Appeal Court ref: CA-2025-000161 and 000164

IN THE COURT OF APPEAL (CIVIL DIVISION)

ON APPEAL FROM

Claim No. IL-2023-000037

IN THE HIGH COURT OF JUSTICE

BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES

INTELLECTUAL PROPERTY LIST (ChD)

BETWEEN:

SHORTS INTERNATIONAL LIMITED

Claimant/Appellant

-and-

GOOGLE LLC

Defendant/Respondent

GOOGLE'S REPLACEMENT APPEAL AND CROSS APPEAL SKELETON

LINDSAY LANE KC

JESSIE BOWHILL

8 New Square, Lincoln's Inn

clerks@8newsquare.co.uk

Instructed by Fieldfisher LLP

16 February 2026

Herein: (i) the Appellant/Claimant is referred to as **SIL**; (ii) the Respondent/Defendant is referred to as **Google**; (iii) references to documents in the Joint Core Appeal Bundle are in the form **[C/tab/page number(paragraph)]**; and (iv) references to documents in the Joint Supplementary Bundle are in the form **[S/tab/page number(paragraph)]**.

INTRODUCTION

1. This is Google's skeleton in respect of:

   1.1. SIL's appeal from the Order of Michael Tappin KC (sitting as a Deputy Judge of the High Court) dated 18 December 2024 ("**the Order"**)[1] by which he *inter alia*:

      1.1.1. dismissed SIL's claim for trade mark infringement (paragraph 1);

      1.1.2. ordered that UK Trade Mark Number 3428383 was invalid in respect of the goods and services identified in Schedule 1 to the Order (paragraph 2);

   1.2. Google's cross appeal in relation to the findings of partial validity in relation to the other marks in issue.

2. Permission to appeal was granted to SIL by the trial Judge on (what are now) Grounds 4 to 8, with permission being granted on Grounds 1 to 3 and 9 to 12 by Arnold LJ.[2] Permission to appeal was granted to Google on all grounds by the trial Judge.

3. This skeleton addresses SIL's appeal first (responding to SIL's appeal skeleton dated 21 November 2025), before addressing Google's cross appeal.[3]

4. In short, Google's position on SIL's appeal is that it must be dismissed as all the grounds amount to either challenges to findings of fact which are not "*plainly wrong*" or "*rationally insupportable*" and/or challenges to the Judge's finding of trade mark infringement which is an evaluative multi-factorial decision in relation to which SIL has identified "*no gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion*" (see further below).

5. In relation to Google's cross appeal, there can be no doubt that the end result reached by the trial Judge was the correct one – namely that Google should be able to continue to use

[1] [C/3/153]
[2] Order dated 25 March 2025 [C/16/584]
[3] Accordingly, this skeleton runs to 38 pages, but is within the 25-page limit prescribed by paragraph 31(1)(a) of PD52C for each appeal

the descriptive word "shorts" to describe its short form video sharing service, in a context that makes it abundantly clear that the service originates from YouTube/Google. However, this court may take the view that the alternative means of reaching that result, by finding SIL's trade marks invalid, is the correct one.

6. Google's position is that this is the case because the Judge's approach to validity of the SIL's trade marks was legally flawed, in particular because he upheld the validity of marks which comprise only a "*figurative figleaf*" of distinctiveness.

SIL'S APPEAL

BACKGROUND

7. SIL operates a business dedicated to the broadcast of short films. It adopted its current name in 2005 and re-branded in 2017/2018 in which there was a shift from the use of "Shorts" to "Shorts TV" **[C/1/19(63)]**. It is the proprietor of the following five marks:

   7.1. UKTM No. 917834615 for the mark SHORTSTV (**"the 615 Mark"**);

   7.2. UKTM No. 917834649 for the mark SHORTSTV (**"the 649 Mark**");

   7.3. UKTM No. 917834656 for the mark SHORTS (**"the 656 Mark"**);

   7.4. UKTM No. 917834664 for the mark SHORTS (**"the 664 Mark"**);

   each of which was filed on 20 February 2018 and added to the register on 5 October 2018. They are referred to in this skeleton (as in the Judgment) as **"the 2018 Marks"**; and

   7.5. UKTM No. 3428383 for the word mark SHORTSTV (**"the 383 Mark"**) which was filed on 13 September 2019 and added to the register on 6 December 2019.

8. SIL is a relatively small business operating internationally with a turnover of about $9M in 2020 **[C/1/19(63)]**. The evidence relied upon by SIL at trial addressing use was largely irrelevant, with much of it addressing the position outside the UK and/or after the relevant dates. The Judge found that, having regard to the evidence, exposure to SIL and its marks was largely limited to film makers and other people in the film industry and to film buffs,

but that it was 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 **[C/1/36(132)].**

9. 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) **[C/1/4(6)]**. There was no dispute at trial that YouTube is, and has for many years been, a very well known brand and that the YouTube name and the YouTube logo are highly recognisable, whether used separately or together in the following form **[C/1/4(5)]**:

10. YouTube Shorts is a short-form video viewing and creation experience devoted to videos which are less than 60 seconds long and in vertical format **[C/1/4(6)]**. It is available through the YouTube website at youtube.com **[C/1/4(7)]** and through the YouTube app available on mobile devices and smart TVs **[C/1/6(13)].** The Judgment describes the functionality of YouTube Shorts via the website at **[C/1/4(7) – 6(12)],** via the mobile app at **[C/1/6(14) – 8(18)]**, and via a smart TV at **[C/1/8(19) – 9(22)]**, and how the signs complained of appear in each context**.**

11. In addition to the use of the word "Shorts" solus, SIL complained about use of YouTube Shorts, and the use of the word "Shorts" alongside the YouTube Shorts logo and in the manners identified at **[C/1/9(23) – (24)]**.

12. The Judge's conclusions are summarised at **[C/1/2(3)]**. In essence he found that:

    12.1. At the relevant dates, the meaning of the word "shorts" extended beyond "short films" and included other short-form audio visual content.

    12.2. The Marks were valid, save for the 383 Mark (SHORTSTV word mark) which was invalid for most goods and services, and the other marks were liable to be revoked for non-use for some goods and services.[4] All of the Marks were of low inherent distinctive character and SIL had not demonstrated sufficient use to enhance that distinctive character.

    12.3. None of Google's uses of the signs complained of gave rise to any likelihood of confusion. The similarities arose because of the adoption (in both the marks and the

[4] Further, SIL's proposed amendment to the specifications to excise "short films" did not comply with the requirements of *Postkantoor* because it identified a characteristic of the goods/services, namely their duration **[C/1/38(139) – 39(141)].**

signs) of descriptive elements. Accordingly, there was no infringement under s 10(2) of the Trade Marks Act 1994 (**"TMA"**).

12.4. None of Google's uses caused damage to the distinctive character or repute of the marks, such that there was no infringement under s 10(3) TMA.

12.5. There was no misrepresentation and thus no passing off.

THE APPROACH ON APPEAL

13. SIL's appeal skeleton does not address the correct approach on appeal. However, its appeal comprises both a challenge to an evaluative decision and an appeal on the facts.

14. The correct approach on appeal to a challenge to an evaluative decision of a first instance judge in the context of trade mark infringement was addressed recently by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anr* [2025] UKSC 25; [2025] RPC 15. Lord Briggs and Lord Stephens held at [93]-[95]:

14.1. The question whether there is a trade-mark infringement under s 10(2) TMA is a classic example of a multi-factorial assessment. It involves the finding of primary facts, the application of relevant principles or rules of law to those facts and the evaluative decision whether, thus considered, something has happened which falls within the statutory definition.

14.2. Reasonable judicially trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multi-factorial questions and the law has imposed structured constraints designed to prevent a free for all in a higher court whenever a party wishes to challenge the first instance decision of the trial judge.

14.3. On a challenge to an evaluative decision of a first instance judge, the appeal court must not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion. On the other hand, for the decision to be 'wrong' under CPR 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation.

15. The relevant principles governing the correct approach on an appeal that involves challenges to findings of fact were summarised by Phillips LJ in *Kynaston-Mainwaring v GVE London Ltd* [2022] EWCA Civ 1339; [2023] RTR 17 at [16]-[19]:

    15.1. Appellate courts should not interfere with findings of fact by trial judges, unless compelled to do so. This applies not only to findings of primary fact, but also to the evaluation of those facts and to inferences to be drawn from them.

    15.2. In order to intervene, the appellate court must be satisfied that the judge was "*plainly wrong*". The adverb "plainly" requires the appellate court to be satisfied that the decision under appeal is one that no reasonable judge could have reached.

    15.3. An appellate court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must consider all of the material evidence (although it need not all be discussed in his judgment), but the weight which he gives to it is a matter for him.

    15.4. An appellate court can set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable. This is a very high hurdle.

THE APPEAL ON INFRINGEMENT

16. Grounds 1 and 4-12 all relate to infringement and so it makes sense to address these first. We do so in the same order as in SIL's appeal skeleton, before turning to Grounds 2 and 3 which relate to validity of the 383 Mark.

Ground 1: the meaning of the word "shorts"

17. SIL contends that the Judge erred in failing to hold that in the context of visual entertainment, the preponderant meaning of SHORTS was "short films".[5] However, the Judge recorded that the parties were agreed that the materials in the case showed that "the predominant use of the term "shorts" was to mean "short films"" **[C/1/16(49)]**. Further, SIL says that it does not challenge the Judge's factual conclusion at **[C/1/18(58)]** that the

[5] Ground 1 of SIL's Grounds of Appeal [C/7/250]

meaning of "shorts" was not limited to "short films" but also included other short-form visual content **[C/4/166(16)]**.

18. Accordingly, it is not at all clear what SIL says that the Judge has done wrong. It argues that "*[t]his was a legal error in that [the Judge] extrapolated from a few outlying examples to the general meaning when the evidence showed that for many … the term "shorts" continued to mean "short films*"" **[C/4/166(16)]**.

19. This argument fails on several levels.

20. First, there is simply no finding in the Judgment that the word "shorts" has a "general meaning".

21. Secondly, the Judgment clearly and comprehensively reflects the various meanings of "shorts", including the case run by SIL which was that the most prominent meaning of the word "shorts" was short trousers **[C/1/16(46)]**.

22. Thirdly, and despite SIL's protestations to the contrary, to the extent that SIL challenges the Judge's finding that "shorts" was not limited to "short films", i.e. it could also mean other short audiovisual content, this was a finding of fact, that is not "*plainly wrong*".

23. At trial, there was a plethora of written and oral evidence which related to the meaning of the word "shorts" (a point which SIL acknowledges at **[C/4/165(13)]**). The Judge reviewed all of this evidence with care, see:

    23.1. **[C/1/16(50)-17(55)]**, where the Judge reviewed the documentary evidence relied upon by both parties. This included (i) articles published in The Observer, The Telegraph and the Guardian which used the word "shorts" to refer to short comedy videos **[C/1/16(51)]**; (ii) examples in The Times, The Observer and The Telegraph of the use of the word "shorts" to refer to videos featuring factual or fictional material shown on TV or online **[C/1/17(52)]**; (iii) an article published in I News referring to awards for "shorts of anywhere from three to 20 minutes" **[C/1/17(53)]**; (iv) the use of "shorts" by Channel 4 to refer to its series of programmes for its on-demand service 4oD **[[C/1/17(54)]**; and (v) a number of articles which referred to "shorts" on YouTube before the launch of YouTube Shorts **[C/1/17(55)]**.

    23.2. **[C/1/16(47)]**, where the Judge noted the unchallenged evidence of Mr Harbinson that "shorts" had been in use in the vernacular of the film, TV and broadcasting industry since before 2014, and that the meaning of "shorts" had evolved

over time from films traditionally made and viewed in a cinema, to mean more accessible, even shorter digital content.

24. Further:

    24.1. The parties were agreed that the evidence showed a number of instances of the use of the term "shorts" to refer to short-form audiovisual content that was not a "short film" **[C/1/16(50)]**.

    24.2. SIL conceded that there was evidence of the use of "shorts" to refer to materials which were not "short films" **[C/1/16(50)]**.

25. Having reviewed the evidence as a whole with care (together with the agreement and concession identified at paragraph 24 above), the Judge then found that it was 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" **[C/1/18(56)]**. This then led him to conclude that at the relevant dates *"the meaning of "shorts" was not limited to "short films" but also included other short-form audio visual content"* **[C/1/18(58)]**.

26. Accordingly, SIL comes nowhere near the "very high hurdle" for an appeal on the facts.

27. Fourthly, SIL does not identify why or how this supposed error makes a difference. Doing the best we can, it appears that SIL's real complaint relates to how the Judge approached descriptiveness when considering the question of infringement (as to which see below). If that is so, the appeal on Ground 1 adds nothing to the other grounds.

Ground 5: wrongly regarding some of the signs as purely descriptive

28. SIL does not challenge the Judge's identification of the sign in these instances. There were two instances of the use of "Shorts" solus: first, in the horizontal menu on the creator pages (see the example at **[C/1/6(12)]**, NB the relevant menu is in the centre of the page, it is not the vertical menu on the left hand side), and secondly, on the creation tools page on the mobile app (see the image on the right at **[C/1/7(16)]**, NB the relevant menu is the horizontal menu at the top of the image, not the horizontal menu at the bottom of the image). The Judge held that in both cases 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*" **[C/1/63(224)]**.

29. SIL argues that this is wrong for two reasons:

29.1. The uses were trade mark usage because they were the name of Google's new short form user-generated content video service **[C/4/167(21)]**.

29.2. The uses were not descriptive for the significant proportion of the relevant public to whom "shorts" means "short films" **[C/4/168(22)]**.[6]

30. The first argument misses two fundamental points. First, the correct legal test is whether the sign is used for the purpose of distinguishing goods or services, as opposed to purely descriptive use, as explained by the Judge at **[C/1/47(172)]**. SIL does not challenge the Judge's summary of the law on this point. Second, the question of whether the sign is used for the purpose of distinguishing goods or services, as opposed to purely descriptive use, is a question of fact for the trial judge.

31. Thus, it matters not whether the signs were the name of Google's new short form user-generated content video service, which is correct and which the Judge obviously knew. The question is what the average consumer would understand by the use of the word "shorts" in this specific context.

32. The finding the Judge made on this point was one that was open to him on the basis of the material evidence (which need not all be discussed in his judgment, see paragraph 15.3 above). The use of "shorts" solus in the horizontal menu on a creator's channel page (see example at **[C/1/6(12)])** appears as a tab alongside other descriptive words such as "home", "videos", "live", "playlists" and "community". The use of "shorts" solus in the horizontal menu on the mobile app (see example at **[C/1/7(16)])** again appears alongside other descriptive words such as "videos", "unwatched" and "watched". Thus, in both cases, the context of use reinforces the natural descriptive meaning of the word "shorts", in particular by indicating to consumers the type of content that they will find on that shelf, in exactly the same way as "videos", "playlists" etc does. It is not used for the purpose of distinguishing and would not be taken by the average consumer as an indication of origin.

33. The Judge's conclusion that such use was descriptive was supported by the documentary and oral evidence at trial (including, SIL's acceptance that third parties using "shorts" in exactly the same way was descriptive and legitimate). See in particular:

[6] NB SIL's appeal skeleton refers to [C/1/63(225)-64(229)] in this context. This is not understood since the Judge's decision about purely descriptive signs (which is what Ground 5 refers to) is at [C/1/63(224)].

33.1. The Disney App on a smart TV has a series of "shelves" which are "series", "movies", "shorts" and "specials": see **[S/12/173]**. Mr Pilcher accepted that the use of "shorts" by Disney in this context was descriptive of the content of what was on the shelf.[7]

33.2. The Disney+ Website contains shelves entitled "shorts", "specials" and "International Originals": see **[S/12/174]**. Mr Pilcher accepted that "shorts" was used here to describe what is on the shelf.[8]

33.3. The Film4 Website in 2019 contained a menu on the website with a series of options along the top called "Productions", "About Film4 Productions", "Shorts", "News" and "On TV": see **[S/6/87-88]**. Mr Pilcher accepted that "shorts" was here being used descriptively.[9]

34. As to SIL's second argument (that the uses were not descriptive for the significant proportion of the relevant public to whom "shorts" means "short films"), this is again an attempt to challenge the Judge's finding of fact on the point, which is unimpeachable for the reasons explained above. Further and in any event, this submission assumes that to the relevant public to whom "shorts" meant "short films" this was the *only* meaning of the word of which they were aware and which they would understand in this context. There was no evidence to this effect at all, and indeed it was not a point that SIL even ran at trial.

Ground 4: failing to compare the sign comprising "Shorts" solus

35. SIL complains that the Judge did not make a comparison between the Marks and the uses of the sign "Shorts" solus. However, the reason for this is that the Judge had concluded (correctly, for the reasons explained above), that these uses were purely descriptive and therefore could not amount to trade mark infringement. Thus, the arguments made above in relation to Ground 5 also dispose of Ground 4.

Ground 6: allowing distinctiveness to pollute the comparison of the marks

36. Under Ground 6 SIL challenges the Judge's comparison of the marks on the basis that he wrongly imported considerations of distinctiveness into his comparison of the marks and

[7] [S/15/188] (see page 111 of transcript, lines 3-12)
[8] [S/15/188] (see page 111 of transcript, lines 16-21**)**
[9] [S/15/190] (see page 118 of transcript, lines 7-16**)**

signs, essentially "airbrushing" the descriptive elements out of the analysis **[C/4/172(34)]**. There are three problems with SIL's challenge under this ground.

37. First, its recitation of the authorities is incomplete and, therefore, inaccurate.

38. In particular, SIL's appeal skeleton ignores the basic point that the court is obliged to take into account considerations of distinctiveness. It is well established that the likelihood of confusion must be appreciated globally, taking account of all relevant factors (see e.g. *Match Group & ors v Muzmatch Ltd & Anr* [2023] EWCA Civ 454; [2023] FSR 18 at [27(a)]). The similarities of the marks is one of the relevant factors, and this must be undertaken by reference to the overall impressions created by the marks *bearing in mind their distinctive and dominant components* (*Match Group* at [27(d)]). The authorities cited by SIL support these general propositions: see Case C-43/15 P *BHS v. EUIPO / KOMPRESSOR* EU:C:2016:837 at [58], [61] and [64]; Case C-102/07 *Adidas v Marca Mode* EU:C:2008:217 [2008] FSR 38 at [29], [30], and [36]; at [34]-[37], [39], [42]-[43].

39. SIL also ignores the relevant English authorities relating to descriptive marks. It is well established that the scope of the monopoly affects the question of infringement (see *Starbucks Ltd & Ors v British Sky Broadcasting Group PLC* [2012] EWHC 3074 (Ch); [2013] FSR 29 (cited by the Judge at **[C/1/25(87)]**) and there is a body of case law concerning the adoption by both parties of common descriptive elements and the impact of that on the question of whether there was a likelihood of confusion. These authorities were reviewed by the Judge, who cited extracts of *PlanetArt LLC v Photobox Ltd* [2020] EWHC 713 (Ch); [2020] FSR 26 and *Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd* [2024] EWCA Civ 814; [2024] FSR 32 at **[C/1/51(178)-52(179)]**. SIL does not challenge the Judge's summary of the relevant legal principles.

40. Second, SIL's characterization of the Judge's reasoning does not fairly reflect the Judgment.

41. At **[C/1/65(232)]** he compared the visual, aural and conceptual similarities. He identified the similarities and differences and concluded that there was visual and aural similarity. In terms of the conceptual similarities, he found these were obvious and arose from the word "shorts" and a play symbol. He then found that because "shorts" was descriptive of the type of material and the play symbol was an indication that the material could be played, the similarities were at a level which differs from that which gave the 615/649 Marks their distinctive character. As for the 383 Mark, he again found visual, aural and conceptual similarity but then noted at **[C/1/65(233)]** that the elements which gave the 383 Mark

distinctive character were absent from Google's signs. These are findings of fact which SIL does not challenge.

42. Accordingly, it is clear that the Judge did not ignore the descriptive elements of the marks when undertaking his analysis of similarity. He merely noted that the distinctive and dominant elements of the Marks were not reproduced in the signs (which is the correct approach in law – see above).

43. The Judge then took account of the descriptive elements when he came to make the multi-factorial assessment of likelihood of confusion. In particular, at **[C/1/67(240)]** he held (emphasis added):

> "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."

44. It is clear from the first passage in emphasis that, contrary to SIL's submissions, the Judge had well in mind the similarities between mark and sign. He did not "airbrush out" any similarities based on descriptiveness. The Judge placed significance on the descriptive elements of the mark/signs when he made the evaluative decision on likelihood of confusion (see second passage in emphasis). It is clear that in this passage the Judge followed the principles summarized in *PlanetArt* and *Lifestyle Equities*, in particular:

    44.1. Where the only similarity between the respective marks is a common element which has a low distinctiveness, that points against there being a likelihood of confusion: *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271(Ch); [2015] FSR 33 at [44].

    44.2. This is 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: *Elliott v LRC Products* (O/255/13) [2014] RPC 13 at [57].

    44.3. The use of descriptive terms also has the impact of somewhat downgrading the significance of conceptual similarity in the evaluation of the likelihood of confusion: *PlanetArt* at [29].

45. Third, SIL's challenge on Ground 6 is ultimately a criticism of the weight which the Judge gave to the descriptiveness of the Marks which, yet again, fails to reach the high threshold for challenging a multi-factorial evaluation by the trial judge.

Grounds 7-10: Overall assessment of likelihood of confusion.

46. Grounds 7 to 10 all concern challenges to the Judge's assessment of the question of likelihood of confusion, which was a multi-factorial assessment made on the evidence before him. As explained at paragraph 14 above, an appeal which simply amounts to a "*free for all*", comprising an attempt to re-argue the case before the appellate court cannot succeed. SIL's appeal skeleton has all the hallmarks of such an attempt. In particular:

    46.1. Every ground is essentially a complaint as to the weight given to a particular aspect of the multi-factorial assessment.

    46.2. Additional points are raised in SIL's appeal skeleton, which are not within the Grounds of Appeal, thereby evidencing SIL's inability to identify a real error of law, upon which it could legitimately rely.

Ground 7: placement of the play symbol

47. By Ground 7 SIL complains that the Judge was wrong to find that the placement of the play symbol was sufficient to dispel confusion. In its appeal skeleton, SIL makes the different point that the average consumer would be unable to discern whether there was a small play symbol within the letter "O" of the sign complained of, especially when accounting for imperfect recollection of the earlier mark **[C/4/174(38)]**. There are several difficulties with this argument.

48. First, it is clear from **[C/1/67(240)-(242)]** that the Judge did not merely rely upon the play symbol to find no likelihood of confusion. Instead, these paragraphs contain careful reasoning reflecting the global assessment undertaken by the Judge. He had in mind the visual, aural and conceptual similarities; the low level of attention paid by the average consumer together with the concept of imperfect recollection; the descriptive nature of both the word "shorts" and the play symbol; the distinctive character of the Marks and the impression created in the mind of the average consumer; as well as the absence of evidence as to actual confusion. This is a paradigm example of a carefully reasoned evaluative decision which is beyond reproach.

49. Second, the Judge had in mind that in the uses complained of, there was a separate logo which contains the play symbol **[C/1/67(240)]**, a finding which SIL does not dispute. In those circumstances, the proposition that the average consumer would not be able to discern whether there was a small play symbol within the letter "O" matters not. If the average consumer could not discern it, then it would understand it to be absent from the sign (as indeed it is), consistent with the Judge's reasoning.

50. Third, SIL's suggestion that the average consumer would be unable to discern whether there was a play symbol within the letter "O" of the signs complained of **[C/4/174(38)]** is inconsistent with the Judge's finding of fact that it is this element which gave the Marks distinctive character **[C/1/28(96)]**, against which SIL does not appeal. It does however, support the case on Google's appeal, as to which see below.

Ground 8: the presence of separate words and logos

51. Ground 8 is that the Judge wrongly held that the presence of separate words and logos made a difference due to context. This ground is not dealt with in SIL's appeal skeleton and we assume it has been abandoned. Indeed, this ground is inconsistent with SIL's submissions at **[C/4/175(40)]** (not contained within the Grounds of Appeal, but addressed briefly

below). This is a good illustration of the "*free for all*" on which SIL has embarked in order to try to criticise the Judgment.

Ground 9: the distinctiveness of the 2018 Marks

52. Ground 9 is difficult to understand, even when SIL's submissions on this point **[C/4/175(41)]** are taken into account. The key complaint appears to be that the Judge wrongly assessed the distinctiveness of the 2018 Marks as being "low" for all goods and services. It is not understood why the distinctiveness for all goods and services matters for the purpose of infringement. For his infringement assessment, the Judge correctly considered those goods and services which SIL relied upon for the purpose of its infringement case, which Google accepted were identical to those for which it had used its signs **[C/1/66(235)]**. For those goods and services, the Judge correctly concluded that the word "shorts" was descriptive **[C/1/67(240)]**.

53. As to the Judge's assessment that the distinctiveness of the 2018 Marks was "low" (see e.g. **[C/1/2(3(ii))]** and **[C/1/33(123)]**), SIL's appeal skeleton does not condescend to any particulars as to why this is said to be in error. The Judge's conclusion is based on the findings the Judge made in the context of the validity of the 2018 Marks. For example, his finding that "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"" **[C/1/27(94)]**. This finding is correct for the reasons explained below in the context of the Respondent's Notice to Google's cross-appeal.

Ground 10: infringement of the 383 Mark

54. Ground 10 is that the Judge erred in his assessment of infringement of the 383 Mark in that "*he failed to carry out any proper infringement analysis, even on a contingent basis*". This is incorrect. The Judge dealt with the question of likelihood of confusion in relation to the 383 Mark at **[C/1/67(241)]**, repeating the reasoning he had given in respect of the 615/649 Marks at **[C/1/67(240)]** but holding that the 383 Mark contained "TV" which was absent from Google's signs which reduced the visual, aural and conceptual similarities further.

Additional grounds

55. There are two additional points that are raised in SIL's appeal skeleton which do not appear in the Grounds of Appeal and in respect of which SIL does not have permission.

56. The first (**[C/4/175(40)]**) is that the Judge failed to address the fact that Google's composite signs incorporated the word "shorts" as an independent distinctive element. This is an attempt to resuscitate an argument that consumers would believe there is co-branding, based on *Liverpool Gin Distillery Ltd v Sazerac Brands LLC* [2021] EWCA Civ 1207; [2022] RPC 5 and *Case C-120/04 Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* ECLI:EU:C:2005:594 [2006] ETMR 13. The Judge considered these cases at **[C/1/49(175)-50(176)]**, in which he noted that:

> "SIL emphasised the point … 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."

57. However, he went on to find **[C/1/67(240)]** that "*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*". This was clearly a finding that there was no likelihood of confusion, of any type, including co-branding. Having cited the case law on which SIL relies and made this finding, it makes no sense to suggest that the Judge failed to deal with this point. This is reinforced by the fact that SIL did not suggest, upon receipt of the Judgment, that there was any material omission in this regard.[10] Indeed, the supposed failure to consider the co-branding point did not even occur to SIL when drafting the Grounds of Appeal.

58. The second argument not in the Grounds of Appeal (**[C/4/175(42)]**) is that the Judge failed to consider the significant proportion of the relevant public to whom "shorts" meant "short films" *and nothing else.* However, the reason the Judge did not consider this is because (as

[10] In accordance with the guidance in *Re: T (A Child) (Contact: Alienation: Permission to Appeal)* [2002] EWCA Civ 1736; [2003] 1 FLR 531, per Arden LJ at [50]

explained at paragraph 34 above) there was no evidence that any members of the public understood that there was only one meaning of the word "shorts" and that this was the only meaning they would understand in the context of Google's use.

Ground 11: reputation for the purposes of s 10(3)

59. Ground 11 is that the Judge failed to find that SIL's Marks had a reputation for the purposes of s 10(3). SIL relies upon two alleged errors: an alleged error of law **[C/4/178(49)]**and an alleged error in assessment of the evidence **[C/4/178(50)]**. However, it is unnecessary to consider these errors because it is plain that the Judge worked on the assumption that SIL did have a reputation under s 10(3) and dismissed the claim for other reasons. This is apparent from the end of **[C/1/72(255)]** (emphasis added):

> "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.**"

60. In any event, SIL's criticisms are misguided. The Judge made no error of law. He properly considered the relevant authorities at **[C/1/68(245)-69(250)]**, including *General Motors Corp v Yplon SA* EU:C:1999:408; [2000] RPC 572 at [26], in which the Court of Justice made clear that "*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.*"

61. At **[C/1/72(255)]** the Judge framed the question as "*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".* This is on all fours with *General Motors.* Accordingly, the Judge made no error of law.

62. Nor did the Judge err in his assessment of the evidence and certainly not by making a finding that is "*rationally insupportable*". As to the specific points relied upon in SIL's appeal skeleton (bearing in mind that the only relevant market is the UK and the relevant date for assessment is June 2021 (see **[C/1/72(255)]**)):

    62.1. **[C/4/178(50(a))]**: Adoption of name, considered by the Judge at **[C/1/19(63)]**.

    62.2. **[C/4/178(50(b))]**: Oscar Nominated Short Films release, considered by the Judge at **[C/1/19(65)-20(68)]**. The Judge found that the evidence relating to releases in cinemas in the UK was "*surprisingly thin*" **[C/1/20(66)]**.

62.3. **[C/4/179(50(c))]**: Other production and distribution activities, considered by the Judge at **[C/1/20(69)]**. He found that there was no evidence as to the revenue generated through these distribution activities in the UK.

62.4. **[C/4/179(50(d)]**: Linear TV channels, considered by the Judge at **[C/1/20(70)-21(71)]**. The Judge found that there was no evidence for viewing figures in the UK.

62.5. **[C/4/179(50(e))]**: Amazon Prime / Video on Demand, considered by the Judge at **[C/1/21(72)-(73)]**. The Judge found that there was "*surprisingly little evidence*" about viewership, with only 1000 monthly subscribers in the UK in 2024 (with the oral evidence confirming that the numbers were likely to be lower in previous years **[C/1/21(72)]**).

62.6. **[C/4/179(50(f))]:** FAST / EST channels, considered by the Judge at **[C/1/22(75)-(76)]**. The Judge found that there was "*no real evidence*" as to the viewership of the Samsung FAST channel **[C/1/21(74)]**.

62.7. **[C/4/179(50(f))]**: SIL's app, Youtube channel, social media and publicity at film festivals, all considered by the Judge at **[C/1/22(77)-23(81)]**. The Judge noted that no UK figures were available for SIL's UK social media handles **[C/1/23(80)]**, there was no evidence about use of SIL's branding at the festivals relied upon prior to 2024, and only "*occasional articles*" mentioning ShortsTV in mainstream newspapers **[C/1/23(81)]**.

63. It is clear from the above that the Judge conducted a careful and thorough analysis of the evidence that was available at trial. That SIL would have preferred him to reach a different conclusion is no basis for an appeal.

Ground 12: s 10(3) dilution

64. Ground 12 is that the Judge erred in failing to find that any of the s 10(3) harms followed. SIL's appeal skeleton only pursues this ground in relation to detriment to distinctive character (dilution/swamping).

65. The Judge set out the relevant legal principles at **[C/1/70(253)]**, including the following principles summarized by Arnold J (as he then was) in *W3 v easyGroup* [2018] EWHC 7 (Ch); [2018] FSR 16 (citing *Intel*) (emphasis added):

"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: [67].

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: [69].

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:** [71].

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: [74].

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:** [77]."

66. The Judge then set out his findings on dilution at **[C/1/72(258)]**. Those findings depended on his earlier assessment of the evidence in relation to the meaning of the word "shorts" (as to which see above) and an application of the relevant legal principles to that assessment.

67. SIL's appeal skeleton does not raise any point of law or principle, it is merely a challenge to the Judge's evaluative decision and/or finding of fact. SIL does not even attempt to grapple with the high standard this requires. All that is said in its submission is that the Judge "*turned a blind eye to the obvious"* and that it is *"not a point that requires evidence…it is a matter of common sense"*. However, this submission is contrary to the case law (in particular points (iii) and (v) of *W3* above) which the Judge had well in mind.

68. The Judge's finding that there was no risk of dilution in this case was plainly right for reasons he gave.

THE APPEAL ON VALIDITY

Ground 2: distinctive character of the 383 Mark

69. SIL contends that the Judge erred in his assessment of the inherent and acquired distinctive character of the 383 Mark in relation to the goods and services in Annex 3 of the Judgement **[C/1/84]** in which he held it lacked distinctive character.

Inherent distinctive character

70. The essence of SIL's challenge on inherent distinctive character is that the Judge ought to have held that SHORTSTV was distinctive on the basis of combining "SHORTS" and "TV", which SIL contends (i) follows a *"well established formula"* of "TV" being used together with a letter or another word to distinguish one channel from another **[C/4/181(55)]**; (ii) gives rise to an "*unusual syntax*" **[C/4/181(56)]**; and (iii) is not descriptive for most of the goods and services in question **[C/4/181(57)]**. SIL does not identify any error of law or principle made by the Judge in this regard. Yet again, this is a challenge to the Judge's findings of fact and his evaluation of the evidence.

71. Points (i) and (ii) can be dealt with together. At **[C/1/27(93)]** the Judge correctly identified the law concerning compound marks, by citing *Case C-363/99 Koninklijke KPN Nederland BV v Benelux-Merkenbureau ("Postkantoor")* ECLI:EU:C:2004:86 [2004] ETMR 57 at [98]-[100]. It makes clear that there are two possible exceptions to the general rule that a combination of two descriptive words remains descriptive:

    71.1. 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

    71.2. 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.

72. The Judge applied these principles to the facts at **[C/1/30(111)–(113)]** finding that:

    72.1. There was not a "*perceptible difference between the word and the mere sum of its parts*".

    72.2. SHORTSTV did not have unusual syntax and this point was supported by SIL's submission that consumers were used to TV channels being named "XTV".

72.3. The evidence did not establish that, without use, consumers would understand "XTV" to refer to a particular channel.

72.4. SIL did not have any effective answer to the point that it contended (in the context of s 46 TMA) that the addition of "TV" did not alter the distinctive character of the 656/649 Marks.

73. SIL's points (i) and (ii) simply repeat the same arguments the Judge rejected for good reasons, not least that they are inconsistent with each other. Further, the Judge's conclusion was made after hearing the oral evidence, in particular, that of Mr Pilcher, SIL's founder and CEO, that the name SHORTSTV was chosen because it "*does what it says on the tin*" and was "*descriptive of what we do*".[11] SIL's reference to the evidence in **[C/4/181(56)]** and footnote 17, fails to refer to this passage of the transcript. It is a classic example of "island-hopping".

74. As to SIL's point (iii) (not descriptive for most of the goods and services in Annex 3 **[C/1/84]** to the Judgment), SIL has failed to identify the goods and services in Annex 3 to which this challenge applies (save for computer software). All that is said, is that even if SHORTSTV is held to be descriptive of *some* goods and services, due to its structure and syntax, it cannot function as a descriptive term for "*most of the goods and services e.g., "shorts is not a characteristic of computer software"* **[C/4/181(57)]**. Again, no error of law or principle is identified. Indeed, no attempt is even made to address the relevant parts of the Judgment on this point.

75. The relevant parts are:

75.1. **[C/1/26(91)]**, where Judge referred to the authorities which establish the principle that the characteristics of goods or services for the purpose of s 3(1)(c) include the potential content or subject matter of the goods or services.

75.2. **[C/1/27(92)]** where he noted that 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).

75.3. **[C/1/30(114)]**, where the Judge stated that he had arrived at his conclusions in relation to each of the groups of categories of goods and services in Annex 3 **[C/1/84]** by using the same approach he adopted for the 656/664 Marks.

[11] [S/15/194] (see pages 134-135 of transcript)

75.4. **[C/1/28(98)-30(109)]**, in which the Judge considered the other goods and services covered by the Marks (i.e. other than "sound, video and data recordings", "cinematograph films", "films for television" and "recorded television programmes", which he considered in **[C/1/27(94)]**). These include computer software at **[C/1/28(99)]**.

75.5. Annex 3 **[C/1/84],** in which the Judge went through all the goods and services for which the 383 Mark was registered and considered its inherent validity for these goods and services. These include computer software in relation to which he said that "*to the extent that these categories of goods include software for accessing audiovisual entertainment the potential to provide consumers with content which they will recognize SHORTSTV as denoting is sufficiently real and significant to be a material consideration*".

76. It can be seen that the Judgment adopted agreed principles of law and applied them carefully and comprehensively to the goods and services in issue, including the very lengthy specification of the 383 Mark. There are no good grounds for criticism of the Judge's analysis.

Acquired distinctive character

77. The Judge set out the relevant law at **[C/1/33(125)-34(127)]**. He correctly referred to the six categories of evidence identified by Arnold J (as he then was) in *W3* at [160] as being relevant to acquired distinctive character **[C/1/34(126(iii))]**, and to the observation of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 306 that "*in the case of common or apt descriptive or laudatory works* ***compelling evidence*** *is needed"* to establish acquired distinctive character (emphasis added) **[C/1/34(127)]**. SIL does not challenge the Judge's summary of the law.

78. Having summarized the evidence of SIL's use (such as it was) in the UK at **[C/1/19(65)-23(81)]**, and identified the relevant legal principles, the Judge then set out his evaluation of the evidence at **[C/1/35(128)]**. SIL does not identify any error in this evaluation. Instead, it contends that "*it would only take a small amount of use for the 383 Mark to have acquired distinctive character*" **[C/4/181(57)]**. This ignores the authorities cited above. Further, SIL says that the evidence of use *"clearly showed that SIL has used the 383 Mark*" **[C/4/182(58)]**. Accordingly, this is an appeal against a finding of fact in respect of which

SIL must show that the finding is one that no reasonable judge could have reached. SIL's appeal skeleton does not even attempt to hit this target.

79. At trial, the parties' rival contentions on the facts were set out in the Table of Use.[12] All of this evidence amounted to *mere* evidence of use, and missed the relevant target, because (i) it did not address the relevant date and/or the relevant jurisdiction; (ii) it attempted to address only one of the categories identified in *W3*;[13] (iii) it demonstrated only minimal use; and (iv) it focussed on how well known SIL was amongst film-buffs and film makers (which is not the average consumer for the purpose of validity). This evidence would have been hopeless even if the 383 Mark was not entirely descriptive. But given the nature of the 383 Mark, SIL would have needed "*compelling evidence*"[14] to show acquired distinctive character and its evidence came nowhere near this standard. In contrast, for the reasons carefully explained at **[C/1/35(128)]** the evidence of use relating to the 383 Mark was extremely thin at the relevant date (8 February 2022):

    79.1. There was no evidence about the number of people who saw the marks in the context of Oscar nominated short films.

    79.2. There were no viewing figures for Amazon Prime Video at the relevant time (save in July 2021, when the viewership was very small).

    79.3. There was no satisfactory evidence to show any significant consumer exposure to SIL's Marks through the EST sites.

    79.4. There is no evidence to show any significant consumer exposure to the SHORTSTV+ APP before 8 February 2022.

    79.5. There was no evidence as to UK subscribers or views of SIL's YouTube channel.

    79.6. There was no evidence to show any significant consumer exposure to SIL's Marks through its social media activities.

    79.7. There was no evidence about the use of its branding in UK film festivals and film schools or the reach of such activities. There was some press coverage (some using "ShortsTV"), but mainly in the trade press.

---

[12] [S/9/94]
[13] At trial there was no evidence of: market share; amount invested in promotion; the proportion of the relevant class who, because of the mark, identify the goods or services as emanating from the proprietor from trade and professional associations; or from an opinion poll.
[14] *British Sugar* at p.306

80. SIL does not grapple with (or even challenge) these findings and it is clear that his conclusion was plainly right (and certainly not one that no reasonable judge could have reached).

Ground 3: fall back limitation

81. Ground 3 challenges the Judge's finding that SIL's proposed fall back limitation to the 383 Mark ("*save for / in relation to short films*") lacked clarity or coherence.

82. SIL criticises (i) the Judge's application of the *Postkantoor* principle **[C/4/182(60)-183(61)]**; and (ii) the Judge's finding that SIL's proposed limitations "*do not go far enough*" **[C/4/184(62)]**.

83. As to point (i), the Judge considered *Omega Engineering Inc v Omega SA* [2012] EWHC 3440 (Ch); [2013] FSR 25 which SIL cites in its appeal skeleton at **[C/1/37(136)-38(137)]**. He does not specifically cite the *MERLIN Trade Mark* (O/043/05), although the paragraphs to which SIL refers are essentially an application of the principles to the specific facts of that case, rather than an analysis of the legal principles, which are set out in *Omega*. Accordingly, there can be no criticism of the Judge's approach to the law.

84. So once again, SIL's criticism boils down to an attack on the Judge's finding of the facts. In particular, the Judge's finding that SIL's proposed limitation identified a characteristic of the goods and services rather than a sub-category of goods and services **[C/1/38(138)-(139)]**. He reached this conclusion for two related reasons.

85. First, he held that there was no clear and consistent definition of "short films" **[C/1/38(139)]**. This was a reference back to his factual findings at **[C/1/18(60)-19(62)]**. In particular that:

    85.1. There was no consensus as to the maximum length of a short film.

    85.2. Nor was there a clear answer to the question as to what makes a piece of audiovisual content of that length a "film":

> "61. … 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."

86. It is of note that even now SIL has failed to give a definition of "short films", merely stating "*short films are short films. Consumers absolutely know them when they see them, and there are even three Oscars categories devoted to them*" **[C/4/183(61)]**.

87. Second, the Judge held that "*[e]ven 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'*"" **[C/1/38(139)]**.[15]

88. This was right and obviously so: The words "*save for short films"* identifies the duration – i.e. a characteristic of the goods/services. This is not a sub-category because the nature, function and purpose of the goods/services is the same. The nature remains audio-visual and the function and purpose remains entertainment. This was made clear in SIL's Trial

[15] The quotation derives from *Croom's Trade Mark Application* [2005] RPC 2, approved by Arnold J (as he then was) in *Omega* and cited at [C/1/38(137)]

Opening Skeleton at [138] where it was said that *"Short films are just like feature films on theatrical release, but shorter"*.[16]

89. As to SIL's point (ii), the Judge found at **[C/1/38(140)]**that SIL's proposed limitations (set out in Annex 1 to the Judgment) did not go far enough because they had not been applied to sufficient categories of goods and services, for example, they had not been applied to "*broadcasting…of…television programmes*". SIL disputes this on the basis that its proposed amendments "*went wider than the core goods and services that could possibly have any direct relationship with "short films"*" **[C/4/184(62)]**.

90. SIL's argument on this point stands and falls with one of its arguments under Ground 2, that the 383 Mark is not descriptive for most of the goods and services in Annex 3 **[C/1/84]**. It is bad for the reasons set out at paragraphs 74 to 76 above. For completeness, we note that the Judge dealt with "*broadcasting and transmission of television programmes*" at **[C/1/29(104)]** and in Annex 3 **[C/1/84]**, where he held that "*the potential for these 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*".

CONCLUSION ON SIL'S APPEAL

91. For the reasons set out above this Court is respectfully invited to dismiss SIL's appeal.

[16] [S/7/91]. See also SIL's oral opening at [S/14/181] (see page 18 of transcript, lines 6-12) "*We say short films or shorts have a run-time that's shorter than ordinary feature films on commercial release and generally have lower budgets, but otherwise share many characteristics of feature films in having actors, scenes, narrative structure and having or aspiring to have professional production values in the way that they're made."*

GOOGLE'S CROSS APPEAL

BACKGROUND

92. To recap:

92.1. The 615 Mark is: SHORTSTV and the 649 Mark is: SHORTSTV

92.2. The 656 Mark is SHORTS and the 664 Mark is SHORTS

Together these are the 2018 Marks.

92.3. The 383 Mark is the word mark SHORTS TV.

92.4. The Judge found that the Marks were valid, save for the 383 Mark, which was invalid for most goods and services, and the other marks were liable to be revoked for non-use for some goods and services **[C/1/2(3(ii))]**.

93. Google's appeal consists of six grounds relating to:

93.1. the validity of the 2018 Marks under s 3(1)(c) TMA (Grounds 1 and 2);

93.2. the validity of the 2018 Marks under s 3(1)(d) TMA (Grounds 3 and 4);

93.3. the validity of the 383 Mark for some goods and services under ss 3(1)(b), (c) and (d) TMA (Ground 5); and

93.4. the question of revocation of the 615/649 Marks for non-use under s 46 TMA (Ground 6).

94. SIL has served a Respondent's Notice which raises additional reasons in relation to Grounds 1-4.

Grounds 1 and 2: s 3(1)(c) and the 2018 Marks

The "figurative figleaf" point

95. The appeal under these grounds concerns a vexed question in trade mark law. The question of what amounts to a "*figurative figleaf*" in the context of the law of invalidity.

96. The Judgment explains how this question arises. In short:

96.1. 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*" **[C/1/24(84)]**.

96.2. 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 **[C/1/25(86(i))]**.

96.3. Marks should not be permitted to pass through the s 3(1)(c) hoop by means of what Arnold J (as he then was) 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*" **[C/1/26(90)]**.

97. We do not quarrel with this summary of the law. However, the problem with the Judgment is that the Judge failed to consider the question of whether the play symbol was only a "*figurative figleaf*" when he analysed the 2018 Marks.

98. The Judge dealt first with the 656/664 Marks (at **[C/1/28(95)-(96)]**) but applied the same reasoning to the 615/649 Marks (at **[C/1/30(109)]**), so there is no need to look at these separately. The Judge correctly found that (i) the font and the contrast between the lettering and the background are insignificant in the context of the mark as a whole **[C/1/28(95)]**; and (ii) the red triangle would be recognized by the average consumer as a play symbol, designating a characteristic of the goods, namely that they can be played **[C/1/28(96)]**. However, he then wrongly held (at **C/1/28(96)**) that:

> "…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."

99. In this passage, the Judge, first, wrongly failed to consider the question of whether the play symbol was merely a "*figurative figleaf*" and/or "*was insignificant in the context of the sign as a whole*". Instead, he placed emphasis on the word "*exclusively*" in the statutory provision, rather than applying the more nuanced approach in *Starbucks* and *FLYING SCOTSMAN*.

100. Second, the Judge substituted the approach to assessment of compound marks from *Postkantoor* set out in **[C/1/27(93)]** (see paragraph 71 above), for the approach in *Starbucks* and *FLYING SCOTSMAN*. However, the *Postkantoor* approach is particularly tailored to a combination of words. Furthermore, even if it is appropriate to apply it to the combination of a pictorial element and a word, the Judge failed to do so correctly. In particular, he failed to take into account the reasoning in *Postkantoor* at [99], that in the case of a word mark, which is intended to be heard as much as to be read, the condition (that it must create an impression which is sufficiently far removed from that produced by the combination of elements) "*must be satisfied as regards both the aural and visual impression produced by the mark*".

101. The Judge failed to consider the aural, visual and conceptual impressions of the marks separately. The final sentence of **[C/1/28(96)]** does not grapple with these matters at all. Indeed, it is very hard to understand quite what the Judge is referring to in this sentence, since it contains no reasoning as to why he took the view that the combination went beyond a mere juxtaposition of the two descriptive elements. Doing the best we can, we assume that the Judge was referring to "*the way in which the two elements are combined*" in the previous sentence, i.e. the fact that the play symbol was within the "O".

102. However, at most, this is a visual matter. It does not affect the conceptual or aural impression given by the marks. The Judge erred in failing to take these into account.

103. A further indication that the Judge did not correctly approach the question of whether the play symbol is "*insignificant in the context of the sign as a whole*" is his analysis of the distinctive character of the 615/649 Marks in the context of s 46 TMA **[C/1/43(154)]**. In this context, the Judge needed to consider whether the addition of the "+" symbol altered the distinctive character of these marks. His reasoning was (at **[C/1/43(154)]**) as follows:

> "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."

104. This reasoning is striking in comparison to **[C/1/28(96)]** for two reasons.

105. First, in notable contrast to the Judge's reasoning relating to the play symbol, the Judge properly considers visual, aural and conceptual impressions.

106. Secondly, it would be inconsistent for the Judge to find that the "+" symbol does not change the character of SHORTSTV, whereas the play symbol is significant in the context of SHORTS and SHORTSTV. The more logical explanation is that the Judge was not applying the correct approach in **[C/1/28(96)]**, as explained above.

107. Had the Judge applied the correct approach to the 2018 Marks under s 3(1)(c) TMA, he would have found that the play symbol, like the "+" symbol, does not alter the distinctive of the marks and is no more than a "*figurative figleaf*" and/or "*was insignificant in the context of the sign as a whole*" because:

107.1. It has no effect on the aural or conceptual impression created by the marks.

107.2. It is hidden within the "O" and would be seen as a trivial figurative element, so would not convey any immediate or lasting impression on the average consumer.

107.3. Insofar as it left any visual and/or conceptual impression on the consumer, the play symbol is itself wholly descriptive and/or would simply reinforce the descriptive meaning of the word "shorts".

108. Accordingly, the Judge ought to have found that the addition of the play symbol was insufficient to imbue the 2018 Marks with any distinctive character such that they were invalid pursuant to s 3(1)(c).

The goods/services point

109. The point raised in paragraph 3 of Google's Grounds of Appeal (which relates to the descriptiveness of (i) "*television games*" and "*electronic games*" in class 9, and (ii) "*publication of computer games*" and "*distribution of computer games*" in class 41) is no longer pursued because it will make no difference to the end result on infringement. That is because SIL did not rely upon the aforesaid goods or services as part of its infringement case (see the Amended Particulars of Claim **[C/12/290(3)])** which is why the Judge did not consider these goods and services in the context of infringement at **C/1/66(235)** to **(237)**.

The Respondent's Notice

110. SIL raises three points in its Respondent's Notice (NB there are two numbered points in SIL's Grounds, but the first comprises two different arguments).

111. First, it is said that the Judge ought to have come to the same conclusion on validity "*by considering the inherent distinctiveness of the word elements of the 2018 Marks for all goods and services for which they are registered, without limitation, and not just the goods and services at [100] and [108]*".[17] In other words, SIL seeks to challenge the Judge's findings at **[C/1/27(94)], [C/1/28(98)], [C/1/28(99)],** and **[C/1/29(101)-(107)]** and **[C/1/30(109)].**

112. These findings are entirely consistent with (i) the Judge's earlier finding as to the meaning of "shorts" (see Ground 1 of SIL's appeal above); and (ii) the case law which provides that the relevant characteristic need only be one that the goods or services "optionally possess" (see **[C/1/26(91)]** and **[C/1/27(92)]**). At trial, Google also made reference to *Puma SE v Nike Innovate CV* [2021] EWHC 1438 (Ch); [2022] RPC 2 at [19][18] which provides that the ground of invalidity must be upheld even if it only applies to a sub-set of the goods or services.

113. In particular:

113.1. Consistent with his findings on the meaning of "shorts", the Judge held that the word "shorts" would be recognised by the average consumer as a description of a characteristic of the goods in the case of "*sound, video and data recordings*", "*cinematograph films*", "*films for television*" and "*recorded television programmes*" at **[C/1/27(94)]**. There can be no basis to overturn this decision, even on SIL's approach to the meaning of "shorts" because the undisputed legal position is that a sign is caught by the exclusion from registration even if only one of its possible meanings designates a characteristic of the goods or services concerned (see **[C/1/25(8(i))]**).

113.2. The Judge correctly found (at **[C/1/28(98)]**) that "*video and audio tapes, cassettes, discs*", "*CDs, DVDs*", "*electronic media*" and "*digital media*" are all carriers of audiovisual content, and these have the potential to provide consumers with content

[17] Respondent's Notice point 1[C/9/273]
[18] This principle was identified in Google's Opening Trial Skeleton at [70] [S/13/177(70)]

which (on that assumption) they will recognise the marks as denoting. I.e. the goods may optionally possess these characteristics.

113.3. Likewise, since "*computer software*" and "*electronic entertainment software*" are both categories that include software for accessing audiovisual entertainment, these have the potential to provide consumers with content which (on that assumption) they will recognise the marks as denoting (see **[C/1/28(99)]**). The Judge correctly held that the position was similar for "entertainment services" (see **[C/1/29(107)]**).

113.4. He correctly made similar findings in relation to "*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*" **[C/1/29(104)]** and "*production, presentation and distribution of films, videos and television programmes*" **[C/1/29(106)].**

113.5. At **[C/1/30(109)]**, the Judge considered the position of the 615/649 Marks and concluded that they were the same as the 656/664 Marks, save that they also included the letters "TV" in red. The Judge was correct to conclude that the addition of these letters did not render these marks distinctive, for the reasons discussed above in relation Ground 2 of SIL's appeal.

114. In summary, the Judge was right to find that s 3(1)(c) would have applied to all of the above goods and services because:

114.1. for each of the goods/services, the term "shorts" will be recognised by the relevant class of persons as a description of one of the characteristics of those goods/services; and

114.2. by virtue of the case law outlined above, such recognition does not need to apply to everything, only to optional characteristics, and only to sub-categories.

115. Second, SIL contends that the Judge ought to have held that the 2018 Marks "*had acquired distinctive character through use for all, alternatively some*", goods and services.[19] This is the same point that is made at Ground 2 of SIL's appeal, but in relation to the 2018 Marks as opposed to the 383 Mark. The Judge dealt with all of the Marks

[19] Respondent's Notice point 1, last sentence [C/9/273]

together at **[C/1/35(128)]** and SIL's point on the Respondent's Notice is a bad one for the same reasons we discuss above in relation to Ground 2 of SIL's appeal. In short, the Judge made a careful evaluation of the evidence before him in light of the relevant legal principles. Given the descriptive nature of the Marks, the evidence of use came nowhere near the standard required to displace their primary descriptive meaning.

116. Third, SIL says that the Judge wrongly held that its proposed fall back limitation lacked clarity or coherence and he ought to have allowed SIL's proposed excision which would have overcome the invalidity objection.[20] This is the same as Ground 3 of SIL's appeal and is wrong for the reasons we set out above under that ground.

Ground 3: s 3(1)(d) and the 2018 Marks

117. As set out at **[C/1/31(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*".

118. The Judge correctly held that:

118.1. the same approach should apply to the word "exclusively" in s 3(1)(d) as in 3(1)(c) **[C/1/32(117)]**; and

118.2. "*"shorts", "TV" and the play symbol had "become customary in the current language or in the bona fide and established practices of the trade"*" **[C/1/32(118)]**.

119. However, he went on in **[C/1/32(118)]** to find that "*[f]or 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)*". In so doing he made the same errors identified above under Grounds 1 and 2, and we adopt the submissions above mutatis mutandis.

Ground 4: s 3(1)(b) and the 2018 Marks

[20] Respondent's Notice point 2 [C/9/273]

120. As set out at **[C/1/32(119)]**, s 3(1)(b) TMA provides that trade marks shall not be registered if they are "*devoid of any distinctive character*".

121. The Judge correctly held that s 3(1)(b) was broader in scope than s 3(1)(c) or (d) **[C/1/32(120)]**. However, in his assessment of the 2018 Marks under this ground he simply said that he saw "*no independent basis for considering the 2018 Marks to be objectionable under s.3(1)(b). … the distinctive character of those marks … arises from the particular combination of the word "shorts" and the play symbol (rendered in red in the "O")*" **[C/1/33(123)]**.

122. This analysis was wrong for two reasons. First, for the same reasons already explained in relation to Grounds 1 and 2 above.

123. Second, because the Judge erred in law by failing to consider whether the 2018 Marks possessed any or sufficient distinctive character to escape the s 3(1)(b) objection as a separate matter.

124. That the s 3(1)(b) objection must be considered separately is clear from *Postkantoor* at [67]-[70] (emphasis added):

> "67. As regards the first part of the question, it is clear from Article 3(1) of the Directive that each of the grounds for refusal listed in that provision is independent of the others **and calls for a separate examination** …. That is true in particular of the grounds for refusal listed in paragraphs (b), (c) and (d) of Article 3(1), although there is a clear overlap between the scope of the respective provisions ….
>
> 68. Furthermore, according to the Court's case-law, the various grounds for refusing registration set out in Article 3 of the Directive must be interpreted in the light of the public interest underlying each of them ….
>
> 69. It follows that the fact that a mark does not fall within one of those grounds does not mean that it cannot fall within another ….
>
> 70. In particular, **it is thus not open to the competent authority to conclude that a mark is not devoid of any distinctive character in relation to certain goods or services purely on the ground that it is not descriptive of them.**"

125. The impact of the meaning of the word "exclusively" in s 3(1)(c) and the interplay between s 3(1)(c) and s 3(1)(b) was considered in *Starbucks*. Arnold J (as he then was) concluded on the facts (at [116]), that if the inclusion of the figurative elements meant that the mark in issue in that case did not consist "exclusively" of the unregistrable word NOW, the mark was devoid of distinctive character and thus unregistrable by virtue of art 7(1)(b) (the equivalent of s 3(1)(b)). The judge's summary of the law ([96]-[97]) was affirmed by Sir John Mummery in the *Starbucks* case on appeal [2013] EWCA Civ 1465, [2014] FSR 20 at [25].

126. Although the Judge referred to this aspect of the decision in *Starbucks* at **[C/1/25(88)]** and **[C/1/26(89)]**, he then failed to give s 3(1)(b) separate consideration. This was an error of law in circumstances where he had rejected the objections under ss 3(1)(c) and (d) by reference to the fact that those statutory provisions use the word "exclusively". Having taken that narrow view of those grounds of objection it was incumbent on him to make a separate examination of the s 3(1)(b) ground.

127. Had he done so, he would have concluded that the 2018 Marks were devoid of distinctive character because the combination of the word "shorts" and play symbol (in red in the "O") did not add anything distinctive to the marks for the reasons set out in paragraph 107 above.

Ground 5: ss 3(1)(b), (c) and (d) and the 383 Mark

128. Ground 5 (which relates to the Judge's finding that the 383 Mark was valid for "*computer games; virtual reality hardware and software content and games*" in Class 9 and for "*publication of computer games; distribution of computer games*" in Class 41 (**[C/1/30(114)], [C/1/32(118)], [C/1/33(123)]** and Annex 3 of the Judgment **[C/1/84]**)) is no longer pursued because the outcome will make no difference to the end result on infringement. That is because SIL did not rely upon the aforesaid goods as part of its infringement case (see the Amended Particulars of Claim [3] **[C/12/290])** which is why the Judge did not consider these goods and services in the context of infringement at **[C/1/66(235)]**to **[C/1/66(237)]**.

Ground 6: revocation for non-use of the 2018 Marks

129. The Judgment explains that:

129.1. The issue under s 46(1)(a) TMA 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 **[C/1/40(145)]**.

129.2. The onus is on SIL to show what use has been made of the 2018 Marks – s 100 TMA **[C/1/40(147(ii))]**.

129.3. S 46(2) allows 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 **[C/1/41(149(i))]**.

130. By the time of closing at trial, the only live issues between the parties on non-use were whether the 2018 Marks had been used for "*computer software*" and "*electronic entertainment software*" in class 9 and "*entertainment services*" in class 41 **[C/1/44(155)]**.[21] SIL contended that use of "ShortsTV+" (i.e. in the form of the 615/649 Marks but with an additional "+") in relation to its app constituted use of the 2018 Marks for "*computer software*" and "*electronic entertainment software*" **[C/1/43(154)]** and **[C/1/44(155)]**. The Judge held that it did, by (i) rejecting Google's challenge to the evidence **[C/1/44(157)]** – this part of the Judge's decision is not in issue on the cross appeal; and (ii) finding that the addition of the "+" did not alter the distinctive character of the 615/649 Marks as registered **[C/1/43(154)]**. It is this finding that is the subject of Ground 6 of the cross-appeal.

131. Google does not dispute the Judge's summary of the law under s 46(2) and, in particular, his findings that:

131.1. 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; [2003] RPC 25) **[C/1/41(149(ii))]**.

131.2. 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

[21] SIL had conceded non-use in relation to Class 9: video and audio tapes, cassettes, discs; CDs, DVDs; television games; electronic computer games; and Class 41: publication of computer games; distribution of computer games see SIL's Closing Trial Skeleton at [148]-[149] [S/8/93]

'global appreciation' of their likely impact on the average consumer (see *Walton* at [122]-[121], citing *BUD and BUDWEISER BUDBRAU* at [45] and Case C-501/15 *European Union Intellectual Property Office v Cactus SA* EU:C:2017:750 [2018] ETMR 4 at [68]-[71]) **[C/1/41(149(iii))]**.

132. The problem is that the Judge's application of those principles at **[C/1/43(154)]** was completely inconsistent with his findings in relation to the play symbol in the context of his analysis of the distinctive character of the 615/649 Marks under s 3(1)(c) at **[C/1/28(96)]**. See Grounds 1 and 2 of Google's cross-appeal above, where we set out the key parts of **[C/1/43(154)]** and **[C/1/28(96)]** in full and explain the inconsistencies between them. One or other must be incorrect. For the reasons explained above, our primary position is that the Judge has erred in his reasoning at **[C/1/28(96)]**. However, if we are wrong about that, then he must have erred at **[C/1/43(154)]**.

133. Further and in any event, the Judge made two errors of law in his analysis.

134. First, by failing to start by considering the very low distinctive character of the mark as registered. The authorities at paragraph 131.2 above make clear that it is only possible to analyse whether the distinctive character of the mark as registered has been altered by first considering the distinctive character of that mark. See also *Sony Computer Entertainment Europe Lt v OHIM* EU:T:2015:950 at [44]-[46] (emphasis added):

> "44. In order to determine whether there is an alteration in the distinctive character of the mark, **it is necessary to assess the distinctiveness and dominance of the elements omitted in the form of the earlier mark used on the basis of the intrinsic qualities of each of those elements and the relative position of the different elements in the arrangement of the mark in the form that it was registered** …."

135. In the case of the 615/649 Marks, the Judge held that the word "ShortsTV" is of very low distinctive character and the distinctive character arises solely from the particular combination of the word "shorts" and the play symbol rendered in red in the "O" **[C/1/33(123)]** (i.e. the figurative elements, which are themselves marginal). This makes it easier for an additional element that itself has distinctive character to alter the original character. Accordingly, the Judge ought to have factored into his assessment the low level of distinctive character of the 615/649 Marks, but his analysis at **[C/1/43(154)]**does not do so.

136. Moreover, the Judge asked himself the wrong question at **[C/1/43(154)]** in that rather than considering whether the "+" sign altered the distinctive character of the mark, he considered whether it was "**significantly** distinctive" (emphasis added).

137. Had he applied the correct test he would have found that the "+" symbol is prominent within the sign (unlike the play symbol which is hidden away within the letter "O") and it has distinctive significance: Specifically, the "+" symbol is a prominent visual element, it has conceptual significance in suggesting that something more is offered, and it adds an additional syllable orally.

138. In those circumstances, he would have found that there was no use of the 615/649 Marks, for "computer software" and "electronic entertainment software". It would have followed from that finding that there was no use of the 656/664 Marks, since use of the 615/649 Marks was all that was relied upon in this regard (see **[C/1/44(156)]** and also the agreement that use of the 615/649 Marks counted as use of the 656/664 Marks **[C/1/43(153)]**).

139. Accordingly, paragraphs 15 and 17 of Google's Grounds of Appeal are incorrect and should refer to the 2018 Marks. Google seeks permission to amend these Grounds and has filed an application to this effect.

CONCLUSION ON GOOGLE'S APPEAL

140. For the reasons set out above this Court is respectfully invited to allow Google's appeal.

LINDSAY LANE KC
JESSIE BOWHILL