

IRELAND / JUDGMENT

# Choice Broadcasting Limited -v- Bauer Audio Ireland Limited

2026\_IEHC\_655

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THE HIGH COURT [2026] IEHC 655 [Record No. 2025/3467P] BETWEEN CHOICE BROADCASTING LIMITED PLAINTIFF AND BAUER AUDIO IRELAND LIMITED DEFENDANT JUDGMENT of Mr Justice Jordan delivered on the 2nd day of October 2026. 1

1. These proceedings were commenced by a Plenary Summons which was issued on 20 June 2025. The plaintiff's claim in the general endorsement of claim is for; – a) A Declaration that the use of the brand name “Greatest Hits Radio” is confusingly similar to the plaintiff's brand-name “Classic Hits Ra- dio”. b) An Order restraining the defendant, its servants or agents, from in- fringing the plaintiff's trade mark “Classic Hits” registered on 9 No- vember 2016 and bearing registration number 257944 on the Regis- ter of Trade marks. c) An Order restraining the defendant, its servants or agents, from using the brand name “Greatest Hits Radio” on the Failte DAB+ Multiplex – and any other delivery platform that is available in the Republic of Ireland – for such period as this Honourable Court may deem fit. d) Damages for trade mark infringement. e) Further or in the alternative an account of profits in respect of the trade mark infringement. f) Damages for passing off. 2
- g) Damages for intentional interference with the economic interests of the plaintiff. h) If appropriate an order for relief pursuant to the European Commu- nities (Enforcement of Intellectual Property) Regulations 2006. i) Interest pursuant to statute. j) Such further or other relief as this Honourable Court may deem ap- propriate. k) Costs. 2. At the reply to query 11(b) in its replies to particulars dated 5 September 2025 the plaintiff says that; – “The plaintiff honed its brand name over the course of 14 years, as follows: 2009: 4 FM 2011: Classic Hits 4 FM (from in or around the end of May 2011) 2018: Classic Hits (transition during Q1 2019) 2021: Ireland's Classic Hits (January 2021) 2022: Ireland's Classic Hits Radio (from August 2022).” 3. In the reply to question 17(e) the plaintiff states; – 3

*“Paragraph 21 of the statement of claim draws a distinction between the plaintiff's brand name and the brand, which is a broader concept. The plaintiff's brand name is ‘Classic Hits Radio’ or in the alternatively ‘Clas- sic Hits’. The brand does include the phrase ‘Ireland's Classic Hits Ra- dio’”. Later in the reply to query 18(b) the plaintiff states; – “The plaintiff's brand name is ‘Classic Hits Radio’ or in the alternatively ‘Classic Hits’. The plaintiff's brand is a broader concept and a matter for expert evidence.” At question 22 the plaintiff is asked to identify what conceptual meaning “Classic Hits Radio” allegedly has, and replies: – “This is a matter for evidence and/or legal argument and not a*

*matter for particulars. Without prejudice to the foregoing, and the following is not intended to be exhaustive, a concept is an abstract idea. Where two things are similar, there may be said to be conceptual similarity between them. The concept at issue in these proceedings is the provision of radio entertainment in the form of a specific type or genre of music (primarily music of the 80s and 90s, with some music of the 2000s and 1970s) aimed at a specific audience (those aged 45+). When two entities do the same or a similar thing, and the second entity uses a similar name ('Greatest Hits') 4*

to the first entity ('Classic Hits'), the first entity may fear that the second entity will 'steal its thunder'. The first entity may fear that the second entity – by virtue of its choice of name – will cause confusion in the minds of the target audience. That is what has happened here. The idea of Classic Hits and Greatest Hits is interchangeable because it is conceptually similar.” In the reply to query number 24 the plaintiff states that its brand name is “Classic Hits Radio”, or alternatively “Classic Hits”. It states that the defendant’s use, or proposed use, of “Greatest Hits Radio”, or “Greatest Hits” would be confusingly similar. 4. The plaintiff delivered an amended statement of claim on 26 January 2026. 5. For context, it is worth setting out part of what is pleaded in the amended statement of claim; – The plaintiff has broadcast a radio station using the Classic Hits brand since in or around 2011, or alternatively 2018 or alternatively 2021 or alternatively 2022. By virtue of its marketing campaigns and long use of the brand, the brand “Classic Hits Radio” has acquired distinctiveness in the Irish radio broadcasting market. The plaintiff registered the business name “Classic Hits” with the Companies Registration Office on 6 December 2018 with the effective date being 30 November 2018. 5

The plaintiff is the proprietor of the trade mark “Classic Hits” (“the trade mark”), bearing registration number 257944 on the Irish Register of Trade marks. The trade mark was registered on 9 November 2016 and published on 2 May 2018. The trade mark registration is and was at all material times valid and subsisting. The defendant is the owner of, inter-alia, the Dublin radio stations 98 FM and Spin 103.8 FM, and the national radio stations Newstalk and Today FM. The Bauer Group and/or the UK entities of the Bauer Group launched a Greatest Hits Radio brand in the UK in around 2019. In or around Q1 and/or Q2 of 2025 the defendant, and/or the Bauer Group and/or the UK entities of the Bauer Group decided to launch its “Greatest Hits Radio” brand in Ireland. 6. The plaintiff then pleads the circumstances in which it said confusion would arise and sets out the basis for the passing off claim and the infringement of trade mark claim. 7. The plaintiff states that it is the owner of the Irish radio station “Classic Hits Radio” and is the owner of the goodwill and reputation associated with the name “Classic Hits” used in connection with radio broadcasting services and/or radio entertainment in Ireland. 6

8. It is pleaded that Classic Hits Radio is the only Irish radio service licensed by Coimisiún na Meán to broadcast to the “multicity area” which comprises Dublin, Cork, Limerick and Galway, as well as counties Kildare, Meath, Wicklow and Clare, and the goodwill in the plaintiff's brand is enjoyed in those cities and/or counties and nationally to those who listen to the service via the station's website, smart phone apps and the Irish radio player. 9. The plaintiff pleads that it is licensed to serve a 45-year-old + audience with a variety of music, news, entertainment and current affairs and uses the slogan “the home of the 80s and 90s”.

It says that the plaintiff's station focuses on music from the 80s and 90s but also plays music from the 70s and 2000s. 10. At para. 21 it has pleaded that since 2016 the plaintiff has been broadcasting music aimed at those aged 45+ in the multicity franchise area and has become synonymous with its name and slogan "Ireland's Classic Hits Radio – the home of the 80s and 90s". For the avoidance of doubt, the plaintiff says its name is not "Ireland's Classic Hits Radio". "Ireland" appears on the plaintiff's logo but the words "Classic Hits" are the largest words in the logo and are coloured so they stand out. "Ireland's" is added to the station's name in jingles, stings and on-air announcements to emphasise the large-scale of the station's broadcast coverage footprint, and to differentiate the station from local radio stations that broadcast to smaller geographical areas. 7

11. The plaintiff says that Classic Hits Radio has generated goodwill not only with listeners but also with advertisers, with numerous local and national advertisers choosing it as a service on which to market their business and products over the past 14 years. 12. The plaintiff points to its significant daily and weekly listeners percentage and to its widespread advertising, promotion and investment in marketing to grow the "Classic Hits Radio" brand and pleads that it has acquired a valuable goodwill in the brand "Classic Hits" and/or "Classic Hits Radio" and/or "Ireland's Classic Hits Radio" and it pleads that the plaintiff's brand name has acquired distinctiveness in this jurisdiction. 13. The plaintiff pleads that by launching "Greatest Hits Radio" and/or "GHR" in Ireland the defendant will represent – whether intentionally or unintentionally – its station as a station which is the same as, or is linked to, or is an offshoot of, the plaintiff's station Classic Hits Radio. It says that this is because the defendant's proposed brand is conceptually similar to the plaintiff's, such as to cause confusion in the minds of the plaintiff's target audience. The plaintiff says that it fears that the defendant's brand will engender the erroneous belief in listeners that "Greatest Hits Radio" is the same as, or linked to, "Classic Hits Radio" and the said representation (and/or misrepresentation) will lead to loss and damage on the part of the plaintiff. 8
14. The plaintiff points in particular to the damage which the confusion between names is likely to cause in the Joint National Listenership Survey and its results. 15. It says that the conceptual similarity of "Classic Hits Radio" and "Greatest Hits Radio" is so close as to be confusingly similar. It pleads that confusion is beneficial to a new entrant to the market and detrimental to an existing brand in the market. 16. The plaintiff pleads that by choosing a confusingly similar brand-name the defendant increases the likelihood of misallocation of JNLR audience figures during the trial period of the DAB+ because the plaintiff's listeners may – owing to the conceptual similarity of the names – respond that they listened to Greatest Hits Radio, even though they listened to Classic Hits Radio, and their listening "vote" would thereby be placed in the category "other", owing to the fact that Greatest Hits Radio is not, during the DAB+ trial period, included on the JNLR survey. 17. The plaintiff also claims that Classic Hits has been a registered trade mark of the plaintiff as well as an established radio brand name in the jurisdiction and the defendant knew or must have known that fact before it sought to launch its UK Greatest Hits brand. It pleads that the

defendant could choose a different name to describe its service and it asks the court to infer that the defendant is – in seeking to broadcast as Greatest Hits Radio and/or an associated branding – seeking to benefit from the audience built up by the plaintiff's established brand.

- 9
18. The plaintiff gives particulars of confusion in the statement of claim, namely – - A confusing similarity arising out of the closeness of the plaintiff's brand name which is established in Ireland and the defendant's brand which is not established in Ireland, - The defendant began to offer the same service (a radio station playing the hits of the 70s through to the 2000s, with an emphasis on the 80s and 90s). - To the same target audience (persons aged 45+). - In a geographical area where the plaintiff had established its brand (at the time of pleading, the greater Dublin area). - The defendant specifically applied for permission for a 45+ radio service, target- ing the very same audience as that cultivated by the plaintiff (and which Classic Hits Radio is licensed to serve). - The brand names Classic Hits Radio and Greatest Hits Radio are confusingly similar because they are conceptually similar. The plaintiff says that the differ- ence in the brand names is not sufficient in and of itself to deter listeners from believing that the defendant's station was from the same stable as the plaintiff's station. Furthermore, the similarity in brand names may, the plaintiff fears, con- fuse advertisers. 10
19. The plaintiff anticipates that, if not restrained, the defendant will use in Ire- land marketing and advertising methods which it has used to promote the defend- ant's Greatest Hits Radio brand in the UK and this will contribute to confusion on the part of the public – and specifically on the part of the listenership targeted by the parties. 20. The amended defence and counterclaim (including an objection) delivered on 3 February 2026 is a robust denial of the allegations made by the plaintiff – in- cluding a challenge to the plaintiff's registered trade mark. The defendant denies, inter-alia, that the plaintiff has established the alleged brand “Classic Hits Radio” in the Irish radio broadcasting market or otherwise. It also denies that “Greatest Hits Radio” is similar, whether conceptually or otherwise, to the alleged or any brand name of the plaintiff. 21. The defendant denies that the alleged brand “Classic Hits Radio” has a repu- tation (distinctive or otherwise) and/or has acquired goodwill. It pleads in the al- ternative that if the alleged brand “Classic Hits Radio” has a reputation (distinc- tive or otherwise) “Greatest Hits Radio” would not take advantage or be detri- mental to it. It also denies that there is any confusing or conceptual similarity between “Greatest Hits Radio” and/or “GHR” and “Classic Hits Radio”. 22. The defendant denies that the plaintiff is the owner of any radio station called “Classic Hits Radio” and it denies that it is the owner of the alleged or any good- will or reputation in the asserted name “Classic Hits”. 11
23. The defendant denies that the plaintiff is the owner of the alleged or any goodwill or reputation in the asserted brand “Classic Hits Radio”. 24. The defendant denies that “Greatest Hits Radio” is confusingly similar to “Classic Hits Radio”. It also denies that it has chosen a similar brand name to the plaintiff's. 25. The defendant denies that there is or has

ever been any erroneous belief or confusion on the part of listeners. 26. In its counterclaim the defendant asserts that the plaintiff's registered trade mark is and has at all times been invalid. It pleads that the sign that is the subject matter of the registered trade mark is descriptive and is thus devoid of distinctive character and as a consequence, the registration was contrary to s.8(1)(b) of the Trade Marks Act 1996. 27. It also pleads that the registered trade mark consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality and/or intended purpose of the services for which it is registered and thus its registration was contrary to s.8(1)(c) of the Trade marks Act 1996. It says that the public will perceive the sign that is the subject matter of the Registered Trade mark as providing information as to the content of the broadcast and specifically that it comprises popular songs ("hits") from an earlier era or time ("classic"). 12

28. The defendant asserts that the Registered Trade mark ought to be revoked pursuant to s.51 of the Trade Marks Act 1996 (as amended). 29. The defendant counterclaims for; – a) A Declaration that the registration of Irish Registered Trade mark number 257944 is invalid. b) Without prejudice to the relief at (1) above, an order revoking the registration of Irish Registered Trade Mark number 257944 pursuant to s.51 of the Trade marks Act 1996 (as amended). c) Further or other relief. d) Costs. The Background. 30. The plaintiff is the owner and the operator of an independent radio station which is aimed at the 45+ demographic. It is the case that since May 2011 it has incorporated the description "Classic Hits" within its brand name. On 9 November 2016 the plaintiff was registered as the owner of the trade mark "Classic Hits". On 13 November 2018 it was registered as owner of the business name "Classic Hits". 31. According to the plaintiff its brand name has evolved to Classic Hits Radio which is the name recorded for the station on the regulator's website. It also uses 13

the name Ireland's Classic Hits Radio. In 2021 the word "Ireland's" was added and later that year the word "Radio" was added. The name is sometimes shortened to Classic Hits – but the evidence shows that this abbreviation has not been sufficiently distinctive. 32. The plaintiff does, as is apparent from the pleadings, seek to distinguish its brand from its brand name – but the simple fact of the matter is that it uses two names for its Radio Station – Classic Hits Radio and Ireland's Classic Hits Radio. 33. There are listenership surveys, known as the JNLR surveys [Joint National Listenership Research] conducted on a routine basis with results published and used widely within the industry. They are especially germane to the important revenue generating advertising aspect of the radio industry. The plaintiff points out that its station is described for the purposes of the JNLR surveys as "Classic Hits Radio". 34. The plaintiff is a successful radio station and it makes the case that it has enjoyed continuing and growing success with its audience currently at an all-time high. It makes the case that its market share is such that it has very obviously developed a substantial reputation and goodwill in its offering. 14

35. The precipitant for these proceedings was the commencement of a new trial licence on DAB + and the intention of the defendant to broadcast on this trial licence of DAB + using the brand name "Greatest Hits Radio". 36. The defendant is an Irish subsidiary within Bauer Media Group. Bauer Radio Limited, another member of the group, operates the "Greatest

Hits Radio” net- work of over 50 local and regional stations in the United Kingdom (including Northern Ireland). This network was first launched in January 2019 in the North of England and the Midlands and it expanded across the United Kingdom in Sep- tember 2020. The national version of Greatest Hits Radio was first made available in Northern Ireland in March 2019 and a Northern Ireland version was launched in September 2023. 37. While the defendant did contend that broadcasts of Greatest Hits Radio from Northern Ireland penetrate across the entirety of the border and, in particular, into Monaghan and parts of Donegal and Dundalk, the evidence to support this asser- tion in the course of the hearing was lacking – to the point that the court is not persuaded that Greatest Hits Radio from Northern Ireland has had or has any fol- lowing or listenership of note in this jurisdiction. 38. It was in 2025 that the defendant decided to participate in the digital audio broadcasting trial (DAB + trial). In addition to its well-known Irish FM stations Today FM, Newstalk and Spin 103 – and another station called Go Loud Radio, the defendant decided to include an Irish version of Greatest Hits Radio as that 15

service would it felt be appealing to the over 45 audience in circumstances where it focuses on music from the 70s and 80s, with the 90s and 60s as secondary eras. 39. The plaintiff objected to the defendant's use of Greatest Hits Radio as it al- leged that this infringed its Irish registered trade mark number 2579444 for Clas- sic Hits (the Classic Hits TM) and/or amounted to passing off. These claims were raised by the plaintiff, and disputed by the defendant, in pre-action correspond- ence. 40. The broadcasting of Greatest Hits Radio on the DAB + network commenced on 16 June 2025 but on 20 June 2025 the plaintiff made an ex parte application to the High Court (Cregan J) and secured an interim injunction restraining the defendant from the broadcasting of Greatest Hits Radio on the DAB + network with effect from 1pm on 23 June 2025. 41. On 23 June 2025 the defendant requested the High Court to direct that the matter proceed to trial on an expedited basis and advised the court that it would instead use GHR as the name of its service. That is the brand name which the defendant has used on the DAB + trial since then. 42. The plaintiff took issue with the use of GHR. It applied to Cregan J to prevent it on the grounds that it was either already prohibited by the interim injunction or should be enjoined by a further order. Cregan J rejected the plaintiff's application in a judgment delivered on 30 July 2025 (2025 IEHC 462) – on the grounds that 16

GHR did not fall within the terms of the interim injunction and, insofar as a fresh injunction was sought, the plaintiff had failed to establish that there was a fair issue to be tried, whether as regards passing off or trade mark infringement. 43. It is the position that the plaintiff persisted with its claims as regards GHR – in addition to the case originally framed as against Greatest Hits Radio – only to clarify that it was not pursuing those claims as regards GHR at the commence- ment of the hearing. In the plaintiff's outline written submissions dated 9 Febru- ary 2026 it did not seek to agitate a case against GHR and it confirmed, in the opening stages of the hearing, that such a claim was not being pursued by it. 44. The plaintiff has articulated its case on two separate fronts – firstly, in relation to the law of passing off and secondly, in relation to the law of trade marks. It says that there is an obvious crossover between the two strands of the case in the evidence and it argues that success in one of the heads of claim should bring with it success in

the other in circumstances where its case rests on the following propositions; – (1) That it has established reputation and goodwill in relation to its brand. (2) That the words “Classic Hits” are the crucial part of its brand. (3) That the defendant’s intended brand is confusingly similar to the plaintiff’s brand. 17

- (4) That if the defendant is not restrained it will piggyback on the goodwill enjoyed by the plaintiff’s brand. (5) That if the defendant is not restrained, the plaintiff will suffer actual or perceived loss of market share as a result of unfair competition as well as loss of advertising revenue. 45. The court will deal in detail with the arguments on both sides later in this judgment. At the outset it is worth observing that a significant aspect of the plaintiff’s case is the extent to which the names Classic Hits Radio and Greatest Hits Radio are likely to be confused – or the extent to which they are confusingly similar as brands. On this point, the defendant points to what it describes as a long-established caveat regarding alleged confusion. The defendant says that the law of passing off does not extend monopoly protection to generic or descriptive terms that have been adopted as part of a brand or trade name. The defendant says that such words remain available for use by other businesses and that it has been repeatedly emphasised that this is so regardless of whether the use of those words by other businesses might cause confusion among the public. The defendant says that such confusion is regarded as an unobjectionable consequence of the plaintiff electing to adopt words that have to be available to others. This is a compelling and persuasive argument which is supported by many authorities. It is an argument to which the court will return. 18
46. An observation also worth making at the outset is that the name which the defendant wishes to use here is an existing name which it has used and is using in the U.K. for some years now. 47. Insofar as the alleged infringement of the trade mark is concerned, the defendant says that infringement does not arise in circumstances where the Classic Hits trade mark ought to be declared invalid and/or revoked for non-use. Law, Arguments and Discussion. 48. The plaintiff contends that this is a remarkably simple case. It argues that the case is in essence a passing off case which turns on name confusion between the plaintiff’s radio station (Classic Hits Radio) and the radio station name which the defendant wishes to broadcast under if not restrained from doing so – Greatest Hits Radio. It points to the evidence of Mr. Mike Ormond (CEO of Choice), who put the plaintiff’s case as follows in his evidence; – “I believe the names are very similar. I believe that there is potential for confusion in the JNLR, when people are asked what radio stations they listen to, the names are just too similar, in my view. I believe there is potential for confusion with advertisers. So the simplest thing in the world would be to use a different name, that doesn’t sound like our name.” 49. The plaintiff points to the three-limb test in passing off cases – known as the classical trinity – which consists of; – 19
- the existence of a reputation or goodwill; - misrepresentation leading to confusion; - in a quia timet case, likelihood of damage. 50. The first question which the court must decide is whether the plaintiff has established the necessary reputation or goodwill. This issue is

perhaps more nuanced than proof of having established a reputation or goodwill attached to the radio station itself – however you call it - when the words “Classic Hits” lie at the heart of the complaint of passing off. The plaintiff’s argument that it is the owner of the Irish radio station “Classic Hits Radio” [which it is] and is the owner of the goodwill and reputation associated with the name “Classic Hits” used in connection with radio broadcasting services and/or radio entertainment in Ireland is not persuasive. This is particularly so if that is intended to convey that it has some monopoly on the use of those words in circumstances where the words “Classic Hits” are descriptive words and when the court is satisfied the plaintiff has not established a secondary meaning. 51. The plaintiff relies on the following exchange between counsel for the plaintiff and the CEO of the defendant, Mr. Chris Doyle; - “Q: Those figures indicate that the station, however you call it, enjoys a reputation and a goodwill as a radio station? 20

Yes. Yes? Yes. Thank you, and, as we have agreed, those figures come from the most recent JNLR, isn't that so? Agreed.” 52. It is the case that the fact of the reputation or goodwill existing in the plaintiff’s radio station is independently supported by the quarterly reports on the JNLR. And it is true that the plaintiff's station name is listed as Classic Hits Radio in the JNLR. Classic Hits Radio is also the name by which the plaintiff's station is registered with the regulator Coimisiún na Meán. 53. The evidence does establish that the plaintiff has a market share of 6.8% in the latest JNLR figures. 54. The JNLR is the authoritative survey in this jurisdiction in relation to radio listenership. It is conducted on a rolling basis (50 weeks a year) and the results are published quarterly. Each publication is for a year but moves forward by a quarter. Approximately 16,750 people are surveyed each year. The JNLR has enabled the plaintiff to provide compelling evidence as to its market share and that Classic Hits Radio is the name used in the JNLR - and with which it is associated. 21

55. The court is satisfied that there is nothing to prevent the plaintiff from enjoying goodwill or reputation in the brand name Ireland’s Classic Hits Radio and in the name used in the survey and elsewhere, Classic Hits Radio. It is the position that all the people surveyed were surveyed by reference to the name Classic Hits Radio. 56. It was established by the evidence that the JNLR survey results are hugely important to the plaintiff and to other radio stations. Radio stations derive their income – or much of it – from advertising revenue. The advertising agencies rely heavily on the JNLR survey results – and understandably so. 57. The latest JNLR book puts the daily listenership of Classic Hits Radio at 7.9% and weekly listenership at 13.8% in the multicity area (all adults aged 15+) with a market share of 6.8%. 58. Since 2021 the plaintiff's station is branded as Ireland's Classic Hits Radio rather than Classic Hits Radio. The plaintiff accepts that on air it runs the words Ireland's Classic Hits Radio up to 30 times an hour and it says that the point of this is to convey size. The station is also known by radio listeners and advertisers as Classic Hits Radio. In reality the station uses both of these names. 59. In his communication to IPSOS on 13 August 2021 (it carries out the JNLR survey) Mr Brannigan of the plaintiff company requested that the station's name in the JNLR be listed either as Ireland's Classic Hits Radio or Classic Hits Radio. 22

60. In all of these circumstances, the court is satisfied that the plaintiff has established a reputation or goodwill as a radio station – whether called Ireland's Classic Hits Radio or Classic Hits Radio. Certainly, in the balance sheet sense in which "Goodwill" is used there is such an asset – and it is not a stretch to say the radio station enjoys a reputation which is of value. However, it would be wrong to conflate the existence of such reputation or goodwill with the existence of a reputation or goodwill having been established by the plaintiff in the words "Classic Hits" as if a secondary meaning had been established by it. These are descriptive words and were not coined by the plaintiff nor did they acquire any secondary meaning or distinctiveness through the use or stewardship of the plaintiff – whether with or without the words "Ireland's" and/or "Radio" added on. Rather, the plaintiff chose to use internationally established and well used descriptive words in the name of its Radio Station. That decision was not without advantages – not least the benefit of an identifier for it in the radio market in terms of the music played. But it also came with disadvantages. One disadvantage is that the use of such descriptive words lacks any distinctiveness or unique quality – and use will struggle to create a secondary meaning. Another is that others are free to use such descriptive words and may well require to do so when describing that very genre of music. A further disadvantage is that Classic Hits and Greatest Hits bear some similarity despite their differences and they are both descriptive terms which might be used to describe what some people regard as similar music – sometimes to similar audiences. 23
61. Thus, while the plaintiff does have goodwill and reputation as "Classic Hits Radio" and/or "Ireland's Classic Hits Radio" the words "Classic Hits" in the names have not acquired distinctiveness or a secondary meaning and the plaintiff must live with the consequences of choosing descriptive words as part of the names. One consequence is the possibility of confusion arising when others use those or similar descriptive words. 62. The next question which the court will address is that of misrepresentation leading to confusion and bearing in mind that the Tort of passing off involves one seeking to pass off one's service as that of another. On this the plaintiff points to the judgment of Lord Oliver in the JIF Lemon case where he stated; – "Secondly (the plaintiff) was to demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff." 63. The plaintiff says that the defendant has sought to – and if not restrained would – use the name Greatest Hits Radio which the plaintiff believes is confusingly similar to its own station name. On this point the court considers that there is a significant difference between both names even though there are similarities. The plaintiff says that it fears that the defendant's brand will engender the erroneous belief in listeners that "Greatest Hits Radio" is the same as, or linked to, "Classic Hits Radio". It argues that confusion between both stations may occur 24

by reason of the similarities that exist between both stations' names – especially amongst those unfamiliar with the stations. On this, the court is satisfied that any such confusion falls into the category of confusion described as mere confusion – and the court will return to this. 64. The plaintiff says that it is worth noting that it is not only the name which will contribute to the

confusion. It points to the fact that the defendant has changed its positioning slogan of its Greatest Hits Radio to “playing the biggest songs of the 70s, 80s and 90s”, which is similar to the plaintiff's “the home of the 80s and 90s”. The plaintiff points to the fact that the defendant's own expert accepted that these were “very similar”. On this point the court understands the latter answer but the court considers the tag lines to be materially different – and this is obvious from an actual comparison. That there is similarity is hardly surprising given the genre/period of music played by both. The court is not persuaded that there is any intentional or unintentional misrepresentation at play. Rather, there is evidence of healthy competition in the marketplace. 65. The plaintiff says that it does not take any issue with fair competition but it argues that the defendant seeks to use the same (or very similar) attributes as the plaintiff (i.e. the playlist). It points to the fact that Mr. Liam Thomson, a person experienced in radio who was called by the defendant, said that 100% of the defendant's playlist would consist of pre-2000 songs but accepted that 76% of the plaintiff's playlist consisted of pre-2000 songs. 25

66. Professor Fahy, Professor of Marketing at the University of Limerick, called by the defendant, expressed the view that: - “Yes, they are similar and yes, there is some similarities in the brand name, and I think almost inevitably there will be some similarities in the music”. 67. Pointing to similarities in the playlists adds little weight to the argument that there is misrepresentation leading to confusion in circumstances where the defendant is perfectly entitled to compete with the plaintiff by playing similar music aimed at the same or largely the same listenership [subject of course to any Licensing requirements]. The plaintiff has no entitlement to a monopoly on broadcasting the music in question to any listenership. It is inevitable that a competitor of the plaintiff will always be situated where similarities in its offering to the listenership can be pointed to. 68. The plaintiff submits that one of the most obvious opportunities for confusion is in the course of a future JNLR survey where both Classic Hits Radio and Greatest Hits Radio would be read out, orally for some of the questions, or being written down on those lists. The opportunity for confusion in such a scenario it says it's obvious – and in its submission is highly probable as a matter of common sense. 26

69. The plaintiff points to the fact that the CEO of the defendant himself confused the two names although he claimed to have done so under the pressure of a robust exchange of views with the directors of the plaintiff. 70. Leaving aside the survey evidence for now, insofar as misrepresentation/likelihood of confusion is concerned the plaintiff says - - The two names consist of three words. - The last two are identical. - The first word of each consists of two syllables. - There is a conceptual similarity between the names and the words are adjectives which can be used interchangeably. - The position statement (tagline or strapline) was changed by the defendant to one which is very similar to the plaintiff's. - The defendant seeks to target the same or a very similar demographic with the same or very similar playlists. 71. It is important to observe that the difference between the look, sound and meaning of CLASSIC and GREATEST militates against the notion that they are similar as words. The defendant correctly submits that the fact that they are both adjectives that have two syllables cannot create visual, aural or conceptual similarity where there is none. 27

72. The defendant relies on the evidence of the expert witness Professor Zuckermann [Professor of Linguistics] called by it and who gave uncontested evidence that aurally “it is very easily noticeable that there is a very big difference” between these words which is “actually much more pronounced in Ireland”. The defendant points out that Professor Zuckermann also gave uncontested evidence that semantically CLASSIC and GREATEST are different. 73. The Court is satisfied that there is a notable difference between the word Greatest and the word Classic and that view is supported by the evidence of Professor Zuckermann. That does not mean there will not be confusion when the names Classic Hits Radio and Greatest Hits Radio are used given the similarities that exist. However, such confusion when it occurs is an unavoidable happening - by reason of the choice of descriptive terms in the names. On its own confusion is not enough to ground a claim for passing off. 74. Leaving aside for the moment the likelihood of what is referred to as mere confusion, the plaintiff also submitted in evidence search results yielded by Google and obtained by Mr. Branigan. On this, it is beyond argument that the search results do establish confusion on the part of the AI robot which produced the results. The robot confused the two radio stations – Classic Hits Radio and Greatest Hits Radio. The plaintiff acknowledges that each person’s search may yield a different AI assisted result but it argues that the important point is that the results such as the ones Mr Brannigan put in evidence are possible – and are sure to generate confusion. 28
75. The AI generated Google search results are incorrect. These limited AI search results do not in themselves carry much weight in terms of the evidence presented to the court. This is because – a) AI assisted search results are known to be unreliable and carry a warning to that effect. b) AI generated material must be treated with caution. c) A court must be careful to avoid AI generated material or information from supplanting its own view if different. d) The court has no idea what percentage of searches on different devices and/or by different searchers would yield a correct or more correct result and clarify the fact that Classic Hits Radio and Greatest Hits Radio are entirely different Radio stations with no connection. e) The court does not know the extent to which the fledgling status of Greatest Hits Radio in Ireland contributed to the results of the searches produced in evidence. Put another way, if Greatest Hits Radio was fully licensed and fully operational and on air alongside Classic Hits Radio would that introduce greater AI clarity? (or indeed the opposite). 29
76. It should also be said that this discussion is somewhat academic given that the court is satisfied that there may well be confusion [mere confusion] because of the use of the descriptive words in the names of the two stations. 77. The court should nonetheless deal with the defendants point that the attribution of high significance to AI results yielded by Google as evidence of actual confusion is hopelessly misguided and involves a serious legal error. The defendant makes the following submissions and refers to a number of Authorities; - According to Lord Oliver in *Reckitt & Coleman* [1990] 1 WLR 491, 499, the second of the three requirements of passing off is that the plaintiff “... demonstrate a misrepresentation by the defendant to the public ...” - A defendant cannot be found liable for passing off in respect of statements made by others over whom it has no control (National

Guild of Removers v. Bee Moved [2016] EWHC 3192 (IPEC), [37]; [2018] EWCA Civ 1302, [31]). - In My Kinda Town v. Soll [1983] RPC 407 the English Court of Appeal over- turned a finding of passing off made in favour of the plaintiff, which operated the “The Chicago Pizza Pie Factory”, against the defendants who operated a res- taurant called “L.S. Grunts Chicago Pizza Company”. According to Lawton LJ (416): “... both the Evening Standard and a widely read weekly magazine called Time Out had referred to both restaurants in ways which could have led 30

readers who rely on those journals for information about restaurants (and probably many do) to think that the two restaurants were connected with one another in some way. If confusion did result from these refer- ences, and it is likely that some did, the responsibility for that confusion was not the defendants'.” - This exclusion the defendant says necessarily applies to the AI assisted Google search results that Mr. Branigan conducted. Bauer bears no responsibility for whatever goes on within that technology or what it generates when used as a search tool. - As testified to by Professor Fahy, AI generates what are referred to as “halluci- nations”, in that it produces “factually incorrect” answers and “... essentially ... makes stuff up ... because AI is coded in a way that if it doesn't know the an- swer, it will try to give you an answer ...” - Importantly, the Court of Appeal has recently taken emphatic judicial notice of AI's flaws. In Guerin v. O'Doherty [2026] IECA 48, Costello P stated ([72]): “... Unfortunately, and perhaps as was to be expected, given the nature of large word model Artificial Intelligence systems, the submissions in- cluded references to authorities which simply did not exist. These were hallucinations, so-called, generated by the AI system. There were no such cases, and they were not authority for the propositions which they 31

purported to establish. This is an inherent and well-known risk of using AI to write legal submissions. ...” Similar concerns were expressed by Allen J in Von Geitz v. Kelly [2026] IECA 29, [148]. - Google itself acknowledges in its Google Search Help that “AI responses may include mistakes ...” and “AI overviews can and will make mistakes”. - Without prejudice to this notorious unreliability, the defendant says that the point is a simple one and does not require substantiation by a witness from Google. The defendant submits that Bauer cannot be visited with any liability because of what Google AI or any other third party may say. 78. The Court accepts as correct the substance of the defendant's submissions concerning the AI generated search results. This finding is along with the finding of the court that some confusion – sometimes referred to as mere confusion – is inevitable when using the two names at issue. 79. The plaintiff correctly submits that there is no requirement for the plaintiff to prove intention on the part of the defendant to hold itself out in such a way as to make people think that it was connected to the business of the plaintiff. However, the plaintiff submits that it is open to the court to conclude that the decision to launch a similar station name, together with the change in the positioning state- ment, and the decision to engage in head-on positioning, does point to a deliberate 32

decision on the defendant's part to seek to appropriate the goodwill and reputation that the plaintiff had built up and was increasing. It makes the point that Mr. Doyle of the defendant company was adamant that there was no such intention but conceded that the defendant had changed its positioning statement (strapline or tagline) to one which was similar to the plaintiff's – and that the defendant had decided to engage in head-on positioning which he described as a standard practice in many industries, not just radio. 80. The arguments of the plaintiff concerning the decisions and alleged deliberate actions of the defendant are not compelling or persuasive. 81. Head-on positioning is, the court accepts, standard practice in many industries and not just in the radio industry. It is an aspect of competition. The defendant did not coin the name Greatest Hits Radio when deciding to use it in this jurisdiction and the evidence does not persuade the court that there was any deliberate decision or action on the defendant's part to seek to appropriate the goodwill and reputation of the plaintiff. 82. Moreover, while there may well be incidents of confusion the court is not persuaded that these are or will be due to a deception or misrepresentation by the defendant. The evidence does not warrant such a finding or any finding of misrepresentation. 33

83. As already touched on, the evidence of confusion is evidence of what is referred to as mere confusion and falls short of what is required to justify a finding of misrepresentation leading to confusion (intentional or unintentional). 84. Such potential for confusion as exists is there because the plaintiff is broadcasting using a name which uses words which are descriptive of music. The words Classic Hits are and have been used routinely in a descriptive way for decades – as have the words Greatest Hits. 85. Turning then to the Survey Evidence which was a significant issue in contention in the course of the hearing. The law in this Jurisdiction is quite well settled in so far as such evidence is concerned. 86. In *Galway Free Range Eggs Costello J.* in the Court of Appeal referred to *Hanafin v. Minister for the Environment* [1996] 2 I.R. 321 and *Jordan v. Minister for Children and Youth Affairs* [2015] 4 I.R. 232, both of which addressed the admissibility and evidential value of survey evidence and stated; - “Survey evidence is admissible in passing off claims to prove the opinions of members of the public on matters as to reputation or the likelihood of confusion. The weight to be attached to such evidence is a matter for the court. In assessing the weight of the evidence, the court should have regard to whether a relevant group was surveyed. So, if consumers were surveyed when the survey should have been of pharmacists, the court likely will 34

attach little weight to the evidence derived from the survey. The reverse should also apply and greater weight should be given to surveys of the relevant group of people or businesses. An assessment of the adequacy of the methodology employed in the survey will be significant in weighting the value of the evidence adduced based on the survey. If there are weaknesses in the methodology, the results of the survey are unlikely to be accorded much weight....” 87. The plaintiff adduced survey evidence of likely confusion in relation to the station name. 88. In doing so the plaintiff emphasized that the law does not require evidence of actual confusion. It referred to the judgment of *McMenamin J* in *McCambridge*, in the context of a tangible product passing off case: “The critical point is whether the presentation or packaging of the product leads, or is

likely to lead, the public to believe that another manufacturer made the product in question. Is the misrepresentation likely to cause confusion in the minds of consumers?” 89. The plaintiff accepts that mere confusion on its own does not mean that there is actionable passing off. The key is whether the defendant’s proposed use of Greatest Hits Radio in connection with its proposed radio offering is likely to be taken as a representation that the station has some connection with the business 35

of the plaintiff, thus giving rise to the risk of harm to the goodwill and reputation which the plaintiff is entitled to protect. 90. On this latter point the court is not persuaded that the defendant is guilty of any representation or misrepresentation as alleged by the plaintiff. 91. The plaintiff referenced the Supreme Court decision in *McCambridge*: “For the threshold to be met, it is sufficient that a defendant represents its goods in such a way that it is a reasonably foreseeable consequence that the claimant’s business or goodwill will be damaged. As outlined earlier, proof of intention to deceive is not required. A claimant may prove misrepresentation by calling evidence that the relevant public were in fact confused, but may also succeed in a case where there is no such evidence... The test is...the impression likely to be produced, on the likely customer, taking into account customer perception and imperfect recollection (see *Singer Manufacturing Company v Loog* (1882) 8 App. Cas. 15 at 18 and *HFSC v Midland Bank* [2000] F.S.R. 176 where Lloyd J. emphasised that the level of prudence and the care of the customer depended on the transaction in contemplation. This latter qualification is also material here.” 92. This is why – in the plaintiff’s submission – the answer to Q6 in the survey is so important. 93. The key findings of Ms Rountree’s survey were that: 36

- 67% of people believed the two station names were “likely” to be confused. - 16% of people (or 1 in 6) believed they had listened to Greatest Hits Radio in the past six months (though this was unlikely because it had only been on DAB+ in the Dublin area for 7 days in June 2025). The survey asked (leaving aside initial screening-type questions) five questions, the first two were of a preliminary nature, aimed at finding out whether the respondents were reasonably familiar with Irish radio (Q1: “How often do you listen to radio?” Q2: “Which of these radio stations have you ever heard of?”). 94. The defendant did not commission its own survey. According to Bauer’s CEO, it “wasn’t something that I considered”. The plaintiff invites the Court to draw an inference that Bauer was wary of commissioning one because it was conscious that the question of name confusion between the two was so obvious. But the plaintiff says that the Court does not have to make that inference to determine whether the plaintiff’s survey is useful. 95. In so far as the suggested inference is concerned the court considers it likely that the defendant did not commission its own survey because it concluded that survey results might not be of assistance to it. And that is a logical conclusion given that the two names bear some similarities and any survey results are unlikely to suggest otherwise. Furthermore, the court considers that any survey results would probably suggest a likelihood of confusion between both names - 37

given that descriptive terms are used and similarities exist. Put another way it is likely that any survey results would confirm the likelihood of what is referred to in the case law as mere confusion. 96. The plaintiff relies on the judgment of Laddie J in *Associated Newspapers v Express Newspapers* [2004] IP & T 378. In that case, the claimant's Daily Mail and Mail on Sunday were commonly abbreviated to "the Mail". This contributed to a finding that the defendants' proposed titles (The Evening Mail and The London Evening Mail) would deceive the public. The Court accepted that the defendant's titles would almost inevitably be abbreviated to the Mail as well. It was important that in London – i.e. in a defined part of the UK, not across the entirety of the UK – "Mail" on its own was sufficiently distinctive of the plaintiff. Other newspapers did have "Mail" in their titles but none of those papers had significant circulation in the London area. 97. *Associated Newspapers* was a quia timet action (in passing off and trade mark). The defendant accepted that the plaintiff had substantial goodwill in the titles Daily Mail and The Mail on Sunday but not that there was any reputation in the title "The Mail" simpliciter in relation to any type of newspaper. 98. The plaintiff relied on survey evidence, which was trenchantly criticized by the defendant. Copies of the defendant's dummy newspaper bearing the name Evening Mail were shown to members of the public who were asked: "This is a 38

newspaper that is proposed to be launched in London. Have you any idea who is going to publish it?" A significant number mentioned the Daily Mail. 99. The defendant had said of the survey that it was "so riddled with defects as to be worthless.". 100. Laddie J accepted that some of the criticisms of the survey were justified and even the plaintiff conceded that there were weaknesses with its survey but it maintained that the survey was "still useful in giving a snapshot of the likely views of members of the public". Laddie J agreed, stating: "Notwithstanding the defendant's criticisms, the survey does give a feel for the reaction of members of the public to the defendant's proposed newspaper. This is not a case where the customer will take a lot of time and care over his purchase. On the contrary, the defendant's product will be given away free. The outcome of the survey accords with one's expectations." 101. In so far as the case is concerned, it is apparent that the "the Mail" or the word "Mail" had acquired distinctiveness through use over many years. The plaintiff there could in effect point to a secondary meaning which Choice has not succeeded in doing here. 102. It is correct that the Court does not require a standard of perfection in order to rely on survey evidence which is adduced in evidence. On this the plaintiff points to the judgment of Clarke J. (as he then was) in *Jordan v. Minister for 39*

*Children and Youth Affairs* [2015] 4 IR 232 where he stated, in the context of a challenge to survey evidence adduced in that case: "277....it is important to keep clearly in focus the precise question with which the court is concerned in any particular case. Many disciplines (not least the social sciences) have appropriate protocols for the conduct of research and for reaching conclusions based on that research. It would, indeed, be foolish for any court which is asked to take such evidence into account not to have regard to whether relevant protocols or recommended practises were complied with. But it must be recalled that the task of a court is not the same as the task of those charged with considering whether, for example, an article should be published in a learned peer review journal. A court is required to make a decision on the facts and is invited to take certain evidence into account in assessing those facts. The precise, factual

question which the court may have to address may not raise exactly the same as the issue which might typically be required to be addressed in a journal article. A lack of compliance with what some might consider to be best practice might legitimately lead to an article which reflected the results of relevant research not being accepted for publication. But provided that a court is of the view that the findings were of some assistance in determining facts which needed to be found to decide the case, then the court should consider those findings while, of course, taking into account, 40

in considering the weight to be attached to same, any substantiated criticism of the methodology or analysis.....The question is not whether there might, theoretically, have been better evidence. There almost always will. The question is whether there is enough". Ms Rountree's survey does give a feel for the reaction of members of the public on the confusion issue. Responses were received from 1,081 people in the area where the plaintiff broadcasts its station. The questions were quite straightforward. The most important of the questions, Q6, asked: "Which, if any, of these radio stations is likely to be confused with the radio station CLASSIC HITS RADIO" (a list of stations followed). 103. This is the question to which 67% of respondents replied "Greatest Hits Radio". The plaintiff again emphasizes that it does not have to establish that substantial numbers of listeners will be confused. The evidence suggests that, but the test the plaintiff must meet is to demonstrate likelihood of confusion without putting a number (or a percentage) on it. The plaintiff refers to McCambridge, where McMenamin stated: "The test is not dependent on numbers". 104. As the defendant decided not to carry out a survey of its own the expert evidence it called [Mr. Graham Williams – a Research Director at Dynata which is a global data and research insights company] was limited to criticisms of the manner in which the questions had been asked. In the words of Clarke J above, 41

this Court must take "into account, in considering the weight to be attached to same, any substantiated criticism of the methodology or analysis." 105. Mr. Williams placed great significance on the absence of questions which asked respondents to explain why they answered the way they did. This was the way Mr. Williams approached both Q4 and Q6. 106. The plaintiff submits and the court agrees that this criticism falls into the category, referred to by Clarke J above, of asking whether or not there might have been better evidence. The plaintiff was not concerned with why people might confuse the two names - the plaintiff cared whether or not the names would be confused. 107. The same can be said of other criticisms of the survey. It is probable that it could be improved upon in order to give more information and provide better evidence. But nonetheless it is evidence of some value to the court. 108. It was put to Mr. Williams that the key elements of Q6 which prevented it from being biased was the inclusion of the words "if any" and the option, in the answers, of "none of these". 109. The plaintiff submits that Mr. Williams tenaciously held to the view that – "the wording is just likely to confuse". Again, Mr Williams wanted a 'why' question to follow Q6 ("Why did you say that?"). The problem was the absence of a follow-up 'why' question ("...it's something that you could leave that question 42

there as it is. But because you haven't established why they have said that, this is the key part that I am trying to say more often than I care"). 110. On this point, a "why" question would likely have been of assistance to the Court. And the answer of the 67% to a why question would surely have been that those two names were the most alike of those presented. 111. Mr. Williams also believed the survey was flawed because there was not enough testing of the respondents' awareness of radio stations in general (and specifically of Greatest Hits Radio). The plaintiff says the aim was to test whether or not there could be confusion between the names and this did not require any knowledge or prior awareness of radio stations. It was a straightforward question which any person, whether radio-listener or not, could answer. 112. On this the court considers the criticism warranted. A thorough questioning of awareness of radio stations is pertinent in the context of the results. The court considers that the extent of awareness of Classic Hits Radio and Greatest Hits Radio (i.e. what one knows of them) is a worthwhile enquiry if one is trying to establish the likelihood of listeners confusing both stations. But this is again looking at improving the survey and its results. Such criticisms do not render the survey results invalid or to be disregarded. 113. The court will also say that it is not persuaded that regular listeners of Classic Hits Radio and regular listeners of Greatest Hits Radio are likely to be confused 43

as to which is which - if and when Greatest Hits Radio is also on air for a while in this jurisdiction. But this is peripheral to the issue if confusion by reason of deceit or misrepresentation is likely to occur - as one is not concerned with numbers. 114. It was put to Mr. Williams that the 67% was as high as it was because "perhaps the answer is obvious" and he replied: "It might be. I don't know." On this the question posed - whatever about the answer - accords with the view of the Court and accords with common sense. It seems to the court that the answer to the question is obvious as the two names were by far the most similar of those presented. But that goes no further than provide survey evidence of mere confusion. 115. The plaintiff submits that the correct test for the broader issue which the Court must decide in this case was articulated by the Court of Appeal in *Galway Free Range Eggs* as follows: "Is there a real likelihood that the public would get an impression of a connection between the business of the [plaintiff] and the business of the [defendant]?" The evidence may be assessed by reference to the name alone." 44

On this one must also bear in mind the requirement to prove misrepresentation. No misrepresentation - whether intentional or unintentional - is proved here by the plaintiff. 116. The third feature of the passing off test is the question of damage. If there is no prospect of damage, then there can be no cause of action for passing off (Wadlow *The Law of Passing Off*, 6th Edition, 2021 at 4-1). The appropriation of the goodwill which would take place if the defendant was not restrained is what constitutes the damage necessary to sustain an action for passing off. It is not necessary that the plaintiff prove actual damage. This was made clear in the *Galway Free Range Eggs* case. In that case Costello J stated; - "The trial judge concluded his judgment by saying that, although not particularly relevant, the suggestion of confusion had not resulted in damage to the claimant's goodwill or reputation. It appears that he was of the view that it was necessary for the appellant to prove that it had suffered actual damage in order for it to succeed in its claim against the respondents. It is not, in fact, necessary for the plaintiff to show that it has actually sustained damage in order to obtain injunctive relief restraining passing

off in a case such as this. This is clear from the decision in the Kilkenny Brewing case: neither company had commenced to trade and the plaintiffs in that case did not allege any damage had yet been sustained. The claim was a classic quia timet case. (Paragraph 54)". 45

117. Costello J (at para. 56) went on to refer with approval to *Falcon Travel Ltd v The Owners Abroad Group plc* [1991] 1 IR 175 where (at p.182) Murphy J noted that a plaintiff must show "damage or likelihood of damage" where "dam- age" in this context is understood as the "appropriation of goodwill" as opposed to a need to show any financial or other harm caused. 118. The plaintiff did show that the consumers of radio are the people who listen to it but they are not actually the customers of radio in the sense that they are not the people who directly generate the revenue. For commercial radio, almost all of its revenue – in excess of 90% for the plaintiff – is generated by advertising rev- enue. In evidence Mr. Brannigan explained that the business model of the station was at all times and continued to be to generate money from advertisement reve- nue. 119. Mr. Ormond sets out his concerns in relation to damage at para. 32 of his witness statement (which he adopted as his evidence): - "I believe the similarity in names between Greatest Hits Radio and Classic Hits Radio has the potential to cause confusion amongst people who ad- vertise on Classic Hits Radio. This could result in a problem not just in respect of the advertising sold through Media Central Ltd... but also with direct advertisers. In the mind of most advertisers they have decided that Classic Hits Radio attracts the demographic they wish to sell to and put little thought into their advertising choice past that. This is particularly 46

true of large brand advertisers who advertise across all forms of media. It does not take much imagination to think that a client reviewing a media schedule for a number of different radio brands could easily mistake "Classic Hits Radio" for Greatest Hits Radio". We have a legitimate fear that media campaigns that were designed for Classic Hits Radio finish up on Greatest Hits Radio with the advertising client barely noticing. If this was to emerge as a pattern it would not only be disastrous for Classic Hits Radio but also for advertisers who may find themselves unwittingly adver- tising to a much lower listenership". 120. It is the plaintiff's belief that the defendant will, if not restrained, ultimately see Greatest Hits Radio on the JNLR listing, be it via the DAB+ or otherwise. Mr. Ashmore gave his view that the JNLR would have to include DAB+ stations on its questionnaire sooner or later: - "Well, for the JNLR to remain of value, to remain credible, and to continue to meet its objective of measuring radio listenership in the country it would be doing itself a disservice and would reduce its own value if it excluded certain stations just because of the platform they broadcast on." 121. There was evidence before the court from Mr. Doyle that Onic, a Murdoch owned group, had already agitated for the inclusion of DAB+ stations on the JNLR. 47

122. The court considers it likely that, if permitted, Greatest Hits Radio will ulti- mately appear on the JNLR listing, be it via the DAB+ or otherwise. The court is satisfied that the JNLR will likely expand in the future to encompass DAB+ sta- tions. 123. The court has above dealt with the potential for confusion and the conse- quence of the use of descriptive words. And such confusion may arise in the fu- ture JNLR Surveys, amongst listeners and amongst

advertisers - but if it does it is of the mere confusion variety. 124. Amongst the issues debated in the course of the hearing was a contention by the plaintiff that the defendant's radio offering could possibly be viewed as inferior to its own because it had more pre-recorded content and because it had what the plaintiff feels is an undesirable feature in the form of paid entry competitions which the plaintiff felt was the introduction of gambling streams of revenue into radio. These points were disputed by the defendant. Insofar as these issues are concerned, the court accepts that the plaintiff considers pre-recorded content as inferior and does not consider gambling streams as such appropriate for radio. It does not wish to be associated with such a radio format. These are valid opinions which the plaintiff is entitled to hold. However, the paid entry competitions, and perhaps to a lesser extent the amount of pre-recorded content, are also distinguishing features between the plaintiff's offering and that of the defendant. 48

125. The defendant submits that the law of passing off is much more sophisticated and balanced than the plaintiff asserts. The defendant does not agree with the plaintiff's contention that this case "is a remarkably simple case". 126. In this regard, the defendant relies heavily on the decision in *Office Cleaning Services v Westminster Window and General Cleaners* [1946] 63 RPC 39 which the defendant says is an important policy driven limitation on how far the tort can go. 127. Insofar as what goodwill means in the context of passing off the defendant submits that contrary to the plaintiff's submissions it is not a matter of whether the plaintiff has "reputation or goodwill in its radio station" but rather – under the first limb of Lord Oliver's test in *Reckitt v Coleman* – some "... identifying... brand name or trade description...". In *RJ Reuter v Mulhens* [1954] CH.50 at p.89 Evershed MR stated: – "The nature of goodwill has been many times stated; it represents in connection with any business or business product the value of the attraction to customers which the name and reputation possess." 128. The defendant submits that with passing off, goodwill is not to be confused with the value of a business or the size of its clientele per se. The defendant points to *Muckross Park v Randles* [1995] 1 IR 130 where at p.137 Barron J stated; – 49

*"Goodwill is a term used in some of the reported cases. However it seems to me that reputation is a more correct word in the context of passing off. Goodwill is essentially a balance sheet term. It is an intangible asset. It is in my view, inter-alia, the additional sum which will be paid for premises to carry on a particular business there which has either now or in the past been carried on and which will accordingly have a fund of customers already in existence. The value in the name is in the same position. Its importance lies in the number of people who know it and what it stands for."* 129. In this regard, the defendants submit that the plaintiff's selected quotation from the cross examination of Mr. Doyle is erroneously presented as an admission that Choice satisfies the legal test of sufficient goodwill for passing off. It says that the defendant makes no such concession. 130. The defendant submits that when one has regard to the full extent of what Mr. Doyle had to say regarding the JNLR and, in particular, that he could not extrapolate an audience number out to goodwill, then it is clear that his testimony does not bear the interpretation put on it by Choice. 131. The court accepts that the defendant did not in fact concede this point. 132. The defendant goes on to argue that it is immaterial that it might be said that the plaintiff's business points to goodwill as a radio station with a particular

*level of listenership as that does not amount to relevant goodwill in a name or brand.* 50

The defendant says that other factors, such as the personalities of particular pre- senters and their programme formats, may be responsible for the draw to a radio station and contribute to its goodwill in the balance sheet sense. 133. On this, the evidence does show the evolution of the name or names of the plaintiff's Radio Station. The name has changed over the years and the point has now been reached where in reality it has two names – Ireland's Classic Hits Radio and Classic Hits Radio. The use of two names erodes somewhat the weight of the asserted name or brand for which protection is sought. And it is also true that the goodwill and reputation of the plaintiff's Radio Station involves more than its name or names. 134. The defendant goes on to submit that when it comes to the proposition that there is nothing to prevent the plaintiff from enjoying goodwill or reputation in both Ireland's Classic Hits Radio and Classic Hits Radio the problems are two- fold. It says that the former is still denied in Choice's pleadings and the latter is not supported by evidence of recognition within the market as no listeners or ad- vertisers were called to give evidence – thus leaving the plaintiff having to fall back on references used by the JNLR and Coimisiún na Meán. 135. The defendant points to what Mr. Brannigan advised IPSOS in his email of 13 August 2021 – “We now brand the radio station as Ireland's Classic Hits Radio rather than Classic Hits”. The defendant also points out that Mr. Brannigan also asked Playout One (a provider of voice-activated software for Alexa) to change 51

the station's title from Classic Hits Radio to Ireland's Classic Hits Radio. Mr Brannigan explained this by saying: “... We were branding on air as Ireland's Classic Hits Radio and if members of the public were asking it to play the radio station name they would most likely ask it to play Ireland's Classic Hits Radio...” 136. In these circumstances the defendant says that there is a fundamental incon- sistency at the heart of the plaintiff's case. The defendant says that the evidence shows that during its own broadcasts it presents itself as Ireland's Classic Hits Radio – yet the plaintiff contends that it can also have goodwill in Classic Hits Radio. The defendant says that what is missing is any explanation of how sec- ondary meaning can be achieved in respect of this set of descriptive words which is not presented as such to the public through broadcasts or marketing. 137. The court has already expressed its findings in relation to the goodwill and reputation of the plaintiff in so far as what might be referred to as the two names of the Radio station are concerned. It seems idle to seek to contend that the plain- tiff does not own goodwill and reputation as such in the radio station with those names – albeit goodwill and reputation at the lower end of the scale in so far as the names are concerned. 138. On the evidence the radio station name or names have been for some years in a state of flux and creating distinctiveness has been and remains a challenge. The evidence suggests that the plaintiff is not sure whether to plumb for Classic 52

Hits Radio or Ireland's Classic Hits Radio as it's name - and seeks to use both. While that option exists, availing of it does undermine the objective of distinction. 139. Certainly, the plaintiff has not coined a secondary meaning in the words Classic Hits - however it uses or incorporates them in its name or names. This was always a tall order but was made even more difficult by the use of more than one name simultaneously. 140. The defendant points to the fact that as was recently

noted by Hyland J in *Yoplait v Nutricia* [2025] IECA 163, in *Cadbury Schweppes* [1981] 1 WLR 193, Lord Scarman identified the requirement that a plaintiff asserting passing off must prove distinctiveness as the bulwark against the undue stifling of competition. 141. The defendant argues that none of the secondary meaning cases on which Choice relies involve the acquisition of rights over a descriptive term. For instance, in *Muckross Park Hotel* there was no finding that the plaintiff could prevent the defendant from using the term hotel, nor was it held in *Galway Free Range Eggs* that the plaintiff had goodwill in the term free range eggs. 142. The defendant relies upon Lord Davey in *Cellular Clothing Company v Maxton & Murray* [1899] AC 326, 343: "... A man who takes upon himself to prove that words, which are merely descriptive or expressive of the quality of the goods, have acquired the secondary sense to which I have referred, assumes a much greater burden – 53

and, indeed, a burden which it is not impossible, but at the same time extremely difficult, to discharge, a much greater burden than that of a man who undertakes to prove the same thing of a word not significant and not descriptive, but what has been compendiously called a fancy word." 143. The words Classic Hits are not fancy words but are rather well known and widely used descriptive words. 144. The defendant goes on to submit – correctly in the view of the court – that even if some secondary meaning can be established in respect of descriptive material (which it says is not the case here) any resulting goodwill may be extremely weak and not such as to prevent others from using the descriptive terms. It says for example, that in *Planet Art v Photo Box* [2020] EW HC 713 the claimants, who operated a mobile app that was branded "freeprints" (i.e. with no space) alleged that the defendant had engaged in passing off by using "free prints" in its app. In rejecting that claim, Daniel Alexander QC (sitting as a High Court judge) held: "192. The claimants have some goodwill in the mark freeprints in that, to a not insignificant part of the relevant public, that term (as a single word) denotes the claimant's business or one connected with them.... To that extent, I accept that the term freeprints has acquired a secondary meaning in the sense understood by the case law. I would go further: because the composite word freeprints is not itself a normal word, albeit closely similar to 54

a pair of normal English words, it is easier for that composite to acquire such distinctiveness than would be the case had reliance been placed (which it is not) on the two words separately. 193. However, that goodwill is not so strong that the mere use of the words free prints in relation to a business of supplying free prints or an app for that purpose has come to denote the claimant's business or one connected with them, regardless of what other matter appears with those words or regardless of whether they are presented as a single word. This is for two reasons: those words are descriptive and the claimant's have not attempted to use them (separated in that way) to any or any significant extent as their brand. Indeed the claimants do not claim goodwill in the words free prints as such." 145. On the facts the case was quite different given the use of a word which was not a normal word. Freeprints was by reason of its use a fancy word coined by the claimants. And the case shows how the use of descriptive words even when run together to form a fancy word lessens any goodwill in the fancy word because the original descriptive words remain in circulation. 146. In this case, the defendant submits that in contrast to the freeprints case, the plaintiff does indeed make a claim to descriptive terms – and the defendant submits that that

claim has no substance. The court is satisfied that this submission is correct. 55

147. Both the plaintiff and the defendant refer to the Supreme Court decision in *McCambridge Ltd v Joseph Brennan Bakeries* [2013] ILRM 369 which has been referred to already. In giving the judgment of the court MacMenamin J stated at paragraph 19 of his decision; – “It is common case that the applicable criteria for establishing passing off are to be found in the ‘triple test’ laid down by the House of Lords *Reckitt & Coleman Products Limited v Bordan Inc.* [1990] 1 W.L.R. 491. Lord Oliver of Aylmerton explained the three aspects of the test in the following way at p.499 of his judgment: ‘The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get up is recognised by the public as distinctive specifically of the plaintiff's goods and services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) 56

leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as a manufacturer or supplier of the goods or services is immaterial, as long as they are identified with the particular source which is in fact the plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a *quia timet* action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.” 148. Here the plaintiff does not point to “get up” as an issue. Rather, this is a case involving names and in particular what the plaintiffs says is the confusing similarity between its name “Classic Hits Radio” and the defendant's name “Greatest Hits Radio”. 149. In *Galway Free Range Eggs v O'Brien* [2019] IECA 8 the plaintiff sold eggs under the brand name “Galway Free Range Eggs” and the defendants began selling eggs under the brand name “O'Briens of Galway Free Range Eggs”. 150. The plaintiff applied for an interlocutory injunction which was refused by the High Court. The substantive proceedings were heard by the High Court and 57

the plaintiff's claim was dismissed. The High Court decision was reversed on appeal to the Court of Appeal. 151. In the Court of Appeal, Costello J (as she then was) gave judgment on behalf of the court and stated at para. 36 of her judgment; – “In cases such as this one, the ‘get up’ or packaging of the product is largely irrelevant to the determination of the issue. The appellant said that the case was about the decision of the respondents to market their produce in such a manner as to

run the words 'Galway' and 'Free Range Eggs' together in such a way as to tend to confuse consumers or indicate a link between the respondent's produce and the appellant's brand." 152. The Court of Appeal found in favour of the plaintiff and held that it was entitled to an injunction to restrain the defendants from trading under the name of "O'Brien's of Galway Free Range Eggs". 153. In his judgment dated 30 July 2025 which dealt with the plaintiff's application for an interlocutory injunction to restrain the defendant from using the initials "GHR" in its logo or broadcasting radio station until the trial of the action Cregan J referred to these authorities. In referring to the Galway Free Range Eggs case he understandably said that one could readily see how the Court of Appeal came to its conclusion that for the defendants to use the brand name "O'Briens of 58

Galway Free Fange Eggs" would amount to passing off of the plaintiff's products "Galway Free Range Eggs". 154. It is worthwhile touching on some other authorities referred to by Costello J in her judgment in the Galway Free Range Eggs case. 155. At para. 28 of her judgment, Costello J referred to O'Neill's Irish International Sports Company Limited v O'Neills Footwear Dryer Company Ltd [1997] IEHC 75 where Barron held as follows; – "The nature of this tort is to be found in its name. The wrong is that of passing off one's goods as those of another. This can be done by similarity of name, appearance, get up or any other similarity which achieves the same purpose. How it is done is immaterial so long as the similarity is calculated to deceive those who might buy or otherwise deal in the goods. Deliberate intention is not necessary". 156. And at para. 31 of her judgment; – "Laffoy J referred to the decision of Kenny J in the Supreme Court in C&A Modes v C&A (Waterford) Ltd [1976] I.R. 198 at 214 as follows ; – "The legal wrong known as passing off includes the incorporation in the Republic of Ireland of a company with a name likely to give an impression to the public that it is a subsidiary or branch of or is associated or 59

connected with another company which has an established goodwill, whether the latter company is incorporated in the Republic or outside of it." 157. Costello J went on to state at paragraph 24 of her judgment; – "From this I conclude that the test to be applied when considering whether a claimant's reputation or goodwill in a brand name is infringed by that of the impugned brand-name (as opposed to the get up of the product) 'is there a real likelihood that the public would get an impression of a connection between the business of the appellant and the business of the respondents?' The evidence may be assessed by reference to the name alone." 158. It is however important to note once more that confusion alone is not sufficient to sustain an action in passing off. 159. Insofar as names and secondary meanings are concerned, the High Court decision in Muckross Park Hotel Limited v Kathleen Randles & Dromhall Hotel Company Limited [1995] 1 I.R. 130 is informative. There, the plaintiff had bought "the Muckross Hotel", Muckross, County Kerry in February 1990 – including the goodwill and the sole right to use the name "the Muckross". Following a scheme of development and refurbishment it reopened for business in June 1991 as "the Muckross Park Hotel". In late February of 1992 the plaintiff became aware that a 60

new hotel was being built adjoining the Dromhall Hotel on the road from Killarney to Muckcross and it was to be called “the Muckcross Court Hotel”. Both of the hotels were grade A and both had been recently renovated at considerable expense. They both obtained their custom as hotels by marketing their premises with the same tour operators and travel agents. 160. In the case, evidence was called which showed confusion between the two hotels. The plaintiff sought inter alia injunctions restraining the defendants from passing off their hotel, the Muckcross Court Hotel, as the Muckcross Park Hotel and restraining the defendants from using the word “Muckcross” in the title or name of their hotel premises. 161. Barron J, in granting the reliefs sought by the plaintiff, held that passing off occurs where it is established that persons are likely to be deceived. It was not necessary that an actual instance of deception should be established in the case. He held that the determination of whether there is a real likelihood of deception is a matter for the court. He held that the name “the Muckcross” had a considerable value. Its importance lay in the number of people who knew it and what it stood for. He held that “the Muckcross” when applied to hotels had acquired a secondary meaning and meant the plaintiff's hotel. He went on to hold that having established a secondary meaning and in the circumstances that both the hotels were grade A, both had recently been renovated at considerable cost, both obtained their customers by marketing their premises with the same tour

operators and travel agents, and the plaintiff's hotel was in Muckcross while the defendant's hotel was not, there had been a passing off. He also held that even if there was no secondary meaning attached to the name “the Muckcross” all the facts combined together made it likely that people would be deceived into thinking that the defendant's hotel was that of the plaintiff. 162. Insofar as the Muckcross case is concerned, it is worth observing that the Muckcross Hotel was a long-established hotel situated in Muckcross, County Kerry. It had been established in 1795 and had had a long and renowned history. It had faded from its former glory at the time the plaintiff bought it in 1990 and restored it at considerable expense. Although it had been known as the Muckross Hotel the plaintiff changed the name to the “Muckcross Park Hotel” to promote the fact that it was beside Muckcross Park and also that it was a country house type hotel. Its original promotion material indicated that it had formerly been the Muckcross Hotel but in the main the hotel was promoted by its new name. 163. While the allegations of copying related primarily to the name there were also allegations of copying of the hotel sign, the hotel notepaper and certain aspects of the plaintiff's furnishings (its cornices, chandeliers, couches and fabrics). Barron J held that it was not surprising that those similarities existed in circumstances where Killarney is a relatively small town and the number of suppliers was limited. Furthermore, the quality of the hotels was the same and it was not surprising that there were some similarities – particularly as the names

of 62  
suppliers to the plaintiff hotel were freely given by it to the defendants. Barron J held that the similarity of the sign was, in his view, something about which the plaintiff was entitled to complain. He held that photographs of the other hotel signs in Killarney suggested that there was at least a subconscious copying of the plaintiff's sign. He said that the same could perhaps be said to a lesser extent about the notepaper since green was an unusual colour. In the latter respects therefore, the plaintiff's allegations of copying had been established. The primary reason for

choosing the name Muckross in the name Muckross Hotel by the defendants was that the name of the hotel was known internationally. In choosing a name it is important to attract a name which has an inbuilt attraction such as the defendants believed Muckross to have was accordingly particularly relevant. He was of the view that the defendants realised the importance of the word "Muck-ross" in the title and that it did not occur to them that they might not be entitled to use it.

164. In addition to evidence of actual confusion, the evidence was that the defendants were approached by the postal authorities at the end of March 1992 and the possible confusion was explained to them. He said that it was a reasonable inference that any businessperson would wish to avoid confusion between their business and that of another. The refusal to act by changing their name could be explained by matters such as the stamping of their cutlery but also, he thought, by the belief that they had more to gain than to lose by such confusion. 63

165. Amongst the evidence of the confusion was; – (1) Post was still being addressed to the Muckross Hotel when the plaintiff's hotel was intended. (2) A tourist with a voucher for the plaintiff's hotel thought that he was booked into the defendant's hotel. (3) Someone who had stayed at the plaintiff's hotel actually thought when booking into the defendant's hotel that he was booking into the plaintiff's hotel. (4) There were incidents at workshops when it was apparent that tour operators assumed that there was only one hotel. (5) A lady booked into the plaintiff's hotel ended up in the defendant's hotel. (6) Also, people were ringing the wrong hotel and goods were being delivered to the wrong places and invoices sent to the wrong person. 166. Barron J stated that the matter which had to be established was whether or not persons are likely to be deceived and that it was not necessary that an actual instance of deception should be established in the case. Nevertheless, he said, the decision as to whether or not there is sufficient evidence of likely deception is a matter essentially for the court. 64

167. Barron J referenced the following statement of the law from *Parker Knoll Limited v Knoll International Ltd* [1962] R.P.C. 265 at p. 285 where Lord Hodson stated; – "All relevant circumstances must be taken into account, and the question whether or not there is a real likelihood of deception of the public is ultimately for the court and not for the witnesses to decide: see *Spalding & Bros v Gamage Limited* [1915] 32 R.P.C. 273 at 286 Lord Parker of Waddington: "There may, of course, be cases so doubtful in nature that a judge cannot properly come to a conclusion without evidence directed to the point: but there can be no doubt that in any passing off action the question whether the matter complained of is calculated to deceive, in other words, whether it amounts to a misrepresentation, is a matter for the judge, who looking at the documents and evidence before him, comes to his own conclusion, and to use the words of Lord McNaughton in *Payton & Co Limited v Snelling, Lampard & Co Ltd* [1900] 17 R.P.C. 635 'must not surrender his own independent judgment to any witness whatsoever!' The evidence should assist the court in reaching its conclusion, but the assistance will be of a limited nature when, as here, evidence of actual deception is not available." 65

168. The Office Cleaning case has already been mentioned above. It is referred to by Barron J in the Muckcross case and dealt with as follows; – “... the case which the defendants relied on very strongly was the case of Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd [1946] 63 R.P.C. 39. That was the case where the plaintiff, Office Cleaning Services Ltd, were bringing an action for passing off against the defendant who was trading as “Office Cleaning Association” and the question was whether or not there was sufficient distinction between the two names. Now that case depended entirely upon the fact that “office cleaning” was descriptive of what they did, that the words “office cleaning” had not acquired a secondary meaning to mean the plaintiff company and that accordingly there was a more than adequate distinction between “services” and “association” and the action failed. At p.42 of the report there is a passage which I think is pertinent in the judgment of Lord Simmons who says: – “The real question is a simple and familiar one. Have the appellants proved that the use by the respondents of the trading style ‘Office Cleaning Association’ is calculated to lead to the belief that their business is the business of the appellants? It is in these words ‘calculated to lead to the belief’ that the issue lies. It is a calculation often difficult to make, as the different estimates in the court below in this case indicate. The nature of 66

the words which are used in the trade name, the circumstances and peculiarities of the trade, the motives, proved or presumed of the trader who would use the words, all these and many other factors must be considered by the judge in determining whether a plaintiff can succeed in its claim. It is a question upon which the judge who has to decide the case has to bring his own mind to bear and which he has to decide for himself... but instances of actual deception will be given their due weight”. That again, is a further passage indicating that ultimately it is a matter for the judge to say whether or not there is a likelihood of deception. Obviously, as it is said, if evidence shows there is deception then that must be taken into account.” 169. In the Muckcross case, Barron J concluded as follows; – “Essentially, then, my view of this case is that, once the secondary meaning has been established, in all the circumstances there has been a passing off. The relevant facts in my view are as follows: Both the hotels are grade A. Both have recently been renovated at considerable cost. Both obtain their custom as hotels by marketing their premises with the same tour operators and travel agents. And while the plaintiff's hotel is in Muckcross, the defendant's hotel is not. In my view, even if there were no secondary meaning attaching to the name “the Muckcross” all these factors would combine to make it likely that people would be deceived into thinking that the 67

defendant's hotel is that of the plaintiff. In the circumstances there will be relief granted to the plaintiff”. 170. Passing off cases will by definition involve different scenarios and contexts. The Muckcross case is helpful because, inter alia, it deals with a situation of secondary meaning and other factors which made that secondary meaning of lesser import. In this case an analysis shows the absence of a secondary meaning and also the absence of any other factors which combine to make it likely that people will be deceived into thinking that the defendant's radio station is that of the plaintiff. If people do think it is then that is a consequence of mere confusion by reason of the use of descriptive terms. Here it so happens that there are descriptive terms on

both sides – which are not the same but do bear some similarity. 171. The plaintiff's assertion that Bauer's use of the name GREATEST HITS RADIO for the DAB+ trial resulted from a deliberate decision to appropriate its goodwill and reputation took up considerable time and has already been touched on above. 172. This argument loses traction when one considers that Bauer did not create the GREATEST HITS RADIO name or brand for the DAB+ trial. It was for some years an established and successful part of the Bauer Group's stable of brands long before the controversy arose. In evidence Mr. Doyle stated: "I can categorically say there was no attempt on our part nor was there any attempt to appropriate any goodwill from Ireland's Classic Hits Radio. Greatest Hits Radio is a very successful brand that Bauer owned, we have no need to appropriate somebody else's brand when we have got such a successful proven brand in our arsenal that has goodwill, huge audience success, huge commercial success in the UK and Northern Ireland, 68

including spillover into the Republic, and we have no reason in making the decision or currently to encroach on Ireland's Classic Hits Radio." The Court is not persuaded that there has been any spillover of note but that does not take from the force of the defendant's argument that it has for some years now established Greatest Hits Radio as a name and a brand – albeit outside this jurisdiction. 173. As touched on above, the plaintiff seeks to add to the argument by pointing to Bauer's use of the strapline "The biggest songs from the 70s, 80s and 90s" when Choice uses "Home of the 80s & 90s". The defendant submits that this in effect means that Choice is taking exception to a radio station identifying by slogan the decades from which its music is selected because it happens to overlap with decades that Choice has identified in its slogan. On this Mr. Diarmuid O'Leary a witness for the plaintiff [Director at Classic Rock Radio 2015-2017] acknowledged that it was common for radio stations to have similar straplines. 174. The defendant submits that Choice is attempting to appropriate descriptors that must be available to all within the radio industry. 175. Mr. Doyle made the point that, as with the name GREATEST HITS RADIO, the strapline was not conceived of as part of any strategy pertaining to the DAB+ trial, but rather was already used as a secondary strapline with GREATEST HITS RADIO by Bauer in the UK: "I think it is an accurate description of the product and what we're offering. Also, its origins are something that exists within the Greatest Hits Radio brand in the UK. It may not be the same strapline but it is a music descriptor. So that's the origins of it and that was part of the decision to use it. It wasn't something that was invented on scratch in arriving with the 69

Greatest Hits Radio to Ireland, it's something that has existed within the brand in the UK." 176. The court accepts that the plaintiff's assertion that the strapline was "... changed by the defendant to a very similar one to the plaintiff's ..." is not correct. Like the name GREATEST HITS RADIO the evidence shows that Bauer utilised brand architecture that it already used in the UK. In mainland UK and N.I. Greatest Hits Radio uses the strapline "The good times sound like this" but this strapline was understandably ruled out for use in this jurisdiction as the words "good times" were already in use in two Bauer stations here. 98FM has "Dublin's Good Times" and RedFM in Cork has "Cork's Good Times". 177. The plaintiff also contends that "... the defendant seeks to target the same demographic with very similar playlists." On this, Mr. Doyle testified: "... Greatest Hits Radio will not play any songs from after the Millennium, turn of the Millennium, 2000, whereas Ireland's Classic Hits Radio will and does play songs from later than that, and some

within the last number of years as well. ... but the focus on Greatest Hits Radio, or GHR, is around music from the 1970s and 80s, with some shoulder from the 60s and 90s. So it is different than Ireland's Classic Hits Radio in terms of the music offer.” 178. The defendant points out that this differentiation from Choice's playlist had to be demonstrated to CnM in order for GREATEST HITS RADIO to obtain a licence. Mr. Doyle testified: “We did, at the behest of the Regulator, provide some analysis in relation to this. This is done using a system where, it is an independent system that listens to radio stations and tracks the music they play. So we were able to provide analysis of the proposed music to be played on GHR versus what 70

was on in the market, both for Ireland's Classic Hits Radio but also other operators in the market, too. I think that showed that it was significantly and sufficiently different to others and the Regulator were happy with our proposal. There was no pushback from the Regulator in terms of the radio station name or the radio station offer when we submitted the Section 71 and the accompanying Programme Policy Statement.” 179. The plaintiff's reliance on what is clear evidence of “head on positioning” as evidence of a deliberate intention to appropriate its goodwill and reputation is not persuasive. In a competitive market there is something normal if not inevitable about such positioning. 180. On Misrepresentation the defendant submits that the mere fact that HITS and RADIO are the last two words of GREATEST HITS RADIO cannot provide a basis for a cause of action if Choice has no right to lay claim to these descriptive industry terms in the first place. And the court is satisfied that the plaintiff cannot lay claim to these words. 181. Nor can the plaintiff lay claim to the words Classic Hits. They are descriptive words in wide circulation and use - and no secondary meaning has been established by the plaintiff. 182. The defendant submits that even if the plaintiff could establish goodwill in CLASSIC HITS RADIO, the defendant does not concede that there is any likelihood of confusion as between that name and GREATEST HITS RADIO. Choice it says has not established any actual confusion and is left to rely on a slip of the tongue by Mr. Doyle, an AI hallucination in a Google search conducted by Mr. Branigan, and a survey to which no weight should be attached given its multiple deficiencies. 71

183. The court has already expressed its finding in relation to goodwill and the possibility of confusion. It has also dealt with the AI and Survey evidence. The comment or misspeaking by Mr. Doyle carries little weight. 184. The defendant goes on to argue that confusion within the public arising from the adoption of the same or similar descriptive terms by different traders is not passing off. The defendant points to a number of authorities in this regard and submits; - This principle was laid down in *Office Cleaning* – already referred to - and reiterated by both Lord Scarman in *Cadbury Schweppes* and Lord Oliver in *Reckitt & Colman v. Borden* [1990] 1 WLR 491, 505, where the latter stated: “Then it is said ... that the mere fact that the produce of the appellants and that of the respondents may be confused by members of the public is not of itself sufficient. There is no “property” in the accepted sense of the word in a get-up. Confusion resulting from the lawful right of another trader to employ as indicative of the nature of his goods terms which are common to the trade gives rise to no cause of action. The application by a trader to his goods of an accepted trade description or of ordinary English terms may give rise to confusion. It probably will do so where previously another trader was the only person in the market dealing in those goods, for a public which

knows only of A will be prone to assume that any similar goods emanate from A. But there can be no cause of action in passing off simply because there will have been no misrepresentation. So the application to the defendants' goods of ordinary English terms such as “cellular cloth- ing” (Cellular Clothing Co. Ltd. v. Maxton and Murray (1899) 16 R.P.C. 397) or, “Office Cleaning” (Office Cleaning Services Ltd. v. Westminster Window and General Cleaners Ltd. (1946) 63 R.P.C. 39) or the use of de- scriptive expressions or slogans in general use such as “Chicago Pizza” 72

(My Kinda Town Ltd. v. Soll [1983] R.P.C. 407) cannot entitle a plaintiff to relief simply because he has used the same or similar terms as descrip- tive of his own goods and has been the only person previously to employ that description.” - In Phones 4U v. Phone4u.co.uk Internet [2006] EWCA Civ 244 Jacob LJ, after referring to the comments of Lord Simonds in Office Cleaning, stated ([23]): “... where the “badge” of the plaintiff is descriptive, cases of “mere con- fusion” caused by the use of a very similar description will not count. A certain amount of deception is to be tolerated for policy reasons – one calls it “mere confusion”.” - An example of the Office Cleaning principle is provided by A&E Television Net- works v. Discovery Communications [2013] EWHC 109 (Ch) where Peter Smith J dismissed a “bold” ([21]) passing off claim by the broadcaster of a television channel named HISTORY (formerly called THE HISTORY CHANNEL) which sought to prevent the defendant from broadcasting the channel DISCOVERY HISTORY. - In Cranford Community College v. Cranford College Ltd [2014] EWHC 2999 (IPEC) Judge Hacon (as he then was) felt that it was possible to distil the follow- ing from the reasoning of Lord Simonds in Office Cleaning ([19]): “... confusion caused solely by the common use of descriptive words (or possibly the use of a common descriptive idea, albeit in different words) in a trade name is not evidence of a misrepresentation – it's just confusion generated by two traders describing their respective businesses in the same way. An addition to descriptive words, even a minor one, can in principle give rise to a badge of origin – a trade name which the claimant can pro- tect. But he cannot use such a trade name to fence off to his own use the 73

descriptive words contained within the name; he cannot rely on those de- scriptive words, where those words are the source of confusion, to sustain an action for passing off.” - In Au Vodka Ltd v NE10 Vodka Ltd [2022] EWHC 2371 (Ch) Mellor J stated ([41]): “... I acknowledge that in passing off cases involving descriptive names (cf Office Cleaning), public policy can and often does play a part in persuad- ing the Court that the claimant must tolerate a degree of confusion, but what the Court is doing in those circumstances is specifying (as best it can) where the dividing line lies between mere confusion (giving rise to no lia- bility) and deception (which does).” 185. The cases relied on by the defendant identify the disadvantage of using de- scriptive words in one's brand name - and the benefit of coining one's own fancy word when choosing a brand name. 186. The fear of confusion arising which is voiced by the plaintiff is referable to confusion as a result of it's use of descriptive words. The plaintiff must live with the consequences of it's decision to use those descriptive words - and incidents of mere confusion may arise. The court is satisfied that the evidence does not show any misrepresentation. 187. On considering the market in which they operate and the history of Classic Hits Radio and Greatest Hits Radio - and the evidence provided to the court – the court is satisfied that the use of the name Greatest Hits Radio by the defendant

is very far removed from what is required to prove the Tort of Passing off. The court will go further and say that it is not even persuaded that the defendant in using or seeking to use the name Greatest Hits Radio in Ireland is “flying close to the wind” in that regard. 74

THE TRADE MARK 188. The court will now turn to the Counterclaim concerning the asserted invalidity of Irish Registered Trade Mark Number 257944 for CLASSIC HITS (the “CLASSIC HITS TM”) and its revocation. 189. The Counterclaim contains pleas concerning invalidity and revocation and they have to be approached differently when it comes to the onus of proof. The facility to grant a declaration of invalidity is provided for in s.52 of the Trade Marks Act 1996. It is based on the premise that, whether by reason of breaching the rules in s.8 as to what is registrable as a trade mark (absolute grounds) or conflicting with the earlier rights of a third party (relative grounds), the trade mark should not have been registered in the first place. For this reason, the registration is a nullity ab initio under s.52(6) :- “Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made, provided that this shall not affect transactions past and closed.” 190. The words “to any extent” reflect s.52(5), which recognizes that a registration may be declared partially invalid if the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered. 191. Revocation – which is provided for in s.51 TMA – does not expunge the registration of a trade mark ab initio. S.51(6) provides: - “Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from— (a) the date of the application for revocation; or (b) if the Controller or the High Court is satisfied that the grounds for revocation existed at an earlier date, that date.” 75

192. Again, the words “to any extent” reflect the possibility of a partial revocation in respect of some of the goods or services (s.51(5)). 193. The distinction between invalidity and revocation can have important practical consequences. There can be no liability whatsoever for infringement of a registered trade mark that has been invalidated as it is deemed never to have existed. On the other hand, it is possible to make a finding of infringement in respect of activity that predated the date from which a trade mark is treated as having been revoked, but the removal of the trade mark thereafter would preclude the granting of an injunction. 194. While the defendant refers to the “important practical consequences” arising from the distinction between the two the plaintiff expresses the view that this is not a case in which any such practical consequences are particularly important. That appears to be so. INVALIDITY – ONUS. 195. A challenger attacking the validity of a registered trade mark bears the onus of establishing an absolute ground of objection on which reliance is placed. However, if the proprietor then seeks to overcome the prima facie invalidity on the basis of acquired distinctiveness, they bear that onus. In the words of Jacob J in *British Sugar v. James Robertson & Sons* [1996] RPC 281, 302: - “... one cannot simply look at the position at the time of the attack and say the onus lies on the attacker. Once the attacker is over the hurdle of showing the original registration was bad, the onus shifts to the proprietor if he wants to say, “never mind, I can show the mark is distinctive now.”” 196. The defendant argues that the invalidity issue is decided by reference to s. 52 of the Trade Mark Act 1996, and the revocation issue is decided by reference 76

to s. 51 of the Trade Mark Act 1996, and that the onus of proof in relation to the two is different. There is no issue between the parties in this regard. INVALIDITY – GROUNDS. 197. By virtue of s.8(1)(b), “trade marks which are devoid of any distinctive character” shall not be registered as trade marks. 198. The defendant submits that; - - The requirement of distinctiveness lies at the heart of what can be registered as a trade mark. According to the ECJ in C-53-55/01 Linde (8 April 2003): “... pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings...” - While evidence as to how consumers actually perceive the mark can be adduced in respect of this issue, care must be taken to ensure that this does not become conflated with whether there is acquired distinctiveness. In C- 136/02P Mag Instrument v. OHIM (7 October 2004) the ECJ held ([50]): “...that evidence must show that consumers did not need to become accustomed to the mark through the use made of it, but that it immediately enabled them to distinguish the goods or services bearing the mark from the goods or services of competing undertakings. As the 77

Office rightly argues, Article 7(3) of Regulation No 40/94 would be redundant if a mark fell to be registered in accordance with Article 7(1)(b) by reason of its having become distinctive in consequence of the use made of it.” - In the English case of *Okotoks v. Fine & Country* [2013] EWCA Civ 672 Lewison LJ, at [96-97], attached considerable importance to the guidance provided by the ECJ in C-342/97 *Lloyd Schuhfabrik v. Klijsen* (22 June 1999), at [23], that in determining whether a mark is distinctive “... account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered...” 199. The defendant then submits that it is beyond argument that CLASSIC HITS is descriptive and, in the context of radio broadcasts, speaks to the type of content being broadcast. This, it argues, implicates both s.8(1)(b) and s.8(1)(c). The defendant submits that; - S.8(1)(c) excludes from registrability “trade marks which 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”. - In C-51/10P *Agencja Wydawnicza v. OHIM* (10 March 2011) the CJEU identified a number of key considerations that inform the operation of this exclusion: o “The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or 78

more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services... o With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes... o By the same token, the Court has stated that the application of that ground for refusal does not depend on there

being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question... It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration... It follows from the foregoing that the application of Article 7(1)(c) of Regulation No 40/94 does not require the sign at issue to be the usual means of designation....” The court accepts as correct the above submissions of the defendant. As already stated, the words Classic Hits are descriptive words – and indeed have enjoyed wide circulation as such for many years. By virtue of Section 8(1) (b) the Trade Mark Classic Hits should not have been registered as it was devoid of any distinctive character. 79

And it is also true that its registration was precluded by Section 8(1) (c) on the basis that the words consisted exclusively of signs or indicators which may serve, in trade, to designate the kind, quality or intended purpose of the service to which they related. The words are likely to be perceived as providing information as to the content of the broadcast and specifically that it comprises popular songs (“hits”) from an earlier era or time (“classic”). ACQUIRED DISTINCTIVENESS 200. The defendant submits that the original registration of the CLASSIC HITS TM cannot be maintained on the basis that, of the date of the application, it had acquired distinctiveness that could overcome its inherent drawbacks as a generic/descriptive term. The court is satisfied on the evidence that this is so. 201. The defendant also submits that Choice’s experience with the Classic Hits TM after registration shows that no such distinctiveness arose post-registration. 202. On this it submits that mere use does not give rise to acquired distinctiveness. The court is satisfied that this is so. 203. The defendant relies on the judgment of Jacob J (as he then was) in *British Sugar v. James Robertson & Sons* [1996] RPC 281, 302 where he stated: - “... I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark....” 80

- Jacob J noted, in particular, that such use of the mark “Treat” (for dessert sauces and syrups) on which reliance was placed was not freestanding, but rather in tandem with the prominent display of the well-established brand “Silver Spoon”. He stated (286): “I think the Registrar was wrong to accept this evidence as demonstrating that the mark was “capable of distinguishing”... Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin. This is all the more so when the use has been accompanied by what is undoubtedly a distinctive and well-recognised trade mark.” 204. The defendant relies also on *Bach Flower Remedies* [2000] RPC 513 where Morritt LJ stated (530/[49]): “... use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.” 205. Such use as the plaintiff made of the TM after registration created no distinctiveness in

the words. The fact that this is so is apparent from the evidence - and explains in part at least the evolution of the names of the Radio Station to what they currently are. 206. Mr. Sean Ashmore (Chief Executive of Sunshine Radio) who was called on behalf of the plaintiff, and who had instructed trade mark agents to obtain the registration of the CLASSIC HITS TM, offered the following definition of the term CLASSIC HITS: "I suppose, it generally refers to hits from the past over a number of decades that would be well known and considered classics." 81

207. Mr. Ashmore also accepted that the word "hits" "... in and of itself has a particular meaning in respect of the radio industry" and that "... it's a fairly wide-spread use. I mean a hit usually means it has done well in the charts, it is popular et cetera, but it's very widely used. Obviously there is Greatest Hits Radio, there's Classic Hits Radio, there's Dublin's Hit Music Station, there is Hit Music Now used as slogans. In fairness it is very generic and it does depend on the context, how it is used and who it is used by and why it is used." 208. Similarly, Mr. Diarmuid O'Leary who was called by the plaintiff accepted that in the radio industry "hits" is a reference to a hit record. 209. Mr. Ashmore accepted that Choice do not claim to have coined the phrase CLASSIC HITS. He said that he thought "that would be quite a claim for anybody to make". 210. It is a fact that long before Choice managed to register it as a trade mark, CLASSIC HITS was a descriptive and/or generic term. On this, the defendant correctly points to the following evidence - (a) Searches conducted by Professor Zuckerman showed: - "The tunes could have been randomly chosen from a classic hits radio playlist..." - a reference to cover versions included on Andrew Strong's album Out of Time that appeared in The Irish Times on 14 October 2000. - "The thumping baseline and memorable melody have kept it a staple of classic hits radio" - a reference to Frankie Goes to Hollywood's debut single Relax in an article that appeared in The Irish Independent on 14 February 2014. - The term "classic hits" is a descriptor or category that refers to a particular radio format according to Mr. Chris Doyle who said "... Then there are 82

descriptions such as Classic Hits which I would say Ireland's Classic Hits Radio would fit under that format descriptor..." (b) Mr. Doyle in evidence also said that he "worked for the owner of Classic Hits 98FM for quite a period of time and he was responsible for bringing Jeff O'Brien and the format of Classic Hits Radio to - or, sorry, Classic Hits 98FM to Ireland in the late 80s." (Jeff O'Brien was the launch programme director for Classic Hits 98FM). (c) Professor Fahy for the defendant felt that "... even though Classic Hits is beneficial in terms of suggesting the types of music that is played, Classic Hits is quite a generic term when you are looking at issues of music and therefore that's not very, very distinctive". 211. It is true that not only did Choice not coin the phrase CLASSIC HITS, but it was not the first broadcaster in Ireland to include these words in a radio station name or a trade mark registration. In 1989 the Dublin radio station "Classic Hits 98FM" was launched and it used the words CLASSIC HITS until 1995 or 1996. On foot of an application filed on 5 May 2011 Bauer (under its former name Communicorp Group Limited) successfully applied to register a series of four trade marks (under number 245664) comprising CLASSIC HITS 98FM; CLASSIC HITS 98 FM; 98FM CLASSIC HITS and 98FM'S CLASSIC HITS. 212. The evidence reveals that when Choice's attempt to register CLASSIC HITS 4FM was met with

an objection from the Patents Office that cited Communicorp's application, the response from Choice's own trade mark agents in a letter dated 19 August 2011 expressly relied on the generic nature of the term CLASSIC HITS to the point of contending its use in the names of different radio stations would not cause them to be confusingly similar. They stated: 83

*"The term 'Classic Hits' is totally generic and a search for the phrase on Google turned up more than 3.5million hits. By way of example we enclose herewith an extract from Wikipedia confirming that 'classic hits' is a radio format which generally includes rock and pop music from 1964 to 1989...."*

213. *It is true that not only had Choice not exclusively appropriated CLASSIC HITS to itself by the time it applied for the CLASSIC HITS TM on 9 November 2016, but it continued to be a generic term thereafter. As acknowledged in evidence by Mr. Kevin Branigan the term was used descriptively in the Programme Schedule in Choice's own contract with the Broadcasting Authority of Ireland dated 22 December 2020.*

214. *When cross-examined about the letter of complaint that he had sent to Q102 on 11 April 2018, Mr. Ashmore acknowledged that "... there is a lot of descriptive use of the phrase 'Classic Hits' by radio stations in ad lib or accidental use..."*

215. *When presented with the same letter, Mr. O'Leary agreed that the references at the bottom of the first page to "It's a Classic Hits weekend with Beshoff Brothers", "This is another feel good Classic Hit on Dublin's Q102" and "Dublin's Q103 [sic] on this Classic Hits weekend" were probably used in a generic sense. He also agreed with the statement in the response dated 24 April 2018 from Murgitroyd trade mark attorneys on behalf of Q102 that "'Classic hits' is a term that is directly descriptive of a radio format which generally includes rock and pop music from the early/mid 1960s through the mid/late 1980s/1990s. ... It is defined in Wikipedia and is widely used by many broadcasters".*

216. *The defendant correctly submits that it is obvious that not only was it generic/descriptive but that there was no acquired distinctiveness when Choice applied to register CLASSIC HITS as a trade mark. Nor was such distinctiveness acquired afterwards.* 84

217. Mr. Ashmore in evidence accepted that at that time Choice was not using CLASSIC HITS independently as a freestanding trade mark. He further accepted ["Technically, you are right"] that the Statement of Case dated 29 November 2017 furnished by Choice's trade mark agents to the Patents Office in support of the application to register CLASSIC HITS was "misleading" because it stated that Choice had been providing services under the "Trade Mark CLASSIC HITS" when that was not the case and Choice was in fact still trading under its trade mark "CLASSIC HITS 4FM".
218. According to Choice [although contrary to what is expressly pleaded in its Amended Statement of Claim] its brand is "Ireland's Classic Hits Radio" and it also claims that the station is called "Classic Hits Radio. The court has earlier dealt with these names. It is clear from the evidence adduced by the plaintiff that despite dropping "4FM", it was not happy with CLASSIC HITS as a brand. It was not working.
219. Mr. Branigan's witness statement and his testimony to the court are instructive. He testified - "I, at the time, felt it needed something more, that describing it purely as "Classic Hits" wasn't enough, that people needed - - you know, you are saying "We are Classic Hits", Classic Hits what? Is it Classic Hits FM? Is it Classic Hits Radio? Is it something? So that was something on our minds, that even though we were now branding it as "Classic Hits", that it still wasn't the final name solution."
220. According to the evidence Mr. Branigan's actual experience is completely at odds with the case presented to the Patents Office in 2017 to the

effect that CLASSIC HITS was distinctive of Choice and thus worthy of registration as a trade mark. He testified: "... if I picked the phone up and I rang somebody and I said I was from Radio Nova, there'd be an instance "oh yes, you're from Radio Nova", 85

people would be excited about Nova but would know it was a radio station. When I would say I was calling from Classic Hits there would be a pause and you'd have to explain you are phoning from the radio station, Classic Hits, and then they go, "oh yes, how can I help you?" To me, the word "Classic Hits" on its own, somebody might think you were calling from a shop that sold records, you could be the drummer in a wedding band called Classic Hits, people just didn't know, and it was pretty clear at that point that we did need to add something else." Later in evidence, and dealing with the plaintiff adding Radio to the name, he said: - "We did decide on "Radio". There was also an issue to me of perception, a huge issue with perception. At that point Classic Hits had 296,000 listeners and was the largest radio station in Ireland outside Today FM and Newstalk, but yet if you spoke to someone and said to me [sic] they would express great surprise. What you would find was some people would even be surprised to hear that the radio station was still on air...". As the defendant submits, it is obvious that at the time when Choice applied to register CLASSIC HITS as a trade mark, the supposed mark was not actually standing on its own two feet and doing the job of distinguishing. 221. Once it had managed to secure that registration Choice discovered that CLASSIC HITS could not function as a trade mark and that it would have to migrate to another brand. 222. Classic Hits should not have been registered as a TM - by reason of s. 8(1) (b) and (c) of the act. REVOCATION FOR NON-USE 86

223. Paragraph 6(d) of Bauer's Amended Defence and Counterclaim pleads: "... it is denied that the plaintiff has made use of the Registered Trade Mark in respect of any of the services for which it is registered and the defendant will contend that it ought to be revoked by reason of section 51(1)(a) and/or section 51(1)(b) of the Trade Marks Act 1996 (as amended)." 224. This is repeated in paragraph 43 of the Counterclaim. 225. Choice's Reply and Defence to Counterclaim does not contain anything specific by way of answer to this plea and relies on general traverses, 226. S. 99 TMA provides: - "Where, in any civil proceedings under this Act, an issue arises as to the use made by any person of any registered trade mark, the onus of proving such use shall lie with the proprietor." This requirement is consistent with EU law, which has been explained by the CJEU as reflecting "... an application of common sense and requirements of procedural efficacy" (C-610/11P *Centrotherm v. OHIM* (26 September 2013), [61]) because "... the proprietor of the mark at issue which is best placed to adduce evidence in support of the assertion that its mark has been put to genuine use" (C-720/18/ C-721/18 *Ferrari v. DU* (22 October 2020), [81]). 227. S.51 requires not merely use, but "genuine use", which the CJEU in Case C40/01 *Ansul v. Ajax* (11 March 2003) defined as follows ([36]: - "36. Genuine use must... be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or 87

end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned....” 228. Satisfying the onus is not a matter of mere assertion. As stated by the Court of First Instance in T-39/01 Kabushiki Kaisha Fernandes v. OHIM (12 December 2002), [47]: “... genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.” 229. The CLASSIC HITS TM is registered in three classes of services and within each class there are a number of services (7 in Class 35; 8 in Class 38; and 5 in Class 41). Not only must genuine use be proved in respect of each specified service, but if broad terms are used in the specification that encapsulate independent subcategories, the obligation to prove genuine use applies to each. In Ferrari v. DU, [38] the CJEU stated: - “... with regard to goods or services in a broad category of goods, which may be subdivided into several independent subcategories, it is necessary to require the proprietor of a mark registered in respect of that category of goods or services to adduce proof of genuine use of his mark for each of those independent subcategories, failing which he will be liable to forfeit his rights to the trade mark in respect of those independent subcategories for which he has not adduced such proof...” 230. To take one example relating to the CLASSIC HITS TM which illustrates this, the Class 41 specification includes “organisation, production and 88

presentation of shows, competitions, games, concerts and events”. This is not a single service. 231. The plaintiff has failed to provide any persuasive evidence of genuine use by it of the TM after registration in the sense explained by the authorities. The evidence of the plaintiff failed to address the independent sub-categories. Its evidence did not prove any genuine use of Classic Hits as a TM. 232. The evidence of the plaintiff revealed the ongoing and problematic lack of distinction in the words Classic Hits - and the failure of the TM to distinguish the plaintiff’s radio station. The experience of the plaintiff was that the TM failed to function as a TM should. Essentially, it was not possible to make genuine use of it because it lacked any distinctive character. 233. The plaintiff delivered its Closing Written Submissions on 20 March 2026. Those submissions focussed mainly on the plaintiff’s passing off case but deal also with matters relating to its TM. While the court has addressed the issues raised it is necessary to address some aspects of these submissions in some more detail - albeit there is considerable overlap with points already dealt with. 234. The plaintiff relies on the saver provision in Section 52 of the Act which provides that a trade mark shall not be declared invalid; - “... if, in consequence of the use which has been made of it, it has before the date of application for a declaration of invalidity, acquired a distinctive character, in relation to the goods or services for which it is registered” 235. The defendant sought to have the plaintiff’s trade mark declared invalid (pursuant to Section 8 of the Act) by way of its Counterclaim, which was delivered on 31 July 2025. In the plaintiff’s submission, the plaintiff’s trade mark “Classic Hits” had acquired a meaning distinctive of the plaintiff, in the context of radio in Ireland, before 31 July 2025. 89

236. On this, the plaintiff submits that; - in the context of the Irish radio industry, the words “Classic Hits” are often used to denote the plaintiff’s station name and thus, it is clear that the words have acquired distinctiveness with respect to the plaintiff. This was put to the defendant, in particular to Mr. Liam Thompson, and Mr Thompson was adamant that he himself never shortened the plaintiff’s station name in that way and was not aware of anyone else who did that. He was forced to accept that this was simply not correct, when he was referred to a suite of documents which contained (among other things) the following: a. The defendant’s own home page (screenshots taken on 19 February 2026) which uses “Classic Hits” to signify the plaintiff’s station. b. An article from the defendant’s home page (dated 01.09.23) c. The Media Central website (screenshot taken 25.02.26) where it refers to “Classic Hits” as one of the brands in its stable. d. Media Central’s ‘rate card’ (i.e. the rates charged for advertising on a given station) which refers simply to “Classic Hits”. e. An email between himself and Mr. Chris Doyle, CEO of the defendant, dated 07.04.25 in which Mr Thompson refers to the plaintiff’s station as ‘Classic Hits’. f. An email between Mr. James Brownlow, the former group managing editor with the defendant, and Mr. Thompson dated 10.04.25 in which Mr. Brownlow referred to “Classic Hits”, meaning the plaintiff’s station. g. A ‘promo brief’ where the client was Red Bull and the station was 90

referred to simply as Classic Hits. - Professor Fahy [the defendant’s branding expert], when considering how the plaintiff presented itself to the listening public through in-car entertainment systems, stated: “The Ireland’s Classic Hits Radio brand regularly appears as simply the word ‘classic’ or ‘classic hits’.” 237. Thus, the plaintiff submits it is clear that it has built up goodwill in the words “Classic Hits”, and those words have acquired a distinctiveness which is associated with the plaintiff. Consequently, its trade mark should not be declared invalid because it acquired a distinctive character “before the date of application for a declaration of invalidity”. 238. The plaintiff argues that the defendant makes a distinction between “mere use” and “acquired distinctiveness” but does not explain why it could be said that the plaintiff had merely used the words CLASSIC HITS, and does not engage at all with Mr. Thompson’s concessions in relation to how in the 2023 – 2026 period he and others often abbreviated the plaintiff’s name to Classic Hits, with Bauer itself doing this on its own home page. 239. On this core point the court is not persuaded that the evidence shows genuine use of the TM - and the evidence of Mr. Branigan is to the effect that he regarded it as insufficient to even distinguish the radio station as a radio station. On its own case, Choice transitioned away from the CLASSIC HITS TM for the reasons identified by Mr. Branigan. 240. The plaintiff may argue that Mr. Branigan was speaking of the position as it was in 2021/2022 and that things changed thereafter such that the words Classic Hits had acquired a distinctive character before 31 July 2025. However, the evidence does not persuade the Court that this is so. The evidence is compelling to 91

the effect that the words Classic Hits have been and remain words without any distinctive character. 241. If the plaintiff reverted to the name Classic Hits as the name of its radio station in the morning it would encounter all of the problems that led to the name changes in 2021/2022 – because those words remain devoid of any distinctive character. 242. There is no doubt that the name of the plaintiff’s radio station was and is at times abbreviated to Classic Hits. The plaintiff

points to evidence which shows this to be so. However, that use is as an abbreviation of the name Classic Hits Radio or Ireland's Classic Hits Radio. It is not evidence of genuine use of the TM. Classic Hits did not establish itself as a standalone name sufficient to distinguish the plaintiff's radio station. 243. The use must be consistent with the essential function of a trade mark - which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him or her, without any possibility of confusion, to distinguish the product or service from others which have another origin. 244. The problem the plaintiff has had is that the TM did not ever fulfil its essential function. 245. The evidence does not persuade the court that the use made by the plaintiff of the TM after registration caused it to acquire a distinctive character in relation to the goods or services for which it is registered, or any of them. Such use of the words Classic Hits as the plaintiff made of them prior to 31 July 2025 failed to succeed and give those words the distinctive character which is essential for the Section 52(1) saver. 246. As a TM Classic Hits failed in its function to the point that the name has been changed and the radio station now goes by the names Ireland's Classic Hits 92

Radio and Classic Hits Radio. And the JNLR listenership figures do not assist the plaintiff in proving that it has acquired distinctiveness in the context of the Irish radio market in 'Classic Hits'. 247. The plaintiff points to the English High Court decision in *Dryrobe Ltd. v Caesr Group Ltd (t/a D-Robe Outdoors)* 2025 EWHC 3167 (IPEC). There the court considered the acquisition of a distinct character in *Dryrobe*. The Court ultimately held that the plaintiff's trade mark, when "standing back and looking at all of the evidence", although being descriptive in relation to some of the goods for which they were registered, had ultimately acquired distinctive character. Judge Clarke looked to the following evidence to assist in assessing acquired distinctiveness: (i) The volume of sales. (ii) The market position. (iii) The volume of media coverage the claimant received as a brand. The Court noted that, as per Arnold LJ in *Oska's Trade Mark* [2005] RPC 20, this serves two purposes: showing how well known the brand was at the time of the press coverage, and serving to increase and widen that knowledge. (iv) The sums spent by the Claimant on marketing to build the brand. (v) Direct evidence from members of the public showing that they understood the phrase as a brand identifier. (vi) Evidence of actual confusion by consumers. 248. Although the plaintiff submits that there are elements of (i), (ii), (iii), (iv) and (vi) present in the evidence led by the plaintiff the court is not persuaded that the evidence proves that the words ultimately acquired distinctive character in the context of the Irish Radio market. 93

The Court in *Dryrobe* stated: - "In my judgment, and standing back and looking at all of the evidence through the eyes of the average consumer, I am satisfied that there is compelling evidence that a significant proportion of the general public as at the date of the counterclaim identified the Claimant's goods as originating from the Claimant because of the Marks, and that the Marks had by that date acquired a medium level of distinctive character. It follows that the invalidity counterclaim fails, and the Marks will not be revoked..." That decision is understandable. The word *Dryrobe* is a word where one can comprehend it acquiring a distinctive character. The TM at issue here is fundamentally different and involves descriptive words which have been for years in wide circulation and use. 249. The defendant objects to the plaintiff's closing submissions because it says the plaintiff now seeks, for the first time, to invoke

s.52 as an answer to Bauer's invalidity challenge. It says the plaintiff is simply not entitled to do so because it never pleaded, by way of defence to Bauer's Counterclaim, that the CLASSIC HITS TM had acquired distinctiveness after being registered. 250. And it is true that such a specific pleading is absent from the plaintiff's pleadings. But argument on this pleading point is academic as the court is not persuaded that the CLASSIC HITS TM obtained post-registration acquired distinctiveness. 251. Thus, the plaintiff has failed to prove that it is entitled to the benefit of the saver provided for in s. 52(1). 252. The court is satisfied that the TM should be declared invalid pursuant to s. 52(1) as it was registered in breach of s. 8(1)(b) and (c) of the Act. 94

253. Separately, the court is satisfied that the defendant has proved the case for revocation of the TM by reason of not being put to genuine use under s. 51 (1) (a). The evidence does not prove the genuine use in the State which is required. Conclusion. - The plaintiff has failed to prove the Tort of passing off. It has failed in particular to prove misrepresentation leading or likely to lead to confusion. - The court is satisfied that the TM should be declared invalid pursuant to s. 52(1) as it was registered in breach of s. 8(1)(b) and (c) of the Act. - Separately, the court is satisfied that the defendant has proved the case for revocation of the TM by reason of non-use under s. 51. The evidence does not prove the genuine use in the State which is required. The Court will list the matter at 10.30 a.m. on Wednesday 14th October 2026 to deal with the issue of costs, to finalize the order and to deal with any other matters arising. 95

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