

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2026436  
by Mr Gananath Wimalal Ediriwira for the registration  
of a trade mark in Class 42**

**AND IN THE MATTER OF Opposition thereto  
under No 44755 by The Baywatch Production Company**

**Background**

1. On 7 July 1995, Gananath Wimalal Ediriwira made an application to register the mark shown below in respect of 'restaurant services' in Class 42.

BAYWATCH

2. On 17 June 1996, The Baywatch Production Company of Los Angeles, California, filed Notice of Opposition to the application. The grounds of opposition pursued before me were, in summary that:

- (i) The applicant's mark is identical or similar to the opponent's trade mark BAYWATCH, which is registered in Class 30 with effect from 27 January 1995, in respect of:

Snack food products, candy, bakery goods; dairy desserts; ice cream, frozen yoghurt; breakfast cereal, pretzels, pizza, popped popcorn, corn and taco chips, crackers, biscuits, bread, muffins, chewing gum, tacos,

burritos, enchiladas, chilli peppers and sauce, coffee, hot chocolate; sandwiches of fish, hamburger, hot dogs, cheese, poultry, vegetables and meats; meat pies, noodles, pasta, Danish pastries, liquorice, doughnuts, fruit pies, tea, herbal tea, honey, milkshakes, spaghetti sauce, chocolate syrup, corn dogs, biscuits, grain-based food beverages; herbal foods beverages, bubble gum; candy and edible cake decorations; cereal derived food bars, cereal-based snack food, processed cereal; granola-based snack bars.

- (ii) The services for which it is proposed to register the applicant's mark are similar to those for which the opponent's mark is protected, and there exists a likelihood of confusion, including the likelihood of association. Registration would therefore be contrary to Section 5(2) of the Act
- (iii) Further, the opponent claims to be the proprietor of the mark BAYWATCH which it claims is entitled to protection under the Paris Convention as a "well known mark" based upon its reputation in the field of television entertainment services.
- (iv) The opponent's 'well known mark' constitutes an 'earlier trade mark' by virtue of Section 6(1)(c) of the Act. Use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the repute or distinctive character of the opponent's mark. Registration would therefore be contrary to Section 5(3) of the Act.
- (v) The application offends the provisions of Section 32(3) of the Act because the applicant has made no use of the mark and, at the time the application was made, had no bona fide intention to use the mark in respect of the restaurant services.
- (vi) The application was made in bad faith.

3. The opponent originally listed other grounds of opposition but these were not pursued at the hearing. I should record that a further ground of opposition under Section 5(4)(a) was not completely dropped, but the opponent conceded that it could not succeed under this heading if it failed with the opposition under Section 5(3).

4. The applicant failed to file a counterstatement but both sides subsequently filed evidence.

5. The matter came to be heard on 24 August 1999, when the opponent was represented by Mr P Prescott QC, instructed by S.J. Berwin & Co, and the applicant appeared in person.

### **Opponent's evidence**

6. The opponent's evidence includes a Statutory Declaration dated 13 February 1997 by Paul Anthony Pavlis, who is the Executive Vice-President and General Counsel of All American Communications Inc (the parent company of the opponent).

7. Mr Pavlis explains that BAYWATCH is the name of a television programme first shown in the USA in 1990. The programme features lifeguards patrolling a beach in California. It is classed as light entertainment.

8. Mr Pavlis says that the programme was first shown in the UK in 1992. It is shown weekly on Saturday and Sunday evenings at around 6.00pm. Attached to Mr Pavlis' declaration as exhibit PAP5 are copies of extracts from Broadcast Cable International's publication "rap", and extracts from a UK magazine called "Broadcast". These support Mr Pavlis' claim that BAYWATCH was the second most popular US TV show in the UK by August 1994. According to the extracts from "Broadcast", by 15 May 1994, BAYWATCH was the 43rd most popular programme on UK TV with nearly 8 million viewers.

9. Mr Pavlis says that the success of the programme has enabled the opponent to licence use of the BAYWATCH name as a trade mark for a wide variety of merchandise. This started in mid 1994. Exhibit PAP7 consists of a list of licensees in the UK who are authorised to use the

name Baywatch and a logo on goods ranging from sunglasses, swimsuits, bed linen, magazines, clothing, dolls, cakes, posters and games to chocolate Easter eggs.

10. Mr Pavlis further says that:

"The retail value of merchandise sold in the UK since 1994 totals more than £12 million which represents an average of approximately £4 million per year. The UK licensees are not involved in direct consumer advertising, relying upon the strength, reputation and goodwill in the Baywatch name generated through the television programme to promote their products."

"Further, (and of particular relevance to these opposition proceedings), Baywatch PC is in active negotiations with several major prospective restaurant licensees with a view to opening a Baywatch themed restaurants throughout the world (including London)."

11. Exhibit "PAP9" to Mr Pavlis includes a certificate of incorporation of a company called Interlibro Ltd. There is also a copy of a certificate of change of name to BAYWATCH RESTAURANTS LTD dated 13 May 1994.

### **Applicant's evidence**

12. The applicant filed a Statutory Declaration made by himself and dated 27 February 1998. In summary he says that:

- (i) The services listed in his application are not the same or similar with any goods or services covered by the opponent's applications or registrations.
- (ii) There is no likelihood of confusion (including the likelihood of association) with the opponent's UK trade mark in respect of the goods/services for which it is protected.
- (iii) The applicant is the owner of Bay Watch Restaurants Limited, which has registered as a company in the UK before the opponent's UK trade mark applications.

- (iv) The opponent's name BAYWATCH is the name of a television programme not a trade mark.
- (v) The opponent's mark is not entitled to protection under the Paris Convention as a well known mark.
- (vi) An earlier application by him to register the same mark, which pre-dated all the opponent's applications was "lost" because he failed to pay the application fees.

13. No further details are provided about the last claim.

14. In relation to the grounds of opposition under Section 3(6) Mr Ediriwira denies that his application was made in bad faith. He explains how he adopted the mark, as follows:-

"My application for the name "bay watch" has nothing whatever to do with their television programme. I come from an island country and all my life I have wanted to have a restaurant, and as I stood in front of one of the numerous beautiful bays in my home country, I felt that it would be very nice and romantic to to have a restaurant facing the bay. In the same way as countless people around the world have named businesses as "Sea View Restaurant" or "Good View Hotel" or "Buona Vista Hotel" and even houses as "Good View", "Bay View Restaurant" was the original choice of name, but because on reflection I felt it was too passive or negative, I hit upon "Bay Watch" as more indicative of what such beauty of the bay demanded. The name, therefore, was decided long before I came to this country and long before the "BayWatch" television programme" was even made. The fact that I made the application here, rather than in my home country, merely reveals the extent of my homesickness and the wish to have a substitute which will always remind me of home."

15. In relation to the ground of opposition under Section 32(3) of the Act based upon the allegation that he had no bona fide intention to use the mark, Mr Ediriwira says:-

"a. I come from an island country and all my life I have wanted to have a restaurant, and as I stood in front of one of the numerous beautiful bays in my home country, I felt that it would be very nice and romantic to to have a restaurant facing the bay. <The fact that I made the application here, rather than in my home country, merely reveals the extent of my

homesickness and the wish to have a substitute which will always remind me of home.

- b. I have also registered a limited company called "Bay Watch Restaurants Limited" which was registered much earlier than any of the trade mark applications made by the Opponent and where the mark "Bay Watch" already existed much earlier than the marks applied for by the Opponents. The limited Company was registered for the purpose of setting up the restaurant and so it can hardly be claimed that there is no bona fide intention in relation to the services listed in the specification.
- c. The delay in starting is simply due to a question of the delay in finding the finance. While I have spoken to some people, I am not very interested in the venture as a partnership, and I will be able to raise the money from the sale of my books (one book has already been written, and two more are in the pipeline), my inventions (one invention has already been patented and two more are in the pipeline) and other sources.
- d. In fact, it is the Opponents who do not have a bona fide motive in their opposition. They, clearly, did not have any intention at all of opening a restaurant till they got the idea from my trade mark application: otherwise they would have made a trade mark application for restaurant services at the same time as they made the applications for all the other classes (they have applied for *eleven* classes!), which as they themselves state, they made earlier."

### **Opponent's evidence-in-reply**

16. The opponent filed a Statutory Declaration dated 15 May 1998 by Stewart Keith Lewis, who is a partner of MORI. Mr Lewis describes the outcome of a survey of 951 adults over 15 conducted between 21 and 24 November 1997. In response to the questions "What does the name BAYWATCH mean to you?" and "Why do you say that?", 75% spontaneously associated the name with the TV series. This rose to 84% when the second question was put to clarify the answer to the first question.

17. The opponent also filed Statutory Declarations dated in May 1998 by Steven Thomas Corney and Elie Simon Zekaria, who are solicitors employed by S.J. Berwin & Co. They describe the outcome of Street surveys they conducted in London around December 1997. The surveys were conducted by approaching people and testing reaction to a card upon which was written "A restaurant called BAYWATCH."

18. Mr Corney says that all 33 people connected the restaurant with the TV programme. He

says that 12 of these connected the name with a BAYWATCH them restaurant.

19. Mr Zekaria says that he conducted two surveys. In the first 27 out of 29 interviewed said they thought of the TV programme. Fifteen of these are said to have assumed that the restaurant was relating to or contained themes from the TV programme.

20. In the second survey, the name shown on the card was changed to "BayWatch". Nevertheless 5 of the 8 people interviewed connected the TV programme with the restaurant.

21. Robert Norman Furneaux, who is a trainee solicitor employed by S.J. Berwin & Co gives similar evidence to that of Mr Zekaria and Mr Corney. He conducted two street surveys with similar results.

22. The opponent also filed 7 Statutory Declarations from those who were followed up after being interviewed by Mr Corney and Mr Zekaria. The majority of these are in a similar vein to the evidence given by Robert Arthur Reginald Wetherall. The key paragraph of his evidence is as follows:-

"On 21 April 1998 I telephoned Elie Zekaria at S J Berwin & Co in response to a letter I had received from him requesting my assistance. During that telephone conversation Elie Zekaria asked me my reaction to using the words "Baywatch" and "restaurant" together. I responded that the two words together made me think of a restaurant which was called "Baywatch" like the television programme."

23. However, one or two of the declarants go a bit further. The most helpful evidence (from the opponent's perspective) is that of Michael Robert Lindley. He says:-

"Mr Zekaria then contacted me by letter requesting that I telephone him to discuss whether it was possible for me to assist him further. When I did telephone him Mr Zekaria asked me to explain why I had thought of a theme restaurant with the name "Baywatch". I explained that I worked for The Carlton Food Network, a Cable Television Channel devoted to food and drink. I was therefore very familiar with the Cheers bar (named after the television programme of the same name), Capital Café, Fashion Café and Planet Hollywood and had assumed that the makers of the television programme "Baywatch" were planning to open a restaurant along those lines."

24. The opponent also filed a further Statutory Declaration dated 8 June 1998 by Raymond David Black, who is a partner in S.J. Berwin & Co. Mr Black describes various discussions he had with the applicant. The following extracts from his evidence are most relevant:-

"I had two telephone conversations with the Applicant. In my first conversation with the Applicant on 16 July 1997 I asked on what terms the Applicant would be willing to drop his application and give an undertaking that he would not open a restaurant using the mark applied for. No proposals were put forward by the Applicant during this conversation but he did indicate that he would consider further the possibility of reaching a commercial arrangement and revert to me. There is now produced and shown to me marked "RDB 1" a copy of a typewritten telephone attendance note recording that part of this conversation and a copy of my handwritten contemporaneous note of our conversation."

"The Applicant telephoned me on 23 July 1997 and said that he had spoken to his "advisers" and that if we wanted to talk about selling the name to the Opponent he would be prepared to accept £15 million plus 7.5% royalties, 5% of which were to be paid to charity. I told the Applicant that this was "mad" and terminated my conversation."

"I have been advised by Counsel that although the conversations of 23 July 1997 and 8 August 1997 were expressed to be without prejudice, the demand by the Applicant on 23 July 1997 did not constitute a genuine attempt at settlement and therefore cannot be regarded as privileged. Rather it was an attempt by the Applicant to use his application to extort money from the Opponent. I believe that this is self-evident anyway, but in any case refer to the second statutory declarations of Michael Eve and Paul Pavlis which show that the Applicant's demand is not a genuine attempt at settlement."

25. Michael Eve is the Managing Director of Trigger Licensing Limited. He has substantial experience in the licensing industry. His evidence addresses the various factors that go into the licensing of a trade mark for use on a "themed" restaurant. He concludes that:-

"I anticipate that, if a license was granted by the Opponent to open a theme restaurant, along the lines outlined above, the flat fee for such a license would be approximately £50,000. I have calculated this based on 1% of an anticipated annual turnover of £1 million a year for five years. I would expect the royalty arrangement to be about 5% on sales of food and beverages and 8% on sales of "Baywatch" merchandise."

26. Mr Pavlis made a second Statutory Declaration dated 5 April 1998. He says that the



opponent took a decision about three years previous to this to make available a worldwide restaurant licence as part of its worldwide merchandising strategy. He says that the opponent intends to open one or more licenced restaurants in the UK. He says that the opponent values the UK element of the proposed worldwide licence at \$50,000. The proposed royalty rate is 5% on food and beverages and 8% on merchandise.

27. The opponent filed a number of other Statutory Declarations. However, I do not consider that they add anything further to the opponent's case and I do not therefore intend to summarise their contents. This therefore concludes my review of the written evidence.

28. Before I turn to the decision I should record that, at the Hearing, I accepted the opponent's request that Mr Ediriwira should be cross examined on this evidence. I will return to this at the appropriate points in my decision.

#### **Admissibility of Mr Black's evidence**

29. Although the applicant had not challenged the admissibility of Mr Black's evidence, I felt it proper in circumstances where the applicant had no legal representative, to raise the matter with the opponent's counsel at the hearing. Mr Prescott relied upon the decision of Mr Justice Lightman in *Glaxo Plc v Glaxowellcome Limited and Others* (1996 FSR 388) as authority for the proposition that a communication from a party described as "without prejudice" was not truly such where it could not be regarded as a bona fide effort to settle the dispute but rather an attempt to obtain a totally unwarranted sum from the other party.

30. In this connection Mr Prescott relied upon the evidence of Mr Eve as giving a broad indication of the commercial value of a licence from the opponent to set up a themed "BAYWATCH" restaurant in the UK. The sum the applicant had requested to assign the application bore no relation to the commercial value of a licence. Mr Prescott pointed out that the applicant had indicated in his evidence that he had no actual restaurant. The £15m asked for was purely in relation to the trade mark application.

31. Mr Ediriwira sought to distinguish his own case from Glaxowellcome by pointing out that “Bay” and “Watch” were two ordinary dictionary words which he had adopted honestly and before the opponent made its UK trade mark applications. He argued that the commercial value of property is determined by the market and what people are prepared to pay for it. To illustrate his point he said that whilst the cost of a can of Coca Cola may be only 25 pence in a shop, to a dying man in a desert it may be worth £2m.

32. I took the view that, on the face of it, the communications between the parties did not appear to fall in the category of normal commercial negotiations. However, Mr Ediriwira came to adopt the mark, the sum he was said to have subsequently placed upon his application (which was not denied) bore no possible relation to its normal market value or its apparent commercial value to him. In these circumstances I allowed Mr Black’s evidence to remain in the proceedings.

### **Decision**

33. I will first deal with the ground of opposition under s5(2). Before me, the opponent relied upon its registration of BAYWATCH under No 2009012 which includes Class 30. The mark was placed on the register on 23 February 1996, but by virtue of s40(3) of the Act it is registered as of 27 January 1995. The full specification in Class 30 is shown in paragraph 2 above.

34. This registration predates the application under opposition and it therefore constitutes an “earlier trade mark” by virtue of s6(1)(a) of the Act.

35. Section 5(2)(b) is as follows:

- (2) A trade mark shall not be registered if because -
  - a) it is identical to an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

36. The proper approach to the matter has been set out by the European Court of Justice in a number of recent cases, including *Canon v MGM* (1999 ETMR 1). The following passage from that case is relevant:

“17. A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

18. Furthermore, according to the case law of the Court, the more distinctive the earlier mark, the greater will be the risk of confusion (*SABEL*, paragraph 24). Since protection of a trade mark depends, in accordance with Article 4(1)(b) of the Directive, on there being a likelihood of confusion, marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.”

37. The applicant’s mark is BayWatch whereas the opponent’s is BAYWATCH. I do not think that whether a word is written in upper or lower case, or a combination of both, will normally have a bearing on whether the marks are identical. In my view they are identical. If I am wrong about this, the marks are virtually identical and therefore as similar as it is possible to be without being identical.

38. The opponent’s mark is registered in Class 30 for, *inter alia*, “snack food products” and “pizza”. The applicant’s mark is proposed to be registered for “restaurant services.” In my view the mark BAYWATCH has a highly distinctive character *per se* in relation to these goods and services. Although Mr Ediriwira says that the name was meant to conjure up an image of a

restaurant with views of a bay, I do not regard BayWatch as a natural use of the language for this purpose. There may have been more to say for this argument if the marks had been “BayView” or “Buena Vista.” I do not understand Mr Ediriwira’s explanation that BayWatch was chosen because these other names were too “passive” for what he had in mind. I can see that a more positive term might be more appropriate to describe a lifeguard’s duties, but I fail to see the inherent attraction of the word for restaurant services.

39. There is a degree of similarity between snack food products, such as pizza, and restaurant services, which can, of course, include pizza restaurants. Indeed although the possibility is already there within the services listed in his application, Mr Ediriwira indicated during cross examination that he envisaged his restaurant actually selling vegetarian snack food such as pizzas and samosas.

40. Taking account of the identity (or near identity) of the marks, the distinctive character of the marks and the degree of similarity between the goods and services, I believe there is a likelihood of confusion with the earlier trade mark. In this connection I note that the Court of Justice stated in paragraph 29 of their decision in Canon that:-

“...the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive.”

41. Accordingly, it is enough if the trade marks would lead the public to believe that the applicant’s restaurant and the opponent’s snack food products are produced by undertakings connected in trade, perhaps by a trade mark licence. I believe that the name BAYWATCH is an inherently strong mark and if used concurrently by the parties in respect of these goods and services, there is a likelihood that the marks will bring about such an understanding.

42. The fact that the applicant has owned a company with the name Baywatch Restaurants Ltd since 1994 can have no bearing on the matter under s5(2). Registration of a company name gives no right to register the name as a trade mark. I have therefore reached the clear view that the opposition under s5(2) of the Act succeeds.

43. Section 32(3) is as follows:

The application shall state that the trade mark is being used by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.

44. The application form contained such a statement. Clearly the statement must be true or the application is liable to refusal under s3(6) because it has been made in bad faith.

45. The opponent's case under s32(3) is that the applicant has no restaurant business and had no real plans to enter the restaurant business when the application was made. Mr Ediriwira was cross examined on his evidence at the hearing. The following extracts from the transcript cover the main points relevant to the question of whether he had a bona fide intention of setting up a restaurant under the BayWatch name in July 1995.

Q. You have had a company registered since the middle of 1994 to do with restaurants under the name Baywatch. Are your plans for opening a restaurant concrete at the moment or just a hope for the future?

A. ....If I had started a restaurant under that name, you would have issued a writ and drawn me into court, which would have cost me vast amounts of money. I was not going to be baited into such a situation. So that is why I postponed setting it up whilst this matter was finally settled so that I could go ahead peacefully.

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Q. So your concrete plans at the moment are for a single restaurant. Where is it going to be?

A. In London.

Q. In what part of London?

A. Any part of London will do.

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Q. How is this going to be financed?

A. Take out a mortgage and finance it.

Q. No, no, not just the building but the whole restaurant business. How are you going to finance it?

A. Bank loans. I will go and speak to a bank manager. I will also speak to my relations, friends or anybody who is interested. If I have to sell various things, I will do so.

Q. You will sell various things. Have you submitted various business plans to bank managers?

A. I told you I did not press it. I have not proceeded beyond that level because if I proceeded

beyond that level, I would have had to go to the High Court. I do not have the money to employ High Court lawyers to fight this case so I could not go that route. I had to wait until you finished this hearing and get my BayWatch name free. Then I could find any number of backers.

Q. What kind of food will you have?

A. Any kind of food.

Q. Any kind of food. What kind of food? Fish and Chips? Hamburgers? Caviare?

A. I do not intend to serve meat products. I intend to serve vegetarian products.

Q. Do you have any previous experience in the restaurant trade?

A. No, I do not have.

Q. Just so that you know where I am going, I say that this restaurant is simply not real. I submit that there is not a concrete idea in your head. Tell us about it. Give us a description to make it seem real. Convince the Hearing Officer that it is a real restaurant that you are thinking about.

A. It is a real restaurant. I told you that it will be a vegetarian restaurant. I do not anticipate having a bar. I anticipate serving very good food to people, either on a take away basis or eat on site. There are a number of types of foods, such as snacks, which will be sold. Some of the meals will be samosas, which will be vegetarian only. There are some other kinds of meals which are peculiar to Sri Lanka, which also I anticipate selling. I will also be selling pizzas and vegetarian pizzas as well. I am prepared to look at any kind of food which will catch the public's imagination to make it a success.

46. It will be apparent from the above that the applicant did not have well developed plans to provide restaurant services under the name BayWatch by the date of the hearing. It is not unreasonable for an applicant to delay progressing his plans when faced with a legal challenge from an opponent. Nevertheless, if the applicant had a bona fide intention to provide restaurant services under the mark in 1995, one would have expected him to have produced some business plans by 1999. Instead, I was left with the impression that the basic characteristics of the proposed restaurant were being formulated during the course of the cross examination.

47. The opponent claims that the applicant's real purpose was always to sell his application to it for an inflated price. Accordingly, it says the application was made in bad faith and should be refused under s3(6). This is pleaded as a separate but related ground of opposition to s32(3).

48. I note that the applicant's company changed its name to BAYWATCH RESTAURANTS LIMITED two years after the opponent's TV series was first shown in the UK. I have already indicated that I find Mr Ediriwira's explanation for choosing the BayWatch trade mark unconvincing.

49. The BayWatch name is a highly unusual mark for restaurant services. The fact that it was chosen after the opponent's TV series had been running successfully in the UK for a couple of years suggests to me that the mark was adopted because it would benefit from the distinctive character and repute of the TV programme of the same name. That *may* provide grounds for refusal under s5(3) of the Act, but I do not consider that, in itself, it amounts to bad faith.

50. Mr Pavlis states in his second declaration that the opponent decided to licence its mark in respect of restaurant services around April 1995 - a few months before the date of the application.. However, there is nothing to suggest that the applicant was or could have been aware of the opponent's intended trading activities in this area when he made his application in July 1995.

51. It seems that since becoming aware of the opponent's plans, the applicant has been prepared to exploit his application by placing a price on it that the opponent is entitled to label as "extortionate." But I am not persuaded that his application was originally made with the sole intention of selling it to the opponent.

52. Mr Ediriwira described himself as "a dreamer." I am prepared to accept that, at the time he made his application, he had a dream which involved a restaurant or restaurants called BayWatch. However, judging by subsequent events and the vagueness of many of the answers given during cross examination, I am not persuaded me that this dream was sufficiently concrete at the time of the application so as to amount to a bona fide intention to provide restaurant services under the mark. The opposition under ss32(3) and 3(6) therefore succeeds.

53. In the light of this finding, and my earlier finding under s5(2), I find it unnecessary to formally decide whether, for the purposes of s5(3), the title of the opponent's TV series

constitutes an earlier “well known” trade mark, or whether the applicant’s use of the BayWatch mark would, without due cause, take unfair advantage of the distinctive character or repute of the opponent’s mark.

54. There is also the ground of opposition under s5(4). Again, it is not necessary for me to determine the matter in the light of my earlier findings. I should observe, however, that although the opponent has provided substantial evidence that the use of the name BAYWATCH on a restaurant would provoke an association with their TV programme, there is less convincing evidence that this association would lead members of the public to believe that a restaurant or restaurants bearing the name was actually operated by, or connected in trade with, the providers of the TV programme. Misrepresentation is one of the necessary requirements for the opponent to succeed in establishing that it held a passing off right at the date of the application.

55. The opposition has succeeded and the opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1000.

**Dated this 12 Day of November 1999**

**Allan James**  
**For the Registrar**  
**The Comptroller General**