



Neutral Citation Number: [2024] EWHC 2738 (Ch)

Case No: IL-2023-000037

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)

Rolls Building
Fetter Lane
London, EC4A 1NL

31 October 2024

Before :

MICHAEL TAPPIN KC
(sitting as a Deputy Judge of the High Court)

Between :

SHORTS INTERNATIONAL LIMITED

Claimant

- and -

GOOGLE LLC

Defendant

SIMON MALYNICZ KC, DANIEL SELMI and LAURA ADDE (instructed by **Sheridans**)
for the **Claimant**

LINDSAY LANE KC and JESSIE BOWHILL (instructed by **Fieldfisher LLP**) for the
Defendant

Hearing dates: 2-4, 7-8 & 10-11 October 2024

Approved Judgment

I direct that no official shorthand note shall be taken of this judgment and that copies of the version as handed down may be treated as authentic.

This judgment was handed down remotely at 10.30 am on 31 October 2024 by circulation to the parties' representatives by email and release to The National Archives.

The Deputy Judge:

1. These proceedings concern the YouTube Shorts service of the Defendant (“Google”). The Claimant (“SIL”) contends that Google’s use of certain signs in relation to its YouTube Shorts service amounts to infringement of SIL’s registered trade marks and passing off. Google contends that there is no infringement or passing off and that SIL’s registered trade marks are invalid.
2. The bulk of the oral submissions and cross-examination at trial was conducted by Mr Malynicz KC for SIL and Ms Lane KC for Google. However, Mr Selmi and Ms Adde each carried out some of the cross-examination for SIL and Ms Bowhill did some of the cross-examination and made some of the oral closing submissions for Google. I was glad to see junior counsel being given the opportunity to conduct some of the oral advocacy at trial. I am grateful to them all for their written and oral submissions in this interesting and complicated case. I am also grateful to Sheridans for SIL and Fieldfisher for Google for their preparation of the case and their work in making the trial run smoothly.
3. I am conscious that there has been a measure of public interest in this case. Therefore, because my judgment is lengthy, I have decided to set out a summary of my conclusions in a more digestible form, though my actual reasoning and conclusions are set out from paragraph 5 below. My conclusions, in summary, are:
 - i) At the relevant dates, the meaning of the word “shorts” extended beyond “short films” and included other short-form audiovisual content.
 - ii) SIL has a number of registered trade marks incorporating the word “shorts”. Most of those trade marks are valid, though the word mark “SHORTSTV” is invalid for most goods and services, and the other marks should be revoked for non-use for some goods and services. However, all SIL’s trade marks have low inherent distinctive character, and SIL’s use of its trade marks in the UK has not been extensive enough to enhance that distinctive character.
 - iii) Google has used the word “shorts” in various ways in relation to the YouTube Shorts service. Some of those uses are purely descriptive of the type of material on the service. Others, in combination with the YouTube name or logo, or with a derivative logo, act as indications of origin.
 - iv) None of Google’s uses of signs including the word “shorts” gives rise to a likelihood of confusion as to origin. While there are significant similarities between the signs used by Google which include the word “shorts” and SIL’s trade marks, the similarities concern the aspects which are descriptive rather than those which give SIL’s trade marks their (low) distinctive character.
 - v) While the similarities between Google’s signs and SIL’s trade marks will give rise to a link in the minds of the limited group of UK consumers amongst whom SIL’s trade marks have a reputation, Google’s uses of signs

including the word “shorts” will not cause damage to the distinctive character or repute of SIL’s trade marks.

- vi) If I had concluded that there was a likelihood of confusion or significant damage to the distinctive character or repute of SIL’s trade marks, then I would have rejected Google’s defence that it was using its signs in accordance with honest practices. However, as a result of my conclusions, SIL’s claim of trade mark infringement fails.
- vii) While SIL has protectable goodwill associated with its trade marks amongst a limited group of UK consumers, Google’s signs do not misrepresent its service as being provided by SIL or in some way authorised by SIL. Therefore there is no passing off.

4. My judgment is structured as follows:

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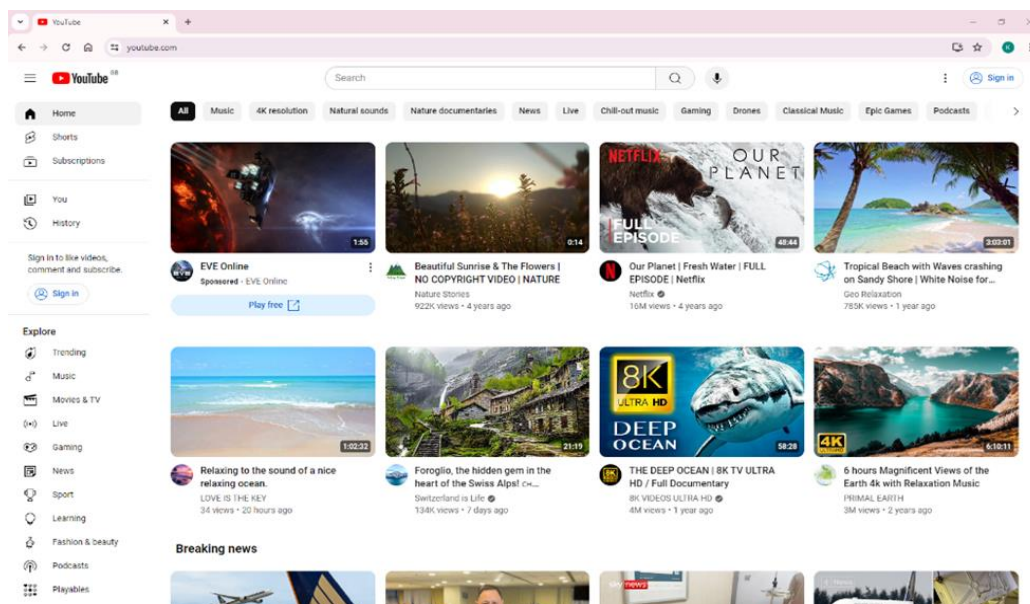
THE NATURE OF THE DISPUTE

YouTube Shorts and SIL's complaint

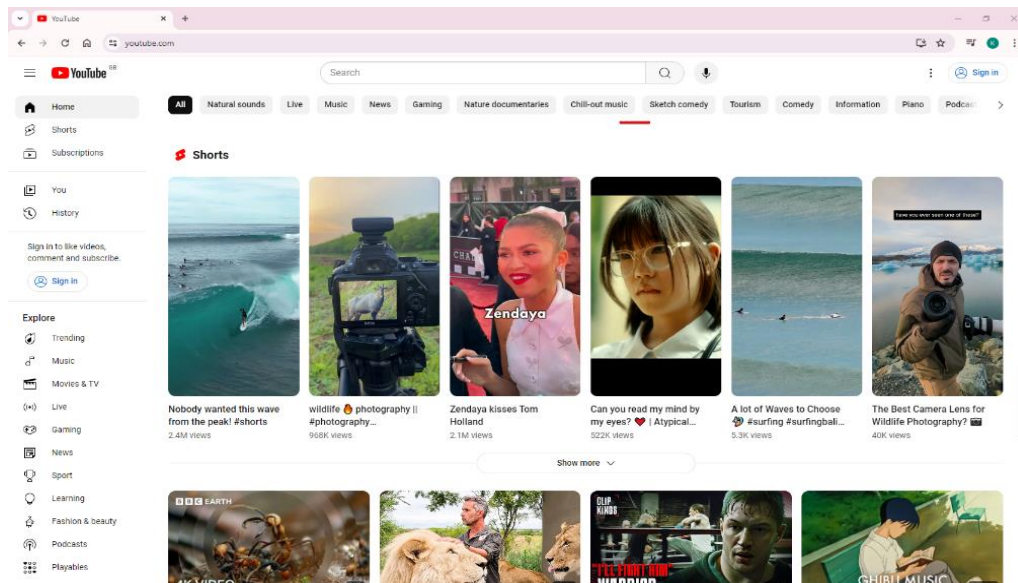
5. There was no dispute that YouTube is, and has for many years been, a very well known brand. The YouTube name and the YouTube logo are highly recognisable, whether used separately or, as shown below, together:



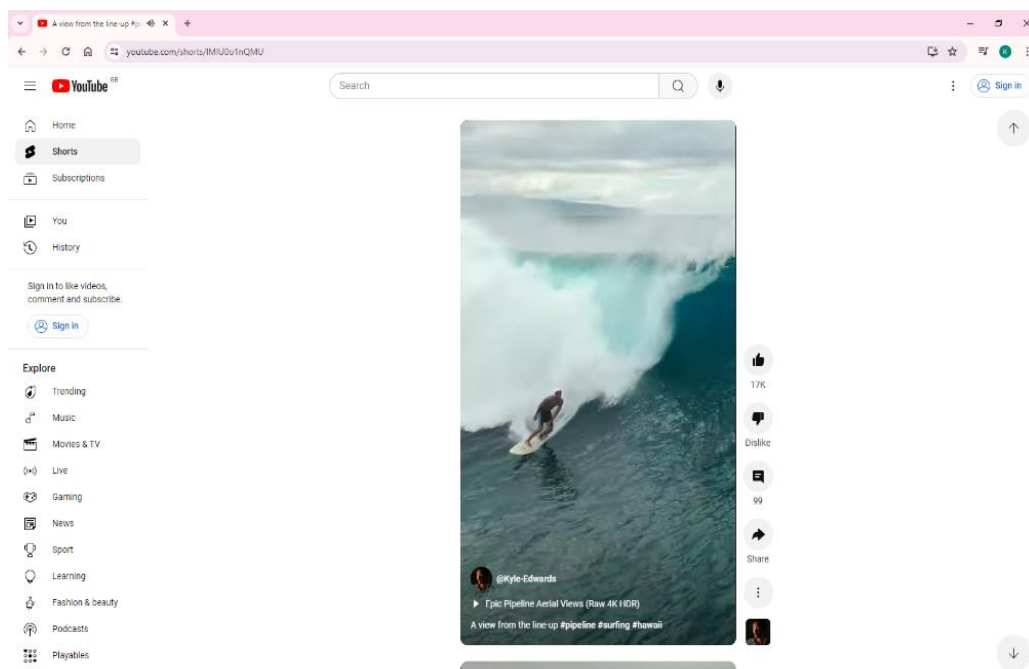
6. YouTube Shorts is devoted to videos which are less than 60 seconds long and in vertical format. Google launched the YouTube Shorts service in the UK in June 2021, following earlier launches in India in September 2020 and the USA in March 2021.
7. YouTube Shorts is available through the YouTube website at youtube.com. If a user accesses the YouTube website they will be taken to a home page, on which the word “Shorts” with accompanying logo is the second entry in the sidebar:



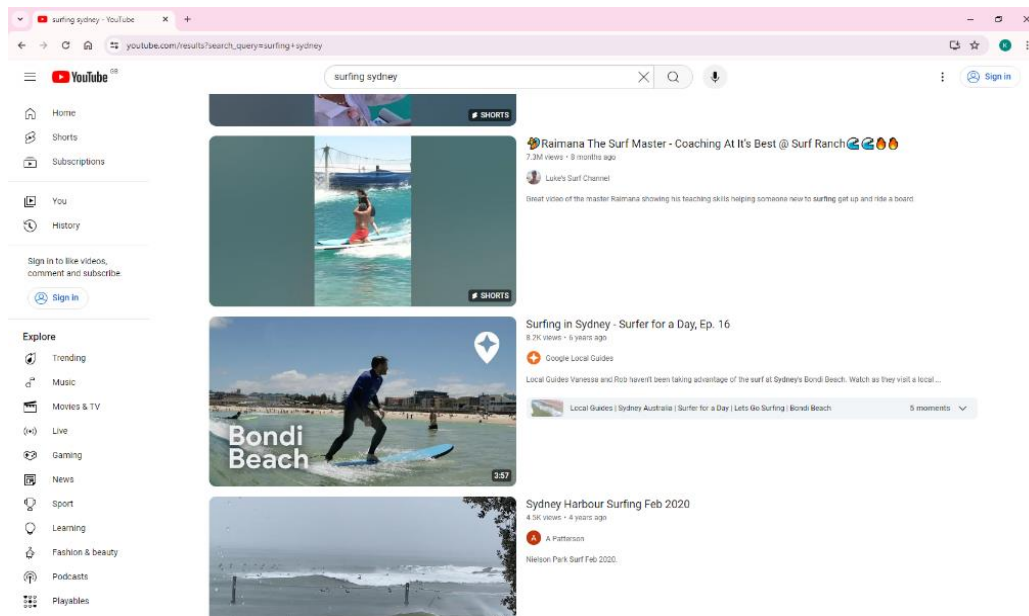
8. If the user scrolls down the sidebar they will see further options, including YouTube Premium, YouTube Music and YouTube Kids. If the user scrolls down the main part of the home page they will find a number of “shelves”, such as the “Breaking news” shelf shown above. Those shelves include “Shorts” shelves, which look like this:



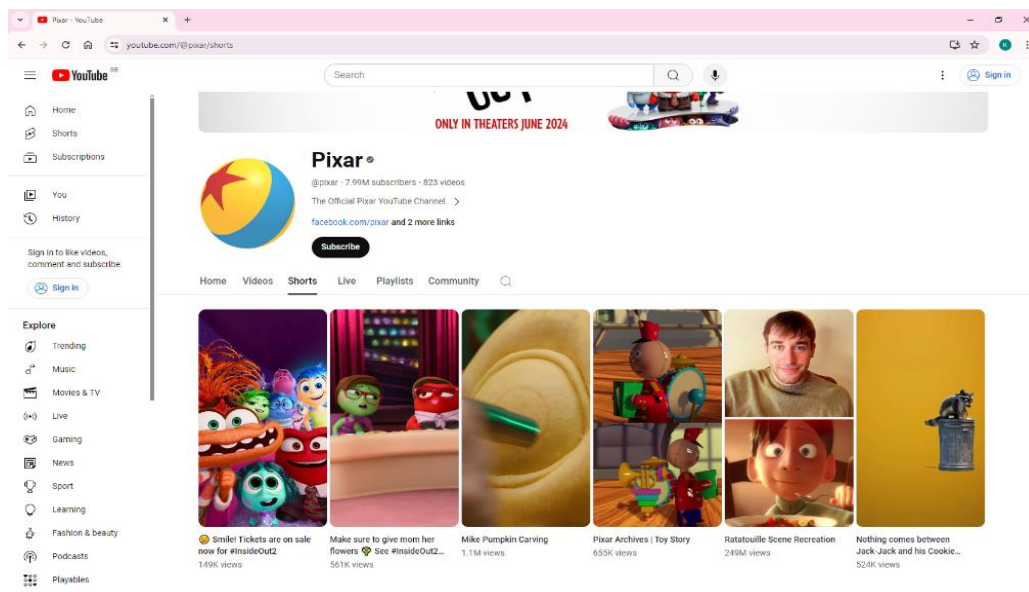
9. If the user clicks on “Shorts” in the sidebar, or on a video on a Shorts shelf, they will be taken to a feed of videos. The feed looks like this:



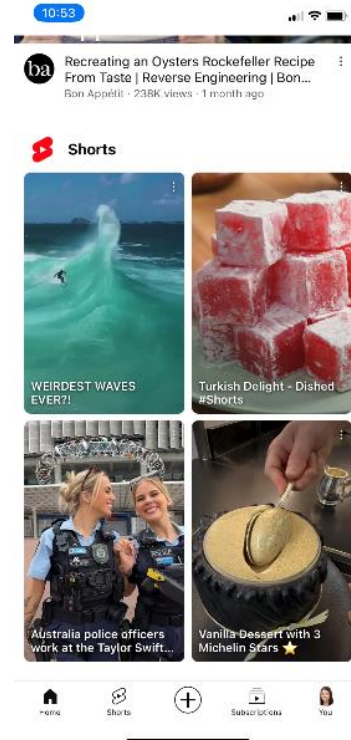
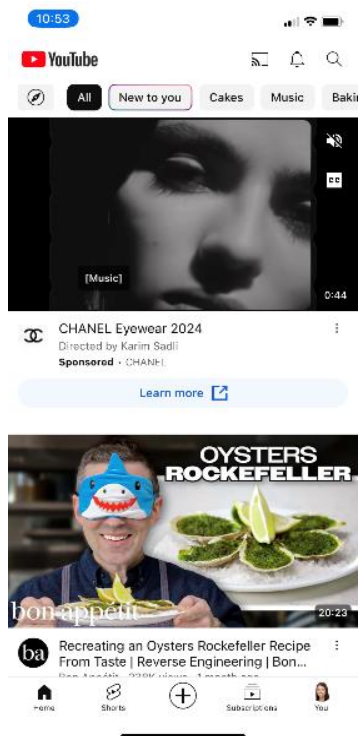
10. The first video in the feed will play automatically, and will repeat unless the user scrolls to the next video, which will then play automatically.
11. If the user uses the search function they will be taken to a page of suggested videos, on which videos in the YouTube Shorts service are distinguished from other videos by use of the word “SHORTS” and accompanying logo in the bottom right hand corner:



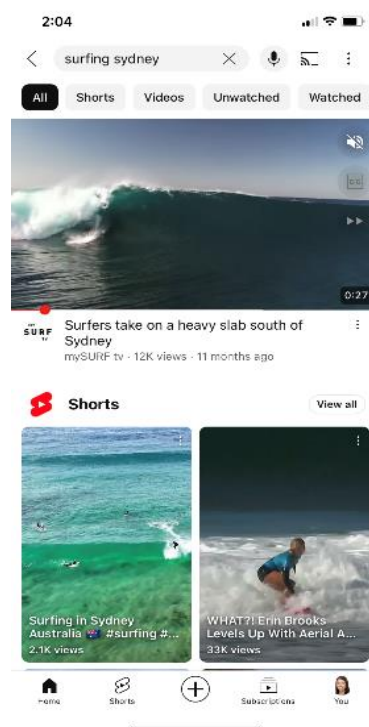
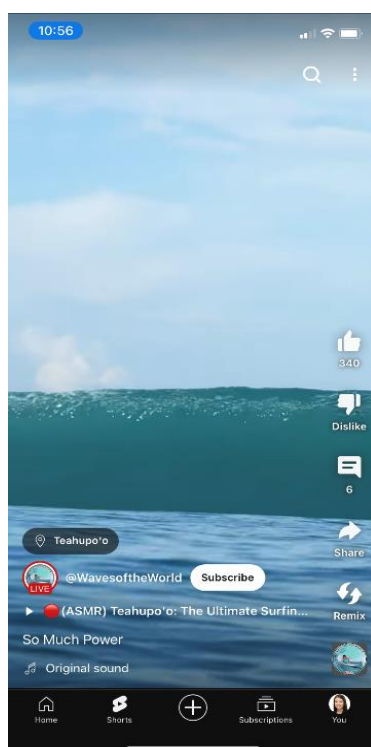
12. Creators have their own channel pages with links that include “Shorts”. Clicking on the “Shorts” link takes the user to all the YouTube Shorts videos uploaded by that creator, as in the example shown below:



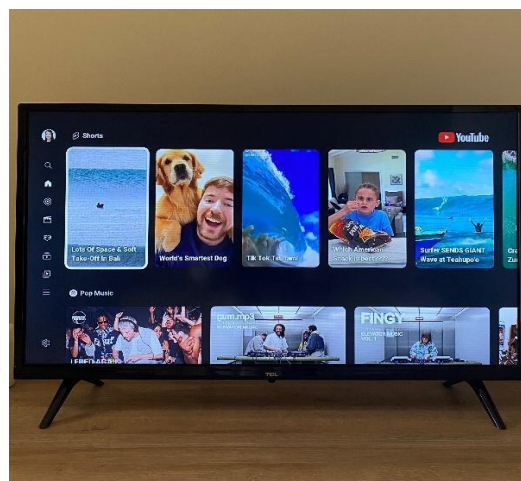
13. YouTube Shorts is also available on YouTube apps for mobile devices and smart TVs. The evidence was that the majority of the use of YouTube Shorts is through the app on mobile devices.
14. On mobile devices the YouTube app is accessible by clicking on an icon consisting of the YouTube logo with the name “YouTube” underneath. The home page of the app looks like the left hand illustration below; “Shorts” with accompanying logo appears second from the left at the foot of the screen:



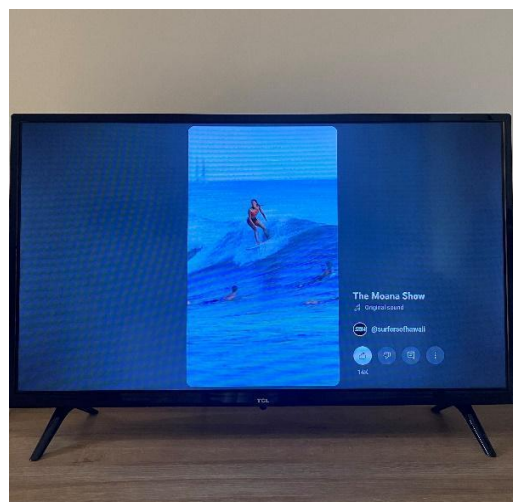
15. If the user scrolls down the home page they will find shelves, including the “Shorts” shelf which looks like the right hand illustration above.
16. If the user clicks on an entry in the Shorts shelf, or on the Shorts link at the bottom of the screen, they are taken to the Shorts feed, which looks like the left hand illustration below. Again, the first video in the feed will play automatically, and will repeat unless the user swipes to the next video, which will then play automatically.



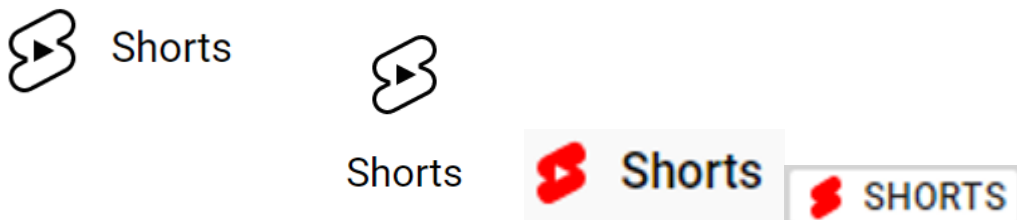
17. If the user uses the search function on the home page, in the search results videos in the YouTube Shorts service are distinguished from other videos as shown in the right hand illustration above.
18. Unlike in the YouTube website (and the smart TV app), the mobile app contains creation and upload tools accessible by clicking on the “+” in the middle of the bottom of the screen. That takes the user to a page where they are given options of “Video”, “Short” or “Live”.
19. On a smart TV, the user accesses the YouTube app by clicking on an icon containing the YouTube logo and the name “YouTube”. The home page of the app on a smart TV does not contain a link to the YouTube Shorts service in the sidebar. Instead, there are a number of shelves, including a “Shorts” shelf, which looks like this:



20. If the user uses the search function, results are shown with videos in the YouTube Shorts service identified in a similar manner to that used for the Shorts shelf on the home page.
21. Again, clicking on a video on the Shorts shelf or in the search results takes the user to the Shorts feed, which looks like the illustration below. The user can move between videos using the up and down buttons on the remote control.



22. In initial versions of the smart TV app, prior to November 2022, the Shorts feed was presented with black bars either side of the videos, and it was not possible to move up and down between videos.
23. SIL complains about each instance of use of the word “Shorts” in or associated with the YouTube Shorts service. That includes the use of “YouTube Shorts” itself and (as can be seen from the illustrations above) the use of the word “Shorts” alone, and alongside the YouTube Shorts logo in various manners:



24. In addition, Google’s style guidelines allow use of (inter alia) the following:



25. Each of these uses is alleged to amount to infringement of SIL’s registered trade marks under s.10(2) and/or s.10(3) Trade Marks Act 1994 (“TMA”) and/or passing off.
26. Google denies infringement under both s.10(2) and s.10(3) and raises a defence under s.11(2)(b) TMA, i.e. that its use is of a sign which is not distinctive and/or which concerns the kind...or other characteristics of goods and services and is in accordance with honest practices in industrial or commercial matters. It also says that SIL’s registered trade marks are invalid and that they should be partially revoked, for reasons I will explain below. Finally, it also denies passing off.

SIL’s Marks and Google’s attacks on them

27. SIL owns the following UK registered trade marks:

No. 917834615 (“the 615 Mark”):

SHORTSTV

No. 917834649 (“the 649 Mark”):

SHORTSTV

No. 917834656 (“the 656 Mark”):

SHORTS

No. 917834664 (“the 664 Mark”):

SHORTS

28. Each of those marks was filed on 20 February 2018 and added to the register on 5 October 2018. I shall refer to them collectively as “the 2018 Marks”. Each is registered for the following goods and services:

Class 9 - Sound, video and data recordings; cinematographic films; films for television; video and audio tapes, cassettes, discs; computer software; recorded television programmes; CDs, DVDs; electronic media; digital media; television games; electronic computer games; electronic entertainment software; all the aforesaid also supplied to or provided by telecommunications networks, mobile telephones, mobile media devices, on-line from a computer database or the Internet.

Class 38 - Broadcasting and transmission of television programmes; broadcasting and transmission of television programmes and games via telecommunications networks, mobile phones, mobile media and on-line from a computer database or the Internet.

Class 41 - Entertainment services; production, presentation and distribution of films, videos and television programmes; publication of computer games; distribution of computer games; including delivery of the aforesaid services by telecommunications networks, mobile phones, mobile media and online from a computer network or the Internet.

29. SIL is also the owner of UK registered trade mark no. 3428383 (“the 383 Mark”), being the word mark “SHORTSTV”. The 383 Mark was filed on 13 September 2019 and was added to the register on 6 December 2019, and so is not vulnerable to revocation for non-use until December 2024. It is registered in respect of a large number of goods and services in classes 9, 38, 41 and 42. Annex 1 to this judgment sets out the specification of goods and services for the 383 Mark (I shall explain the red amendments below). I shall refer to the 2018 Marks and the 383 Mark collectively as “SIL’s Marks”.
30. SIL alleges that its use of the signs “SHORTS” and “SHORTSTV”, both as word marks and in the form in which they appear in the 2018 Marks, means that (a) SIL’s Marks have an enhanced distinctive character for the purpose of its claim of infringement under s.10(2); (b) SIL’s Marks have acquired a reputation for the purpose of its claim of infringement under s.10(3); and (c) SIL owns goodwill associated with those signs sufficient to establish a claim in passing off.
31. Google alleges that SIL’s Marks are invalid on the grounds that they:

- (1) are devoid of any distinctive character (s.3(1)(b) TMA);
- (2) consist exclusively of signs or indications which may serve, in trade, to designate the kind...or other characteristics of goods or services (s.3(1)(c) TMA);
- (3) consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade (s.3(1)(d) TMA);

and have not acquired distinctive character as a result of the use made of them.

- 32. As I explained in my judgment [2024] EWHC 2565 (Ch) (“my 8 October judgment”), SIL responded by indicating that if any of those invalidity attacks had merit, they could be avoided by limiting the goods and services for which SIL’s Marks were registered. In the case of the 2018 Marks SIL proposed that each of “sound, video and data recordings”, “cinematograph films”, films for television” and “recorded television programmes” in class 9 and “production, presentation and distribution of films, videos and television programmes” in class 41 should be qualified by the words “save for short films”, and that “entertainment services” in class 41 should be qualified by the words “save for those provided in relation to short films”. In the case of the 383 Mark it proposed the limitations shown in red in Annex 1.
- 33. In response, by an amendment which I allowed for reasons explained in my 8 October judgment (essentially that SIL could not identify any prejudice to it arising from the late amendment), Google alleges that in so far as the specifications of SIL’s Marks were to be narrowed as described above, SIL’s Marks would be of such a nature as to deceive the public as to the nature of the goods and services (s.3(3)(b) TMA).
- 34. Google also alleges that the 2018 Marks should be partially revoked on the ground that within the period of five years since their registration they have not been put to genuine use in the UK by SIL or with its consent in respect of certain categories of goods and services and there are no proper reasons for non-use.
- 35. In its opening skeleton argument SIL conceded non-use in respect of “video and audio tapes, cassettes, discs”, “CDs, DVDs”, “television games” and “electronic computer games” in class 9 and “publication of computer games; distribution of computer games” in class 41. SIL’s opening skeleton argument also conceded non-use in respect of “computer software”, but SIL withdrew that concession without objection from Google. The only live issues on non-use remaining on the original pleadings were in respect of “electronic entertainment software” and (following its revival) “computer software” in class 9 and “entertainment services” in class 41.
- 36. However, by an amendment for which I gave permission for reasons explained in my 8 October judgment (again essentially that SIL could not identify any prejudice to it arising from the late amendment), Google now alleges that if and to the extent that SIL’s Marks are amended as I have described above, the 2018 Marks are liable to revocation for non-use in respect of the goods and services

covered by the remaining parts of SIL's specifications where limitations are proposed (i.e. "sound, video and data recordings save for short films" etc.).

Identification of the issues to be determined

37. The CMC was held before Master Kaye on 23 May 2023. Her order contained a list of issues to be determined at trial, which forms Annex 2 to this judgment (her order contained the caveat that the list of issues was without prejudice to SIL's contention that issues 4 and 5 did not have any legal relevance). I have had regard to (and believe I have addressed) the issues in that list, but it was compiled before revocation for non-use was pleaded at all, as well as before SIL's indication of its fall-back position and Google's response in the form of an expanded non-use pleading and the introduction of deceptiveness as a ground of invalidity.
38. At the outset of the trial I asked the parties for a list of the questions of fact that needed to be determined. Unfortunately they were not able to agree such a list. I have considered the lists proposed by the parties, and in my view the questions of fact (as opposed to the application of the law to the facts) which require decision are:
 - i) The meaning of the word "shorts" as at (a) the dates on which SIL's Marks were applied for (20 February 2018 and 13 September 2019) and (b) the commencement of Google's acts complained of (June 2021). This includes the question of whether short films are a recognised and identifiable category of goods.
 - ii) What marks SIL has used in the UK and the nature, scale, dates and extent of such use.
 - iii) Google's knowledge of SIL's Marks and business during the process of adoption and use of the name YouTube Shorts. This includes the question of whether it carried out a trade mark search during the process of adoption of the name.
 - iv) Whether there have been any instances of actual confusion.
39. I shall deal with question (iii) when considering the s.11(2)(b) defence and question (iv) when considering infringement under s.10(2). Questions (i) and (ii) are relevant to many of the issues in the case, and so I shall address them before turning to the application of the law to the facts.

THE EVIDENCE

SIL's evidence

40. SIL relied on evidence from nine fact witnesses, of whom seven were cross-examined. It also relied on a large number of documents under a CEA notice.
 - i) **Carter Pilcher** is the founder of SIL and is currently its CEO. He gave evidence about the history of the company and its activities and branding. He also gave evidence comparing SIL's content with that on YouTube

Shorts, about the harm that he said YouTube Shorts was causing SIL and incidents relied on by SIL in support of its infringement case, and about matters which he said showed Google's awareness of SIL and its activities.

- ii) **Simon Young** has worked for SIL for over 20 years and is currently its VP for EMEA Acquisitions. He gave evidence about SIL's content acquisition process as well as its involvement with film festivals and film schools. He also gave evidence as to the usage and meaning of "short films" and "shorts" in the film industry.
- iii) **Stephanie Charmail** has been Head of Production at SIL since 2015, overseeing the team responsible for delivering the video and graphic content (other than the short film content itself) for SIL's broadcast channels, VoD services, app and website. She gave evidence regarding SIL's production activities and the use of SIL's branding. She also gave evidence as to what "short films" and "shorts" meant to those in the film and TV industry, as well as about an incident relied on in support of SIL's infringement case.
- iv) **Robert Scurfield** joined SIL in January 2020 and had various roles in the legal department of SIL, becoming VP, Legal and Business Affairs in December 2021. He left SIL in January 2024 to join CNN. His roles involved responsibility for agreements licensing content from third parties and sales and distribution agreements relating to SIL's content. He gave evidence about viewing figures for and branding on SIL's services and content.
- v) **Ian Carrasco-Szule** has been VP, Distribution and Business Development for Latin America and EMEA since June 2022, overseeing the sales and distribution of SIL's channels and services in those regions. He gave evidence about SIL's revenue streams, branding and contracts. He also gave evidence about an incident relied on by SIL in support of its infringement case.
- vi) **Jade Tan** joined SIL in January 2022 as Director of Programming, having previously worked at Sky TV for almost 20 years. In April 2024 she took on responsibility for SIL's social media accounts. She gave evidence about SIL's social media presence, as well as its branding.
- vii) **Tarun Sawney** joined SIL in October 2018 as President for the Asia region. He gave evidence about incidents relied on by SIL in support of its infringement case.
- viii) **Michael Buchallet** joined SIL in 2017 and is now its Chief Technology Officer. He explained the history and operation of SIL's ShortsTV+ app. He was not cross-examined.
- ix) **Barnaby Thompson** is a film director and producer and one of the founders of Ealing Studios. He served as a director of SIL from 2000 to 2002 and has subsequently assisted SIL in an advisory role. He gave brief evidence about SIL's role and reputation in the film industry and was not cross-examined.

41. Google's main criticism of the evidence of SIL's witnesses related to its cogency. In particular it pointed to the absence of any witnesses who were alleged to have been confused, and attacked the cogency of the evidence of SIL's witnesses who reported incidents of alleged confusion. It also observed that some of the evidence of use of SIL's Marks was undated or from after the relevant dates, or related to use outside the UK (or it was unclear whether it did). I have had those points in mind when considering the relevant issues below.
42. Google pointed out that there was some tension between the evidence of some of SIL's witnesses as to the meaning of the word "shorts" and the position adopted by SIL at trial, but in my view the evidence was honestly given. Google suggested that Mr Pilcher was "*at times, very much an advocate for SIL's case*". However, it did not identify any instances in support of that suggestion, and I reject it. Mr Pilcher was enthusiastic about SIL's business and had strongly held views on various matters but did not cross the line into advocacy for SIL's case. Google also said that Mr Sawnhey's evidence on confusion was vague and inconsistent. As will appear below, I agree with that description of some of his evidence, but there was no suggestion that he was not an honest witness doing his best to assist the court.

Google's evidence

43. Google relied on evidence from eight fact witnesses, of whom seven were called for cross-examination. It also relied on a number of documents under a CEA notice.
 - i) **Sarah Ali** is Senior Director of Product Management at Google. She led the Product Team that was responsible for creating the product that became YouTube Shorts, and was involved in the process of naming the product. She gave evidence about that process, as well as about the launch, functionality and presentation of YouTube Shorts. She also gave evidence regarding the absence of consumer confusion between YouTube Shorts and SIL and its marks.
 - ii) **Jodi Ropert** is Vice President of Marketing at Google. She gave evidence about the fame of YouTube, its platform and branding and about the absence of confusion.
 - iii) **Junluo (Laurel) Su** is Global Brand Marketing and Standards Operations Manager at Google, within the YouTube Creative Studio. She gave evidence about the standard approach to naming YouTube features, and how the naming process operated in the case of YouTube Shorts.
 - iv) **Zoe Clapp** is Managing Director of the YouTube Creative Studio for EMEA. Before joining Google in September 2020 she was Chief Marketing and Communications Officer at UKTV. She gave evidence relating to the fame of YouTube in the UK, as well as about the meaning of "shorts" in the film and TV industry and the absence of confusion.
 - v) **Raquel Small** is a Legal Enablement Program Manager at Google. She gave evidence about YouTube's revenue, user statistics and marketing

spend, as well as about the searches conducted to identify any relevant records relating to SIL.

- vi) **Joseph Harbinson** has been the Distributions and Partnerships Senior Lead for Social and Digital Platforms at Channel 4 since August 2021. Prior to that he held various roles in the TV and video industry from April 2014 onwards, including as Head of Content Operations and Digital Production at Endemol Shine Group. He gave evidence about the meaning of “shorts” in the TV, film and broadcasting industry and about the use of “shorts” by Channel 4. He was not cross-examined.
 - vii) **Nick Rose** is the partner at Fieldfisher with conduct of the proceedings on behalf of Google. He gave evidence as to the conduct and results of various searches, including searches for uses of the word “shorts”. He was called for cross-examination, but that terminated after I queried the utility of asking a solicitor about the meaning of the word “shorts” in articles produced by the searches.
 - viii) **Katherine Warner** is a solicitor at Fieldfisher. She gave evidence about her visits to cinemas to see SIL’s 2024 Oscar nominated short films compilations and to the Disney100 exhibition.
44. SIL said in its closing submissions that *“save as set out below, we do not invite any formal criticism of the way in which Google’s witnesses gave their evidence, even though they were impeccably prepped and came to Court to advocate Google’s case”*. I do not regard this kind of casual, unparticularised, blanket allegation as being acceptable. If witnesses are to be accused of coming to court to advocate a case then the basis for those allegations should be identified. The specific allegations that SIL did make were that Ms Ali, and to some extent Ms Ropert, had given evidence relating to matters of which they did not have personal knowledge or recollection. In the case of Ms Ali, it was said that her written evidence on the process of naming of YouTube Shorts was *“thin to the point of contrivance”*, the implication being that it was artificial. I reject that. Ms Ali and Ms Ropert made it clear what they knew and could remember.
45. SIL’s real complaint was that Google had not called witnesses who might have known more about the naming process than the witnesses it did call. Again I have had that point in mind when considering the relevant issue below. SIL also made a number of complaints about the scope of disclosure which had been given by Google. However, Google pointed out that there had been a number of hearings relating to the scope of the disclosure order to be made and Google’s compliance with the order, and that SIL had no outstanding application relating to disclosure. I have to deal with matters on the basis of the material I have (including, where appropriate, the explanation for the absence of material) rather than speculate about whether other material might be available had a different disclosure order been made.

THE CORE ISSUES OF FACT

The meaning(s) of the word “shorts”

46. SIL’s position at trial was that while the word “shorts” had other meanings (most prominently short trousers), one meaning was “short films”. It explained in its opening skeleton argument that *“short films are just like feature films on theatrical release, but shorter”*. It said that they share with feature films the characteristics of having narrative structure, a plot, scenes and actors, and having (or aspiring to have) professional-looking production values. It also relied on the Academy of Motion Picture Arts and Sciences’ definition of a “short film” for the purpose of the Oscars, namely *“a documentary, live action or animated film which is less than 40 minutes in duration”*.
47. Mr Harbinson gave unchallenged evidence that “shorts” had been in use in the vernacular of the film, TV and broadcasting industry since before he joined the industry in 2014. He explained that “shorts”, traditionally, are short films, usually lasting anything between 2 and 45 minutes, shot either digitally or on film. However, he continued, the meaning of “shorts” has evolved over time from films traditionally made and viewed in a cinema, to mean more accessible, even shorter digital content. He did not put a timeframe on that evolution, however, so that is a matter for me to assess based on the materials before me.
48. Google’s evidence included the results of various searches, including one of UK originating articles in a press aggregator database for the date range 1 February 2018 to 1 February 2022. Extracts from those articles, and from other documents in evidence showing the use of the word “shorts”, were compiled in Annex 3 to Google’s opening skeleton argument.
49. The parties were agreed (in the case of Google, subject to the question of whether “short films” could be sufficiently clearly defined) that these materials showed that the predominant use of the term “shorts” was to mean “short films”.
50. However, the parties were also agreed that these materials showed a number of instances of use of the term “shorts” to refer to short-form audiovisual content that was not a “short film”. With their closing submissions, the parties provided different tables of such instances. Google’s table included articles from The Guardian, The Observer, The Telegraph, The Times, The Independent, i News and The Yorkshire Post, all of which, as Google pointed out, are directed at the general public. While SIL’s table did not accept all of those instances, it did concede that several were use of “shorts” to refer to materials which were not “short films”. I do not propose to go through each instance relied on, but will instead highlight some examples.
51. There are a considerable number of examples of use of the word “shorts” to refer to short comedy videos; I select just a few by way of illustration. On 18 August 2018 The Observer published an article entitled *“A Titanic Success: how Boris Johnson inspired my viral Brexit satire”* which contained the sentence: *“Yet political satire still has its place – a fact that was underlined last week when an online comedy short sending up Brexit became a viral hit, racking up more than 10 million views.”* Similarly, in 2018 both The Telegraph and The Guardian

published articles referring to the BBC 1985 children's series Chuckleheads, featuring the Chuckle Brothers, in which they referred to the shows as "shorts". On 1 December 2018 The Guardian referred to some TV comedy in the following terms: *"Romesh Ranganathan is in hilarious 'Bah humbug!' mode in the first of a series of five-minute shorts counting down to Christmas with comedians' takes on the festive season."*

52. There are also several examples of use of the word "shorts" to refer to videos featuring factual or fictional material shown on TV or online. For example, on 16 February 2019 The Times published an article entitled *"Soon Gone: A Windrush Chronicle"* containing the sentence: *"All have a connection to the Windrush story, and the powerful collection of shorts, curated by the Young Vic's artistic director Kwame Kwei-Armah, explores the highs and lows of one family, starting in the 1940s."* On 15 September 2019 The Observer published an article about the TV series *State of the Union*, saying *"these episodes are 10-minute chunks and can be indulged in one glut without acid reflux; it's almost rude not to. Because they're so good. It's a simple formula, but the ingredients have to be perfect for such successful shorts – or "short-form" if you want to sound faintly (a) au fait, because you're in the trade yourself, or (b) pretentious."* On 9 May 2020 The Times published an article about Nadia Hallgren and her Netflix documentary *"Becoming"*, explaining that in 2018 she *"had directed only three short films and a series of TV shorts about female candidates running for political office, called She's the Ticket."* On 13 May 2020 The Telegraph published a review encouraging readers to *"Watch the Explained (Netflix), shorts that cover topics from the rise of cryptocurrency to the world of K-pop."*
53. Such a use of the term "shorts" can also be illustrated by an article on 7 April 2018 in i News headed *"TV Baftas are heading in the right direction"* in which it reported on new awards, saying *"Included for the first time, it rewards shorts of anywhere from three to 20 minutes in any genre that have been commissioned or premiered on an online or broadcast platform",* adding *"Both new awards reflect how people watch television now: online, in short, viral clips, or in long binges."*
54. Similarly, Google pointed to the fact that in 2014 Channel 4 had produced a series of programmes for its on-demand service 4oD, described in the press release thus: *"The Shorts are designed to be watched anywhere, on the move on mobiles and tablets via 3G, 4G or wifi – perfect for when people want to fill those spare five minutes with quality bite-sized shows. ... Channel 4's original Shorts collection, badged with their length (e.g. 4 or 5 mins) features a diverse range of innovative shows for viewers to snack on wherever they are – Shorts on films, games, comedy and satire, popular science and futurology, lifestyle and food shows, current affairs – and engaging education shows for teens."*
55. Google particularly highlighted the fact that a number of the articles in its table referred to "shorts" on YouTube (before the launch of YouTube Shorts). For example, on 19 November 2019, The Telegraph reported on *"London drama Blue Story – the writing-directing debut of Andrew Onwubolu (aka Rapman), whose YouTube shorts have garnered millions of views"* and on 25 April 2020 The Observer said, when urging readers to curate their own Spike Jonze mini-season: *"The rest is to be found by digging through YouTube, Vimeo and other free*

platforms, where his dizzy array of shorts, commercials and music videos are to be found, albeit often in variable quality.” However, in these particular instances it is not clear that the “shorts” being referred to are not “short films”. Nevertheless, the first example shows that it is natural to refer to “YouTube shorts”.

56. Having looked through the tables produced by the parties and considered the evidence as a whole, in my judgment it is clear that in the period 2018 to 2021 the word “shorts” was being used to refer to short-form audiovisual content which went beyond “short films”. SIL pointed out that not all short audiovisual content was referred to as “shorts”. In particular, it noted that neither a 30 second advertisement nor a four minute music video would be referred to as a “short”. I accept that. However, advertisements and music videos are normally of those lengths and so, in respect of those particular forms of content, the use of the word “short” would not be expected.
57. I need to determine what the position was as at 20 February 2018 as well as at 13 September 2019 and in June 2021. Because Google’s searches, and in particular that of the UK press articles, used 1 February 2018 as a start date (for reasons which are unclear to me) most of the material I have been provided with is dated after 20 February 2018. However, while I accept Mr Harbinson’s evidence that there has been an evolution in usage, in my judgment there is nothing to suggest that there was a significant shift in usage such that the position as at 20 February 2018 was significantly different from that in 2019 or indeed 2020 or 2021.
58. Therefore, I conclude that as at each of 20 February 2018, 13 September 2019 and June 2021, the meaning of “shorts” was not limited to “short films” but also included other short-form audiovisual content.
59. Google also relied on evidence that those at Google involved in the naming process for the product that became YouTube Shorts regarded “shorts” as descriptive of the content, and that a number of individuals who took part in the consumer research conducted as part of that process said something similar. Apart from the fact that all these individuals appear to have been US residents (something Google warned me about when considering incidents of alleged confusion) in my view this evidence is not quite on point. It shows that when people in 2020 were asked to consider a short-form audiovisual content service, they regarded “shorts” as descriptive of such a service and its content. That is not the same as whether “shorts” had an established meaning which included short-form audiovisual content (in 2018, 2019 or 2021).
60. For reasons that will become apparent, it is also necessary to consider whether “short films” is a clear definition of a category of goods. As can be seen from paragraph 46 above, the principal basis on which SIL sought to distinguish short films from feature films was that they are shorter. But there did not appear to be a consensus as to their maximum length – the Academy’s definition for the purpose of the Oscars is up to 40 minutes whereas Mr Harbinson said they could be up to 45 minutes.
61. Moreover, the question is what makes a piece of audiovisual content of that length a “film”. As mentioned above, SIL said that it was something with narrative

structure, a plot, scenes and actors, and having (or aspiring to have) professional-looking production values. But it also accepted that it included animations (which have no actors) and documentaries (which have neither actors nor any plot in the normal sense of the word), and I cannot see why whether something has what could be called scenes or not affects matters. Further, whether something has (or aspires to have) professional-looking production values is a subjective assessment of the characteristics of the content rather than an aspect of the definition of a type of good. It may be possible to make a more objective assessment of whether something has narrative structure, but the amount of narrative structure must lie on a spectrum and I cannot see how one could draw the line. In any event, narrative structure is, again, a characteristic of the content rather than an aspect of the definition of a type of good.

62. I gained the strong impression that SIL was really aiming for a definition of “short films” and hence “shorts” which was based on the quality of the content. So for example Ms Charmail said that the kind of content on YouTube Shorts was “*not a film because there is no narrative, no story, no serious filmmaking craft. ... The difference is the craft – the composition, the storyline, the acting or documentary content or animation, the framing, the lighting, the camerawork, the editing, the direction, the music, the costumes etc.*” In my judgment this is not a proper basis on which to identify a category of goods, as opposed to characteristics of the goods.

SIL’s use of its marks

63. SIL was founded in 2000 under the name Britshorts Ltd and adopted its current name in 2005. There was a re-branding exercise in 2017/2018 in which there was a shift from the use of “Shorts” to “ShortsTV”. It is a relatively small operation, with a turnover of about \$9M in 2020. It operates internationally, but for present purposes what matters is its use of its marks in the UK.
64. At my request the parties produced a table identifying the evidence as to the use of SIL’s Marks in the UK. That table has been helpful in organising the evidence from disparate sources and identifying the issues between the parties. Because the parties agreed that use of the 615 Mark was to be regarded as use of the 649 Mark and vice versa and that use of the 656 Mark was to be regarded as use of the 664 Mark and vice versa, in what follows I have not distinguished between black on white and white on black renditions of the marks.

Oscar Nominated Short Films release

65. SIL first released the Oscar nominated short films on iTunes in 2006 (initially only individually but later also as compilations). Also in 2006 it started distributing the Oscar nominated short films to cinemas in North America, and since 2009 has been solely responsible for the theatrical release of compilations of films nominated in each of the three short film categories (live action, animation and documentary). The compilations have been made available on various platforms (see below) as well as in cinemas. In North America the theatrical release of the Oscar nominated short films compilations has been successful (for example in 2024 it grossed \$3.2M, and takings were higher than that in 2018-2020).

66. The evidence relating to the release of the Oscar nominated short films compilations in cinemas in the UK was surprisingly thin. It appears from Ms Charmail's evidence that such releases have taken place since at least 2016 (apart from 2021, when the release was digital only due to the Covid pandemic), but there was little evidence about their reach. Mr Carrasco-Szulc said that in 2024 the Oscar nominated short films compilations were shown in around 30 cinemas in the UK, with about 900 tickets sold; he was unable to give figures for previous years.
67. Ms Charmail gave evidence about the branding on the Oscar nominated short films compilations in 2024. She explained that the 615/649 Marks were present on the screen for 5-6 seconds at the start and that for about 20 seconds during the end credits the screen showed either the 615/649 Marks, the word ShortsTV or an advert for the ShortsTV+ app. The evidence did not make it clear whether that was also the case in previous years, but on balance I think a fair reading of the evidence is that at least some use has been made of the 615/649 Marks at the start and end of the compilations since the re-branding exercise in 2017/2018.
68. Ms Charmail also explained that SIL also produces posters and trailers to promote its Oscar nominated short films compilations, which carry the 615/649 Marks. However, Mr Carrasco-Szulc explained that SIL does not track which cinemas actually use this material, though he said that the Barbican cinema does not (which is consistent with the fact that Ms Warner did not see any when she visited) while others do (he gave the examples of the Battersea cinema, Riverside Studios and Phoenix Cinemas using material on their websites which contained the 615/649 Marks, and Chiswick cinema showing such material on a screen in its foyer, though Ms Warner explained that the display was small).

Other production and distribution activities

69. Ms Charmail said that, apart from the Oscar nominated short films release, SIL's main production activities from about 2014 to 2020 involved packaging collections of short films for distribution on SIL's own channels (including hosted shows), producing content around film festivals, producing content around the making of short films, including filmmaker interviews and "behind the scenes" programmes, and running short film competitions including one called The Pitch. She also referred to a short film produced by SIL called Freeze-Frame commissioned by the Sino-British partnership in about 2014. However, post-Covid, these activities have decreased in scale. Ms Charmail provided screenshots showing the use of a variant of the 656/664 Marks at the end of Freeze-Frame and one of the films arising from The Pitch (apparently from before the rebranding exercise) and of the use of the 615/649 Marks at the end of compilations of short films distributed through Amazon. However, she explained that distributions through the BBC did not include SIL's Marks. There was no evidence as to the revenue generated through distribution in the UK.

Linear TV channels

70. SIL had a linear TV channel on Sky for a little over a year from 2008 and on Amazon Prime Video from November 2020 until late 2022. There was no evidence as to viewing figures for the Sky channel, nor as to viewing figures for

the Amazon Prime Video channel in the UK (the only evidence was that, worldwide, this channel received only 2% of the viewership of the Amazon Prime Video VoD service referred to below).

71. The position for the Sky channel is not clear, but Ms Charmail explained that the Amazon Prime Video channel had the 615/649 Marks visible in the “bug” at the top right of the screen at all times and also used that mark in “ad bumpers”, “stings” and “interstitials” between content, and in content produced by SIL that was shown on the channel, including filmmaker interviews and “behind the scenes” programmes. “ShortsTV” was also used orally in voiceovers between content.

VoD

72. SIL launched its Amazon Prime Video VoD (video on demand) channel in the UK between October 2020 and January 2021. There was surprisingly little evidence about its viewership. Mr Carrasco-Szulc said that as of 2024 it had an average of 1000 monthly subscribers in the UK, but he agreed that the numbers were likely to be lower in previous years. In July 2021 only 71 people streamed the most streamed title and Mr Pilcher agreed that at that time viewership was very small.
73. The evidence as to the use of the 615/649 Marks in relation to the Amazon Prime Video VoD channel came from Mr Carrasco-Szulc (who joined SIL in June 2022) and Ms Tan (who joined in January 2022), and their evidence was expressed in the present tense and illustrated with screenshots that were either dated 2023/2024 or undated. It is therefore not possible to be sure that all the uses of the 615/649 Marks that they described also took place before either June 2021 or 8 February 2022. However, I find that it is more likely than not that, since launch, the 615/649 Marks have been used as the name of the channel, and appeared within the ShortsTV branded area within Amazon Prime Video (which can be accessed either via a shortcut from the home page for subscribers or via a search for ShortsTV or for a film title which is included in the ShortsTV VoD service). It was not clear whether the content on the VoD channel included content such as filmmaker interviews and “behind the scenes” programmes.

FAST channels

74. SIL launched a FAST (free, advertising supported, streaming TV) channel in the UK between late June/July and October 2021, on Samsung, LG and Rakuten. It was available on Samsung and LG until January 2024 and remains available on Rakuten. Mr Pilcher accepted that the LG and Rakuten channels had “very small reaches”. In re-examination Mr Pilcher was referred to a document showing that between 14 July and 1 August 2021 the viewing figures of SIL’s Samsung UK FAST channel increased until it had 14,000 unique viewers per day. In closing, SIL sought to extrapolate this to 5.1 million unique viewers per year, but there was no basis for the assumption that the number of unique viewers per day would remain constant. Further, as Google pointed out, Mr Carrasco-Szulc had explained that, for about a month following the launch of SIL’s Samsung FAST channel, Samsung featured it in a prominent front-page rail. It is likely that that promotion led to the initial growth in viewership of the Samsung FAST channel.

The result is that I have no real evidence as to the viewership of the Samsung FAST channel apart from the snapshot soon after launch.

75. The FAST channels use the 656/664 Marks rather than the 615/649 Marks. The evidence showed that the 656/664 Marks appear in the “bug” at the top right of the screen and in the bar for the channel in the EPGs (though it was not clear where the channel appeared in the EPGs). While the evidence was not entirely clear, in my judgment it is more likely than not that this was the case since launch of the channels. SIL submitted that the FAST channels also used the 656/664 Marks in “ad bumpers”, “stings” and “interstitials” between content, and in content produced by SIL that was shown on the channels, but Ms Charmail’s evidence relating to such matters clearly related to a ShortsTV channel, which cannot be a reference to the FAST channels.

EST

76. SIL has sold content by EST (electronic sell through) on iTunes since around 2009, on Amazon since July 2013 and on Google Play since September 2014. The only evidence of sales was that in 2024 EST generated UK revenues of more than £40,000; Mr Carrasco-Szulc said that he could not speak to revenues in previous years. Based on the evidence I have, the only appearance of the 615/649 Marks on the sites is in thumbnails, if the content being sold is itself branded with those marks, which appears to be the case only for the Oscar nominated short films compilations.

SIL’s app

77. SIL launched its app for mobile (iOS and Android) and TV (Android) in November 2021. There are currently around 500 subscribers globally; UK figures are not available, nor are figures at earlier dates. While Mr Carrasco-Szulc gave some evidence about promotional activities for the app, that all related to 2024 or was undated.
78. The app is branded SHORTSTV+ (in the form of the 615/649 Marks with an additional “+”). That mark appears on the icon on the App Store or Google Play, on the download page, on the front screen within the app and in the “bug” when viewing a film.

SIL’s YouTube channel

79. SIL’s YouTube channel was created in February 2009. SIL’s Marks do not appear on the channel itself, but only on the content (if that content bears SIL’s Marks). Ms Tan said that in July 2024 the channel had 26,000 subscribers and had received more than 26 million views since its creation. However, she was unable to provide figures for UK subscribers or views. Mr Scurfield produced data showing how the number of unique views had fluctuated since 2020. At one point there seemed to be a suggestion that there had been some sort of interference by Google with SIL’s YouTube channel, leading to a drop in viewing figures, but that suggestion was not pursued by SIL in closing.

Other social media

80. According to figures produced by Ms Tan, as of July 2024 SIL had about 1200 UK followers for its Instagram account and 50 UK followers for its TikTok account. UK figures are not available for its Facebook, Twitter or LinkedIn accounts.

Publicity at film festivals etc.

81. SIL has had associations with numerous film festivals, in particular those featuring short films. Its involvement has included providing a speaker or a panel participant, sponsorship or involvement with competitions. However, the evidence about its involvement at film festivals in the UK, such as the London Short Film Festival, the Glasgow Short Film Festival and the Manchester International Film Festival was vague, and there was no evidence about use of its branding at those festivals before 2024. SIL also has associations with film schools, including the National Film and Television School, including giving talks and attending panel discussions. But again there was no evidence about use of its branding at such events. Finally, there was some press coverage for SIL (sometimes using the name ShortsTV) in the period 2018-2021, but most of that was in the trade press, with only occasional articles in mainstream newspapers.

INVALIDITY

82. It was common ground that:

- i) The issues of inherent distinctive character of the 2018 Marks are to be addressed as of 20 February 2018; those in respect of the 383 Mark are to be addressed as of 13 September 2019.
- ii) The issues of whether SIL's Marks have acquired distinctive character as a result of the use made of them are to be addressed as of the date of Google's counterclaim, i.e. 8 February 2022.
- iii) It is necessary to consider each of the objections under s.3(1) in relation to each of the categories of goods and services for which the relevant mark is registered.
- iv) If any of the grounds of invalidity apply in respect of only some of the goods or services for which any of SIL's Marks are registered, that mark should be declared invalid only as regards those goods and services – s.47(5) TMA.
- v) However, if one of the objections under s.3(1) applies to goods or services within one of the categories of goods or services for which the relevant mark is registered then the mark should be declared invalid in respect of that category, unless a satisfactory proposal is made to limit that category to goods or services to which the objection does not apply.
- vi) If and to the extent that any of the grounds of invalidity apply in respect of any of SIL's Marks, that registration is deemed never to have been made – s.47(6) TMA.

83. As will be seen below, the issues of validity require identification of the “average consumer” or the “relevant class of persons”. They are deemed to be reasonably well-informed and reasonably observant and circumspect. The average consumer is a consumer of the goods or services for which the mark is registered (see e.g. *W3 Ltd v easyGroup Ltd* [2018] EWHC 7 (Ch) at [150]-[152]). While there was some fluctuation in the parties’ submissions on this point, I believe that ultimately it was common ground that the relevant class of persons in this case is the general public. In any event, in my judgment that is correct, having regard to the goods and services for which SIL’s Marks are registered.

S.3(1)(c) – the law

84. S.3(1)(c) TMA provides that trade marks shall not be registered if they “consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services”.
85. Both parties referred me to the judgment of the Court of Justice of the European Union (“the CJEU”) in Case C-51/10 P *Agencja Wydawnicza Technopol v OHIM* at [33]-[50], as set out by Arnold J (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group plc* [2012] EWHC 3074 (Ch) at [91]. In particular, the following statements of principle emerge (as applied to s.3(1) TMA):
- i) Where a mark has descriptive character in respect of goods or services it is also devoid of any distinctive character in respect of those goods or services (*Technopol* [33]).
 - ii) S.3(1)(c) must be interpreted in the light of the general interest underlying it, which is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (*Technopol* [36]-[37]).
 - iii) It is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign *could* be used for such purposes (*Technopol* [38]).
 - iv) This ground for refusal is not dependent on there being a real, current or serious need to leave a sign free. It is irrelevant to know the number of competitors who have an interest (or who might have an interest) in using the sign. It is also irrelevant whether there are other, more usual, signs than the one in issue for designating the same characteristics of the goods or services (*Technopol* [39]).
 - v) There is partial overlap between the scope of s.3(1)(c) and s.3(1)(b), in that s.3(1)(b) encompasses the scope of s.3(1)(c) but also covers other cases in which the marks is not distinctive, and it is important that s.3(1)(c) is applied only to the situations specifically covered by that ground (*Technopol* [46]-[48]).

- vi) The list of characteristics specifically mentioned in s.3(1)(c) is not exhaustive: any characteristics of goods or services may be taken into account (*Technopol* [49]).
 - vii) The word ‘characteristic’ highlights the fact that the signs referred to in s.3(1)(c) are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods/services in respect of which registration is sought. A sign can only be refused registration under s.3(1)(c) if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (*Technopol* [50]).
86. In *Starbucks*, Arnold J added the following statements of principle derived from other decisions of the CJEU:
- i) A sign is caught by the exclusion from registration in s.3(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned (at [92]).
 - ii) There must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (at [94]-[95]).
87. Google submitted that *Starbucks* establishes that the reference in s.3(1)(c) to “exclusively” does not preclude the application of this provision to marks which consist of a dominant descriptive word with some other visual content. In *Starbucks* at [96]-[97] Arnold J referred to differing approaches which had been taken to whether marks consisting of a descriptive term presented in a particular graphical style were caught by s.3(1)(c). In *Starbucks* itself the mark in question was the descriptive word “now” with lines radiating from the “o”:



88. Arnold J arrived at the following conclusion in relation to this mark at [116]:

“Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b).”

89. As will be seen, Arnold J's view as to the scope of s.3(1)(c) was not a necessary element of his decision in that case. Google pointed out that Arnold J's analysis went unchallenged on appeal in *Starbucks* ([2013] EWCA Civ 1465), and that he had adopted the same approach in *Supreme Petfoods Ltd v Henry Bell & Co (Grantham) Ltd* [2015] EWHC 256 (Ch) at [58] and [61] (though again his view as to the scope of s.3(1)(c) was not a necessary element in his decision). Google also pointed out that in Case T-37/16 *Caffè Nero Group Ltd v EUIPO* the General Court had upheld the decision to reject, under the equivalent of s.3(1)(c), a mark consisting of the words "Caffè Nero" written in black in a particular font, with "Caffè" above "Nero" and in smaller letters, against a blue background, saying that the figurative elements did not "convey an immediate and lasting impression which members of the public may retain". Further, Google observed that SIL had not produced any case which said that "exclusively" meant that a mark which contained any figurative element in addition to a descriptive term could not be rejected under s.3(1)(c). Indeed, I did not understand SIL to advance such a bright line distinction in its closing submissions.
90. In my judgment it is necessary to have in mind the observation of the CJEU in *Technopol* that it is important to ensure that s.3(1)(c) is applied only to the situations which it specifically covers, while also bearing in mind its statement that s.3(1)(c) must be interpreted in the light of the general interest underlying it, which is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services. In my judgment that means that marks should not be permitted to pass through the s.3(1)(c) hoop by means of what Arnold J in *Starbucks* at [117] called a "figurative figleaf" or, to use the words of Geoffrey Hobbs QC, sitting as the Appointed Person, in *FLYING SCOTSMAN TM* [2012] RPC 7 at [28], cases in which the figurative content is "insignificant in the context of the sign as a whole".
91. Google also referred me to cases in which it was held that characteristics of goods or services for the purpose of s.3(1)(c) included the potential content or subject-matter of the goods or services. In *LINKIN PARK TM* [2006] EMTR 74 at [44]-[47], Richard Arnold QC (as he then was), sitting as the Appointed Person, held that a "characteristic" of goods included their information content or subject-matter. Similarly, in *FLYING SCOTSMAN TM* at [15]-[16], Mr Hobbs referred to a number of cases demonstrating that regard must be had to characteristics that goods or services may optionally possess, including the content or subject-matter of the goods or services. At [18] he said:

"The approach adopted in these decisions is applicable where: (a) the potential for goods or services of the kind specified to provide consumers with imagery or information about someone or something denoted by the sign is sufficiently real and significant to be a material consideration; and (b) it is reasonable to believe that the sign 'will actually be recognised by the relevant class of persons' as a description of the content or character of such goods or services [citing *Technopol*]. The latter requirement is not satisfied if the sign would be understood to designate content or character of a kind that the relevant average consumer would take to have come from

a single economic undertaking believed or expected to be linked to the use of that sign...”

92. As I understood it, SIL did not take issue with the principle that the potential content or subject-matter of goods and services could be one of their characteristics for the purpose of s.3(1)(c). But it said that it was necessary to be careful about the application of the approach. In my judgment the necessary care is built into the approach set out by Mr Hobbs.
93. Google also referred me to cases about the approach to the assessment of compound marks under s.3(1)(c). It is sufficient to cite Case C-363/99 *Koninklijke KPN Nederland BV v Benelux-Merkenbureau* (“*Postkantoor*”) at [98]-[100]:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.

100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.”

S.3(1)(c) – assessment

94. I shall start by considering the 656/664 Marks. They consist of the word “shorts” in an ordinary sans serif capitalised font, either black on a white background or white on a black background, with a red triangle in the “O”. I have found that, as of 20 February 2018, one meaning of the word “shorts” was short-form

audiovisual content, including but not limited to what SIL calls “short films”. In my judgment, the word “shorts” would be recognised by the average consumer as a description of a characteristic of the goods at least in the case of “sound, video and data recordings”, “cinematograph films”, “films for television” and “recorded television programmes”.

95. I now need to consider whether the presentation of the word “shorts” in the 656/664 Marks means that those Marks do not consist “exclusively” of signs or indications which may serve to designate characteristics of those goods, applying the approach I have explained above. In my judgment the font and the contrast between the lettering and the background are insignificant in the context of the mark as whole.
96. That leaves the red triangle in the “O”. In my judgment the triangle would be recognised by the average consumer as a play symbol, designating a characteristic of the goods, namely that they can be played. However, I need to consider the effect of the combination of the word “shorts” and the play symbol, rendered in red and located within the “O”. In my judgment the way in which the two elements are combined is such that the mark does not consist “exclusively” of indications which may serve to designate characteristics of those goods. The combination creates an overall impression which goes beyond a mere juxtaposition of two descriptive indications.
97. While that is sufficient to dispose of the allegation that the 656/664 Marks are objectionable under s.3(1)(c), in case I am wrong (and because it helps to establish the groundwork for when I come to consider the 383 Mark) I shall consider the position in respect of the other goods and services covered by the marks.
98. I shall start with “video and audio tapes, cassettes, discs”, “CDs, DVDs”, “electronic media” and “digital media”. These are all carriers of audiovisual content. If the 656/664 Marks consisted exclusively of indications designating characteristics of the goods, then in my judgment the potential for such goods to provide consumers with content which (on that assumption) they will recognise the marks as denoting is in my judgment sufficiently real and significant to be a material consideration.
99. The next group of goods is “computer software” and “electronic entertainment software”. When those categories of goods are expressed in those generic terms, it is not immediately apparent that they have the potential to provide short-form audiovisual content to be played. However, each category includes software for accessing audiovisual entertainment (which, for reasons which will appear below, is the sub-category of goods to which in my judgment SIL is entitled having regard to the use which it has made of the 656/664 Marks). For that sub-category of goods the potential to provide consumers with content which they will recognise the marks as denoting is sufficiently real and significant to be a material consideration.
100. Finally in class 9 there are “television games” and “electronic games”. Even if I am wrong about the assessment of the 656/664 Marks and they are properly to be

regarded as objectionable under s.3(1)(c) for the goods I have considered above, I cannot see how the marks are descriptive of characteristics of these goods.

101. I should add that the final words of the class 9 registration: “all the aforesaid also supplied by or provided by telecommunications networks, mobile telephones, mobile media devices, on-line from a computer database or the Internet”, does not seem to me to affect any of the analysis above. That only provides options for how the goods are provided rather than affecting the goods themselves.
102. I now turn to class 38, for which the specification is “broadcasting and transmission of television programmes; broadcasting and transmission of television programmes and games via telecommunications networks, mobile phones, mobile media and on-line from a computer database or the Internet”.
103. SIL pointed out that the notes to class 38 that were in force in 2018 (and 2019) explained that class 38 related to services which allow people to communicate with each other by sensory means, including the diffusion of television programmes. In other words, SIL submitted, class 38 concerns the act of transmission rather than the content of the transmission.
104. However, if I had found that the ground of objection under s.3(1)(c) applied to television programmes, I would also have held that it applies to the class 38 services. In my judgment the potential for the service of broadcasting and transmission of television programmes to provide consumers with content which (on that assumption) they will recognise the marks as denoting is in my judgment sufficiently real and significant to be a material consideration; once again the final words of the specification does not seem to me to affect the analysis.
105. The class 41 specification is “entertainment services; production, presentation and distribution of films, videos and television programmes; publication of computer games; distribution of computer games; including delivery of the aforesaid services by telecommunications networks, mobile phones, mobile media and online from a computer network or the Internet.”
106. I start with “production, presentation and distribution of films, videos and television programmes”. If I had found that the ground of objection under s.3(1)(c) applied to films, videos and television programmes I would have held that it also extended to these services, as their potential to provide consumers with content which (on that hypothesis) they will recognise the marks as denoting is self-evident.
107. “Entertainment services” in my view stand in a similar position to “electronic entertainment software”. That category of services is very broad and includes within it “production, presentation and distribution of films, videos and television programmes” (which again, for reasons which will appear below, is the sub-category of services to which in my judgment SIL is entitled having regard to the use which it has made of the 656/664 Marks).
108. Again, even if I am wrong about by assessment of the 656/664 Marks I would not regard the s.3(1)(c) objection as applying to “publication of computer games” or

“distribution of computer games”; once more I do not regard the words at the end of the specification as affecting the analysis.

109. The 615/649 Marks are the same as the 656/664 Marks save that they also include the letters “TV” in red. SIL’s position on these marks cannot be worse than in respect of the 656/664 Marks and so the s.3(1)(c) objection must fail. However, for reasons which will become apparent, I do not believe that SIL’s position in respect of these marks is any better than on the 656/664 Marks.
110. I now need to consider the 383 Mark, i.e. the word mark “SHORTSTV”. I have explained how the average consumer would understand the word “SHORTS”. The letters “TV” would be recognised by the average consumer as meaning “television” and so, taken on their own, would designate a characteristic of goods and services which are or can be provided by televisual means.
111. The question is whether the combination of “SHORTS” and “TV” creates “an impression which is sufficiently far removed from that produced by the simple combination of those elements”. In my view it does not. There is not a “perceptible difference between the word and the mere sum of its parts” or an “impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts”. On the contrary, the impression given by the combination of “SHORTS” and “TV” is simply that the goods are shorts provided by televisual means and that the services involve the provision of shorts by televisual means.
112. Mr Malynicz submitted that “SHORTSTV” had unusual syntax, but I do not see why. He also submitted that consumers were used to TV channels being named “XTV” where X was a reference to the type of content. That rather supports the view that there is nothing unusual about the syntax. Mr Malynicz’s point was that consumers will take “XTV” as a reference to a channel (i.e. having a particular origin). However, while with use consumers may understand “XTV” (where X is a reference to the type of content) to refer to a particular channel, that does not mean that without use they would assume it did, and the evidence did not establish that they would.
113. Further, Google made the point that SIL’s case was that use of the 615/649 Marks constituted use of the 656/664 Marks for the purpose of s.46 (see below). In other words, SIL was contending that the addition of “TV” to the 656/664 Marks did not alter their distinctive character. So, Google said, SIL had effectively conceded that the addition of “TV” did not confer distinctiveness. In my judgment it is a matter for me to determine whether the addition of “TV” confers distinctiveness, rather than to rely on an implied concession. However, SIL did not have any effective answer to this point, and it is consistent with the view I would have arrived at in any event.
114. The 383 Mark is registered for many more goods and services than the 2018 Marks and I need to consider the extent to which the s.3(1)(c) objection applies. That is not an issue to which the parties directed any real attention in their submissions. In Annex 3 to this judgment I have rearranged the order of some of the categories of goods and services in the specification of the 383 Mark, grouped

some of the categories together, truncated some of the long lists of genres of content, and omitted phrases similar to those which appear at the ends of the categories in the specifications of the 2018 Marks which do not affect the analysis (I have also italicised the goods and services on which SIL does not rely for its infringement case). I have then indicated my conclusions in relation to each of the groups of categories of goods and services, which I have arrived at using the same approach as set out above when considering the goods and services for which the 656/664 Marks are registered.

S.3(1)(d)

The law

115. S.3(1)(d) TMA provides that trade marks shall not be registered if they “consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade”.
116. SIL referred me to the summary of the law by the General Court in Case T-322/03 *Telefon & Buch Verlagsgesellschaft mbH v EUIPO* at [49]-[52] (citations omitted):

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark.

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question.

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered.

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark.”

117. In my judgment I should apply the same approach to the word “exclusively” in s.3(1)(d) as in s.3(1)(c).

Assessment

118. SIL said that in this case “the trade” was consumers, and Google did not dissent. In my judgment the matters I have explained above mean that “shorts”, “TV” and the play symbol had “become customary in the current language or in the *bona fide* and established practices of the trade”. For essentially the same reasons as under s.3(1)(c) I do not regard the 2018 Marks as consisting exclusively of signs or indications of the type addressed by s.3(1)(d), but I regard the 383 Mark as vulnerable to the same extent under this ground.

S.3(1)(b)

The law

119. S.3(1)(b) TMA provides that trade marks shall not be registered if they are “devoid of any distinctive character”.
120. As is apparent from *Technopol*, s.3(1)(b) is broader in scope than s.3(1)(c) or (d). Both parties referred me to the judgment of the CJEU in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* at [29]-[45], as set out in *Starbucks* at [90]. In particular, the following statements of principle emerge (as applied to s.3(1)(b) TMA):
- i) The fact that a sign is capable of constituting a trade mark does not mean that it necessarily has distinctive character in relation to a specific product or service (*BORCO* at [29]).
 - ii) Under s.3(1)(b), marks which are devoid of any distinctive character are not to be registered (*BORCO* at [30]).
 - iii) For a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*BORCO* at [31]).
 - iv) Distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*BORCO* at [32]).
121. In the case of compound marks, the question is whether the mark as a whole is devoid of distinctive character. The mere fact that each element of a compound mark lacks distinctive character does not mean that the mark as a whole will do so. See for example Case C-304/06 P *Eurohypo v OHIM* at [41]:

“As regards a compound trade mark, such as that at issue in the present case, the assessment of its distinctive character cannot be limited to an evaluation of each of its words or components, considered in isolation, but

must, on any view, be based on the overall perception of that mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, have a distinctive character (see, to that effect, Case C-329/02 P *SAT.1 v OHIM* [2004] E.C.R. I-8317, paragraph 35). The mere fact that each of those elements, considered separately, is devoid of any distinctive character does not mean that their combination cannot present such character (Case C-37/03 P *BioID v OHIM* [2005] E.C.R. I-7975, paragraph 29)."

122. SIL also referred me to the CJEU's decision in *SAT.1* itself and in particular its statement in [44] that "*The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.*" However, that does not amount to a proposition of law. Each case needs to be assessed on its own facts.

Assessment

123. Because this ground of objection encompasses s.3(1)(c) and (d), it follows that it also applies to the 383 Mark to the same extent as those objections do, though if I am wrong about the 383 Mark being objectionable under s.3(1)(c) and (d), then in my judgment it is also not objectionable under s.3(1)(b). I see no independent basis for considering the 2018 Marks to be objectionable under s.3(1)(b). However, in my view the distinctive character of those marks is low, and arises from the particular combination of the word "shorts" and the play symbol (rendered in red in the "O").

Acquired distinctive character

124. Given my findings on the validity of the 2018 Marks, the question of whether those marks had acquired distinctive character through use does not arise. However, I need to consider that question in relation to the 383 Mark, and I shall also consider it in relation to the 2018 Marks in case I am wrong about their inherent distinctive character.

The law

125. The proviso to s.3(1) TMA provides that a trade mark shall not be refused registration by virtue of s.3(1)(b), (c) or (d) if, before the date of application for registration, "it has in fact acquired a distinctive character as a result of the use made of it". Further, s.47(1) TMA provides that where a trade mark was registered in breach of s.3(1)(b), (c) or (d) it shall not be declared invalid if, "in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered". As mentioned above, it was common ground that the relevant date for assessing whether SIL's marks had acquired a distinctive character was 8 February 2022.
126. Google referred me to the review of the law on acquired distinctive character by Arnold J in *W3* at [156]-[165], while SIL referred me to cases considered by

Arnold J as part of that review. For present purposes the following statements of principle are relevant:

- i) For a trade mark to possess distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings.
- ii) The distinctive character of a trade mark must be assessed by reference to (i) the goods or services in respect of which registration has been applied for and (ii) the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.
- iii) In assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character.
- iv) With regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression “use of the mark as a trade mark” refers solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product as originating from a given undertaking.
- v) A trade mark may acquire a distinctive character in consequence of the use of that mark as part of, or in conjunction with, another trade mark (which may itself be a registered trade mark).
- vi) It is not possible to state in general terms, for example by referring to predetermined percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has acquired a distinctive character through use. Nor can the results of a consumer survey be the only decisive criterion to support the conclusion that a distinctive character has been acquired through use.

127. In addition, Google reminded me of the observation of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] PRC 281 at 306 that “in the case of common or apt descriptive or laudatory words compelling evidence is needed” to

establish that a mark has acquired the distinctive character necessary to function as a trade mark.

Assessment

128. I have set out SIL's use of its marks in the UK in paragraphs 65-81 above. As at 8 February 2022 the position was as follows, in summary:

- i) Since 2017/2018 there had been use of the 615/649 Marks (and hence the 383 Mark) at the start and end of the Oscar nominated short films compilations, and in publicity materials for its theatrical release. However there was no evidence about the number of people who saw the marks when viewing the compilations at cinemas or on publicity materials. There was also use of the 615/649 Marks and a variant of the 656/664 Marks at the end of other SIL-produced materials distributed through various digital channels. However, there was no evidence about the numbers of people who watched either those materials, or the Oscar nominated short films compilations, on those digital channels.
- ii) There was use of the 615/649 Marks (and hence the 383 Mark) in relation to the Amazon Prime Video linear TV channel which had been running since November 2020, but there were no viewing figures for that channel. There was also use of those marks in relation to the Amazon Prime Video VoD channel which had been running since between October 2020 and January 2021, but there were no viewing figures for that channel at the relevant times (save in July 2021 when viewership was very small).
- iii) There was use of the 656/664 Marks in relation to the Samsung, LG and Rakuten FAST channels which had been running since between late June/July and October 2021. The LG and Rakuten channels had very small reaches. In late July 2021 the Samsung channel had 14,000 unique viewers per day but there is no basis for thinking that such viewing figures continued.
- iv) There was no satisfactory evidence to show any significant consumer exposure to SIL's Marks through the EST sites.
- v) The SHORTSTV+ app had been launched in November 2021. There is no evidence to show any significant consumer exposure to it before 8 February 2022.
- vi) Content bearing SIL's Marks had been available on SIL's YouTube channel, but there was no evidence as to UK subscribers or views.
- vii) There was no evidence to show any significant consumer exposure to SIL's Marks through its social media activities.
- viii) While there was evidence that SIL had been involved with UK film festivals and film schools, there was no evidence about the use of its branding in such activities or the reach of such activities. There was some press coverage (some using "ShortsTV"), but mainly in the trade press.

129. SIL relied on the unchallenged evidence of Mr Thompson that “*From conversations I have had with others in the film industry, I believe Shorts International is well known within the film making community and has a very good reputation as being a place that curates high quality short films (i.e. films with good look, design, acting or storytelling)*”. It also relied on the evidence of Mr Young that SIL receives around a hundred approaches from filmmakers every month; he exhibited some of these and most came from filmmakers outside the UK.
130. Ms Charmail said in her witness statement that SIL has a strong reputation among short filmmakers and is well known in the industry more generally. In cross-examination she said that the people who know about SIL are not exclusively filmmakers, actors and film buffs. However, Mr Young’s evidence was that SIL’s audience is mainly a mix of film buffs, aspiring filmmakers and established filmmakers.
131. This evidence was directed to knowledge of SIL rather than knowledge of it operating under the name ShortsTV or knowledge of its marks operating as indicators of origin, and was not really focussed on the position in the UK.
132. I have to make an overall assessment of the relevant evidence bearing in mind the factors set out in paragraph 126(iii) above. In my judgment, having regard to the evidence to which I have referred, it is clear that exposure to SIL and its marks was largely limited to filmmakers and some other people in the film industry and to film buffs. Even then the evidence is such that it is not possible to assess how many of that group of people had been exposed to any of SIL’s Marks prior to 8 February 2024. In my judgment a significant proportion of the relevant group of persons (i.e. the general public in the UK) had not come to identify goods and services as originating from a particular undertaking because of any of SIL’s Marks.
133. The consequence is that none of SIL’s Marks had acquired a distinctive character because of the use made of them prior to 8 February 2022 and the 383 Mark must be declared invalid to the extent that the s.3(1)(b),(c) and (d) objections apply to it, as set out in Annex 3.

SIL’s proposed amended specifications

134. As mentioned above, in response to the invalidity attacks, SIL proposed, as a fall-back position, a set of proposed amended specifications of goods and services. I have set out SIL’s proposed amended specifications for the 2018 Marks in paragraph 32 above, and indicated that for the 383 Mark by means of red amendments in Annex 1.
135. Google objected to the proposed amended specifications on the grounds that (i) the proposed limitations were too narrow, in that even in the cases where limitations had been proposed they were limited to “short films” but the meaning of “shorts” was more extensive, (ii) the proposed limitations were too narrow, in that they should have been applied to further categories of goods and services, and (iii) the proposed limitations were not permissible having regard to the decision of the CJEU in *Postkantoor*. I shall address the law on point (iii) before

assessing Google’s objections. Given my findings on the validity of the 2018 Marks, no limitation to the specification of those marks is needed to overcome a validity objection, but I shall nevertheless consider whether the proposed limitations would have been acceptable for those marks, as well as for the 383 Mark.

The law

136. Google referred me to the analysis of the law by Arnold J in *Omega Engineering Inc v Omega SA* [2012] EWHC 3440 (Ch) at [43]-[45]:

“43. *The POSTKANTOOR principle.* In *POSTKANTOOR* the applicant applied to register the word POSTKANTOOR (Dutch for POST OFFICE) in respect of goods and services in Classes 16, 35–39, 41 and 42. The Benelux Trade Mark Office refused registration on the grounds that the sign was descriptive. On appeal, the *Gerechtshof te s’-Gravenhage* (District Court of The Hague) referred nine questions of interpretation of the Directive to the Court of Justice, of which the eighth was as follows:

“Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign ‘Postkantoor’ for the services of direct-mail campaigns and the issue of postage stamps ‘provided they are not connected with a post office’)?”

44. The Court of Justice answered this question as follows:

“113. ... when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties – particularly competitors – would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

45. The guidance given by the Court of Justice must be seen in the context of the question to which it was addressed, namely whether it was acceptable to restrict the goods or services by reference to the absence of “a specific quality”. What the District Court of The Hague meant by this can be seen from the example it gave, viz. “the services of direct mail campaigns and the issue of postage stamps provided that they are not connected with a post office”. When the Court of Justice referred in its answer to “a particular characteristic”, it must have meant the same thing as the District Court meant by “a specific quality”.”

137. Arnold J went on (at [46]-[52]) to observe that the application of this guidance has caused some difficulty in subsequent cases and to provide some examples. In particular he referred with approval to the distinction drawn by Geoffrey Hobbs QC, sitting as the Appointed Person, in *Croom’s Trade Mark Application* [2005] RPC 2 at [30], namely whether the limitation referred to “characteristics that may be present or absent without changing the nature, function or purpose of the goods”. In that case, Mr Hobbs refused a limitation to the specification of goods in classes 18 and 25 which involved adding the words “none being items of haute couture” or “not including items of haute couture”.

Assessment

138. Google contended that the proposed limitations to the specifications of goods and services fell foul of the principles in *Postkantoor* and led to legal uncertainty because (a) “save for / in relation to short films” identified a characteristic of the goods or services rather than a sub-category of goods or services and (b) there was no clear and consistent definition of “short films”. SIL contended that “short films” were a defined category of goods and related to a defined category of service. It said that “short films” were defined not just by their duration but by their “*condensed narrative structure, purpose and format (e.g. they are used to explore experimental storytelling techniques or test new ideas)*”.
139. I agree with Google. For the reasons I have explained in paragraphs 60-62 above, in my judgment there was no clear and consistent definition of “short films”. Even if it was possible to define “short films” by their duration and their “condensed narrative structure, purpose and format”, in my judgment those are all characteristics of the goods which “may be present or absent without changing the nature, function or purpose of the goods”. A sound, video or data recording has the same nature (it is a recording of sounds, video or data) and has the same function and purpose (to record sounds, video or data and allow them to be reproduced) whether it is longer than or shorter than 40 minutes (using the Academy definition) and whether or not the sounds, video or data recorded represent something with “condensed narrative structure”. Similar points can be made about the other goods and services to which SIL seeks to apply the limitation.
140. I also agree with Google that even if it is possible to regard “short films” as a sufficiently clear and consistent definition of a sub-category of goods having the meaning attributed to it by SIL, the proposed limitations do not go far enough. For the reasons I explained in paragraphs 46-59 above, “shorts” had a meaning which went beyond SIL’s definition of “short films”. I also agree with Google

that the proposed limitations have not been applied to sufficient categories of goods and services. For example, I do not understand the basis on which SIL proposes the limitation of the specification of the 383 Mark in the case of “television programmes” but not “broadcasting...of...television programmes”. For these reasons, SIL’s proposed limitations do not overcome the invalidity objections to the 383 Mark, and would not have overcome the invalidity objections to the 2018 Marks if those had succeeded.

141. I should add that in its oral closing submissions, SIL said that whatever the meaning of “shorts” was, it should be possible to limit the specifications to exclude “shorts”. However, it did not advance any other form of proposed limitation for consideration.

S.3(3)(b)

The law

142. S.3(3)(b) provides that a mark shall not be registered if it is “of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)”.
143. SIL referred me to the summary of the case law of the CJEU and the General Court (with which Google did not take issue) by Prof. Phillip Johnson, sitting as the Appointed Person, in the *Paris Breakfast Tea* case (O/358/17) at [84] (citations omitted):
- (a) it is necessary to establish that the mark will create actual deceit or a sufficiently serious risk that the consumer will be deceived;
 - (b) the deception must arise from the use of the mark itself (i.e. the use *per se* will deceive the consumer);
 - (c) the assessment of whether a mark is deceptive should be made at the date of filing or priority date and so cannot be remedied by subsequent corrective statements;
 - (d) the deception must have some material effect on consumer behaviour;
 - (e) where the use of a mark, in particular a collective mark, suggests certain quality requirements apply to goods sold under the mark, the failure to meet such requirements does not make use of the mark deceptive;
 - (f) only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will the consumer be deceived by the trade mark;
 - (g) where a mark does not convey a sufficiently specific and clear message concerning the protected goods and services or their characteristics but, at the very most, hints at them, there can be no deception in relation to those goods and services;

- (h) once the existence of actual deceit, or a sufficiently serious risk that the consumer will be deceived, has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading;
- (i) where a trade mark contains information which is likely to deceive the public it is unable to perform its function of indicating the origin of goods.

Assessment

144. Given the conclusions I have reached above, I shall only address this briefly. The hypothesis on which I have to approach matters is that SIL's proposed limitations to its specifications of goods and services are acceptable because "short films" is a defined sub-category of goods having the meaning it attributes to it. On that basis, and on the basis of my findings of fact as to the meaning of "shorts", I would not regard SIL's Marks with their proposed amended specifications as being deceptive. While the marks do convey a message about the characteristics of the goods and services, those characteristics are ones which the goods and services can in fact possess (because the limitations have not excluded all "shorts").

REVOCATION FOR NON-USE

The law

145. The issue is whether each of the 2018 Marks have been put to "genuine use" in the UK by SIL or with its consent in the relevant five year period in relation to the goods and services for which they are registered, without "proper reasons" for non-use – s.46(1)(a) TMA. For these purposes, use includes use in a form "differing in elements which do not alter the distinctive character of the mark in the form in which it was registered" – s.46(2) TMA.
146. It was common ground that the relevant dates for assessing the allegations of non-use of the 2018 Marks are 5 October 2018 to 4 October 2023. SIL did not suggest that there were proper reasons for non-use.
147. It was also common ground that:
- i) Each of the 2018 Marks is derived from an EU parent mark following Brexit, so SIL is entitled to rely on use in the EU prior to 31 December 2020 for the purpose of defending the allegations of non-use – see paragraph 8 of Part 1 of Schedule 2A TMA. However, SIL did not in its closing submissions rely on any use made in the EU (but outside the UK) prior to 31 December 2020.
 - ii) The onus is on SIL to show what use has been made of the 2018 Marks – s.100 TMA.

- iii) Where grounds for revocation exist in respect of only some of the goods and services for which any of the 2018 Marks are registered, revocation shall relate to those goods or services only – s.46(5) TMA.
 - iv) If the registration of any of the 2018 Marks are revoked to any extent, SIL’s rights shall be deemed to have ceased to that extent as from the date of the application for revocation or, if the court is satisfied that the grounds for revocation existed at an earlier date, that date – s.46(6) TMA.
148. SIL referred me to the summary of the law on what amounts to genuine use by Arnold LJ in *easyGroup Ltd v Nuclei Ltd* [2023] EWCA Civ 1247 at [105]-[107]. I have had that summary in mind, but the issues between the parties in this case do not turn on whether the use which has been made of the 2018 Marks qualifies as “genuine use”. I also bear in mind the point made by SIL by reference to the decision of Richard Arnold QC (as he then was) in *Pan World Brand Ltd v Tripp Ltd* [2008] RPC 2 at [31] that documentary evidence of use is not needed if a witness with knowledge of the facts is able to explain when, where, in what manner and in relation to what goods and services the mark has been used.
149. The law on the application of s.46(2) was reviewed by Arnold J in *Walton International Ltd v Verweij Fashion BV* [2018] EWHC 1608 (Ch) at [119]-[123]. I adopt the summary by Nicholas Caddick KC in *easyGroup Ltd v Easy Live (Services) Ltd* [2024] EWHC (Ch) at [40], to which Google referred me, and would add a fourth point of relevance to this case:
- i) The objective of s.46(2) is to allow the proprietor of the mark, in the commercial exploitation of the sign, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (see *Walton* at [119], citing Case C-252/12, *Specsavers International Healthcare Ltd v Asda Stores Ltd* at [29]).
 - ii) There are two parts to the necessary inquiry. First, to identify the points of difference between the mark as used and the mark as registered and, second, to ask whether those differences alter the distinctive character of the mark as registered (see *Walton* at [120], citing *BUD and BUDWEISER BUDBRAU Trade Marks* [2002] EWCA Civ 1534).
 - iii) The normal approach to the assessment and comparison of distinctive character applies in this context. Accordingly, it is necessary to analyse the 'visual, aural and conceptual' qualities of the mark as used and of the mark as registered and to make a 'global appreciation' of their likely impact on the average consumer (see *Walton* at [120]-[121], citing *BUD and BUDWEISER BUDBRAU* at [45] and Case C-501/15 *European Union Intellectual Property Office v Cactus SA* at [68]-[71]).
 - iv) Alteration or omission of elements which are not distinctive is not capable of altering the distinctive character of a trade mark. Further, when a trade mark is composed of word elements and figurative elements, the former are, as a rule, more distinctive than the latter. Accordingly, it is possible in an appropriate case for use of the word element on its own to constitute use

of the trade mark (see *Walton* at [122], citing Case T-690/14 *Sony Computer Entertainment Europe Ltd v OHIM* at [45], [49] and [51]).

150. SIL also referred me to the judgment of the General Court in Case T-146/15 *hyphen GmbH* at [27]-[31] relating to the corresponding provision (citations omitted):

“27. It must be observed that the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 relates to a situation where a national or Union registered trade mark is used in trade in a form slightly different from the form in which registration was effected. The purpose of that provision, which avoids imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In accordance with its purpose, the material scope of that provision must be regarded as limited to situations in which the sign actually used by the proprietor of a trade mark to identify the goods or services in respect of which the mark was registered constitutes the form in which that same mark is commercially exploited. In such situations, where the sign used in trade differs from the form in which it was registered only in insignificant respects, and the two signs can therefore be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark which was registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.

28. Thus, a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark.

29. For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the earlier mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true.

30. It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole.

31. It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the

form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character.”

151. In relation to the law on the application of s.46(5), Google referred me to the following statements of principle from *Merck KGaA v Merck Sharp and Dohme Corp* [2017] EWCA Civ 1834 at [245]-[248]:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered from the viewpoint of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.”

152. SIL also referred me to the summary of principles by Henry Carr J in *Property Renaissance Ltd v Stanley Dock Hotel Ltd* [2016] EWHC 3103 (Ch) at [47], and in particular to points (iv)-(vii) which concern partial revocation. I have had regard to those points but it is not necessary to set them out in addition to the statements of principle from *Merck*.

Assessment

153. There was a degree of common ground as to whether the use which SIL had made of its marks was use of each of the 2018 Marks within the meaning of s.46(2). It was agreed that use of the 649 Mark counted as use of the 615 Mark and vice versa, and that use of the 664 Mark counted as use of the 656 Mark and vice versa. It was also common ground that use of the 615/649 Marks counted as use of the 656/664 Marks (though Google said that had consequences for validity, as explained above) and that use of the 656/664 Marks did not count as use of the 615/649 Marks.
154. The dispute was whether the use of “ShortsTV+” (in the form of the 615/649 Marks but with an additional “+”) counted as use of the 615/649 Marks. Google contended that the addition of the “+” altered the distinctive character of the registered marks, because it was a prominent visual element, had conceptual significance in suggesting that something more is offered, and adds an additional

syllable orally. I do not agree that the addition of the “+” alters the distinctive character of the 615/649 Marks as registered. While I agree that the “+” adds a visual element, and an additional syllable orally, and has some conceptual significance in suggesting something more, I do not agree that it adds anything significantly distinctive to the 615/649 Marks. In so far as those marks have distinctive character, that distinctive character is retained rather than altered.

155. I now turn to consider the use which has been made in respect of the goods and services in issue, turning first to the categories of goods and services for which the allegations of non-use of the 2018 Marks remained live in any event, namely “computer software” and “electronic entertainment software” in class 9 and “entertainment services” in class 41. For reasons which will become apparent, I can consider the class 9 goods together before turning to consider “entertainment services”.
156. In its closing submissions, SIL contended that use of “ShortsTV+” (in the form described above) in relation to its app constituted use of each of the 2018 Marks for “computer software” and “electronic entertainment software”. It also contended that use of the 615/649 Marks in relation to the Amazon Prime Video VoD service and in relation to content sales as part of its distribution activities constituted use of each of the 2018 Marks for “electronic entertainment software” (but not “computer software”). I can deal with the latter point briefly. I cannot see how those uses of the 2018 Marks are use in relation to “electronic entertainment software”, and SIL did not attempt to explain why it said they were.
157. That leaves the use of “ShortsTV+” in relation to the app. As I have explained above, the mobile app was launched in November 2021 on the App Store and Google Play store and the Android TV app was launched at the same time. That in my view amounts to genuine use of the mark in the UK. Google’s points were really that there was no dated documentary evidence to show the availability of the app or its promotion by SIL. But it did not challenge Mr Buchallet’s evidence as to the launch date, and indeed it indicated that the launch date was agreed.
158. The app is a form of both “computer software” and “electronic entertainment software” but it remains necessary to consider the appropriate specification of goods having regard to the use which has been made of the 2018 Marks. SIL submitted that no limitation needed to be made to “electronic entertainment software” and that any limitation to “computer software” should be to add “for viewing, delivering or accessing entertainment”. I need to consider matters from the viewpoint of the average consumer and consider the purpose and intended use of the products in issue to arrive at a fair specification of goods having regard to the use which has been made of the mark. Bearing in mind the purpose and intended use of the goods, in my view a fair specification to replace “computer software” and “electronic entertainment software” would be “software for accessing audiovisual entertainment”.
159. Next I need to consider “entertainment services”. SIL said that all its uses of the 2018 Marks were in relation to “entertainment services”. There is no dispute that genuine use of the 2018 Marks has been made in relation to services falling within that category. The dispute is about the fair specification of services given the use that has been made of the 2018 Marks. SIL said that no limitation was required,

but as Google pointed out, “entertainment services” covers a wide range of services including the provision of stand-up comedy, theatre productions, circus productions and party planning. I agree with Google that a fair specification of services does not extend beyond “production, presentation and distribution of films, videos and television programmes” for which Google had conceded use.

160. I am also asked to consider whether there has been genuine use for the goods and services remaining in the categories to which SIL’s proposed limitations apply, namely:

Class 9: sound, video and data recordings save for short films; cinematographic films save for short films; films for television save for short films; recorded television programmes save for short films.

Class 41: entertainment services save for those provided in relation to short films; production, presentation and distribution of films, videos and television programmes save for short films.

161. The parties’ submissions on this point in their written closings were brief. Google said it was not aware of any evidence of use other than in relation to short films, while SIL asserted that its “offerings extend beyond “short films”” without specifying what it was referring to. However, I understood that SIL was relying on the filmmaker interviews and “behind the scenes” programmes, not on the basis that they were not “short” but on the basis that they were not “films”. In my view, this just highlights the problem of trying to define goods and services by saying that they are not, or do not relate to, “short films”. Given the conclusions I have reached, and the multiple hypotheses that I would need to adopt, in my view it is not necessary to try to decide what an appropriate specification would be if SIL’s proposed limitations were allowed, and the filmmaker interviews and “behind the scenes” programmes were regarded as not being “short films”. That is something which the Court of Appeal can address on the basis of my findings if it becomes necessary for it to do so.
162. Finally, I should say that I am satisfied that the grounds for revocation existed as of 5 October 2023. Therefore, the 2018 Marks should be partially revoked to the extent indicated above as from that date.

INFRINGEMENT

163. SIL indicated that, for the purpose of its infringement case, it relied on only some of the goods and services for which its marks were registered.
164. In the case of the 2018 Marks, it relied on the following goods and services:

Class 9 - Sound, video and data recordings; cinematographic films; films for television; computer software; recorded television programmes; electronic media; digital media; electronic entertainment software; all the aforesaid also supplied to or provided by telecommunications networks, mobile telephones, mobile media devices, on-line from a computer database or the Internet.

Class 38 - Broadcasting and transmission of television programmes.

Class 41 - Entertainment services; production, presentation and distribution of films, videos and television programmes; including delivery of the aforesaid services by telecommunications networks, mobile phones, mobile media and online from a computer network or the Internet.

165. In the case of the 383 Mark, SIL relied on all the goods and services save for those italicised in Annex 3. However, I have held that the 383 Mark is invalid in so far as it is registered for goods and services in all the non-italicised categories, though in some cases not for all the goods and services in each category. I shall consider infringement of the 383 Mark on the basis that it is valid for all the goods and services for which it is registered.

166. It was common ground that, as regards the use of signs in respect of the YouTube website and mobile app, the date at which the issues of infringement should be assessed was June 2021. SIL suggested that in the case of the smart TV app the relevant date was November 2022 but I reject that. That could only be the case if there was a material change in the use of the sign (see e.g. *BDO* at [94]), but there was no material change in the use of “shorts” in the smart TV app at that time.

167. There was some debate about the identity of the average consumer for the purposes of infringement. SIL referred me to what Arnold J said in *Sky plc v SkyKick UK Ltd* [2018] EWHC 155 (Ch) at [275]:

“The average consumer for the purposes of an infringement claim must be a consumer of the relevant goods and/or services who is both (i) familiar with the trade mark and (ii) exposed to, and likely to rely upon, the sign.”

168. As I understand it, as applied to s.10(2), this is a different way of expressing the point that, when considering whether there is a likelihood of confusion, the court must have regard to the impact of the alleged infringing sign on the proportion of consumers to which the trade mark is particularly distinctive (see *Interflora Inc v Marks & Spencer plc* [2014] EWCA Civ 1403 at [123] and also *Enterprise Holdings Inc v Europcar Group UK Ltd* [2015] EWHC 17 (Ch) at [136]-[137]). For the purpose of s.10(3), the average consumer must be one for whom the trade mark has a reputation. I have in mind that the level of attention that will be paid by consumers who are exposed to, and likely to rely upon, the signs being used by Google is relatively low.

169. Google reminded me that the overriding requirement for infringement was that the use of the sign complained of must affect or be liable to affect one of the functions for which the trade mark is protected by registration, including the essential origin function, and that, for that reason, purely descriptive use does not infringe – see e.g. Case C-206/01 *Arsenal Football Club plc v Reed*.

S.10(2) – the law

170. S.10(2) TMA provides that:

“A person infringes a registered trade mark if he uses in the course of trade a sign where because—

- (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or
- (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

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

171. In order to establish infringement under s.10(2), six conditions must be satisfied: (i) there must be use of a sign by a third party within the relevant territory; (ii) the use must be in the course of trade; (iii) it must be without the consent of the proprietor; (iv) it must be of a sign which is at least similar to the trade mark; (v) it must be in relation to goods or services which are at least similar to those for which the trade mark is registered; and (vi) it must give rise to a likelihood of confusion: see e.g. Arnold LJ in *Match Group LLC v Muzmatch Ltd* [2021] EWCA Civ 1207 at [26].
172. Google reminded me that in order to be used “in relation to goods or services” a sign needs to be used for the purpose of distinguishing goods or services, i.e. as a trade mark as such, and that purely descriptive use of a sign does not amount to use of a sign “in relation to goods or services” (though a sign can be used both descriptively and as a trade mark) – see e.g. Arnold J in *Frank Industries Pty Ltd v Nike Retail BV* [2018] EWHC (Ch) at [89]-[90].
173. SIL reminded me that goods or services can be considered identical if they fall within the scope of those for which the mark is registered (see Case T-133/05 *Gérard Meric v OHIM*). In considering whether goods or services are similar to each other, it is necessary to consider all relevant factors including their intended uses, their method of use, and whether they are in competition with each other or complementary (see Case C-39/97 *Canon KKK v Metro Goldwyn Mayer Inc*); in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 296-297 Jacob J identified the following factors for assessing similarity: the respective uses, users and physical nature of the goods and services, the trade channels through which they reach the market and the extent to which they are competitive.
174. Both parties referred me to the well-known summary of the principles to be applied when considering whether there is a likelihood of confusion. For example, see Arnold LJ in *Iconix Luxembourg Holdings Sarl v Dream Pairs Europe Inc* [2024] EWCA Civ 219 at [10]-[11]:

“10. There is no dispute as to the applicable legal principles. The manner in which the requirement of a likelihood of confusion in section 10(2), and the corresponding relative ground of objection to registration, should be interpreted and applied has been considered by the Court of Justice of the European Union in a large number of decisions. In order to try to ensure

consistency of decision making, a standard summary of the principles established by these authorities, expressed in terms referable to the registration context, has been adopted in this jurisdiction. The current version of this summary is as follows:

“(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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.”

11. The same principles are applicable when considering infringement, although it is necessary for this purpose to consider the actual use of the sign complained of in the context in which the sign has been used: see *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24, [2012] FSR 19 at [87] (Kitchin LJ).”

175. Both parties also reminded me of the analysis of different types of confusion by Arnold LJ in *Liverpool Gin Distillery Ltd v Sazerac Brands LLC* [2021] EWCA Civ 1207 at [10]-[14]:

“10. It is well-established that there are two main kinds of confusion which trade mark law aims to protect a trade mark proprietor against (see in particular *Sabel BV v Puma AG* (C-251/95) [1997] E.C.R. I-6191 at [16]). The first, often described as “direct confusion”, is where consumers mistake the sign complained of for the trade mark. The second, often described as “indirect confusion”, is where the consumers do not mistake the sign for the trade mark, but believe that goods or services denoted by the sign come from the same undertaking as goods or services denoted by the trade mark or from an undertaking which is economically linked to the undertaking responsible for goods or services denoted by the trade mark.

11. In *LA Sugar Ltd v Back Beat Inc* (O/375/10) Iain Purvis QC sitting as the Appointed Person said:

“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)."

12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.

14. "Likelihood of confusion" usually refers to the situations described in [10] above. As this court held in *Comic Enterprises*, however, it also embraces situations where consumers believe that goods or services denoted by the trade mark come from the same undertaking as goods or services denoted by the sign or an economically-linked undertaking (sometimes referred to as "wrong way round confusion")."

- 176. SIL emphasised the point made in [12] of *Liverpool Gin Distillery*, referring me to Case C-120/04 *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* where the CJEU said that, in the case of a composite sign juxtaposing the claimant's mark and a widely-known mark belonging to the defendant, it suffices to establish a likelihood of confusion if the origin of the goods and services covered by the composite sign is attributed by the public to the owner of the claimant's mark. There was no requirement that the overall impression produced by the composite sign be dominated by the part of it represented by the earlier mark.
- 177. SIL also emphasised the point made in [14] of *Liverpool Gin Distillery* that a likelihood of confusion could include "wrong way round confusion" of the type

discussed in *Comic Enterprises Ltd v Twentieth Century Fox Film Corp* [2016] EWCA Civ 41 at [75]-[84], and made the point that such confusion was likely to be more prevalent than “right way round confusion” in a case where the defendant’s use of the sign complained of was much more extensive than the claimant’s use of its mark. However, Kitchin LJ emphasised that such evidence must be assessed with care to see whether it is of any assistance in answering the statutory question in the context of any particular case.

178. Google emphasised the line of case law concerning the impact on the assessment of likelihood of confusion of the use of common descriptive elements in the registered mark and the sign complained of. It referred me to the observations of Daniel Alexander QC in *PlanetArt LLC v Photobox Ltd* [2020] EWHC 713 (Ch) at [26]-[29]:

“26. One aspect of the approach to determining whether there is a likelihood of confusion which is important to this case is the significance of the adoption of common descriptive elements. In *Reed Executive Plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] E.T.M.R. 56 at [83]-[84] the Court of Appeal said:

“...where you have something largely descriptive the average consumer will recognize that to be so, expect others to use similar descriptive marks and thus be alert for detail which would differentiate one provider from another”.

See also *Elliott v LRC Products* (O/255/13) at [57] where the Appointed Person, Daniel Alexander QC, observed that consumers are less likely to think that two descriptive marks denote businesses that are connected with one another because a credible and dominant alternative explanation exists for the similarity in marks which has nothing to do with their denotation of a common trade source, namely that the similarity is attributable to their descriptiveness.

27. The case law does not suggest that there are general rules as to how descriptiveness should be taken into account but it is clear that it should be done. The fact sensitivity of such is illustrated in a number of cases. For, example, one concerning registration of a figurative mark incorporating “VAPE & Co” for e-cigarettes which was opposed by the proprietor of a prior registration for a figurative mark including the words “The Vape Co” (*Nicoventures Holdings Ltd v London Vape Co Ltd* [2017] EWHC 3393 (Ch)). Birss J said (see [31]-[36]):

“The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive ... it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed.”

28. That approach drew on the analysis by Arnold J of the case law of the European courts in *Whyte & Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271 (Ch); [2015] F.S.R. 33 where he said at [44]:

“...what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion”.

29. These cases show that there is no hard rule that use of a descriptive term cannot lead to a finding that there is confusion but they also show that such a case is harder to establish. It also has the impact of somewhat downgrading the significance of conceptual similarity in the evaluation of the likelihood of confusion at least insofar as the mark is descriptive of the goods and services in question.”

179. Similarly, in *Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd* [2024] EWCA Civ 814 at [38]-[39], Arnold LJ said this, after referring to the principle that marks with a highly distinctive character enjoy broader protection than marks with a less distinctive character:

“38. Although the principle is usually stated in the form set out above, it is common ground that the converse proposition is equally true: trade marks with a less distinctive character enjoy narrower protection than marks with a highly distinctive character.

39. The converse proposition manifests itself in a variety of ways. Perhaps the most common way is where the trade mark is allusive to the goods or services in question. Contrary to the submission of counsel for the Claimants, however, the principle is not confined to that situation. For example, it is well established that, if the only similarity between the trade mark and the sign (or between the trade marks, as the case may be) is a common element which has low distinctiveness, that points against there being a likelihood of confusion: see *Whyte & Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271 (Ch), [2015] FSR 33 at [44]. The common element may have low distinctiveness because it is descriptive or allusive, but that need not be the case.”

180. One issue that arises in this case is how to identify the sign being used in order to carry out the assessment of similarity of mark and sign and of likelihood of confusion. Google referred me to *Julius Sämaan Ltd v Tetrosyl Ltd* [2006] EWHC 529 (Ch) in which the question was whether the sign used by the defendant was a Christmas tree shape, ignoring the roundel including the words “CarPlan Air Care” which appeared on the tub, or the whole tree including the roundel and wording. Kitchin J (as he then was) held that the latter was correct, saying (at [49]):

“The matter must be considered from the perspective of the average consumer. The tree is fixed into the tub and the two are presented as a composite whole. Further, the roundel clearly has some trade mark

significance. It cannot simply be disregarded as descriptive material which is not part of the sign.”

181. Both parties also referred me to *Lidl Great Britain Ltd v Tesco Stores Ltd* [2023] EWHC 873 (Ch). In that case Tesco had used a yellow circle on a blue square background, containing the words “Clubcard Prices”. Lidl conceded at trial that the sign was the whole device, including the wording, but Joanna Smith J expressed the view (at [79]) that that concession was plainly correct, saying that it was unrealistic to suggest that the average consumer would understand the yellow circle on a blue square to be the sign, especially where “Clubcard” was a highly distinctive brand which the average consumer would not disregard as “context” or “separate information”.
182. In addition, SIL referred me to *Samuel Smith Old Brewery (Tadcaster) v Lee (t/a Cropton Brewery)* [2011] EWHC 1879 (Ch). In that case the defendant’s beer bottle labels looked like this:



183. Arnold J addressed the question of identification of the signs at [88]–[91]:

“88. Counsel for Samuel Smith opened the case on the basis that the signs used by Cropton Brewery were the two white rose devices. By contrast, counsel for Cropton Brewery approached the case on the basis that the signs consisted of the entire labels. I do not consider that either position is correct.

89. In the case of Yorkshire Warrior, I acknowledge that the white rose device is printed in different colours to the remainder of the cap badge image, and as such it stands out prominently, but even so I consider that it forms part of the composite image. The words YORKSHIRE WARRIOR, on the other hand, seem to me to form a separate sign (and that is so even though the word YORKSHIRE is superimposed on the scroll). The remainder of the label is plainly distinct from those two signs.

90. The Yorkshire Bitter label is more difficult. It is certainly possible to view the white rose device as a distinct sign, but given the overall design and the red accents, I think the better view is that the roundel plus white rose device comprise a composite sign. Again, I see the words

YORKSHIRE BITTER as a separate sign; Cropton Brewery as a separate sign again; and the remainder of the label as distinct.

91. It should be said, however, that it does not matter greatly how one analyses the signs, given that the trade mark only consists of a white rose device and given that one the hand regard must be had to the signs' dominant elements and on the other hand their impact must be assessed in context, that is to say, in the context of the surrounding matter.

184. However, in this case another issue concerns what can be taken into account as “context”, once the sign has been identified. It is well established that the context in which the sign appears must be taken into account when assessing confusion – see *Specsavers* at [87] per Kitchin LJ:

“In my judgment the general position is now clear. In assessing the likelihood of confusion arising from the use of a sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of that use that are likely to operate in that average consumer's mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.”

185. In that case, the court held that it was therefore necessary to take account of the signs “spec saver” and “Spec savings” in the context of the whole of the straplines “Be a real spec saver at Asda” and “Spec savings at Asda” and indeed of the whole of the posters on which they appeared (see [88]).
186. In the present case, one question is whether “context” can include matter which is not visible to the user at the time at which a sign is used. In *Och-Ziff Management Europe Ltd v Och Capital LLP* [2010] EWHC 2599 (Ch) Arnold J considered the judgment of the CJEU in Case C-533/06 *O2 Holdings Ltd v Hutchison 3G UK Ltd* and said this, at [77]-[78]:

“77. The question which arises is this: how far do the ‘context’ referred to by the Court at [64] and the ‘circumstances characterising that use’ referred to by the Court at [67] extend? Counsel for Och-Ziff submitted that the context and circumstances were limited to the actual context and circumstances of the use of the sign itself. Thus, in *O2* itself, where the sign was used in a comparative advertisement, the context was the whole of the comparative advertisement, but no more. By contrast, counsel for the defendants submitted that the context and circumstances included all circumstances relevant to the effect of the use of the sign, including circumstances prior to, simultaneous with and subsequent to the use of the sign.

78. In my judgment the context and circumstances are limited to the actual context and circumstances of the use of the sign itself. The Court of Justice explicitly said at [64] that the referring court was right to ‘limit its analysis’ to the context in which the sign was used. Furthermore, it referred at [67] to the circumstances ‘characterising the use’, not to the circumstances more generally. Thus circumstances prior to, simultaneous with and subsequent

to the use of the sign may be relevant to a claim for passing off (or, under other legal systems, unfair competition), but they are not generally relevant to a claim for trademark infringement under art.9(1)(b). In saying this, I do not intend to express any view on the question of post-sale confusion referred to below.”

187. That passage, and the observations about it made by Kitchin LJ in *Specsavers* at [86], were considered by Mr Alexander in *PlanetArt* at [24]-[25]:

“24. In my view, Arnold J, as he then was, in *Och-Ziff* was saying that the CJEU took the view that, in considering infringement of a registered trade mark, it was not appropriate to look so broadly at the context that use which was prima facie infringing was nonetheless to be regarded as non-infringing because other, separate, acts of the defendant had countered actual deception. An extreme example is where a defendant uses a well-known brand for counterfeit goods but nonetheless makes it very clear that the goods are in fact counterfeit so that no actual purchaser is confused. There may be no actual confusion as a result of the use of the sign but there is nonetheless trade mark infringement because the court must focus on the use of the sign in question not the other statements by the defendant as to the trade origin of the goods.

25. Accordingly, while it is right to take the context in which the given sign will be seen into account, I am not persuaded that it would be right to expand the view so broadly as to take account of the fact that a given sign only appears in this case after a different sign has been used. To that extent, each use of the signs must be examined separately in what might be described as its 'local' context.”

He added at [164] that:

“It is also necessary for the court to be cautious in adopting an overly expansive approach to taking account of context in a trade mark claim. One purpose of registered trade mark protection (in which it is distinguished from passing off) is to provide an element of exclusivity in the use of a registered mark, regardless of the wider context in which it is used, so long as the conditions for protection are fulfilled.”

188. In *Lifestyle Equities* Arnold LJ returned to this topic. At [54], having referred to the statement of principle in *Specsavers* at [87] he said:

“Although the principle is clear, its application can cause difficulty. The difficulty usually arises where the defendant relies upon context as negating a likelihood of confusion in a case where, absent whatever is relied upon as constituting the relevant context, the identity or similarity of the mark and the sign and the similarity or identity of the respective goods or services would give rise to a likelihood of confusion. While it is clear from *O2* that this is legally possible in an appropriate case, it is not clear how far the principle extends outside the special circumstances of comparative advertising.”

Then, having cited the passages from *PlanetArt* that I have quoted, he said this:

“56. It is worth pointing out that there are other answers to the problem identified by Mr Alexander at [24]. Suppose, for example, that counterfeit Rolex watches are sold, and at the point of sale the purchaser is notified that they are counterfeit. Even if it is permissible to take the notice into account as part of the context of use, a straightforward answer to this problem is that it does not avoid a finding of infringement, because the notice does not prevent post-sale confusion...

57. Furthermore, similar issues can arise even if the context is tightly defined. Suppose, for example, that counterfeit Rolex watches are marketed bearing the words FAKE ROLEX on the watch face where the word ROLEX normally appears. Even if the sign is taken to be ROLEX rather than FAKE ROLEX (which is itself dubious), it is difficult to say that the context of use does not include the word FAKE. Post-sale confusion may not be an answer to this problem if the word FAKE is as prominent as the word ROLEX. But this would not mean that the trade mark proprietor was left without a remedy, because it could still bring a claim under section 10(3) of the 1994 Act (extended protection) where the trade mark has a reputation.

58. Having cited *PlanetArt*, the judge said at [67] that “[t]here are sound policy reasons for not taking an over-expansive view of the context of the allegedly infringing use”. While I have some sympathy with that point of view, the issue of how far context extends is a difficult one for the reasons explained above. It follows that it is best decided in a case where it actually matters. It does not matter in this case, because the crowded market is relevant to the distinctive character of the Trade Marks regardless of how narrowly or broadly the context of the allegedly infringing use is drawn.”

189. It appears to me that Arnold LJ was expressly not approving (or disapproving) what Mr Alexander said in the passages from *PlanetArt* which he cited, and leaving open the question of the proper scope of “context”. I propose to proceed on the basis that the law permits, and indeed requires, the court to consider each use of the sign taking into account the context in which consumers will see the sign, but that the law does not permit the court to take into account matter which is not visible to the consumer when that use of the sign is being made. That is particularly the case where not all consumers will have been exposed to such matter.

The evidence about confusion

190. SIL relied on a number of instances of alleged confusion. An overarching point made by Google in relation to each of these instances was that the person alleged to have been confused was not called as a witness, or in most cases even identified by name (though in several cases it emerged that SIL could have named them). Further, in each case the instance relied on was an oral conversation of which there was no contemporaneous record. That means that it is necessary to try to form a view on whether the individuals were confused (and if so, why and about what) only on the basis of what SIL’s witnesses said they could recall about the relevant conversations. That is inherently less satisfactory than in a case in which

the people alleged to have been confused are called to give evidence, or even one in which there are transcripts of conversations or email exchanges.

191. Further, Google pointed out that many of the instances of alleged confusion involved non-UK residents. It said that the exposure of such people to SIL and its marks might not be representative of that of people in the UK, given different levels of use of SIL's Marks in (for example) India and the UK, and that the meaning(s) of the word "shorts" might differ between the UK and other countries, especially ones in which English was not the first language. Given these factors, Google said that it would be risky to embark on an attempt to use such instances of confusion when assessing the likelihood of confusion in the UK. I have taken note of these warnings, but believe it would be wrong to give no weight at all to such instances, as Google suggested I should, if otherwise they are relevant to the statutory question.

International Film Festivals in Goa

192. In his witness statement, Mr Pilcher said this:

"I have personally experienced confusion. At the International Film Festival of India in Goa in 2021, which I mentioned above, YouTube's branding was displayed alongside Shorts International's all around the festival. I include below photographs of billboards evidencing this:



People, including the YouTube influencers I mentioned above, kept introducing me as the CEO of YouTube Shorts – they never were clear that we are not part of YouTube."

193. In cross-examination Mr Pilcher said that the date of the incidents he was referring to was probably 2022 rather than 2021, as that was the year in which both SIL and YouTube were involved with organising a competition at the festival (in which SIL coached and mentored the teams of directors, writers etc.

and YouTube sponsored the competition and provided an influencer for each team).

194. Further, while Mr Pilcher said that while all four or five influencers “were confused the entire time”, it was one particular influencer who had interviewed him and introduced him as the CEO of YouTube Shorts. The influencers were not identified nor was their nationality clear.
195. In cross-examination Mr Pilcher attributed the confusion to the fact that the billboard had the YouTube and ShortsTV marks next to each other; he said it made it look like they were one brand.
196. In my judgment this incident does not shed light on whether the use of the relevant signs by Google in the UK in relation to the YouTube Shorts service gives rise to a likelihood of confusion. In my judgment the most likely explanation is that the influencers had thought there was a commercial relationship between YouTube and SIL because they were involved in a competition sponsored by YouTube and organised by SIL, and they had seen the billboards with the YouTube and ShortsTV logos next to each other.
197. In cross-examination Mr Pilcher also referred to other people being confused at the festivals in Goa. He mentioned a filmmaker friend of his, Signe Baumann (who he said had been confused at the 2023 festival) and staff members from the National Film and Development Corporation of India (he did not say which year that was). There was so little specificity about these incidents that I do not feel able to place any weight on them.
198. Mr Sawnhey said in his witness statement that in Goa in both 2022 and 2023:

“almost every other person we came across thought that we were related to YouTube Shorts. The sort of people we met there – lots of them were budding filmmakers – might either have overheard us talking about ShortsTV, or watched a presentation by Carter Pilcher or myself, and these sorts of people would come up to us afterwards and say something like “we didn’t know you also did short films – we thought you just did very short user-generated content type videos”.”
199. As can be seen, this evidence was rather vague, as to the number of people involved, who they were, what they said and what may have prompted them to say what they did. In cross-examination Mr Sawnhey said that “*there were 75 people who had signed up who were chosen to be a part of this film competition and everybody was confused and they were asking us questions about what – about the confusion between us being part of YouTube.*” He then explained that he and others from SIL were working with all the film competition participants from start to finish over 48 hours and so “*when I’m saying “everybody”, they are the 75 participants and the support staff which was there*” and that “*there were various instances of where people come and ask you a question, “Is YouTube and Shorts the same brand?”.*” As I understood it, he said that this happened in both 2022 and 2023, whereas the confusion amongst the influencers to which Mr Pilcher had referred was only in 2022.

200. I did not find this evidence satisfactory. There was no mention in Mr Sawnhey's witness statement of confusion amongst participants in the film competitions, let alone all of them. Instead in his statement he suggested that the confusion was amongst "*almost every other person we came across*" who he suggested may simply have "*overheard us talking about ShortsTV, or watched a presentation by Carter Pilcher or myself*". Further, the kind of comment he reported in his statement ("*we didn't know you also did short films – we thought you just did very short user-generated content type videos*") is very different from the question he said in cross-examination he was being asked ("*Is YouTube and Shorts the same brand?*") which, if correctly reported, does not necessarily show confusion between YouTube and SIL's brand). I have concluded that the vague and inconsistent nature of Mr Sawnhey's evidence on this topic means that I can place no reliance on these incidents.

Kingston International Film Festival

201. In her witness statement Ms Charmail said this:

“For example, at Kingston International Film Festival in London in 2022, I was talking to a member of the public after a screening and I said I work for ShortsTV – and he said “Oh is it the same as YouTube Shorts?””

202. In cross-examination Ms Charmail said that this incident had in fact taken place after a panel discussion about what was needed to regenerate the independent film industry, and that the individual had been waiting to speak to her after the panel finished. She accepted that she did not know what the person concerned was thinking, nor whether when he said “it” he meant the content rather than the company or brand. However, she pointed out that she had been speaking about short films in the panel discussion, which she suggested meant that he knew that the content she had been speaking about was different from that on YouTube Shorts.
203. Ms Charmail's evidence about this incident was clear, in material respects consistent (I do not regard the difference between it taking place after a screening or a panel discussion as material), and she showed no tendency to exaggerate it. While absence of evidence from the individual concerned makes it hard to assess his state of mind, in my judgment the conclusion to be drawn is that they wondered whether ShortsTV and YouTube Shorts were “the same”, but did not mistake one mark for the other nor actually form the belief that ShortsTV and YouTube Shorts were economically connected.

UnJadedJade

204. In his witness statement, Mr Sawnhey said this:

“I went to India at the end of February 2024, and on my way back from Delhi to London (via Doha) I started talking to the person in the seat next to me on the flight. She worked in entertainment, and was a vlogger, and YouTuber, with close to 1 million followers. The channel is called @UnJadedJade. She lives in the UK. It was a 9-hour flight, and we talked extensively. I told her all about what Shorts International does – I told her

we worked in short films, and had channels where we host short films and also offer video on demand. I also told her the name of our company (Shorts International) and about the brand (ShortsTV). Once we landed, and were waiting for our luggage, she said something like “you have told me about what you do, and short films and so on, but what you do on YouTube is even shorter – just 10 - 20 seconds or something - so how does that fit with your short film business? Do you use shortened versions of the short films on Shorts, or is that a completely separate thing?”. I then had to explain to her that we had nothing to do with YouTube Shorts.”

205. It was put to Mr Sawnhey that when UnJadedJade said what he reported her as saying, she could have been referring to the content that SIL posts on YouTube Shorts. He said that she was confused about the brands, and supported that by saying that, just before saying what he had reported in his statement, she had said “*I’ll find you when I’m at the YouTube office next time I’m around*”. Then, he said, she asked the questions he had reported in his statement, at which point he had clarified that he worked for Shorts International and not YouTube.
206. I did not find this evidence convincing. If UnJadedJade had said “*I’ll find you when I’m at the YouTube office next time I’m around*” I would have expected that to be in Mr Sawnhey’s statement. It is also surprising that, after a lengthy discussion on the flight (Mr Sawnhey said they spoke for over five hours) during which Mr Sawnhey told UnJadedJade all about what SIL did, its work in short films, the channels it operated and what its company name was, and (he added in cross-examination) they discussed “*various things pertaining to this vertical genre*”, UnJadedJade could have believed that SIL was part of YouTube. That is of course possible, but to be persuaded of that I would have wanted to hear from UnJadedJade herself. This is the one instance in which SIL has identified the person alleged to have been confused, but it did not offer any explanation of why no witness statement from her had been provided.

UK Asian Film Festival

207. Mr Sawnhey said in his witness statement that on 4 May 2024 he gave a talk on short films at the UK Asian Film Festival at the BFI. He continued:

“I started with an introduction about Shorts International (I would usually start by saying something like “I am from ShortsTV”, but cannot remember exactly what I said on this occasion – but I would always say I work for ShortsTV, not Shorts International – that’s just how I refer to the business). For the first 10 minutes or so I then focussed on the advantages to filmmakers of making short films. For the last 5 minutes I took questions. One of those questions was something like “how do you feel about creative jobs being taken over by AI?”. While I was answering, somebody else from the audience interrupted to say something like “don’t you think a company as big as yours has a particular responsibility to protect jobs from AI? You have to understand that Google is so big it has the power to make or break the creative industries.” I asked him to elaborate – I didn’t quite understand the direction of the question. He then said something like “Well, YouTube Shorts has lots of AI generated content”. I then had to clarify that I was

there representing Shorts International, and that ShortsTV has nothing to do with either Google or YouTube Shorts.”

208. Mr Sawnhey said that the man in question was “from the field of law” and that he would be able to identify him “with some digging”. I have not been persuaded by Mr Sawnhey’s evidence on other aspects, and I note that his suggestion that he would always say he worked for ShortsTV not Shorts International appears to be inconsistent with his evidence about his conversation with UnJadedJade, so I am not prepared to conclude that he did say he was from ShortsTV rather than Shorts International.
209. Nevertheless, in this instance I see no reason to doubt that the man in question said something along the lines of that reported by Mr Sawnhey. It strikes me as being quite a memorable question for someone in Mr Sawnhey’s position to be asked. It appears that the man in question had formed the view that Mr Sawnhey’s company was part of Google, and I can see no reason for him doing so other than that Mr Sawnhey had introduced himself as being from either ShortsTV or Shorts International.
210. However, whether the man in question was representative of the average consumer is another matter. There is no evidence as to whether he had encountered the YouTube Shorts service, other than to be aware of its existence. Further, he seems to have had a strong view about the responsibility of Google to protect creative industries from AI that he was eager to advance; that may have made him keen to make the assumption that Mr Sawnhey was from Google so that he could raise the point.

Cable companies in Mexico and Chile

211. Mr Pilcher said that following the launch of YouTube Shorts it has become harder for SIL to convince cable companies, especially in Latin America, to carry a short film channel, because they think SIL is selling user-generated content (UGC). He explained that in July 2022 SIL presented to a number of Mexican cable companies and at every pitch had to explain that it did not offer UGC. He said that the same occurred when presenting to cable companies in Chile in September 2023.
212. While Mr Pilcher identified the companies, he did not identify the individuals concerned. Nor did he explain what introduction the individuals concerned had had to SIL. In particular, he did not say whether they had been exposed to SIL’s Marks or had merely seen SIL’s company name.
213. I do not think this shows confusion of the type with which s.10(2) is concerned, even “wrong way round” confusion. It does not show any form of confusion as to trade origin. At its highest it shows that some people in the Mexican and Chilean cable industries think that SIL offers UGC, perhaps because of its company name and the use of “shorts” by YouTube to refer to UGC.

Content Americas

214. In his witness statement, Mr Carrasco-Szulc said this:

“Due to the existence of YouTube Shorts as a brand, I have recently found that I have to explain a bit more that this is not what Shorts International are doing as a business, and have to explain a bit more exactly what it is that we do.

I have experienced this at industry events, such as MIPCOM (an annual trade show for the TV industry that happens in Cannes, France) where I now have to explain more and be very specific about what we do. For example, in Miami in January 2023, at an industry event called Content Americas, I had a conversation with a content distributor who was offering a catalogue of content and there was some confusion for a while because she felt the need to explain to me that she did not distribute vertical content. I then had to explain and reassure her by saying that we don’t acquire vertical content.

There is no reason that this person would have felt the need to explain that they don’t offer vertical content if YouTube Shorts had not existed. I do not recall the exact conversation, but I think I told her that we are not YouTube Shorts, we are ShortsTV.”

215. Mr Carrasco-Szulc said he did not know the name of the woman he met in Miami, nor could he remember the name of her company, but he said she was Eastern European. He explained that they had been introduced at the event by the person who acts as SIL’s agent in Latin America and that they had sat down for a coffee and he had explained who he was. However, he did not say whether he had introduced himself as being from Shorts International or ShortsTV. He said that one of the first things the woman said was that her company did not distribute vertical content.
216. In my view this incident is to be regarded in a similar way to those involving the Mexican and Chilean cable companies. It does not show any confusion as to trade origin. At most it shows someone thinking that SIL may be interested in vertical content, perhaps because of its company name and the use of “shorts” by YouTube to refer to vertical content.

Evidence about lack of instances of confusion

217. Various of Google’s witnesses gave evidence that they were not aware of any instances of confusion and suggested that if there had been any significant consumer confusion they would know about it.
218. Ms Ali referred to a report summarising feedback from press, creators and users at about the time of the UK launch in June 2021. She said that there was no mention in the report of any confusion with SIL or ShortsTV and expected that would have been raised if there had been. She also said that more generally user feedback is monitored, summarised and reported to her but she had not seen any confusion with SIL or ShortsTV. So far as I am aware, she was not cross-examined about that evidence.
219. Ms Ropert said that she was not aware of any consumer confusion between YouTube Shorts and ShortsTV and that, if there had been, she believed she would

have heard about it. She said that if YouTube Shorts was creating consumer confusion Google might see it in consumer studies or in customer support or in the press or social media (which she said were monitored). She was not cross-examined on that evidence.

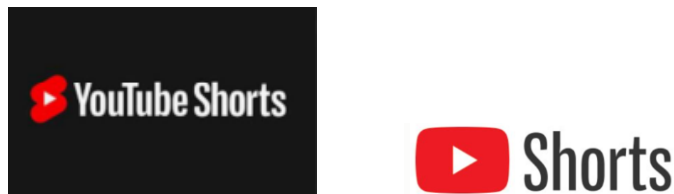
220. Ms Clapp said that there were teams within YouTube that monitor the press and social media and that Google also works with community management agencies to understand what the public are thinking about YouTube and its products. She said that if significant confusion around a branding issue had arisen, she would expect it to be reported, but she had not heard of any confusion between YouTube Shorts and ShortsTV. It was put to her that people who were confused might not say anything on social media, but she said that she had received reports on social media of confusion about other matters.
221. Ms Small explained in her statement that Google has messaging tools which are used to track external enquiries or complaints made by consumers. She said that she understood that these tools were searched using keywords including “ShortsTV” and “Shorts International” and that no records were marked as relevant as a result of those searches. In cross-examination she said that to the best of her knowledge the records that were marked as not relevant related to technical enquiries, and indeed Mr Scurfield’s evidence was that SIL had made enquiries about various incidents related to SIL’s YouTube channel.
222. In addition, Ms Tan said that she had been monitoring SIL’s social media accounts since April 2024 and had not come across any comments indicating confusion.

S.10(2) – assessment

Identification of the signs and the context

223. Google’s position was that (save in the case of “Shorts” in the menus on the creator pages, as in the instance shown in paragraph 12 above, and “Short” on the creation tools page on the mobile app) the signs it was using were composite signs, namely “YouTube Shorts” and the various combinations of “Shorts” and logos shown in paragraphs 23-24 above. SIL’s position was that in each of those cases Google was using the sign “Shorts” alongside other signs. I need to consider matters from the perspective of the average consumer.
224. I shall start with the use of “Shorts” in the menus on the creator pages. Here there was no dispute about the sign being used; the dispute was whether it was being used in relation to goods or services. I agree with Google’s submission that the average consumer would understand “Shorts” in that context to be being used purely descriptively to refer to the type of material rather than as a trade mark and so not “in relation to goods or services”. The same applies to the use of “Short” on the creation tools page on the mobile app.
225. By contrast, in my judgment when the average consumer sees “YouTube Shorts”, as a word mark or in a format such as that on the left below, they would understand that “Shorts” is being used both descriptively to refer to the type of material (and in that respect not “in relation to goods or services”) and as part of

a composite sign which indicates the origin of the goods or services. That also applies to the use of “Shorts” in combination with the YouTube logo, as shown on the right below.

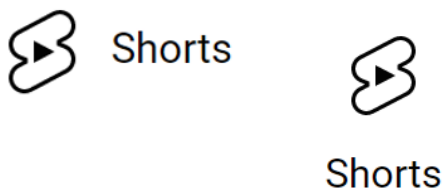


226. I now turn to consider the combinations of “Shorts” and accompanying logos shown in paragraph 23 above, as they appear on the YouTube website and apps. The combination shown on the left below appears above the “Shorts” shelves on the website and the mobile app. Again in my judgment the average consumer would understand that the word “Shorts” is being used descriptively but also as a part of a composite sign which includes the logo and which operates as a trade mark. In the website, but not in the mobile app, when this combination appears the YouTube name and logo is always present on the screen, as part of the context of the use. Further, in my judgment the average consumer will notice the resemblance between the logo and the YouTube logo. The same would apply if the text were white on black, as in the centre in paragraph 24 above.



227. The combination shown on the right above appears only on the website, in the results from use of the search function, and it does so in black and white. Again in my judgment the average consumer would understand that the word “Shorts” is being used descriptively but also as part of a composite sign which includes the logo and which operates as a trade mark. I do not think that the average consumer would detect any resemblance between the logo and the YouTube logo, but the YouTube name and logo is always present on the screen when this combination appears, as part of the context of the use.

228. Finally, there are the combinations shown below:



229. Again in my judgment the average consumer would understand that the word “Shorts” is being used descriptively but also as part of a composite sign which includes the logo and which operates as a trade mark. The one on the left appears in the sidebar on the website and above the “Shorts” shelf on the TV app. In each case the YouTube name and logo are always present on the screen at the same time. The one on the right appears at the foot of the screen in the mobile app. On some occasions the screen also contains the YouTube name and logo at the same

time. On other occasions the screen also contains, at the same time, the combination shown on the left in paragraph 226 above. But on other occasions the screen does not contain any either of those, most notably when the user is scrolling through the Shorts feed (see the illustration on the left in paragraph 15 above). For the reasons I have explained above, I do not think it is right to take into account, as part of the context of that use, the fact that the user accessed the Shorts feed through the YouTube app and via the home page of the app. In any event, I agree with SIL that it is entirely realistic that some consumers will be shown another's screen with the Shorts feed already open; such consumers will not have seen the YouTube name or logo.

The distinctive character of SIL's Marks

230. For the reasons I have explained above, in my judgment the 615/649 Marks have a distinctive character for the goods and services in respect of which they are registered. However, their inherent distinctive character is low, and it comes solely from the particular combination of the word "shorts" and the play symbol rendered in red in the "O". The same applies to the 656/664 Marks. The 383 Mark also has low inherent distinctive character (and, on my findings, only for some of the goods and services for which it is registered).
231. I need to consider whether any of SIL's Marks have an enhanced distinctive character as a result of the use that was made of them before Google's use commenced (i.e. June 2021). I have summarised the use made of SIL's Marks before 8 February 2022 in paragraph 128 above. By June 2021 the Amazon Prime channels had been running for only about six months, the FAST channels had not started operation and the app had not been launched. In my judgment by June 2021 the use that had been made of SIL's Marks was not sufficient to give them enhanced distinctive character.

Comparison of the marks and the signs

232. I shall start with the 615/649 Marks. There is visual similarity between those marks and each of the composite signs used by Google, in that both contain the word "shorts" and (save in the case of "YouTube Shorts" and the combination on the right in paragraph 226 above) a play symbol. However, there are also visual differences, most notably that the play symbol is contained in a separate logo rather than in the "O" of the word "Shorts" itself and/or that the word "Shorts" is accompanied by "YouTube", both of which make a difference to the overall impression. The aural similarities between the 615/649 Marks and the composite signs used by Google are obvious, though the similarity is reduced in the case of the combinations which include "YouTube". The conceptual similarities are also obvious, given that each contains the word "shorts" and a play symbol. However, for the reasons I have explained, the word "shorts" is descriptive of the type of material and the play symbol is an indication that the material can be played. So the similarities are at a level which differs from that which has given the 615/649 Marks their distinctive character.
233. Next I shall consider the 383 Mark. Here there is a degree of visual, aural and conceptual similarity, in that each includes the word "shorts", but the absence of "TV" from Google's combinations is a visual, aural and conceptual difference. I

have held that the 383 Mark is invalid for most of the goods and services for which it is registered, but even if it was valid, its distinctive character would arise from the combination of “Shorts” and “TV”, which is absent from all of Google’s signs.

234. The points of visual, aural and conceptual similarity between the 656/664 Marks and Google’s composite signs are the same as for the 615/649 Marks, but they have the additional visual, aural and conceptual difference arising from the absence of “TV”.

Comparison of the goods and services

235. I shall start by considering the goods and services for which the 2018 Marks are registered and on which SIL relies for the purpose of its infringement case. Google accepted that it has used its composite signs in relation to goods that are identical to “sound, video and data recordings”, “electronic media” and “digital media” and in relation to services that are identical to “entertainment services” and “production, presentation and distribution of films, videos and television programmes” (in so far as that covers presentation of videos) and that it has used its composite signs in relation to such goods and services provided by telecommunications networks, mobile phones, mobile media devices and online from the internet.
236. Google also accepted that it had used its composite signs in relation to goods and services that were similar to “cinematographic films”, “films for television”, “recorded television programmes” and “broadcasting and transmission of television programmes” and in relation to goods and services that had a low level of similarity to “computer software” and “electronic entertainment software”. I did not understand SIL to take issue with any of this, so I shall proceed on that basis.
237. The parties did not expressly address the question of the extent to which Google had used its composite signs in relation to goods and services which are identical or similar to those for which the 383 Marks is registered. However, bearing in mind the common ground regarding the 2018 Marks set out above, it follows that the goods and services in relation to which Google has used its composite signs includes ones that are identical to, and ones that are similar to, ones for which the 383 Mark is registered.

Overall assessment of likelihood of confusion

238. I have to make a global assessment of the likelihood of confusion, bearing in mind the guidance which I have set out in the section on the law relating to s.10(2) above.
239. It seems to me that SIL’s best case is based on the 615/649 Marks (which do not include “TV”) as registered for goods and services identical to those for which Google has used its composite signs (such as “video recordings” and “presentation of videos”) and on Google’s use of the composite sign shown below. That sign does not include the word “YouTube” or the YouTube logo

itself, and in some instances appears on the screen of the mobile app without the YouTube name or logo.



Shorts

240. In my judgment the use of this sign does not give rise to a likelihood of confusion with the 615/649 Marks. I bear in mind that both contain the word “shorts”, which gives rise to visual, aural and conceptual similarities, and that the sign is used in relation to identical goods and services to those for which the marks are registered. I also bear in mind that the average consumer will have a relatively low level of attention and also has imperfect recollection of the marks even though they are familiar with them. However, the word “shorts” is descriptive of the material in question, and the play symbol indicates that the material can be played. The distinctive character of the 615/649 Marks (which is low) arises from the particular combination of the word “shorts” and the play symbol (rendered in red in the “O”), which is absent from this composite sign. In this sign there is a separate logo which contains the play symbol. In my judgment the average consumer would appreciate that the similarity between the 615/649 Marks and this composite sign arose from the fact that the marks are registered for, and the sign is being used in relation to, goods and services for which the word “shorts” and the play symbol indicate characteristics. Therefore, in my judgment the average consumer would not mistake the sign for the mark, nor would they believe that the goods and services denoted by the sign come from the same undertaking, or an economically linked undertaking, as that responsible for the goods and services denoted by the mark.
241. In the case of any other comparison between SIL’s Marks and Google’s combination signs, there are additional factors which point against a likelihood of confusion. Google’s other composite signs are either essentially the same as the one I have just considered but with the logo in red and white (so the consumer will be more likely to notice the resemblance with the YouTube logo), or contain the YouTube name and/or logo, and/or appear on screen together with the YouTube name and logo. The 656/664 Marks and the 383 Mark each contain “TV” which is absent from Google’s composite signs and so there are reduced visual, aural and conceptual similarities.
242. In making my overall assessment, I have taken into account the evidence as to actual confusion. For the reasons I have explained above, the only incident which in my judgment appears to show a member of the public being confused as to the economic links between SIL and Google was that which took place at the UK Asian Film Festival. But, for the reasons I explained above, it is not clear that that person is representative of an average consumer who is familiar with one or more of SIL’s Marks and sees one of Google’s composite signs. I also bear in mind the evidence given as to the absence of confusion, while also bearing in mind that

there may be instances of confusion that would not come to light as a result of the monitoring that has been conducted.

243. For these reasons, in my judgment the case of infringement under s.10(2) fails.

S.10(3)

244. S.10(3) TMA provides:

“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.”

245. There are nine conditions that a claimant must satisfy in order to establish infringement under s.10(3): (i) the trade mark must have a reputation in the UK; (ii) there must be use of a sign by a third party within the UK; (iii) the use must be in the course of trade; (iv) it must be without the consent of the proprietor of the trade mark; (iv) it must be of a sign which is at least similar to the trade mark; (vi) it must be in relation to goods or services; (vii) it must give rise to a “link” between the sign and the trade mark in the mind of the average consumer; (viii) it must give rise to one of three types of injury, that is to say, (a) detriment to the distinctive character of the trade mark, (b) detriment to the repute of the trade mark or (c) unfair advantage being taken of the distinctive character or repute of the trade mark; and (ix) it must be without due cause: see e.g. *Match Group* at [55].

246. As to the requirement for the trade mark to have a reputation in the UK, SIL referred me to what Arnold J said in *SkyKick* at [307]:

“This is not a particularly onerous requirement. As the Court of Justice explained in Case C-375/97 *General Motors Corp v Yplon SA*, EU:C:1999:408, [1999] E.C.R. I-5421, [2000] R.P.C. 572:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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.””

247. Google raised the question of what was meant by a “significant part of the public concerned by the products or services covered by that trade mark.” It submitted that the relevant public was that concerned with the goods and services “across the breadth of the specification” and that it was necessary to show a reputation amongst a significant part of that public.
248. In support of that submission it cited the judgment of Fancourt J at first instance in *Sazerac Brands LLC v Liverpool Gin Distillery Ltd* [2020] EWHC 2424 (Ch) on a point which was not considered by the Court of Appeal. In that case the mark was registered for “whisky” but the claimants had only used it for bourbon, which was what the defendants were also selling. The defendants argued that in order to invoke s.10(3) the claimants needed to show a reputation across the whisky market. Fancourt said this at [36]:

“In my judgment the claimants are right on this issue, both in principle – where the alleged infringing use is in the narrower class of goods – and as a matter of interpretation of the ruling of the CJEU. Paragraph 24 of the judgment in *General Motors v Yplon* makes it clear that the extent of the reputation that needs to be established depends on the use of the trade mark on products or services actually marketed, and that it is only the part of the public concerned by the actual use of the mark that must have the relevant knowledge of it. The words of [26] (“the products or services covered by that trade mark”), though capable of being read as a reference to the specification of the trade mark, are not in context making that reference: [26] explains that only a significant part of the public concerned, as identified in [24], and not the whole of it, needs to have knowledge of the trade mark. It would be illogical for the owner of the mark to have to prove a reputation in a field in which the mark has not yet been fully deployed, or deployed at all, if all that they were seeking to do was restrain infringement in a narrower field in which the mark had been used. Were the owner of a mark seeking to restrain infringement under [s.10(3)] that went beyond the scope of the use of the mark then a different conclusion might well be reached, on the basis that reputation on a wider basis needed to be proved to restrain a wider infringement.”

249. Google also relied on the judgment of HHJ Hacon in *Gnat & Co Ltd v West Lake East Ltd* [2022] EWHC 319 (IPEC). There the relevant part of the registration was for restaurant services and the claimant had only made limited use of the mark, operating out of a single (albeit award-winning) restaurant for four years. The judge held that the mark was not known by a significant part of the UK public concerned with restaurant services. There does not appear to have been any discussion of whether it might be possible to consider a sub-set of restaurant services for the purpose of establishing a reputation.
250. The first point to make is that these cases provide no basis for a suggestion that for a trade mark to have a reputation for the purposes of s.10(3) it needs to extend “across the breadth of the specification”. In *Sazerac* one of the marks was

registered for beer as well as whisky and in *Gnat* the mark was also registered for self-service restaurants. If the mark has a reputation for one of the categories of goods or services for which it is registered I cannot see why it matters, for the purpose of being able to invoke s.10(3) at all, whether it also has a reputation for all the others (though of course the scope of the protection afforded by s.10(3) will be affected by the scope of the reputation). The decision of Fancourt J shows that in some cases it may be possible to invoke s.10(3) based on a reputation for a narrower category of goods than one mentioned in the specification. In my judgment whether that is possible will depend, *inter alia*, on whether there is an identifiable sub-category of goods and the relative size of that sub-category compared to the category for which the mark is registered. In any event the size and scope of the mark's reputation is relevant to the question of whether a link will be made in the mind of the average consumer giving rise to one of the three types of injury.

251. As to the requirement for a link, both parties referred me to Case C-252/07 *Intel Corp Inc v CPM UK Ltd*. That establishes that there is a link when, on seeing the sign, the average consumer calls the mark to mind (see [63]). The existence of a link must be assessed globally, taking into account all factors relevant to the circumstances of the case, which include (i) the degree of similarity between the conflicting marks; (ii) the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; (iii) the strength of the earlier mark's reputation; (iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and (v) the existence of the likelihood of confusion on the part of the public (see [41]-[42]).
252. SIL relies on two of the three forms of injury: detriment to distinctive character (dilution) and detriment to repute (tarnishing).
253. On dilution, Google referred me to the summary of principles from *Intel* set out by Arnold J in *W3* at [295] and to what Mr Alexander said in *PlanetArt* at [33]-[34], while SIL referred me to the summary by Joanna Smith J in *Lidl* at [75], points (15)-(19), drawing on *PlanetArt* at [31]-[34]. I have had all of that in mind, but believe it is sufficient to cite the principles set out in *W3* at [295]:

“i) The more immediately and strongly the trade mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is detrimental to the distinctive character of the mark.

ii) The stronger the earlier mark's distinctive character and reputation, the easier it will be to accept that detriment has been caused to it.

iii) The existence of a link between the sign and the mark does not dispense the trade mark proprietor from having to prove actual and present injury to its mark, or a serious likelihood that such an injury will occur in the future.

iv) The more “unique” the trade mark, the greater the likelihood that use of a later identical or similar mark will be detrimental to its distinctive character.

v) Detriment to the distinctive character of the trade mark is caused when the mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor is weakened. It follows that proof that the use of the sign is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the mark is registered consequent on the use of the sign, or a serious likelihood that such a change will occur in the future."

To which I would add *PlanetArt* at [32] (following citation of *Comic Enterprises* at [113]-[118]):

"...Actual evidence of a change in the economic behaviour of consumers is often difficult to obtain. Moreover, where the distinctiveness of a mark is whittled away, the detrimental impact can, in some circumstances, be reflected just as much in the evasive action that a proprietor needs to take to re-establish distinctiveness. Where a rival creeps up on a brand, a proprietor is sometimes forced to edge away from the newcomer at some cost or devote resources to amplifying its brand message to avoid its original distinctiveness being drowned out by the alleged infringer. In my judgment where the evidence, taken as a whole, shows that damage of that kind is sufficiently likely, it is a corollary of the statement of principle of the Court of Appeal that it is not invariably necessary for there to be actual evidence that consumers have changed their behaviour as a result of the adoption of the rival mark."

And at [34]:

"Just as in a case of infringement under section 10(2), so under section 10(3), descriptiveness of the respective marks is a key element. A trader has less right to complain that its brand is being diluted if it has chosen a mark which is of limited distinctiveness in the first place. Nor can a trader complain that precisely because its brand is so vulnerable to loss of distinctiveness and swamping by a newcomer using it descriptively that this gives rise to a claim for dilution. Nonetheless, these propositions must have regard to the precise marks in issue and the extent to which they only consist of descriptive terms."

254. On tarnishing, SIL referred me to Case C-487/07 *L'Oreal SA v Bellure NV* at [40]:

"As regards detriment to the reputation of the mark, also referred to as 'tarnishment' or 'degradation', such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark."

Assessment

255. I first need to consider whether SIL's Marks had a reputation in the UK at the time Google commenced the acts complained of, i.e. June 2021. I have addressed SIL's use of its marks by that date above. In my judgment, if the question is whether SIL's Marks were known by a significant part of the public concerned by any of the categories of goods or services for which the marks are registered then the answer is no. Even if one were to consider "cinematograph films", in my judgment only a very small part of the UK public concerned with such goods knew of any of SIL's Marks. As explained above, the *Sazerac* case suggests that it may be possible to overcome the threshold issue of reputation by showing a reputation amongst a significant part of the public concerned with a sub-category of goods or services. However, for the reasons I have explained above, I do not regard "short films" as a proper sub-category of goods. Therefore I do not regard SIL's Marks as having a reputation in the UK for the purpose of s.10(3). However, if they do, it is amongst consumers of "short films" and I shall consider matters on that basis.
256. I shall now consider whether Google's uses of its composite signs (being those used in relation to goods and services) give rise to a "link" between the sign and any of SIL's Marks in the mind of the average consumer. In my judgment for consumers amongst whom SIL's Marks have a reputation (i.e. consumers of "short films"), Google's composite signs would principally bring to mind "short films" and, where the signs include the YouTube name or logo, YouTube. However, because of those consumers' familiarity with SIL's Marks, on balance I think it likely that they would also bring to mind SIL's Marks, though in a less strong and immediate fashion.
257. SIL contended that Google's use of its signs would dilute the distinctive character of SIL's Marks in two ways. First, it said that it would reduce their capacity to act as a badge of origin for SIL. Secondly, it said that it would alter the meaning of the word "shorts" so that it came to mean UGC, which would make it harder to "locate" SIL commercially. In that regard it relied on the incidents with the cable companies in Mexico and Chile and that at Content Americas.
258. In my judgment the distinctive character of SIL's marks has not been diluted by Google's activities. The distinctive character, such as it is, arises from the particular combination of the word "shorts" and the play symbol that I have referred to above, and that has not been affected. I accept that Google's activities have had the effect of increasing the use of the word "shorts" for one type of short-form audiovisual content (vertical format, less than 60 seconds, generally user-generated), and so moving the centre of gravity of the use of the word "shorts" away from "short films". That change in the weight of usage of the word may mean that SIL now has to explain its business more than it had to previously, but it does not mean that there has been an effect on the distinctive character of SIL's Marks.
259. SIL's case of tarnishing was that a significant proportion of its consumers are likely to consider the image of SIL's services and marks to have been cheapened by an association with the low production qualities of the material available on YouTube Shorts. Mr Pilcher said that YouTube Shorts "*diminishes short films as*

an art form” and so damaged the reputation of SIL’s catalogue, while Ms Charmail said that it “*demeans short films*” and so was damaging to filmmakers and the short film industry.

260. The question is whether Google’s use of its signs causes detriment to the repute of SIL’s Marks, rather than whether it has diminished “short films” as an art form. Further, the premise of the argument is that “shorts” previously exclusively meant “short films”, which I have held not to be correct. The fact that the centre of gravity of the use of the word “shorts” has moved away from “short films” does not mean that the repute of SIL’s Marks has suffered. Further, as Google pointed out, SIL itself posts material on YouTube Shorts. A number of SIL’s witnesses accepted that YouTube Shorts was an excellent marketing tool for SIL’s services and that it was not demeaning for SIL to be associated with YouTube Shorts.

261. For these reasons, in my judgment the case of infringement under s.10(3) fails.

The s.11(2)(b) defence

262. As the claim of infringement of SIL’s Marks has failed, it is not strictly necessary to consider the defence under s.11(2)(b). However, in case this case goes further, I will address it briefly and make some findings of fact relevant to the application of the defence.

The law

263. S.11(2)(b) TMA provides that a registered trade mark is not infringed by “the use of signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services...provided the use is in accordance with honest practices in industrial or commercial matters.”

264. It was common ground that this provision can apply even where the defendant uses the sign as a trade mark as well as an indication of the characteristics of goods or services: Case C-100/02 *Gerolsteiner Brunnen GmbH & Co v Putsch GmbH*.

265. On what amounts to “honest practices”, SIL referred me to the judgments of Arnold J in *Hotel Cipriani srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch) and *Samuel Smith* at [118], while Google referred me to the judgment of the Court of Appeal in *Maier v Asos plc* [2015] EWCA Civ 220 at [147]-[149].

266. In *Samuel Smith* at [114]-[117] Arnold J summarised the principles as follows (citations omitted):

“114. First, the requirement to act in accordance with honest practices in industrial or commercial matters “constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark proprietor”.

115. Secondly, the court should “carry out an overall assessment of all the relevant circumstances”, and in particular should assess whether the defendant “can be regarded as unfairly competing with the proprietor of the trade mark”.

116. Thirdly, an important factor is whether the use of the sign complained of either gives rise to consumer deception or takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark. If it does, it is unlikely to qualify as being in accordance with honest practices.

117. Fourthly, a mere likelihood of confusion will not disqualify the use from being in accordance with honest practices if there is a good reason why such a likelihood of confusion should be tolerated.”

267. Arnold J then went on at [118] to provide a list of material factors in the application of these principles:

“i) whether the defendant knew of the existence of the trade mark, and if not whether it would have been reasonable for it to conduct a search;

ii) whether the defendant used the sign complained of in reliance on competent legal advice based on proper instructions;

iii) the nature of the use complained of, and in particular the extent to which it is used as a trade mark for the defendant's goods or services;

iv) whether the defendant knew that the trade mark owner objected to the use of the sign complained of, or at least should have appreciated that there was a likelihood that the owner would object;

v) whether the defendant knew, or should have appreciated, that there was a likelihood of confusion;

vi) whether there has been actual confusion, and if so whether the defendant knew this;

vii) whether the trade mark has a reputation, and if so whether the defendant knew this and whether the defendant knew, or at least should have appreciated, that the reputation of the trade mark would be adversely affected;

viii) whether the defendant's use of the sign complained of interferes with the owner's ability to exploit the trade mark;

ix) whether the defendant has a sufficient justification for using the sign complained of; and

x) the timing of the complaint from the trade mark owner.”

268. Google did not suggest that there was anything in the judgment of the Court of Appeal in *Maier* that was inconsistent with Arnold J's summary of the principles or his list of material factors. Its point was that the ten factors identified by Arnold

J were not a checklist, and that it was not necessary for a defendant to succeed on each, or even most, of the factors in order to establish the defence. I do not think that SIL submitted that it was – it accepted that the court had to carry out an overall assessment to decide whether a defendant was acting fairly with regard to the legitimate interests of the trade mark owner.

Assessment

269. For the reasons I have explained earlier, in my judgment Google's use of the word "Shorts" alone (in the menus on creators' pages) is the use of a sign concerning the kind (or other characteristics) of goods or services. It is also the use of a sign which, in itself, is not distinctive. The same applies to the use of "Short" on the creation tools page on the mobile app. As I have explained above, the average consumer would also regard the word "shorts" in Google's composite signs as functioning both as a non-distinctive sign concerning the kind (or other characteristics) of the goods and services and as a trade mark in combination with the other aspects of the composite signs.
270. That also deals with point (iii) in the *Samuel Smith* list of factors relevant to honest practices. I shall now address the facts relevant to points (i), (ii), (iv) and (x) in that list.
271. The process by which Google arrived at the name "Shorts" was addressed by Ms Ali and Ms Su in their evidence. YouTube had a feature called YouTube Stories (eventually phased out in 2023) which allowed creators to post short videos in vertical format which disappeared seven days after being posted. In early 2019 the YouTube Product Team decided that they wanted a different product in which the content would not disappear. The term "shorts" was adopted as the code name for that product. In about July 2020 it was decided to accelerate the product; it appears that the decision to accelerate was linked to a perceived opportunity to enter the Indian market following a ban on TikTok there. The acceleration project was code-named Project Fireworks.
272. The naming process for the product began in July 2020. There was a brainstorming meeting in mid July at which various possible names were suggested, including "Shorts". Those names were then narrowed into a shortlist and some of the shortlisted names were then subjected to testing with panels of creators. In August 2020 there was an executive meeting (which Ms Ali attended) at which the name "Shorts" was approved. Following the naming decision, the accompanying icon was designed and approved.
273. YouTube Shorts was launched in India in September 2020, initially in "beta" form (i.e. an early release, with some features remaining to be developed). That led to a letter to Google dated 23 September 2020 from SIL's Indian lawyers, putting Google on notice of SIL's business activities and registered trade marks, and complaining about the launch of YouTube Shorts, saying that Google's use of "Shorts" was deceptive and confusing and would lead to detriment to the distinctive character of SIL's trade marks.
274. It might be thought that, given that Google was on notice of SIL's business activities and marks nine months before YouTube Shorts was launched in the UK,

it did not matter whether it was also aware of SIL and its marks at the time of adopting the “Shorts” name. However, Mr Malynicz maintained that this was significant and so I shall address the question.

275. Ms Su explained that YouTube’s normal naming process involved assessment by the trade marks team for trade mark risk after the initial shortlisting process but before the stage of executive approval, though she was not involved in the trade marks step in this particular case. The timeline of the “Shorts” naming process shows that, just before the executive meeting, material has been redacted for reasons of privilege. In my judgment, having regard to Ms Su’s evidence, the likelihood is that a trade mark search was conducted on “Shorts”. I can see no reason to think that, if such a search had been done, it would not have revealed SIL’s Marks. Therefore I conclude that, prior to the executive meeting in August 2020, Google had conducted a trade mark search which revealed SIL’s Marks. Ms Ali said that she had not heard of SIL or ShortsTV at the time of the naming decision in August 2020, but it may be that, for whatever reason, the results of the trade mark search were not presented at the executive meeting.
276. Google said that I was not entitled to draw any adverse inference from the fact that it had not waived privilege in relation to whether trade mark searches were carried out. I am not drawing any inferences from Google’s decision not to waive privilege. I am drawing an inference from the evidence of Google’s witness as to the normal practice.
277. It is less clear whether Google took legal advice about the name and if so when. Ms Ali said that she would take legal advice if an issue was raised about the name, but also that nothing was flagged to her about names at the time of naming; she could not remember when she first became aware of the issue about the name. However, Google’s decision not to waive privilege in any legal advice it received means that there is no basis for a conclusion that it used “Shorts” in reliance on competent legal advice based on proper instructions.
278. Therefore, my conclusions in relation to points (i), (ii), (iv) and (x) in the *Samuel Smith* list are:
 - Google knew of the existence of SIL’s Marks from August 2020;
 - There is no evidence that Google used “Shorts” in reliance on competent legal advice based on proper instructions;
 - Google knew that SIL complained about its use of “Shorts” from September 2020;
 - SIL’s complaint was made nine months prior to the launch of YouTube Shorts in the UK.
279. I now turn to consider the remaining factors in the *Samuel Smith* list. Google’s justification for using “shorts” was that it described the type of material in the service, but in my judgment that would not be sufficient justification if there was a likelihood of confusion, or significant detriment to the distinctive character or repute of SIL’s Marks. While I have held that there is no likelihood of confusion

nor any detriment to the distinctive character or repute of SIL's Marks, I have to approach this defence on the basis that there is. However, it was not put to Google's witnesses that they knew, or even that they should have appreciated, that there would be a likelihood of confusion or any detriment to the distinctive character or repute of SIL's Marks, or that they were aware of any instances of actual confusion.

280. Looking at everything in the round, in my judgment if there had been a likelihood of confusion, or significant detriment to the distinctive character of SIL's Marks, I would have held that the s.11(2)(b) defence failed. In proceeding with its launch of YouTube Shorts in the UK in the face of knowledge of SIL's Marks and of its business and of its allegations that there would be infringement of its rights, Google took the risk that SIL's allegations would prove to be correct. If they had, then in my judgment Google would properly be regarded as not acting fairly with regard to SIL's legitimate interests.

PASSING OFF

The law

281. The parties cited a number of cases on the law of passing off, and there was no discernible dispute as to the law.
282. To succeed in a claim for passing off a claimant must establish three elements: goodwill, misrepresentation and damage: see *Reckitt & Colman Products Inc v Borden Inc* [1990] 1 WLR 491 at 499. The question of whether there has been passing off falls to be determined at the date on which the defendant commenced the acts complained of (here, June 2021).
283. I believe it is sufficient to set out the following principles, based on the summary by Joanna Smith J in *Lidl* at [263] of those set out by Arnold J in *Glaxo Wellcome UK Ltd v Sandoz Ltd* [2019] EWHC 2545 (Ch) at [156]-[189], and adding a point made by Jacob LJ in *Phones 4u Ltd v Phone4U.co.uk Internet Ltd* [2006] EWCA Civ 244 at [23], one arising from *Reddaway v Banham* [1896] AC 199, and one made by Mr Alexander in *PlanetArt* at [69]:
- i) Passing off requires deception – it is not enough if members of the public are merely caused to wonder if there is a connection.
 - ii) For there to be passing off, a substantial number of members of the public must be misled. It is insufficient that careless or indifferent people may be led into error.
 - iii) The judge must consider the evidence adduced and use his own common sense and his own opinion as to the likelihood of deception.
 - iv) It is not enough for a claimant to prove that the public recognises a particular attribute and associates it with the claimant – mere recognition is not enough, the relevant public needs to perceive the attribute as a badge of origin.

- v) It is not a necessary ingredient of passing off that the misrepresentation was deliberate.
- vi) Where the claimant's mark is descriptive, cases of "mere confusion" caused by the use of a very similar description will not count.
- vii) It is possible for a descriptive term to acquire a secondary meaning, distinctive of the claimant, through use.
- viii) Where a defendant uses its own brand alongside the sign complained of, that can signal to the consumer that the defendant is the origin of the goods. It can also "unbrand" a sign which has acquired a secondary meaning distinctive of the claimant as well as a descriptive meaning.

Assessment

284. During his opening, I asked Mr Malynicz in what circumstances SIL's claim of passing off could succeed if its claim of trade mark infringement failed. In SIL's closing submissions it identified two sets of circumstances in which it said that could be the case. First, it said that if the trade marks were held invalid for descriptiveness or lack of distinctiveness, SIL could nevertheless succeed on the basis that even purely descriptive terms can acquire a secondary meaning. Secondly, it said that if there was a likelihood of confusion but the s.11(2)(b) defence succeeded, it could still succeed in passing off. The second scenario has not come to pass, while the first has come to pass only in respect of the 383 Mark. However, because SIL did not accept that it could not succeed in passing off if it failed on trade mark infringement, I need to address the passing off case.
285. I should add that, in its closing submissions, SIL sought to advance a case of passing off on the basis of a misrepresentation as to equivalence of the type considered in *Glaxo Wellcome* at [174]-[181]. However, such a case was not pleaded by SIL (the pleading was that Google had passed off its services as those of SIL or authorised, licensed or approved of by SIL), and in my judgment it is not open to SIL to advance that case.
286. I am prepared to accept that in June 2021 SIL had protectable goodwill in the UK associated with SIL's Marks (but not the word "SHORTS" alone). That goodwill was principally amongst filmmakers, some others in the film industry and film buffs.
287. However, in my judgment it is clear that Google's use of "shorts", in the various manners set out above, does not amount to a misrepresentation or thereby cause damage to SIL's goodwill.
288. I do not accept that a substantial number of members of the public will be misled into believing that YouTube Shorts comes from the same trade origin as (or has been in some way authorised by) that represented by SIL's Marks, essentially for the same reasons that led me to conclude that there is no likelihood of confusion for the purposes of s.10(2).

289. At least in the vast majority of cases a viewer of YouTube Shorts will be aware that it is a YouTube service (the exception being the viewer of a video on someone else's phone, but then for there to be an operative misrepresentation the viewer would have to notice the "Shorts" at the foot of the screen and rely on that as an indication of trade origin). YouTube is a very well known and long established brand. In my view there is no possibility of substantial numbers of members of the public being misled into believing that YouTube Shorts is a service of SIL.
290. Further, in my judgment users of the YouTube Shorts service will understand that the word "Shorts" is being used to describe the nature of the videos forming part of that service. That applies even amongst the group of consumers amongst whom SIL has goodwill. SIL's reputation is, as Mr Thompson said, for curating "*high quality short films (i.e. films with good look, design, acting or storytelling)*". Mr Pilcher was keen to point out that the content on YouTube Shorts is totally different from that disseminated by SIL, in terms of length, format, quality and content and curation process. I find it hard to imagine that any significant number of people amongst whom SIL has goodwill will believe that it has authorised, licensed or approved of YouTube Shorts.
291. I am reinforced in my view by the fact that there is no evidence that anyone has been deceived. None of the incidents which featured in the evidence involved people within SIL's goodwill believing that YouTube Shorts was a service of SIL or authorised, licensed or approved by it.
292. For these reasons, the claim in passing off fails.

CONCLUSION

293. For the reasons explained above, my conclusions are as follows:
- i) The 2018 Marks are not invalid under s.3(1)(b), (c) or (d) but the 383 Mark is invalid in so far as it is registered in respect of the goods and services indicated in Annex 3. SIL's proposed amendments do not cure that invalidity.
 - ii) The 2018 Marks should be revoked as of 5 October 2023 in so far as they are registered for "computer software" and "electronic entertainment software" extending beyond "software for accessing audiovisual entertainment" and in so far as they are registered for "entertainment services" extending beyond the remainder of the class 41 registration.
 - iii) The claim under s.10(2) fails.
 - iv) The claim under s.10(3) fails.
 - v) Had there been a likelihood of confusion or significant detriment to the distinctive character or repute of SIL's Marks, the defence under s.11(2)(b) would have failed.
 - vi) The claim in passing off fails.

Annex 1 – the specification of the 383 Mark

Class 9 - Sound, video and data recordings ~~save for short films~~; cinematographic films; films for television ~~save for short films~~; video and audio tapes, cassettes, discs; computer software; television programmes recorded on magnetic, optical and electronic media ~~save for short films~~; CDs, DVDs; electronic data media ~~save for short films~~; digital recording media; computer programmes for interactive television and for interactive games and/or quizzes; computer games; virtual reality hardware and software content and games; electronic entertainment software; interactive video content and game programs; all the aforesaid also supplied to or provided by telecommunications networks, mobile telephones, mobile media devices, on-line from a computer database or the Internet; Software for streaming audio-visual and multimedia content via the internet and global communications networks; software for streaming audiovisual and multimedia content to mobile and smart digital electronic devices and consumer goods; software for searching, indexing, organizing, and recommending audiovisual and multimedia content; mobile applications for accessing and streaming audiovisual and multimedia content via the internet and global communications networks; downloadable audiovisual content such as ~~short films, short film series, short form content, episodic and non-episodic~~, motion pictures ~~save for short films~~, television shows across all genres ~~such as action-adventure, animation, anime, biography, classics, comedy, crime, documentary, drama, factual entertainment, faith, family, fantasy, history, horror, international, kids, musical, mystery, news, general interest, reality television, romance, science-fiction, sports, thrillers, war, and westerns~~ ~~save for short films~~ provided via a video-on-demand service; software and/or firmware which enhances the users experience of searching and making choices; publications in electronic form supplied on-line from databases or from facilities provided on the Internet or other communications networks; electronic magazines, directories, pamphlets, books, periodicals, catalogues, bulletins, guides, manuscripts and newsletters.

Class 38 - Broadcasting, streaming, webcasting and transmission of films, videos and television programmes; broadcasting and transmission of television programmes and games via telecommunications networks, mobile phones, mobile media and on-line from a computer database or the Internet; electronic delivery of films, videos, television programmes and computer games by telecommunications networks, mobile phones, mobile media and online from a computer network or the Internet; video-on-demand transmission services; subscription television, video broadcasting; transmission of voice, data, images, signals, messages and information.

Class 41 - Entertainment services ~~save for those provided in relation to short films~~, online and educational services, in the nature of the development, production, post production, presentation and distribution of ~~short films, serialized short films, short form content~~, feature films, videos, music videos, television programmes and live events; publication of computer games; distribution of computer games; entertainment services consisting of ~~short films, short film series, short form content~~, episodic and non-episodic, motion pictures, television shows, television series ~~save for short films; all the aforesaid in relation~~

to the fields of action-adventure, animation, anime, biography, classics, comedy, crime, documentary, drama, factual entertainment, faith, family, fantasy, history, horror, international, kids, musical, mystery, news, general interest, reality television, romance, science fiction, sports, thrillers, war, and westerns; Providing information on the subjects of ~~short films, serialized short films,~~ feature length motion pictures, television programming ~~save for short films,~~ and ~~short-form episodic and non-episodic content,~~ current events, entertainment ~~save for short films,~~ sports, comedy, drama, music, and music videos, via a website; providing information, reviews, and personalized recommendations regarding ~~short films, serialized short films,~~ feature length movies, television shows ~~save for short films, and short-form episodic and non-episodic content~~ via a website, set top box application, mobile application and other video on-demand transmission services, video-on-demand transmission services; providing non-downloadable ~~short films, serialized short films,~~ feature length films, television shows ~~save for short films,~~ and episodic and non-episodic ~~short and~~ long form content via a video-on-demand transmission service; providing electronic publications, and databases on-line and/or on electronic media relating to entertainment, movies, ~~short films,~~ programmes ~~save for short films,~~ documentaries, television and radio programming, previews, trailers, competitions, sports, concerts, celebrity and entertainment news, education, games, culture, leisure, activities, contests and events; cable television programming services ~~save for short films;~~ premium and pay television programming services ~~save for short films;~~ pay per view television programming services ~~save for short films;~~ providing the aforesaid services using the Internet and other electronic communications networks.

Class 42 - Hosting and maintaining an online community featuring audio, audiovisual, and multimedia content in the fields of ~~short film, short form content,~~ motion pictures, television programming, current events, entertainment ~~save for short films,~~ sports, comedy, gaming, esports, drama, music, and music videos; design and development of interactive databases ~~save for short films.~~

Annex 2 – list of issues referred to in the CMC Order

The following list adopts the definitions used in the Statements of Case. This list is not intended to take the place of the Statements of Case herein.

Goodwill, reputation and enhanced distinctiveness

1. Did each of the Trade Marks have, in respect of the goods and services for which they are registered being relied upon in these proceedings, a reputation and/or an enhanced distinctive character in the UK at the relevant dates (being June 2021 and 8 February 2022) and if so what was the extent of that reputation and/or enhanced distinctive character? (PoC ¶¶5; AmDefence ¶¶17, 27; Reply ¶¶8, 10)
2. Did SIL own a goodwill in respect of each of the Signs and the Trade Marks through use for the goods and services for which use is relied upon in these proceedings at the relevant date (being June 2021) and if so what was the extent of that goodwill? (PoC ¶¶2, 5; AmDefence ¶¶3, 17, 27; Reply ¶¶8, 10)

Validity/UKIPO Proceedings

3. Are the Trade Marks or any of them invalid pursuant to section 3(1)(b), 3(1)(c) and/or 3(2) of the 1994 Act for any or all of the following reasons:
 - a. that the Trade Marks and each of them are devoid of any distinctive character; (AmDefence ¶¶12, 13; Reply ¶13)
 - b. that the Trade Marks and each of them consist exclusively of signs or indications which may serve, in trade, to designate the kind of goods and services, or other characteristics of the goods and services, in respect of the Core Goods & Services for which they are registered; or (AmDefence ¶¶12, 14; Reply ¶14)
 - c. that the Trade Marks and each of them consist exclusively of indications which have become customary in the current language or in the bona fide and established practices of the broadcasting, media and telecommunications trade? (AmDefence ¶¶12, 15; Reply ¶15)

The Defendant's activities

4. Did the YouTube Marks and each of them have a goodwill, reputation and/or an enhanced distinctive character in the UK at the relevant date (being June 2021)? (AmDefence ¶¶23-25, 27)
5. What is the nature of the Defendant's use of the signs complained of, including:
 - a. Has the Defendant used the sign SHORTS solus, in a distinctive way (i.e. as an indication of origin) (PoC ¶9; AmDefence ¶28);
 - b. Have the signs been used as secondary brands to the YouTube Marks (AmDefence ¶28)

Trade mark infringement

6. Does there exist a likelihood of confusion on the part of the public by virtue of the use by the Defendant of the signs complained of? (PoC ¶12; AmDefence ¶32)
7. Have there been any instances of actual confusion? (AmDefence ¶32(e))
8. Would the use complained of:
 - a. result in a link by members of the public between the Trade Marks, the Google Signs, the Devices and the Signs or any of them;
 - b. be without due cause; and/or
 - c. be detrimental to the distinctive character of the Trade Marks? (PoC ¶13; AmDefence ¶34)

s.11(2)(b) defence

9. Does the use complained of amount to the use of a sign or indication which is not distinctive and/or which concerns the kind of other characteristics of the goods or services offered under the Signs? (AmDefence ¶33; Reply ¶16)
10. Was the Defendant's use in accordance with honest practices in industrial or commercial matters? (AmDefence ¶33; Reply ¶16)

Passing off

11. Have members of the public actually been confused or deceived as a consequence of the acts complained of (including in the sense that they believed that such acts were endorsed and/or approved by the Claimant)?
12. Has the Defendant misrepresented that their goods and/or services are connected in the course of trade with the Claimant's business, and has such misrepresentation caused the Claimant damage?

Annex 3 – conclusions on the 383 Mark

Goods / services	Inherent validity?
Class 9	
sound, video and data recordings; cinematographic films; films for television; television programmes recorded on magnetic, optical and electronic media; downloadable audiovisual content such as short films [etc.] provided via a video-on-demand service	No – SHORTSTV would be recognised as a description of a characteristic of these goods, i.e. that they are short-form audiovisual content which are or can be delivered by televisual means
<i>video and audio tapes, cassettes, discs; CDs, DVDs;</i> electronic data media, digital recording media	No – these goods are carriers of audiovisual content and the potential for such goods to provide consumers with content which they will recognise SHORTSTV as denoting is sufficiently real and significant to be a material consideration
computer software; electronic entertainment software	No – to the extent that these categories of goods include software for accessing audiovisual entertainment the potential to provide consumers with content which they will recognise SHORTSTV as denoting is sufficiently real and significant to be a material consideration
computer programmes for interactive television <i>and for interactive games and/or quizzes;</i> interactive video content <i>and game</i> programs	No – for the non-italicised categories of goods the potential to provide consumers with content which they will recognise SHORTSTV as denoting is sufficiently real and significant to be a material consideration
<i>computer games; virtual reality hardware and software content and games</i>	Yes
software for streaming audio-visual and multimedia content via the internet and global communications networks; software for streaming audiovisual and multimedia content to mobile and smart digital electronic devices and consumer goods; mobile applications for accessing and	No – the potential for such goods to provide consumers with content which they will recognise SHORTSTV as denoting is self-evidently sufficiently real and significant to be a material consideration

streaming audiovisual and multimedia content via the internet and global communications networks	
software for searching, indexing, organizing, and recommending audiovisual and multimedia content; software and/or firmware which enhances the users experience of searching and making choices	No – the potential for such goods to provide consumers with content which they will recognise SHORTSTV as denoting is self-evidently sufficiently real and significant to be a material consideration
<i>publications in electronic form supplied on-line from databases or from facilities provided on the Internet or other communications networks; electronic magazines, directories, pamphlets, books, periodicals, catalogues, bulletins, guides, manuscripts and newsletters</i>	No – these goods are information carriers and so can include carriers of information about audiovisual content, including content with characteristics which consumers will recognise as being denoted by SHORTSTV
Class 38	
broadcasting, streaming, webcasting and transmission of films, videos and television programmes; broadcasting and transmission of television programmes <i>and games</i> via telecommunications networks, mobile phones, mobile media and on-line from a computer database or the Internet; electronic delivery of films, videos, television programmes <i>and computer games</i> by telecommunications networks, mobile phones, mobile media and online from a computer network or the Internet; video-on-demand transmission services; subscription television, video broadcasting; transmission of voice, data, images, signals, messages and information	No – the potential for these services (save those italicised) to provide consumers with content which they will recognise SHORTSTV as denoting is self-evidently sufficiently real and significant to be a material consideration
Class 41	
entertainment services, online and educational services, in the nature of the development, production, post production, presentation and distribution of short films [etc.]; entertainment services consisting of short films [etc.]	No – the potential for such services to provide consumers with content which they will recognise SHORTSTV as denoting is self-evidently sufficiently real and significant to be a material consideration
<i>publication of computer games; distribution of computer games</i>	Yes
providing information on the subjects of short films [etc.] via a website; providing information, reviews, and personalized recommendations	No – these services include provision of information about audiovisual content, including

regarding short films [etc.] via a website, set top box application, mobile application and other video on-demand transmission services; providing electronic publications, and databases on-line and/or on electronic media relating to entertainment, movies, short films [etc.]	content including content with characteristics which consumers will recognise as being denoted by SHORTSTV
providing non-downloadable short films [etc.] via a video-on-demand transmission service; video-on-demand transmission services; cable television programming services; premium and pay television programming services; pay per view television programming services	No – the potential for such services to provide consumers with content which they will recognise SHORTSTV as denoting is self-evidently sufficiently real and significant to be a material consideration
Class 42	
hosting and maintaining an online community featuring audio, audiovisual, and multimedia content in the fields of short film [etc.]	No – the potential for such services to provide consumers with content which they will recognise SHORTSTV as denoting is self-evidently sufficiently real and significant to be a material consideration
design and development of interactive databases	No – these services include ones relating to interactive databases of audiovisual entertainment content, for which the potential to provide content which consumers will recognise SHORTSTV as denoting is self-evidently sufficiently real and significant to be a material consideration