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Opposition decision highlights principles from recent case law on reputation

United Kingdom - McDermott Will & Emery UK LLP

**Examination/opposition
National procedures**

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In *FreemantleMedia Ltd v Fleming* (BL O-205-10, June 24 2010), the [UK Intellectual Property Office](#) (IPO) has partially rejected an opposition against the registration of the trademark MODEL IDOL.

[FreemantleMedia Ltd](#) and 19 TV Ltd (collectively the opponents) filed an opposition against the registration of the mark MODEL IDOL in Class 35 of the [Nice Classification](#) for:

"advertising, organising, operating and supervising loyalty and incentive schemes, advertising services provided on the internet, producing television and radio adverts, trade fairs, opinion polling, data processing."

The opposition was based on three trademark registrations for POP IDOL (word and figurative marks) in various classes (including Class 35). The grounds of opposition were as follows:

- MODEL IDOL was similar to POP IDOL and had been filed in respect of identical or similar services, which led to a likelihood of confusion (Section 5(2)(b) of the [Trademarks Act 1994](#));
- MODEL IDOL was similar to the earlier POP IDOL marks, and those earlier marks had a reputation which MODEL IDOL would take unfair advantage of, or cause detriment or damage to (Section 5(3)); and
- MODEL IDOL was passing off as POP IDOL (Section 5(4)(a)).

When considering the Section 5(2) grounds, the hearing officer took into account the evidence of reputation filed by the opponents. He acknowledged the enhanced reputation of the opponents' marks, but also balanced this with the cease of use three years prior to the date of the MODEL IDOL application. The hearing officer found that the sign MODEL IDOL was similar to the POP IDOL marks and that the term 'advertising' was identical to 'advertising services' of the POP IDOL registration. Hence, a likelihood of confusion existed on the part of the relevant public in respect of these services.

In terms of passing off, the hearing officer found that any reputation or goodwill of the opponents' marks related only to television programmes, and found no similarity with the services covered by the MODEL IDOL application. There was no misrepresentation on the part of the applicant in connection with the opponents' goodwill. As such, this claim failed.

The Section 5(3) part of the decision was more revealing, showing the application of recent principles from case law.

Reputation for the purposes of Section 5(3) means that the mark is known by a significant part of the public concerned with the products or services covered by that mark (see *General Motors v Yplon SA* ([2000] RPC 572)). In particular, the market share held by the mark, the intensity, geographical extent, duration of use and the level of promotion undertaken must be considered.

The opponents had produced ample evidence of the success of their *Pop Idol* programme in 2001, 2002 and 2003. However, there was no evidence in respect of the three-year period before the relevant date of May 17 2006. The hearing officer considered that the reputation must have waned to a certain degree, but accepted that the repute of the programme would have remained in the minds of the relevant consumers at the time of filing of the MODEL IDOL application. Again, such reputation was in respect of the Class 41 specification for "television entertainment services in the nature of competitions in the field of popular music".

It was then necessary to have a link between the POP IDOL mark (with reputation) and the MODEL IDOL mark. It is enough for the sign to simply call to mind the earlier mark for there to be the necessary link (see *Intel Corporation Inc v CPM United Kingdom Ltd* ([2009] RPC 15)). Despite the moderate level of similarity between the marks, and the fact that the opponents' services ("television services") and the applicant's Class 35 services were dissimilar, the hearing officer found that the opponents had significant reputation such as to overcome the lack of similarity, and that the relevant consumer would make a link between MODEL IDOL and the opponents' marks.

Having established a link, damage is required for a Section 5(3) claim to succeed. There are three heads of damage:

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- detriment to distinctive character;
- detriment to repute; and
- unfair advantage of the distinctive character or repute.

The opponent claimed detriment to repute and unfair advantage. The reputation of POP IDOL was said to be in respect of a specific television programme, and that reputation had waned. The applicant's services were considered dissimilar to the opponents' "television services", and the marks were said to have only a moderate level of similarity. Therefore, it was held that MODEL IDOL would not cause any detriment to the reputation of POP IDOL.

As to whether the sign MODEL IDOL was free-riding on the reputation of the POP IDOL marks, the hearing officer noted that, in *Intel*, it had been established that, if an earlier mark has a reputation for certain specific services, but those services are dissimilar to those covered by the later mark, and the later mark calls to mind the earlier mark, this is not sufficient to establish that use of the later mark takes or would take unfair advantage of the repute of the earlier mark. Further, it had also been established in *L'Oréal SA v Bellure NV* (Case C-487/07) that taking unfair advantage of the repute of a mark relates not to detriment caused to the earlier mark, but to the advantage taken by the third party (for further details please see "[ECJ clarifies the meaning of 'unfair advantage' in smell-alike case](#)"). Such an advantage may, the hearing officer observed, be unfair, even where the use is not detrimental to the repute of the mark.

The hearing officer concluded that the reputation of the POP IDOL marks was significant, but not as extensive as the opponents claimed, due to the three-year gap between the last broadcast of the programme and the relevant date. As there was dissimilarity of the services and only a moderate level of similarity between the marks, there was no evidence of any advantage, let alone any unfair advantage.

The opposition thus succeeded in respect of the Section 5(2) claim, but only in respect of "advertising services". The opposition failed on the other claims.

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