

Trade Mark infringement and “wrong way round confusion”

The popular TV show *glee* may have to be renamed for future series shown in the UK, following a High Court ruling earlier this year. Mr Roger Wyand QC, sitting as a Deputy High Court Judge, ruled that use of the name 'Glee' infringed the intellectual property rights of Comic Enterprises Limited, the operators of four UK comedy and music clubs. The action was for infringement of Comic Enterprises' UK Trade Mark registration 2200698, and for passing off. The passing off claim relied on the unregistered marks "Glee Club", "Glee" and "the Glee Club" without the registered 'device'.

Background

Comic Enterprises operates four live entertainment venues: Birmingham, Nottingham, Oxford and Cardiff. The Birmingham club opened in 1994, offering live comedy, and began offering live music in 2002. The company applied to register a series of two trade marks, as shown below, in 1999.



The two marks are identical, except that the first in the series claims the colours red, black and white, whereas the second is monochrome. The registration covers a number of services, including entertainment services, comedy services, the provision of live and recorded music, the production and presentation of live shows and production and/or presentation of radio and television programmes.

Twentieth Century Fox (Fox) is a well-known media company, and its television series 'glee' follows an American high school singing club at the fictional William McKinley High School in Ohio, USA. The pilot episode was shown in the UK in 2009.

The action raised numerous interesting questions, including:

- How is a series mark to be construed for the purposes of assessing infringement?
- Was 'wrong way round' confusion sufficient to establish a likelihood of confusion?

- Was there dilution or blurring of the trade mark?

How is a series mark to be construed for the purposes of assessing infringement?

According to Section 41(2) of the UK Trade Mark Act 1994:

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

Fox alleged that, as the trade mark in the present case was a series mark, the court had to identify a single mark which represented both of the series marks, in order to be able to assess infringement. Fox reasoned that, because the first mark in the series claimed certain colours and the second, monochrome mark covered all colours, the colour claim applied to both versions of the mark for the purposes of assessing infringement.

Mr Wyand QC rejected this claim, explaining that he did not see the colour combination as being a part of the distinctiveness of the registered trade mark. He said:

"In the present case, I do not see the colour combination as being a part of the distinctiveness of the registered trade mark. The distinctive characteristics of the two marks, being the words and device, are identical".

Therefore Fox's sign could be compared with both versions of the registered mark, both the monochrome version (which effectively covered all colours) and the version in which colour had been claimed.

Was 'wrong way round' confusion sufficient to establish a likelihood of confusion?

In order for trade mark infringement to exist, where the sign being used is similar to a registered mark, it is necessary to show that the similarity is such that the public is likely to be confused into thinking that the good or services provided under the marks originate with the same trader. The usual type of confusion is where the public believe that the goods or services being offered under the allegedly infringing sign originate with the owner of the registration. In this case, however, the evidence of confusion included several instances where members of the public believed that Comic Enterprises' clubs were, in some way, associated with Fox's TV show. Mr Wyand QC referred to this as "wrong way round confusion". The question to be

answered by the court was whether this type of confusion was sufficient to show that there was a likelihood of confusion on the part of the public, as required by the UK Trade Mark Act.

Mr Wyand QC held that the 'direction' of the confusion was irrelevant. It was a question of whether there was confusion of any kind. Therefore, having already found that the marks were similar, he ruled that Fox's use of 'glee' was an infringement of Comic Enterprises' registered trade mark, under S10(2) of the UK Trade Mark Act.

Was there dilution or blurring of the trade mark?

Comic Enterprises also alleged infringement under S10(3) of the Trade Mark Act, which reads as follows:

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

Having concluded that Comic Enterprises' mark had a reputation, that the registered mark and Fox's sign were similar, and that the use of the sign in dispute would call the mark to the mind of the average consumer, it was necessary for Mr Wyand QC to decide whether the use of the sign was detrimental to the distinctive character or repute of the trade mark.

Fox argued that there was no evidence of a change in economic behaviour of Comic Enterprises' customers. On the other hand, Comic Enterprises provided evidence that potential customers were discouraged from attending Comic Enterprise's clubs in the mistaken belief that they were linked to the television series. It also provided evidence from its marketing company which explained that the television series presented a real threat to the trade mark which had to be addressed in the claimant's marketing programme.

Mr Wyand QC concluded that this was sufficient objective evidence to show a change in economic behaviour of the average consumer and that the trade mark was suffering detriment though 'swamping'. He noted that *"it is not necessary for a Claimant under section 10(3) to produce evidence quantifying a change in economic behaviour. All that is needed is objective evidence that there is or will be such a change."*

Other points of note

Comic Enterprises was required to limit the registration to a subset of the goods and services originally included in the registration, since it had not made proper use of the mark in relation to all of the goods and services.

Fox alleged that the registration was partially invalid because the mark is descriptive. However, Mr Wyand QC disagreed, saying:

"It would seem highly likely that the awareness of the meaning of 'glee club' was due to people's familiarity with the Defendant's series. I believe that the scale of the Claimant's use of the Mark was sufficient for the Mark to have acquired a distinctive character by the date of the application for registration and even more so by the date of the Defendant's challenge to the validity of the Registration in this action."

Interestingly, the claim for passing off failed, despite the claimant's success in its trade mark infringement claims.

Injunction

Mr Wyand QC granted an injunction against Fox, which would prevent them from naming future series of the show 'glee'. He said,

"Although an injunction would be a substantial blow to the defendant, I do not find that it would be disproportionate or futile. I think that an injunction is necessary to protect the claimant's intellectual property."

He added,

"I find it hard to believe that the cost of the re-titling and publicising of the new name would be so prohibitive compared to the value of the series."

However, he stayed the ruling pending the outcome of an appeal.