

EIP

No Glee in the UK with Reverse Confusion

Roger Wyand QC (sitting as a Deputy High Court Judge) recently handed down judgment in Comic Enterprises Limited v Twentieth Century Fox Film Corporation [2014] EWHC 185 [Ch]. He held that the claimant's registered trade mark was infringed but the action for the tort of passing off was not made out due to a lack of misrepresentation.

Background

Since 1994, Comic Enterprises Limited ("Comic Enterprises") has operated a number of live entertainment venues in the UK which are used for various activities including stand-up comedy. In 1999 Comic Enterprises filed a trade mark application ("the Mark") for a device mark which included the words "the glee club". The Mark was registered in 2001 in classes 25 (clothing) and 41 (entertainment services).

The defendant, Twentieth Century Fox Film Corporation ("Fox"), produces a (globally popular) television programme called "glee". This is centred around a group of characters at an American high school, most of whom are members of their school's singing club. Not only has there been a TV series aired in the UK, but albums have been sold in the UK as well as two concerts performed in Manchester and London. Comic Enterprises claimed that all these activities infringed the Mark and passed off the defendant's show as being associated in the course of trade with the claimant. Fox denied both allegations and counterclaimed for partial invalidity and partial revocation of the Mark.

Judgment

The Judge was required to rule upon a number of issues, including the scope of the mark, non-use and whether "glee club" was invalid as being descriptive of a singing club (which it was found not to be).

In terms of infringement the Judge had to consider the application of so-called "reverse confusion" (also referred to as "wrong way around" confusion). A doctrine which US trade mark practitioners will be familiar with, this form of confusion stems from consumers seeing a claimant's mark and associating it with the goods and/or services of the defendant (through the operation of the defendant's sign). In this action the court heard evidence of consumers drawing a link between Comic Enterprises' clubs and the defendant through the use by the defendant of "glee". This association was found to be detrimental to Comic Enterprise's trade.

While reverse confusion has been taken into consideration in previous UK trade mark actions (for example in *Regent University v Regent's University London* [2013] EWPC 39), the position remained unclear enough for counsel for Fox to argue that it was not relevant. However, contrary to such assertions, the Judge found that this form of confusion was probative of his decision under section 10(2)(b) of the 1994 Trade Marks Act:

"It is not necessary for infringement of a registered trade mark to show that there is "right way round confusion". All that is required is a likelihood of confusion."

Having come to this conclusion, the Judge then had to consider the relevant date at which to assess confusion. The question was whether (a) the relevant date was when the sign was first used in the UK; or (b) at a later date when the sign was better known amongst consumers. The Judge found it to be when the sign had been used on such a scale that the reaction of the public to that sign could be assessed:

"Mr Malynicz cautions against taking into account this wrong way round confusion. He says that the relevant date that I am concerned with is December 2009/January 2010 when the TV ads and the pilot for the first series were aired. He says that people who give evidence about their reactions when they see the sign after that date when the series has been extremely successful and when they are extremely well aware of it, cannot shed light on whether in December 2009/January 2010, someone who is an average consumer of the registered services would connect the Mark and sign when they encounter the sign when it is used in context. I disagree. It is when the sign has been used on a substantial scale that one will get evidence of the likely reaction of the public. If the Defendant has been using its sign on a large scale for a couple of years and there is no evidence of confusion, I am sure that the Defendant would be relying heavily on that lack of confusion."

The mark was ultimately found to be infringed under sections 10(2) and 10(3) of the 1994 act.

Comment

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Taking a step back, it is hard to see why reverse confusion would not be relevant to infringement, which may well be why the Judge spent little time addressing the point. At a high level the function of a trade mark must be impaired when the goods and/or services associated with that mark are thought by consumers to be associated with another undertaking. In such circumstances, the trade mark is ceasing to act as a badge of origin for the registered proprietor.

On a more practical level, and as hinted at by the questions underlying the Judge's finding on the relevant date for assessing confusion, the use of such evidence poses interesting questions for trade mark proprietors, and indeed interesting legal questions as to when the infringement first occurs. In the action being considered, the reputation of "glee" the TV show resulted in the reverse confusion that led the Judge to find infringement. Had the action been started at the outset of the appearance of "glee" on our television screens, such evidence would not have been available to the Claimant and one must wonder whether the result would have been the same. In cases such as this, the likelihood of confusion (via reverse confusion) appears to rise with the reputation of the sign, and so a rights holder could find itself walking a tight line between acquiescence and infringement.

By Robert Lundie Smith and Carissa Kendall-Palmer