

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

SHORTS INTERNATIONAL LIMITED'S
APPEAL SKELETON

Simon Malynicz KC
Daniel Selmi

21 November 2025

Instructed by Sheridans

*References to paragraphs in the form [JX] are to paragraphs in the judgment: [2024] EWHC 2738 (Ch) (the “**Judgment**”), references to documents in the Joint Core Appeal Bundle are in the form [C/tab/page number (**paragraph**)] and references to documents in the Joint Supplementary Bundle are in the form [S/tab/page number(**paragraph**)]. Abbreviations are as they appear in the Judgment.*

1. This is the Appellant's (called "**SIL**", as it is in the Judgment) skeleton argument in respect of its appeal against the Judge's findings that Google did not infringe its marks, and that one of its marks was partially invalid. Permission was granted on four grounds by the trial Judge, and in respect of the remainder by Lord Justice Arnold. Google cross-appeals by way of a root and branch attack on the Judge's findings on validity/revocation of SIL's Marks. SIL filed a Respondent's Notice in relation to Google's cross-appeal. This skeleton addresses SIL's grounds of appeal only, with Google's cross-appeal and the Respondent's Notice to be addressed in SIL's reply to Google's skeleton argument.

Introduction

2. SIL is a producer and distributor of short films, which are commonly called "shorts". SIL was founded in 2000 with the mission to celebrate the art of short storytelling on film and in the years since has become a mainstay in the industry, advocating the short art form, holding the world's largest catalogue of short films and running "ShortsTV" (the first and only channel dedicated to showing short films and associated content). Shorts have several well-known annual festivals of their own (e.g., the London Short Film Festival) but they also gain exposure by having their own sections at major feature length film festivals such as the Short Film Palm D'Or at Cannes. One of SIL's most successful ventures has been its production of the cinematic release of each short that has been nominated for an Oscar that year, by way of its very popular "Oscar-nominated Shorts" programme since 2016, bringing these prestigious works to cinema screens around the globe.
3. In addition to broadcasting ShortsTV, SIL plays a crucial role in distributing short films to streaming platforms like iTunes, Amazon Prime Video, and more, ensuring filmmakers gain exposure and revenue.
4. Despite the efforts and success of SIL, the scale of the short film sector remains modest when compared to the budgets, audience figures, publicity spend and general hype in the feature film industry. Nevertheless, the sector plays a critical role in acting as a breeding ground for breakthrough talent and experimental craft that is not possible within the confines of feature films with large budgets and studio backing. Within this critical and niche sector, SIL justly claims to be one of the major industry players, and its activities have helped maintain this vibrant art form.

5. The Respondent, Google, needs no introduction. Google owns YouTube, the global online video-sharing and social media platform. In 2020, it launched a service for short bursts of content, which was similar to a previous service that it had called “YouTube Stories” – the new name was “Shorts”, sometimes coupled with the brand “YouTube” but very often not. Despite the name, the service did not comprise short films, or “shorts”, as most people knew that term, but rather short form videos created by ordinary members of the public to be consumed on mobile phones (so called user-generated content). The primary attraction of this content is that it allows users to create, share, and interact with videos, and when viewing them, “swipe” (scroll) to the next one if after a few seconds their attention is not engaged. And the next, and the next, and so on.
6. YouTube Shorts came late to the market, with Tik-Tok and Instagram Reels already well established, but it works in essentially the same way. Like most social media platforms, its mission is to keep users engaged, and the longer the better. Although each video lasts no more than a minute and most a good deal shorter than that, that does not mean that users are engaged only for a minute – on the contrary, the endless scroll feature coupled with the algorithms designed to deliver videos likely to be of interest to the user, causes many viewers to watch hours of content on a single occasion.
7. The Shorts service by YouTube has gone on to become very commercially successful. Now, when a Google search is carried out, the results deliver a number of “Shorts” results alongside websites, images and other content, and Google’s use of the name “Shorts” has become all pervasive on the internet.
8. At the heart of this dispute is the question of whether before that tidal wave of use¹, the use of certain signs in relation to YouTube Shorts – consisting of or comprising the sign “Shorts” – infringe SIL’s registered trade marks for SHORTS and SHORTSTV (in various stylised forms), and SHORTSTV (in word). See SIL’s Marks and the Signs at paras. [J23]-

¹ Trade mark infringement is judged at the start of the acts complained of, not later when the infringing use may have obliterated the claimant’s trade marks and present a *fait accompli* for the defendant.

[J29] [C/1/9 (23)-(29)]², one comparison of which is shown below (SIL’s 656 Mark is shown at the top, a YouTube Shorts sign below):



9. The Judge helpfully set out a summary of his conclusions at para. [J3] [C/1/2(3)] of the Judgment, which we have adapted below and cross-referenced to the points in issue on appeal³:
 - a. At [J49] [C/1/16(49)], the Judge noted that the materials in the case “*showed that the predominant use of the term “shorts” was to mean “short films”*”, but that at the relevant dates, “*the meaning of the word “shorts” was not limited to “short films” but also included other short-form audiovisual content*” ([J58] [C/1/18(58)]). In effect, the Judge ruled that short films on the one hand, and user generated content shot in portrait mode on a mobile phone on the other, were simply two species of the same genus shorts, i.e. any audiovisual content that was brief. The Judge’s error of law here was to adopt a “single meaning” rule for “shorts”. It is well established in trade mark law that where the meaning of a sign may mean different things to different groups of consumers, it is legitimate to take the vantage point of any significant proportion of those consumers. The Judge should have taken the view that the dominant meaning, or at least a prevalent meaning, of “shorts” at the relevant time was “short films”. This is SIL’s **Ground 1**. This error was then at the heart of the Judge’s analysis of descriptiveness when it came to what he considered to be the extremely narrow scope of SIL’s Marks, and when it came to infringement under ss.10(2) and 10(3). The error also permeated Google’s honest practices defence.

² References in this skeleton to “SIL’s Marks” are to all five of SIL’s Marks; the four stylised marks are called the “2018 Marks”, and the word mark for SHORTSTV is called the 383 Mark, as in the Judgment.

³ The Grounds of Appeal do not appear sequentially, but are presented in the order of the issues below.

- b. At [J223]-[J229] [C/1/63(223)-64(229)], the Judge held that Google has used the word “shorts” in various ways in relation to the YouTube Shorts service. Some of those uses were wrongly held to be purely descriptive of the type of material on the service. Others, in combination with the YouTube name or logo, or with a derivative logo, were held to act as indications of origin. SIL’s **Grounds 4 and 5** relate to the Judge’s identification of the signs and context, noting that, to a substantial proportion of the relevant public, Google’s Shorts service (capital “S”), was intended to, and did, function as a brand.
- c. At [J232]-[J234] [C/1/65(232)-66(234)], the Judge compared SIL’s Marks with Google’s signs. SIL’s **Ground 6** is that the Judge wrongly allowed distinctiveness to pollute this comparison. At [J230]-[J243] [C/1/65(232)-66(234)], the Judge then held that none of Google’s signs gave rise to a likelihood of confusion under s.10(2), even though he noted that a realistic context for assessing infringement was one where consumers would see another user’s screens with the Shorts feed already open, and where Google’s Signs would be visible without the YouTube name or logo ([J229] [C/1/64(229)]). The Judge noted that whilst there are significant similarities between Google’s signs and SIL’s Marks, the similarities were said to “*concern the aspects which are descriptive rather than those which give SIL’s trade marks their (low) distinctive character*” ([J3] [C/1/2(3)] point (iv)). **Grounds 7-10** relate to specific errors in the Judge’s overall assessment of the likelihood of confusion.
- d. The Judge went on to hold at [J244]-[J261] [C/1/68(244)-73(261)] that SIL’s Marks did not have a reputation for the purposes of s.10(3), but if they did, it was amongst consumers of “short films” alone. On that basis, he held that the similarities between Google’s signs and SIL’s Marks would give rise to a link in those consumers’ minds, but that Google’s uses of the Signs would not cause damage to the distinctive character or repute of SIL’s Marks. SIL contends that the Judge erred on both reputation and that this was a paradigm case of trade mark “swamping”⁴. See **SIL’s Grounds 11 and 12**.

⁴ Whilst SIL’s Ground 12 extends to “tarnishing”, that is no longer being pursued on appeal.

- e. At [J262]-[J280] [C/1/73(262)-77(280)], the Judge considered Google’s s.11(2)(b) defence. He held that Google’s uses of its signs were descriptive and non-distinctive, which again is wrongly based on the Judge having adopted a “single meaning” rule for “shorts”. The Judge then went on to consider whether Google had acted in accordance with honest practices, concluding that it had not. Since Google’s s.11(2)(b) defence failed, SIL does not need to challenge the Judge’s incorrect assessment of the first limb of s.11(2)(b).
- f. At [J281]-[J292] [C/1/77(281)-79(292)], the Judge held that SIL has protectable goodwill associated with its trade marks amongst a limited group of UK consumers, but that Google’s signs do not misrepresent its service as being provided by SIL or in some way authorised by SIL, such that there was no passing off.
- g. Finally, at [J84]-[J162] [C/1/24(84)-45(162)], the Judge held that most of SIL’s Marks are valid, though he held the 383 Mark for “SHORTSTV” to be invalid for most goods and services (see Annex 3 of the Judgment), and that the 2018 Marks should be revoked for non-use for some goods and services⁵. The Judge went on to hold that all of SIL’s 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. SIL’s **Grounds 2 and 3** relate to the Judge’s assessment of the distinctive character of the 383 Mark. SIL contends that the Judge ought to have held that the 383 Mark was inherently distinctive for all goods and services for which it is registered, alternatively, that it had acquired distinctive character through use. Further or alternatively, that the 383 Mark was inherently distinctive or had acquired distinctive character for at least some of the goods or services and/or was distinctive once SIL’s proposed amended specifications were considered (see paras. [J134]-[J141] [C/1/36(134)-39(141)]).
10. Therefore, whilst Google was the ultimate winner, many of the findings in the Judgment can be seen to have been favourable to SIL, including in relation to the validity of most of SIL’s Marks, the similarities between the marks and the signs, the identity and/or similarity

⁵ Google cross appeals the findings on the validity of the 2018 Marks, which marks are also the subject of SIL’s Respondent’s Notice, to be addressed in later skeletons.

between the goods and services in issue, and the fact that Google was not using the Signs in accordance with honest practices.

11. Notably, Google has chosen not to appeal the Judge’s findings on honest practices. The Judge held that Google knew of the existence of SIL’s Marks from August 2020, did not adopt the “Shorts” name in reliance on competent legal advice based on proper instructions, and knew that SIL complained about Google’s use of “Shorts” from September 2020, which was nine months prior to the launch of YouTube Shorts in the UK (see [J278] [C/1/76(278)]). The Judge’s fine-grained analysis of infringement, based on small aspects of stylisation, could not possibly have been in Google’s minds when they were notified about SIL’s Marks, and yet Google pressed on regardless. If Google had something innocent and helpful to say on honest practices, SIL contends that it would have done so.
12. Below, we take some of the grounds of appeal out of order, first addressing the meaning of the word “shorts” (**Ground 1**), since it is relevant to infringement and validity. We then address Google’s infringement of SIL’s trade marks (**Grounds 4-12**), before addressing the validity of the 383 Mark (**Grounds 2-3**).

Meaning of “shorts”

Ground 1 – the meaning of the word “shorts”

13. A lot of the written and oral evidence at trial related to the meaning of the word “shorts”, which the Judge summarised at [J46]-[J57] [C/1/16(46)-18(57)]. SIL contended that whilst the word “shorts” had other meanings (most prominently short trousers), its principal meaning, in context, was to “short films”. There was ample evidence to support that, and it was in fact common ground between the parties that the materials in the case “*showed that the prominent use of the term “shorts” was to mean “short films”*” ([J49]) ([C/1/16(49)]). It was therefore plain that at the time that Google commenced the acts complained of, a significant proportion of consumers would know, and understand that to be, the meaning of “shorts”.
14. That should have been the end of the matter, but the Judge (spurred on by Google) felt required to look for a smattering of examples where “shorts” was used to refer to short-

form audiovisual content that was not a “short film”. To that end, Google’s evidence included the results of various searches (press aggregator database and other documents in evidence), which showed a small number of instances where “shorts” was used to refer to short-form audiovisual content generally. That was very much the exception, and not the rule⁶.

15. In light of that, the Judge concluded at [J58] [C/1/18(58)] that at each of 20 February 2018 and 13 September 2019 (the filing dates of SIL’s marks), and June 2021 (when Google’s acts complained of started), “*the meaning of “shorts” was **not limited** to “short films” but also included other short-form audiovisual content*” (**emphasis added**).
16. To be clear, SIL does **not** challenge the Judge’s factual conclusion at [J58] [C/1/18(58)]. The error lies in the *legal* analysis. The Judge treated the existence of some marginal uncertainty – or the ability, with enough forensic effort, to trawl press archives and find a handful of broader usages – as if this displaced the **core** and overwhelmingly understood meaning of “shorts”, namely “short films”. This was a legal error in that he extrapolated from a few outlying examples to the general meaning when the evidence showed that for many – and we would suggest the overwhelming majority – the term “shorts” continued to mean “short films”.
17. We also note that Google itself admitted that the predominant meaning of “Shorts” remained “short films” despite its diligence in seeking to locate uses that differed from that. This developed into a major legal error in the Judge’s failure at any stage to consider the perspective of a significant proportion of consumers who, being only aware of the predominant meaning, could not possibly consider the word “Shorts” to be descriptive when used in relation to Google’s service.

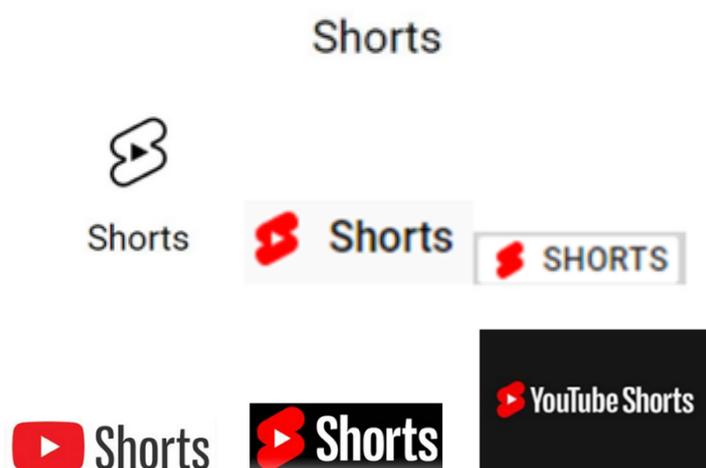
Infringement of SIL’s marks under s.10(2)

⁶ Annexed to its closing skeleton, SIL collated all relevant references to “short(s)”, comprising dictionary definitions, news articles, various internet and other materials. That material was colour-coded to reflect uses of “shorts” as a reference in the context of short films, as a reference to something other than short films, or where the usage was unclear. That is provided in the Joint Supplementary Bundle at [S/10], and perfectly illustrates the point.

Grounds 4-6: Comparison of the marks and signs

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

18. At para. [23] of the Judgment, the Judge rightly noted that SIL complained that the word “shorts” *solus* infringed, as well as all of the uses listed at [J23]-[J24] [C/1/9(23)-(24)], which are shown below:



19. The Judge undertook his assessment of s.10(2) infringement by first identifying the signs and their context at [J223]-[J229] [C/1/63(223) -64(229)].

20. First, the Judge noted that there were instances of “Shorts” being used alone, in the menus of the creator pages, an image of which is shown at [J12] [C/1/6(12)]. As the Judge said, in that case there was no dispute about the sign being used; the dispute was whether it was being used in relation to goods or services. The Judge wrongly held that “Shorts” was being used descriptively to refer to the type of material and so was not being used “in relation to goods or services”. The same applied to the use of “Shorts” on the creation tools page on the mobile app.

21. It is well-settled that use of a sign "in relation to" goods or services means use "for the purpose of distinguishing" the goods or services in question, that is to say, as a trade mark as such: see *Montres Breguet v Samsung* [2023] EWCA Civ 1478; [2024] FSR 13 at [82] (and the cases cited there). The above uses of “Shorts” *solus* were all trade mark usage by Google as the name of its new short form user-generated content video service, created to

compete with the services named “*Tik-Toks*” and “*Reels*” by its commercial rivals, TikTok and Instagram. As such, all of the uses were apt to distinguish and be used as trade marks, quite apart from any allusive meaning the name may also have possessed.

22. Second, the Judge went on at [J225]-[J229] [C/1/63(225)-64(229)] to consider Google’s uses of the combinations shown above, noting that in each case “Shorts” was being used descriptively, but also as part of a composite sign which includes the logo, and which operates as a trade mark. Whilst the Judge was partly right here – “Shorts” was certainly being used as a trade mark – he was wrong not to consider the perception of “Shorts” by the significant proportion of the relevant public to whom “shorts” meant “short films”. For those consumers, the word “shorts” is not descriptive of what YouTube Shorts actually offers. YouTube Shorts is not a curated short-film channel; it is a short-form user-generated content feed. Its only significance in the context of Google’s usage to those consumers is as a trade mark or brand.
23. The Judge then compared SIL’s Marks with Google’s signs in three short paragraphs at [J232]-[J234] [C/1/65(232)-66(234)] (**emphasis added**):

“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”.”

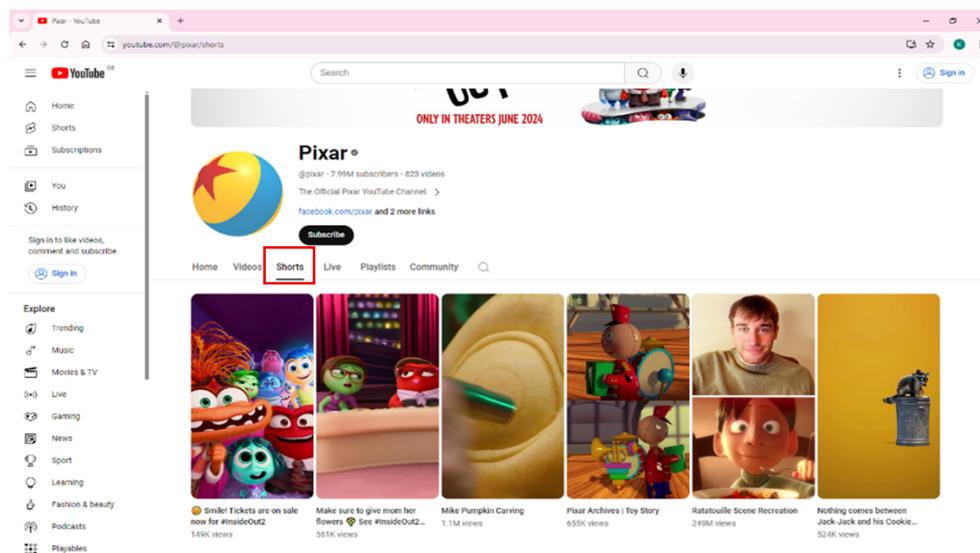
24. The Judge erred as a matter of principle in two key respects.

Ground 4: Failing to compare the sign comprising “Shorts” solus

25. First, at [J23] [C/1/9(23)] the Judge noted that (**emphasis added**):

*“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”.***

26. One example of “Shorts” alone that the Judge had in mind is at [J12] [C/1/6(12)] (see the red rectangle below)⁷:



27. Despite it being specifically pleaded, and despite the Judge saying what he did above, he never actually went on to compare SIL’s Marks with “Shorts” on its own, including when the word “Shorts” was used by Google alongside a wholly separate sign, such as the play symbol logo. That is because he wrongly regarded those sorts of usages as being purely descriptive (which is wrong for the reasons above). SIL contends that the Judge’s fine

⁷ Other examples will be provided in the appeal bundles.

distinctions relating to figurative differences that allowed Google to avoid infringement in respect of its composite usages are wrong (see below), but plainly those sorts of distinctions could not have applied to Google's *solus* uses anyway.

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

28. Second, at [J232] [C/1/65(232)], the Judge erred in the comparison of the marks by wrongly importing considerations of distinctiveness into the exercise, where it had no role, and failing to confine the comparison to the visual, aural, and conceptual similarities. In the last two sentences of that paragraph, it is clear that, rather than limiting the analysis to the visual, aural, and conceptual comparison, the Judge instead assessed the similarities in terms of whether they were “*at a level which differs from that which has given [the marks] their distinctive character*”.
29. In Case C-235/05 P *L'Oréal v OHIM*, an authority cited in countless subsequent judgments, the Court emphasised the importance of not exaggerating the role of distinctiveness in the overall analysis of conflict between two marks. In particular, it stressed the importance of not allowing considerations of distinctiveness to “infect” the comparison of the signs (**emphasis added**):

“40 In the first place, it is settled case-law that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed (see *Lloyd Schuhfabrik Meyer*, paragraph 27).

41 In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (see *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25, and the order in Case C-3/03 P *Matratzen Concord v OHIM*, paragraph 29).

42 **It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.**

43 It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.”

30. This theme has continued in much of the CJEU case law on relative grounds. In Case C-102/07 *Adidas v Marca Mode*, the CJEU warned against “double counting” of distinctiveness. The defendants sought to argue that the public interest in leaving descriptive signs free should be considered at the stage of (the equivalent of) s.10(2). However, the CJEU rejected this argument, clarifying that such considerations are only relevant to s.3(1)(c). Section 10(2) is concerned solely with the similarity between marks and goods, and whether there is a likelihood of confusion in all the circumstances. For good measure, the CJEU further explained that the descriptive defence under s.11(2)(b), while also involving the element of descriptiveness, confines such considerations strictly to that defence.

31. *Adidas v Marca Mode* strongly supports the principle that a finding of descriptiveness/lack of distinctiveness at the validity stage should not be decisive when assessing confusion (including the comparison of marks). Descriptiveness as a concept is not permitted to interfere with the likelihood of confusion analysis, where one weakly distinctive mark may nonetheless infringe another. Moreover, there is a risk of “double counting” if the public interest in descriptiveness is applied both at the validity stage and again at the stage of assessing the similarity of signs. This becomes “triple counting” where the descriptiveness defence, as in Google’s case, is also raised.

32. Perhaps the clearest example is the Grand Chamber’s judgment in Case C-43/15 P *BSH v. EUIPO / KOMPRESSOR* at [58]-[60], where the Grand Chamber of the CJEU said (**emphasis added**):

“58 In paragraph 31 of the judgment under appeal, the General Court observed that to accept BSH’s argument **would have the effect of disregarding the similarity of the marks as a factor in favour of the factor constituted by the distinctive character of the earlier mark, which would thus be given undue importance. The result would be that, where the earlier mark is only of weak distinctive character, a likelihood of confusion would exist only where that mark was reproduced in its entirety by the mark applied for, depriving the degree of similarity between the**

signs in question of any significance. Such a result would not be consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94.

59 Therefore, the General Court held, in paragraph 32 of the judgment under appeal, that BSH's arguments relating to the weak distinctive character of the earlier national marks could not affect the conclusion of the First Board of Appeal of EUIPO as to the existence of a likelihood of confusion.

60 That assessment by the General Court of the likelihood of confusion is not vitiated by any error of law.”

33. Indeed, the notion that the comparison of the marks should not be influenced by distinctiveness considerations has taken root to such an extent that even where the trade mark owner claims a high level of distinctiveness (i.e., a finding of *high* distinctiveness rather than low), that cannot be taken into account in the comparison of the marks. See Case C-115/19 *China Construction Bank v. EUIPO*, in particular at paras. [58] to [62].

34. Therefore, the Judge's assessment of the comparison of marks was flawed as a matter of principle. He improperly imported into the assessment considerations that are relevant only to validity under s.3(1)(b)/(c) and the descriptive use defence under s.11(2)(b). In effect, the Judge held that, because the elements in question were of low distinctive character, there was a need to exclude them in the comparison, essentially “airbrushing” them out of the analysis.

35. Had the Judge not made those errors, on any proper comparison between SIL's Marks and Google's signs, the Judge should have held that SIL's Marks were: (a) highly similar to “Shorts” *solus*; and (b) highly similar to Google's composite signs, in each case based on their visual, aural and conceptual similarities. Those conclusions apply with greater force in respect of the significant proportion of consumers that understood “shorts” to mean “short films”, where Google's use of “Shorts” operates purely as a brand, and where the conceptual meaning for both marks and signs is identical. SIL accepts, of course, that distinctiveness plays a role in the overall assessment of the likelihood of confusion, which assessment we consider below.

Overall assessment of the likelihood of confusion

Grounds 7-9 – infringement of the 2018 Marks

36. These grounds can be taken together, since they relate to the scope of SIL's Marks and the Judge's overall assessment of the likelihood of confusion. The same points overlap with Section 10(3) (as they do in the Judgment) and apply to both Section 10(2) and 10(3) infringements. The relevant paragraphs are [J238]-[J243] [C/1/66(238)-68(243)], set out so far as is relevant, below:

“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. ...

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

37. It is clear from the above that the Judge’s assessment of infringement of the 2018 Marks was in error.

38. First, at [J240]-[J241] [C/1/67(240)-(241)], the Judge erred as a matter of principle by subjecting the marks to minute scrutiny to identify differences in a manner the average consumer would never undertake. This analysis failed to consider the ultimate perception of the average consumer, particularly one faced with a scrolling screen where a very small version of the “Shorts” logo would be presented⁸. In such circumstances, the consumer would likely be unable to discern whether there was a small play symbol within the letter “O,” especially when accounting for imperfect recollection of the earlier mark.

39. The fact of the matter is that, as stated previously, the Judge ought to have held that the marks were highly similar visually, aurally, and conceptually. Each mark contained the word “Shorts” – the only verbal element – and each featured a red play symbol, which the Judge himself had found to be of low distinctive character for media content that is “played.” The Judge’s failure to give proper weight to the identical **word** element was a serious error of approach. It is so well established that, in general, words “speak louder” than device elements that citation of authority is unnecessary—and for good reason. In a case such as this, the identical word SHORTS means that the mark and the sign are identical in all material respects (visually, aurally and conceptually).

⁸ At [J229] [C/1/64(229)], the Judge expressly said “*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*”.

40. Second, the Judge’s analysis failed to address the fact that Google’s composite signs incorporated the word “shorts” as an independent distinctive element. It is well-established that where a composite sign juxtaposes a claimant’s mark (or a similar sign) and a widely known mark belonging to a defendant, there is 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 is no requirement that the overall impression produced by the composite sign be dominated by the common element – in this case “Shorts”⁹.
41. Third, the Judge had in mind a flawed determination of the scope of protection of the 2018 Marks, by wrongly focussing on content (what he described as “the material”) – it is not clear what “the material” is, although it is presumably a reference to the goods and services that the Judge focussed on at [J235]-[J237] [C/1/66(235)-(237)]. Whatever the case, for all goods and services, the Judge wrongly assessed the distinctiveness of the 2018 Marks as being “low” and thereby wrongly factored that consideration into his assessment. Logically, the distinctiveness of SIL’s Marks is not the same for all goods and services, but it also cannot be said to be “low” for any of the goods and services¹⁰.
42. Fourth, the Judge failed to consider the significant proportion of the relevant public to whom “shorts” meant “short films” (and nothing else). That is relevant to the identification of Google’s signs and Google’s brand usage of “Shorts” for that demographic of consumers – and it is also relevant to confusion.

⁹ At [J176] [C/1/50(176)], the Judge cited *Liverpool Gin Distillery Ltd v Sazerac Brands LLC* [2021] EWCA Civ 1207; [2022] RPC 5 at [12] and Case C-120/04 *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, but never applied the principle.

¹⁰ Further, lack of distinctive character must always be justified by reference to specific goods and services in question e.g., Case T-302/06 *Paul Hartmann AG/OHIM* at [40]. In this case, the Judge used general reasoning across the board (see [J94]-[J109] [C/1/27(94)-30(109)]), when the distinctiveness of the 2018 Marks needed to be assessed by reference to the goods and services individually (unless there was some basis or reason for grouping all of them, which there was not).

43. It is now settled that a significant proportion of misled consumers can be sufficient to found an infringement claim¹¹. In the *Interflora v Marks & Spencer* litigation, the judge at first instance found that *most* internet users were not misled by M&S's use of Interflora as a keyword for its advertising. M&S argued on appeal that¹²:

“...the court is faced with a binary question, not a statistical test. It must consider the issue before it from the perspective of the average consumer of the goods or services in question and, from that perspective, answer the question posed by that issue one way or the other. Put another way, in the context of a likelihood of confusion, the average consumer, a hypothetical person, is either liable to be misled or he is not.”

44. M&S therefore advocated for a “single meaning” rule, where the Court had to determine what the view of the average consumer was, and that single view answered the question of whether there was a likelihood of confusion or not. We have already explained why there is no “single meaning” rule, which approach rules out a finding of infringement if only a minority, even a substantial proportion, of consumers are confused. As Kitchin LJ (as he then was, giving judgment of the Court) said in *Interflora CoA* at [129] (**emphasis added**):

“...we do not accept that a finding of infringement is precluded by a finding that many consumers, of whom the average consumer is representative, would not be confused. To the contrary, if, having regard to the perceptions and expectations of the average consumer, **the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then we believe it may properly find infringement.**”¹³

45. In this case, for the significant proportion of consumers that understand “shorts” to mean “short films”, Google were using an identical sign – “Shorts” – as the name of its service, for audio-visual content which is not short films and which far from being a descriptive word, is likely to be seen by those consumers as at best a faintly allusive word (in fact, that probably also applies to those consumers who do not perceive “shorts” as meaning “short

¹¹ See Kerly's Law of Trade Marks and Trade Names (17th edn) at 3-037 to 3-041, summarising aspects of the *Interflora v Marks & Spencer* litigation.

¹² Summarised by Kitchin LJ in *Interflora Inc v Marks & Spencer Plc* [2014] EWCA Civ 1403 at [108] (“**Interflora CoA**”).

¹³ For an example of a case where a likelihood of confusion was found despite the judge concluding that “a majority of consumers will not be confused”, see *Samuel Smith Old Brewery (Tadcaster) v Lee (T/A) Cropton Brewery* [2011] EWHC 1879 (Ch); [2012] FSR 7 at [106].

films” at all). The fact that the 2018 Marks have a relatively narrow scope of protection does not matter: when a mark and sign are virtually identical for the core goods and services, a narrow scope still catches them.

46. The Judge’s overall finding on confusion was tantamount to holding that, for a mark that is weakly distinctive, only an exact facsimile would infringe. Such a conclusion renders such a mark vulnerable to abuse, as infringers could make minor changes to escape infringement. Furthermore, in reaching this conclusion, as mentioned, the Judge improperly imported considerations that are only relevant to validity or the descriptive use defence, which should form no part of the infringement analysis. SIL’s 2018 Marks were held to be validly registered, given the distinctiveness of the play symbol at [J96] [C/1/28(96)], and were therefore distinctive marks when considered as wholes. The Judge should have held them to be infringed.

Ground 10: Infringement of the 383 Mark

47. SIL’s Ground 10 is similar and arises from the same paragraphs above. 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. Had he done so, he ought to have found that the 383 Mark did not have a narrow scope of protection, and that it was infringed.

Infringement under section 10(3)

Ground 11: Reputation for the purposes of Section 10(3)

48. The legal principles on reputation are well-settled (see Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421 at [24]-[27]). Since reputation depends on the nature of the goods and services concerned, and there is no threshold test (or *de minimis* requirement by reference to market share), it has also been described as “*not a particularly onerous requirement*”¹⁴.

¹⁴ Arnold J. (as he then was) in *Sky v Skykick* [2018] EWHC 155 (Ch); [2018] RPC 5 at [307].

49. At [J255] [C/1/72(255)], the Judge found that SIL’s marks did not have a reputation because “*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*”. This was an error of law or approach for the following reasons. First, the principle derived from *General Motors* is that the assessment of reputation is never based on absolute thresholds or rigid criteria. It must always be carried out by reference to the proprietor’s actual business, its competitors, and the market in which it operates. The Judge therefore erred in approaching the matter by reference to the film industry in the round, where even the most successful short-film operator would inevitably appear insignificant. Secondly, the test is not one of general public notoriety. It does not matter whether the average cinema-goer has heard of SIL or its marks. If that were the correct approach, specialist goods and services – no matter how commercially successful within their niche – could never satisfy the reputation requirement.

50. The Judge also erred as a matter of principle in his assessment of the evidence, in that he failed to give the evidence balanced consideration. At [J63]-[J81] [C/1/19(63) – 23(81)], the Judge summarised SIL’s use of its Marks, which points he summarised at [J128] [C/1/35(128)] when considering acquired distinctiveness. Key points going to SIL’s reputation are as follows:

- a. SIL was founded in 2000 to create a foundation for short films, and a short film industry, under the name Britshorts Ltd. It adopted its current name nearly 20 years ago – in 2005. A rebranding exercise in 2017/2018 shifted branding from the use of “Shorts” to “ShortsTV”;
- b. SIL has distributed Oscar-nominated short film compilations since 2006 (being the only company in the world that does so), initially via iTunes and later as theatrical releases in North America (since 2009). UK releases began by at least 2016 and, in 2024 around 30 cinemas showed the compilations, selling approximately 900 tickets (other figures were not available). The Judge accepted that at least some use had been made of the 615/649 Marks at the start and end of the compilations since the re-branding exercise in 2017/2018 (at [J67] [C/1/20(67)]). See also [J68] [C/1/20(68)], where he noted by reference to SIL’s evidence that branding (615/649 Marks) appears on posters and trailers to promote SIL’s Oscar nominated short film compilations, which carry the

615/649 Marks. Furthermore, Battersea Cinema, Riverside Studios and Phoenix Cinemas used SIL's material on their websites, showing the 615/649 Marks, and Chiswick cinema showed such material on a screen in its foyer;

- c. From 2014-2020, SIL's main production activities involved packaging collections of short films for distribution on SIL's own channels (including hosted shows), 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'. SIL's evidence also referred to a short film produced by SIL called Freeze-Frame, commissioned by the Sino-British partnership in about 2014. SIL's evidence 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, and of the use of the 615/649 Marks at the end of compilations of short films distributed through Amazon (notwithstanding that there was no evidence as to the revenue generated through distribution in the UK);
- d. SIL had a linear TV channel on Sky called "ShortsTV" for a little over a year from 2008 and on Amazon Prime Video from November 2020 until late 2022. Whilst there was no evidence of viewing figures for the Sky channel (nor the Amazon Prime Video channel in the UK), SIL's evidence showed that, worldwide, this channel received around 2% of the viewership of the Amazon Prime Video - Video on Demand (VoD) service;
- e. SIL launched its Amazon Prime Video VoD channel in the UK between October 2020 and January 2021 (Amazon Prime being one of the largest subscription services in the world). The Amazon Prime Video channel had the 615/649 Marks visible on the screen in various ways on and between SIL's content, as well as "ShortsTV" being used orally in voiceovers between content. The Judge accepted "*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*" (at [J73] [C/1/21(73)]);
- f. See also [J74]-[J81] [C/1/21(74)-23(81)] for other examples in relation to SIL's FAST channels, EST, SIL's app, SIL's YouTube channel, other social media and SIL's

publicity at film festivals etc., which is all one piece with the evidential picture above showing use of SIL's marks.

51. In summary, SIL's evidence was more than sufficient to show a reputation amongst the relevant public, at least in respect of consumers of "short films", which is the (hypothetical) basis that the Judge went on to assess s.10(3) infringement.

Ground 12: Section 10(3) dilution

52. The Judge also erred in his assessment of "dilution", as set out at paras. [J257]-[J258] [C/1/72(257)-(258)]:

"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."

53. The Judgment on erosion of distinctiveness is difficult to understand, and it is plainly wrong. The Judge turned a blind eye to the obvious, which is that the behemoth that is Google adopted SIL's Marks, aware of those marks and not in accordance with honest practices, and it did so at speed. In comparison to Google, SIL is a bit player (everyone is a bit player in comparison to Google), so of course SIL's Marks have been swamped. This is not a point that requires evidence, and it is a matter of common sense. It is also no good saying, as the Judge did, that SIL's Marks were descriptive, or of low distinctiveness – SIL's Marks represent its brand, and that brand has now been diluted by YouTube Shorts.

Validity of the 383 Mark

Grounds 2 & 3 – Descriptiveness/distinctiveness of the 383 Mark¹⁵

54. The Judge erred in several respects in his assessment of the descriptiveness/distinctiveness of the 383 Mark (including the subsidiary points arising e.g., in relation to acquired distinctiveness and SIL’s fall back amended specifications).
55. First, SIL’s pleaded case was that “SHORTSTV” follows a well-established formula of “TV” being used together with a letter or another word to distinguish one television channel from another and thus to distinguish commercial origin (e.g., ITV, MTV, Fashion TV, LFC TV, UKTV, Zee TV, Racing TV, British Muslim TV, Court TV). In effect, the word “TV” within the 383 Mark (and some of SIL’s other marks) indicates that the mark in question functions as a proper name, and consumers have been educated to understand that formula by exposure to many other TV undertakings distinguishing their channels in that way. That is a paradigm trade mark.
56. Second, SIL also contended that “SHORTSTV” had an unusual syntax, because of the way the two elements are merged, such that there is an ellipsis or brevity to the neologism. That is consistent with consumer perception of the distinctiveness of these sorts of combination – see para. [44] of Case C-329/02 P *SAT.1 v OHIM*¹⁶. It is also consistent with the oral evidence in the case¹⁷.
57. Third, 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 in question – contrary to the Judge’s findings in Annex 3 of the Judgment. The Judge’s analysis is predicated on “shorts” having the single meaning of “short-form audiovisual content”, which meaning he held to be descriptive of specific goods or services e.g., sound, video and data recordings, which could be delivered by televisual means. But that reasoning cannot be applied across the board. Even on the Judge’s analysis, the

¹⁵ Grounds 2 and 3 can be addressed together.

¹⁶ Whilst that does not amount to a proposition of law, as the Judge noted at [J122] [C/1/33(122)], it does accurately reflect how consumers perceive channel names.

¹⁷ See [S/15/187(1064-s)] and [S/18/204(62-716)].

structure of the term “ShortsTV” simply does not suit a descriptive application to most of the goods and services e.g., “shorts” is not a characteristic of computer software.

58. Fourth, at [J124]-[J133] [C/1/33(124)-36(133)], the Judge assessed the acquired distinctiveness of SIL’s Marks and held that none of them had acquired distinctive character (the point only mattered in respect of the 383 Mark, which was held to be descriptive/non-distinctive). Even *if* the 383 Mark was not inherently distinctive when it was filed on 13 September 2019, it could only ever be marginal, such that it would only take a small amount of use for the 383 Mark to have acquired distinctive character in respect of those goods and services as at the later date of 8 February 2022. SIL contends that the evidence of use in this case set out at [J128]-[J130] [C/1/35(128)-36(130)] clearly showed that SIL has used the 383 Mark, and the Judge should have held that it had acquired distinctiveness on that basis¹⁸.
59. Fifth, at [J134]-[J141] [C/1/36(134)-39(141)], the Judge considered SIL’s fallback amended specification in respect of the 383 Mark, which specification excised “short films” from some of the goods and services (see Annex 1 of the Judgment). In terms of the allowability of the proposed amendments, the Judge cited Arnold J (as he then was) in *Omega Engineering Inc v Omega SA* [2012] EWHC 3440 (Ch), which judgment referred to the POSTKANTOOR principle¹⁹. The Judge agreed with Google that the proposed limitations fell foul of the principles in *POSTKANTOOR* and led to legal uncertainty, because he held that: (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”.
60. With respect, the Judge was wrong on both counts:
- a. There are limits to the *POSTKANTOOR* principle. For example, in *MERLIN Trade Mark* (O/043/015) at [27]-[28], Richard Arnold QC (as he then was) sitting as Appointed Person considered an amendment to a specification for various financial services to add “*but not including the provision of venture capital*” and another

¹⁸ See also Ground 11 (reputation).

¹⁹ Case C-363/99 *Koninklijke KPN Nederland NV (POSTKANTOOR)*.

amendment to restrict the specification “*and not including the provision of any such services to the pharmaceutical biotechnological and bioscientific sectors.*”. In allowing both proposed amendments, Mr Arnold QC (as he then was) held at [27]-[29] that:

“27. In my judgment both of the disclaimers offered by the applicant in the present case are free from objection on this ground since they are not disclaimers framed by reference to the absence of particular characteristics of the services but restrictions on the scope of the services embraced by the specification.

28. This is clearest in the case of the first disclaimer, the effect of which is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable.

29. The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be defined in part by the recipient of the service. The opponent’s registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In my view POSTKANTOOR does not make it impermissible to define services in this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively.”

b. Also see Arnold J in *Omega Engineering v Omega SA* [2013] FSR 25 at [43]-[57] (some of which the Judge cited), where he held that it is permissible to exclude a category of goods or services from a specification of goods or services in order to overcome an objection on absolute or relative grounds, but not to exclude goods or services possessing or lacking a particular characteristic or quality.

61. In this case, the Judge should have allowed SIL’s amendments for the simple reason that “save for / in relation to short films” refers to a defined category of goods and/or relates to a defined category of service (rather than a characteristic of the same). Further, words are polyvalent – there is often some uncertainty at the margins, but that does not mean that “short films” lacked a clear and consistent definition. Short films are short films. Consumers absolutely know them when they see them, and there are even three Oscars

categories devoted to them²⁰. Also recall that Google agreed that the materials in the case showed that the predominant use of the term “shorts” was to mean “short films” – so, plainly, Google knew what short films were.

62. Finally, at [J140] [C/1/38(140)], the Judge contended that SIL’s proposed limitations “*do not go far enough*”. In fact, the proposed amendments went too far. Not only are the amendments unnecessary (for the reasons above), but even if SIL is wrong on that, SIL’s proposed amendments went wider than the core goods and services that could possibly have any direct relationship with “short films”.
63. Had the Judge not made the mistakes above, he should have held that the 383 Mark was validly registered, or at worst, was validly registered as proposed to be amended.

Conclusion

64. The Judgment is comprehensive and complicated, but it is also plainly wrong in certain key respects. The Judge’s findings on infringement under ss.10(2) and 10(3) are unsafe and cannot stand. So too the findings that the 383 Mark is largely invalid. SIL respectfully contends that its appeal should succeed in full.

²⁰ Live Action, Documentary and Animation. See also what the Judge said at [J161] [C/1/45(161)], when he considered the scope of “short films” in the context of revocation, and the Court of Appeal’s potential involvement.