radio and television programmes and cultural programmes; ticket reservation and advance sale for events.

transmission; computer network communications; transmission and reception of data and information, namely SMS messaging services namely sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; message collection and transmission services; transmission, broadcasts, reception and processing of sound, data or images by computer, cable, electronic mail, television or satellite means; receiving and exchanging information, messages, text, sound, images and data; electronic mail services; satellite transmission; teletext services; pay per view television transmission services; video on demand transmissions; rental, leasing or hire of apparatus, installations or components for use in the provision of the aforementioned services; advisory and consultancy services relating to the aforementioned services; pod casting; digital downloads; webcasting.

Class 41: Organisation of competition and awards; arranging and conducting competitions; arranging and conducting award ceremonies; presentation of awards for achievement; education and training services; arranging and conducting courses, conferences,

<p>exhibitions, events and seminars; organising, conducting, production of shows, events, displays, and parties; organisation of events for cultural, entertainment and sporting purposes; organisation of competitions; organisation of sporting competitions and sports events; television entertainment services; production and distribution of television programmes; radio entertainment services; production of radio programmes and radio programming; interactive information relating to education, entertainment, sporting and cultural activities provided on-line from computer databases or the Internet; provision of information relating to education, entertainment, sporting and cultural activities for accessing via communication and computer networks production services; publishing services; publication of printed matter, periodical publications, printed publications, books and magazines; publication of printed matter.</p>	
<p>Goods and services of the seventh earlier mark relied upon under s.5(2)(b)</p>	<p>Services of the applicant's mark opposed under s.5(2)(b)</p>
<p>Class 9: Data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; pre-recorded videos; CDs; CDI's, CD-ROMs; discs, cassettes and other data carriers</p>	<p>Class 35: Advertising, including online, in particular advertisements, for others; Employment agencies, in particular in connection with music or for those interested in music; Retail and wholesale</p>

pre-recorded video tapes and cassettes; digital music (downloadable) provided from the internet; digital music (downloadable) provided from the internet.

Class 35: Advertising, marketing and promotion services; provision of advertising, marketing and promotional services provided by means of radio and television broadcasting including internet radio broadcasting; provision of advertising, marketing and promotional services on-line from computer databases or the Internet (including web sites); provision of advertising for accessing via communication and computer networks, including the Internet and web sites; compilation of advertisements, compilation of advertisements for use as web pages on the Internet; arranging, conducting and production of business exhibitions, shows and events.

Class 38: Telecommunication services; communication services; broadcasting services; television programming; radio broadcasting; wireless transmission and broadcasting of television programmes; broadcasting of cable television programmes; broadcasting of cable television; video subscription television

services including online retail services and online wholesale services, of goods and services in the music sector; Compilation, gathering, management and providing of data (for others) (including via databases searchable online or via apps).

Class 41: Organising, coordination and provision of recreational events; booking of events; performance of music, song, (short) films, radio and television programmes and cultural programmes; ticket reservation and advance sale for events.

and radio broadcasting and transmission; computer network communications; transmission and reception of data and information, namely SMS messaging services namely sending, receiving and forwarding messages in the form of text, audio, graphic images or video or a combination of these formats; message collection and transmission services; transmission, broadcasts, reception and processing of sound, data or images by computer, cable, electronic mail, television or satellite means; receiving and exchanging information, messages, text, sound, images and data; electronic mail services; satellite transmission; text based television transmission services; pay per view television transmission services; video on demand transmissions; rental, leasing or hire of apparatus, installations or components for use in the provision of the aforementioned services; advisory and consultancy services relating to the aforementioned services; pod casting; digital downloads; webcasting.

Class 41: Organisation of competition and awards; arranging and conducting competitions; arranging and conducting award ceremonies; presentation of awards for achievement; education and

<p>training services; arranging and conducting courses, conferences, exhibitions, events and seminars; organising, conducting, production of shows, events, displays, and parties; organisation of events for cultural, entertainment and sporting purposes; organisation of competitions; organisation of sporting competitions and sports events; television entertainment services; production and distribution of television programmes; radio entertainment services; production of radio programmes and radio programming; interactive information relating to education, entertainment, sporting and cultural activities provided on-line from computer databases or the Internet; provision of information relating to education, entertainment, sporting and cultural activities for accessing via communication and computer networks production services; publishing services; publication of printed matter, periodical publications, printed publications, books and magazines; publication of printed matter.</p>	
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Annex B

Services of the first earlier mark relied upon under s.5(3)

Class 38: Transmission and broadcasting of radio programmes, radio telecommunication services.

Class 41: Entertainment by radio; audio recording services; production, presentation and syndication of programmes, sound and video recordings for broadcast; production and presentation of shows.

Services of the fifth earlier mark relied upon under s.5(3)

Class 41: Entertainment services provided via a website; radio entertainment services provided via a website; provision of music and music entertainment for accessing by means of software applications; provision of radio broadcasts for accessing by means of software applications; provision of radio entertainment services for accessing by means of software applications.

Services of the sixth earlier mark relied upon under s.5(3)

Class 38: Telecommunication services; broadcasting services; radio broadcasting; radio broadcasting and transmission.

Class 41: Arranging and conducting events; organising, conducting, production of shows, events, displays, and parties; radio entertainment services; production of radio programmes and radio programming.

Annex C

Services relied upon under s.5(4)(a)

Transmission and broadcasting of radio programmes, radio telecommunication services; radio broadcasting; entertainment by radio; audio recording services; production, presentation and syndication of sound for broadcast; production and presentation of shows; organisation of competitions; organisation of events; entertainment services provided via a website; radio entertainment services provided via a website; competitions provided via a website; advertising; information, consultancy and advisory services relating to all the aforesaid.