

The Glee Club

A recent decision of the United Kingdom Court of Appeal has confirmed that “wrong way around confusion” occurred in the GLEE case.

The Facts

The GLEE CLUB

The plaintiff operates a number of entertainment venues in the United Kingdom. The entertainment generally consisted of stand-up comedy acts, but has also included live and recorded music and night club and cabaret entertainment. The plaintiff is the owner of a series of two design marks which are reproduced below:



In the UK trademarks that are closely related can be registered as a series of marks.

The mark was registered in association with live comedy services, night club and cabaret entertainment and related services. By 2009, the plaintiff had made extensive use of its mark in connection with its business and the provision of its services. The plaintiff also promoted its business using the two words GLEE CLUB. The plaintiff's business has been very successful.

Glee

20th Century Fox Film Corporation ("Fox) is a well-known U.S. entertainment company. In the late 2009 it launched in the U.S. and in the U.K. a musical comedy television series called Glee. By the time of the trial the series was in its fourth season.

The television series is a musical comedy about a high school singing club at a fictional high school located in Ohio. The club was called New Directions and competed with singing clubs and other schools in what was described as the show choir competition circuit. The Glee television production has been very successful and has achieved high ratings in the U.K. The series also won many awards and generated a great deal of publicity.

There have been live concert tours, songs released as singles, albums and through the iTunes store. Fox has licensed a wide range of merchandise all related to the television series.

The plaintiff's principal monitored the activities of the Fox television series thinking that it might not be successful. However, it was found that the presence of the Glee series was damaging the plaintiff's business.

The Plaintiff's Action

Proceedings were instituted and the action proceeded to trial. At the trial the plaintiff presented evidence of a number of witnesses who knew of the Glee TV series and on seeing or hearing of the plaintiff's business believed it was in some way connected with the series.

The trial judge found that the plaintiff's mark had been validly registered and was infringed. The judge granted a final injunction restraining Fox from using the word Glee

as the name of its series, save that Fox was entitled to say that the series was previously known as Glee. Finally, the judge awarded to the plaintiff damages or, at its option, an accounting of profits with an immediate payment to the plaintiff of £100,000 on account of the damages or profits.

The Appeal

Fox appealed from this judgement and argued that they had not infringed the plaintiff's mark.¹

The court observed that whether a particular instance of confusion was "right way around" or "wrong way around" really did not matter and simply related to the order in which the consumer happened to come across the respective marks. In both cases, if consumers think that the services in issue came from the same undertaking or economically linked undertakings this may be equally damaging to the distinctiveness and the functions of the mark.

After a detailed review of the relevant U.K. law and the facts of the case, the court dismissed the appeal.

The Canadian Position

Cases similar to this one in Canada are dealt with by the courts in a similar fashion although the concept is referred to as "reverse confusion". This concept seems to have been borrowed from U.S. case law.

In substance, reverse confusion is highly fact specific and depends on a number of key facts. In the typical case, the junior trademark user, who is aware of the senior user, but

¹. [2016] EWCA Civ 41 (U.K.C.A)

which has much greater economic power saturates the market with advertising of a confusingly similar mark, overwhelming the marketplace power and value of the senior user's mark.

The Canadian cases emphasize that the issue of reverse confusion is considered in exactly the same way as a claim to forward confusion. No special considerations apply and in both situations the presence or absence of a likelihood of confusion is the key.

Comments

This decision serves to confirm that confusion can occur in a reverse or a "wrong way around" fashion. However, it also shows the difficulties that can arise in securing trademarks in multiple jurisdictions. No doubt Fox's GLEE mark was protected in most places but unfortunately not in the U.K.

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These comments are of a general nature and not intended to provide legal advice as individual situations will differ and should be discussed with a lawyer.