

O-056-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2431727
BY CREATIVE FASHION LIMITED TO REGISTER THE TRADE MARK**

WANNABE FAMOUS

IN CLASSES 9, 16, 35, 38, 41 AND 42

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 97399
BY ZEN TELECOM LTD/WANNABEFAMOUS LTD/MYFAMETUBE LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2431727
by Creative Fashion Limited to register the trade mark
WANNABE FAMOUS in Classes 9, 16, 35, 38, 41 and 42**

and

**IN THE MATTER OF Opposition thereto under No. 97399
by Zen Telecom Ltd/WannabeFamous Ltd/MyFameTube Ltd**

BACKGROUND

1) On 5 September 2006, Creative Fashion Limited (“Creative”), of 70 Totteridge Village, London, N20 8AE applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark WANNABE FAMOUS.

2) The application is in respect of the following goods and services:

Class 9

Computers; computer games software; handheld computer games; computer software and telecommunications apparatus to enable connection to databases and the Internet.

Class 16:

Reference books; manuals; catalogues; calendars; diaries; folders; conference folders; instructional and teaching materials (other than apparatus); stationery; photographs; photograph albums; drawings; stickers; parts and fittings for all the aforesaid goods.

Class 35:

Advertising and public relations; market surveys; product surveys; price surveys and product characteristics surveys; analysis of advertising response and market research; commercial information services provided by access to a computer database; business management; business administration; office functions; computerise data-base management; information, advisory and consultancy services relating to all the aforesaid.

Class 38:

Telecommunications; broadcasting by radio, television and satellite; broadcasting and transmission of programmes; operation of broadcasting

facilities; computer inter-communication services; communication services provided by electronic, computer, cable, teleprinter, teletype and electronic mail means; communications services provided on the Internet; transmission of information; communication by computer terminals; message sending services; telegraph services; wire services; all the aforementioned services also provided on-line from a computer database or from the Internet; information and advisory services relating to telecommunication services; data links services; information data processing services; compilation, storage, analysis, retrieval and provision of information services; database services; providing databases and directories via communications networks for obtaining data; creating indexes of information received from users of global computer networks for others; advices and consultancy regarding the aforesaid.

Class 41:

Providing on-line electronic publications (not downloadable); publication of newspapers, periodicals, magazines, books, texts and printed matter; publication of electronic information, product surveys, price surveys, product characteristics, newspapers, periodicals, books or journals on-line; theatre ticket booking services: booking services for entertainment; sporting and cultural activities; publishing services; entertainment services provided at country clubs and hotels; night clubs; organising of sporting and entertainment events and competitions; sports and entertainment information services; betting advisory services; provision of news and cultural programmes; radio, television and satellite entertainment services; production of shows and theatre performances; management of entertainment facilities; provision of recreational facilities; provision of sporting facilities and activities; organising and conducting exhibitions, fairs, conferences, conventions, seminars, displays and/or events; production and presentation of films, audio and video tapes and cassettes, slides and records; all the aforementioned services also provided on-line from a computer database or from the Internet; advice and consultancy regarding the aforesaid.

Class 42:

Computer research, development, advisory and consultancy services; computer helpline services; computer hardware and software support services; computer information services; evaluations, assessments and research in the fields of science and technology; design, development, installation, updating and maintenance of software; scientific and technological services and research and design relating thereto; analysis and research services; design and development of computer hardware and software; computer hardware and software consulting services; rental of computer hardware and software apparatus and equipment; multimedia

and audio-visual software consulting services; computer programming; support and consultation services for developing computer systems, databases and applications; graphic design for the compilation of web pages on the Internet; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; provision of web-sites featuring multimedia materials; hosting the web-sites of others; licensing of intellectual property; providing search engines for obtaining data via communications networks; application service provider (ASP) services featuring software for use in connection with online database services.

3) On 19 June 2008, Zen Telecom Ltd, WannabeFamous Ltd and MyFameTube Ltd, all of Kent Innovation Centre, Thanet Reach Business Park, Millennium Way, Broadstairs, Kent, CT10 2QQ filed notice of opposition to the application. These three companies are associated companies and trade as a group. I shall refer collectively to them as “Zen”. Their opposition is based on a single ground, namely that they have goodwill and reputation in the sign WANNABE FAMOUS in relation to unspecified goods and services in classes 9, 16, 35, 38, 41 and 42 and as a result of “extensive advertising of the same”. The application therefore offends under Section 5(4) (a) of the Act. Use is claimed from 7 June 2001. It opposes Creative’s application in respect of all of its goods and services.

4) Creative subsequently filed a counterstatement denying the opponent’s claims and putting them to strict proof of its claims regarding first use, goodwill and reputation.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither party requested a hearing, but both parties filed written submissions in lieu of a hearing. After a careful consideration of the papers, I give my decision.

Zen’s Evidence

6) This consists of two witness statements. The first of these, dated 6 January 2009, is by Terence William Simpson, a director all three companies that I refer to as Zen. He explains that the three opponent companies are associated companies and trade as a group with all three using the sign WANNABE FAMOUS. He states that Zen Telecom Ltd is the owner of the website www.fame-by-phone.co.uk and that, prior to 8 September 2006, it was also the owner of www.britstars.tv, a website now suspended. Myfame Tube Ltd is the owner of website “SpringboardUK” that, before 8 September 2006, was accessed via www.pm-global-services.com. He also explains that Wannabefamous Ltd is the *Google* advertising agent and website content manager for the other two companies.

7) Mr Simpson states that the sign was first used in 2001 by Britstar Ltd, Zen Telecom Ltd's name at that time. Exhibit TWS3 is a copy of a page from Stage magazine, dated 24 May 2001 showing a small advertisement bearing only the words "WANNA BE FAMOUS? www.britstars.tv". Mr Simpson states that this shows use of the sign in respect of "these goods/services", but does not explain what "these goods/services" are. Further exhibits are provided showing advertisements in the same publication. These are:

Exhibit TWS5

The advert is dated 2 August 2001 and appears on the "Classifieds" page under the sub-heading "On-Line Services". Much of the text is small and unclear, but the words WANNABE FAMOUS can be seen at the top and this is followed by what is possibly a list of the websites associated with Zen and the words "Wannabe [????] extra?", "Wannabe TV extra?", "Wannabe [???? ??????]" and a fourth line that is totally illegible.

Exhibit TWS6

The date at the top of the page is 19 November 2003, but Mr Simpson, in his statement, states that it is 13 November 2006. This advert is, once again, on the "Classified" page but this time under the heading "Extras" and reads "WANNABE FAMOUS? Visit www.britstars.com now or send a s.a.e. to Brit Stars Ltd" at an address in London.

8) Exhibit TWS9 provides invoices relating to the advertisements that appeared in Stage magazine. An example of how the order details are recorded on these invoices is:

"24/05/01 Advertising Sales
Run of Paper 2 Columns x 30.00
Inserts 1 09517746
Wanna be famous?
PD BT CREDIT CARD"

9) At TWS7, Mr Simpson provides a proof copy of an advert, together with eight invoices relating to placements of the advert in the magazine New Musical Express between 30 January and 20 March 2002. The advert offered auditions and opportunities for acting, extras, singing auditions and for becoming a model. The words "WANNABE FAMOUS?" appear at the top of the advert and interested parties are invited to text to a given number or to visit the website www.famebyphone.co.uk. Exhibit TWS17 provides copies of two invoices to "Fame By Phone", both dated 30 November 2003, for "clickthrough charges", No further explanation is provided as to what these charges relate to, but it is contended that these invoices also show indicative use of the sign. The sign is not mentioned in the invoices.

10) Exhibits TWS10, TWS12 and TWS 13 consist of a total of five invoices dated between 7 December 2005 and 19 June 2006 showing the recipient company name as “wannabefamous” or “WANNABE FAMOUS”. The first and third appear to relate to the purchase of computer software, the second to the purchase of stationery. Mr Simpson provides these to show indicative use of the sign. Other documents such as a credit note, are also provided to demonstrate the same.

11) Exhibit TWS11 is a copy of a handwritten invoice dated 31 August 2004 for a taxi advertisement. Handwritten, in capitals, at the bottom of the invoice is “WANNABE FAMOUS ADS”. Mr Simpson explains that this relates to the displaying of WANNABE FAMOUS leaflets in taxi cabs.

12) Exhibit TWS18 is a copy of part of a discussion thread from www.ukscreen.com dated 6 January 2006. These discussions are all headed “r.e. Wannabe Famous (pm-global-services.com) – any good?”. Mr Simpson provides this to illustrate that WANNABE FAMOUS is connected to [www. pm-global-services.com](http://www.pm-global-services.com).

13) Exhibit TWS19 is a copy of a letter sent by the opponent to the Department of Trade and Industry (“the DTI”), dated 21 October 2004 notifying it that it intended launching an online publication entitled WANNABE FAMOUS. It explains to the DTI that it offers people who wish to become famous, the opportunity of displaying their details in its publication for a fee. It appears from the continued explanation that a person would access this service via a mobile phone and would be charged £1.50 by the phone operator who would then pass a proportion of this fee on to Wannabefamous. This fee would be required for each edition of the publication.

14) To further illustrate how the sign is promoted, Mr Simpson provides, at Exhibit TWS21, a copy of a “Google Adwords campaign management sheet” relating to the period 10 September 2004 to 7 January 2009. At the top of this page is what appears to be the text of an online advert. This states “WANNABE FAMOUS? Get auditions for acting, modelling & dancing www.fame-by-phone.com”. A table of information relating to this is then displayed, but the meaning of this information is not obvious and has not been explained by Mr Simpson. Also displayed in this exhibit are extracts from the website “Fame by phone”. Displayed prominently on the first of these pages are the following words:

*Wannabe famous?
Anyone can be a star!*

*Opportunities from dozens of companies
Including the BBC, ITV, Channel 4 and 5,
Endemol Productions, Brighter Pictures and
Many many more...*

Springboard to Stardom!

15) A useful explanation of its services is also provided. It explains how audition opportunities for extras/actors, singers, fashion models, dancers and contestants in TV reality shows can be texted to customers' mobile phones. .

16) Exhibit TWS23 provides copies of pages from the website SpringboardUK, hosted by pm-global-services.com. Mr Simpson states that this was launched on 15 March 2005. On the first of these pages, alongside the SpringboardUK name appearing at the top, are the words "Wannabe Famous"

17) At Exhibits TWS24 and TWS25 are copies of the results of Google and Ask.com Internet searches, both dated, 2 January 2009, for the words "wannabe famous". The search was not limited to the UK and it brought back 3,270,000 hits. The first hit recorded is that linking to the website pm-global-services.com. The hit is headed "Wannabe Famous" and the text "You could find yourself shot to stardom overnight appearing on a TV reality show just like dozens of other previous wannabe unknowns who are now house...". I also note that five other hits are shown on the page. All these contain use of the phrase "wannabe famous" or "wanna be famous" in the context of either asking "do you want to be famous" or "who wants to be famous". On one occasion it is used as a noun to describe people who want to be famous. Similar results are obtained from a Yahoo Internet search and a MSN Internet search. These are exhibited at TWS26 and TWS27 respectively. Of the last of these, Mr Simpson states the search result "showing www.pm-global-services.com, as a non-sponsored entry, in 3rd place of over 4 million websites containing the Trade Mark wannabe famous, indicative of the reputation and goodwill My Fame Tube Ltd has acquired in the mark...". Further similar exhibits are provided at TWS28, TWS29 and TWS30.

18) At Exhibit TWS31, Mr Simpson provides twenty invoices from Google Ireland Ltd. These are billed to "wannabe famous", but Mr Simpson provides no explanation as to what these invoices relate to other than to repeat his statement that they are "showing indicative use of the trade mark in relation to these goods/services..." and adding "...showing wannabefamous ltd using wannabefamous as a trading name". These are all dated between 2 February and 12 February 2006 and are "for advertising services rendered". Under the

heading “description” are numerous different entries such as “Fame by Phone USA”, “lost monies”, “land grab”, “auditions line”, “meeting usa” and “Fame by Phone UK”. Similar invoices are also provided at Exhibit TWS32, relating to the date range 2 August and 12 August 2006.

19) At Exhibit TWS33 and TWS34, Mr Simpson also provides extracts from Britstars Limited’s (the previous name of Zen Telecom Ltd) and Wannabefamous Limited’s accounts showing the promotional spend in respect of the sign. These costs are:

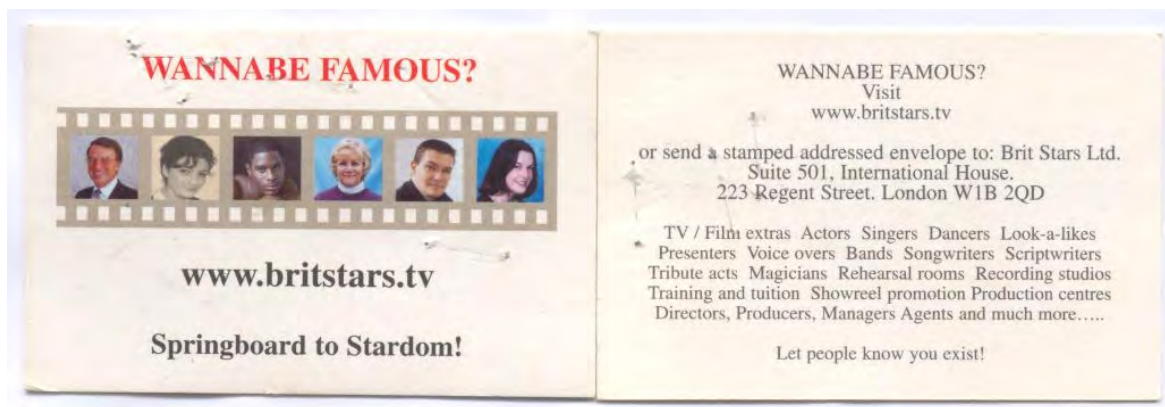
Period	Britstars	Wannabe Famous
1 April 2001 to 31 March 2002	1,762	-
1 April 2002 to 31 March 2003	1,831	-
1 April 2003 to 31 March 2004	19,408	-
1 April 2004 to 31 March 2005	45,928	10,445
1 April 2005 to 31 March 2006	-	122,407
Total	68,930	132,853

20) At Exhibit TWS35 is a subscriber list (with some details removed to compile with data protection regulation) obtained from the debit/credit card processor *World Pay*. Mr Simpson explains that this is a list of paying subscribers for SpringboardUK in June 2006. Mr Simpson states that this exhibit illustrates that SpringboardUK had 6,642 subscribers at that time.

21) The final two exhibits, TWS36 and TWS37, provide copies of a total of 18 invoices from Zen Telecom Ltd to *World Pay* for membership fees to SpringboardUK. The first eight relate to the eight months prior to the filing date of Creative’s mark and are for amounts between £1,181 and £6,339. The second eight invoices relate to a period after Creative’s filing date.

22) The second witness statement, also dated 6 January 2009, is by Stephen Edward Farron, a Dartford Licensed taxi driver. He explains how, in March 2002, he was engaged by Britstars Limited (a previous name of Zen) to distribute credit card sized advertising cards to night clubs and dance venues in London and the South East of England. He distributed “over 10,000 of these cards to the general public during 2002, 2003 and 2004.”

23) One of these advertising cards is provided at Exhibit SEF1 and this is reproduced below:



24) Mr Farron also states that he had a “poster sized” version of the same card fixed to the flop down seat of his taxi. Finally, he also states that, in March 2002, he was engaged by Britstar Limited to distribute advertising postcards in the same way as the cards. He distributed 300 of these during 2002, 2003, 2004. This copy of such a postcard is provided at Exhibit SEF2. This shows a Union Jack with the words WANNABE FAMOUS? Superimposed across the front of the flag and at the bottom is the web address www.britstars.tv.

Creative’s Evidence

25) This is in the form of a witness statement, dated 19 June 2009, by Dennis K T Lee, solicitor with Silverman Sherliker LLP, Creative’s representatives in these proceedings. He states that archived versions of Zen’s websites www.fame-by-phone.co.uk, www.britstars.tv and www.pm-global-services.com are available on the website archive.com. At Exhibits DKTL-1, DKTL-2 and DKTL-3, Mr Lee provides extracts from this last website, known as *Waybackmachine* and with the website address of archive.org. These extracts provide information on the size and scope of the archive.

26) At Exhibit DKTL-4, Mr Lee provides the results from *Waybackmachine* search relating to the website Fame-By-Phone.co.uk. This records that there were no pages matching this search for the years 1996 to 2002 inclusive, two pages in 2003, five pages in 2004, four pages in 2005, five pages in 2006, two pages in 2007 and no pages in 2008. At Exhibit DKTL-5, he provides copies of the most recent pages from Fame-By-Phone.co.uk that pre-date Creative’s application date. Exhibited are fifteen pages. The first of these shows the same page and text referred to in paragraph 14 above and submitted as part of Zen’s evidence. Mr Lee states that he attempted to view the other pages listed on *Waybackmachine* and found that those relating to the period 19 May 2004 to 5 February 2005 appear to show that the website was not operational and that a mere “placeholder” webpage was in use. Exhibit DKLT-6 provides two of these placeholders. The first carries the message “This domain has been registered for

a client by Easyspace”. The second carries the message “Unfortunately, due to various circumstances, Fame by Phone is no longer operational or available. If you wish to unsubscribe from our service click here. Thank you.”

27) In respect to the first three archive records (dated 30, October and 30 December 2003 and 3 April 2004), Mr Lee states that the records did show an operational website, but in a much more basic form than seen in August 2006. Some extracts from this website as of 3 April 2003 are provided at Exhibit DKLT-7. Mr Lee describes these as a “representative selection”. There is one instance of use of the phrase WANNABE FAMOUS. This appears on the page relating to dancing auditions and the most relevant extract is reproduced below:

“Wannabe Famous? Tired of being stuck in a dead end job or bored with wasting your life away? Fed up with missing opportunities? Fame by phone is a unique and exciting new service for the UK public wanting a career in dancing. Whether it be on stage in theatre or dancing behind big starts in concerts etc, if the right people don’t know you exist then you will never realize your dream. Due to the explosion of new groups, singers and concerts, your chances for success are better now than [sic] ever before. Stop missing out! ...”

28) Mr Lee conducted similar investigations into the archive history of Zen’s second website, Britstars.tv. His search results are at Exhibit DKLT-9. This shows the existence of pages on the website from 12 March 2001 until 8 June 2007. At Exhibit DKLT-10, Mr Lee provides copies of the main pages from the search entry for 31 August 2006, being the latest entry prior to Creative’s application date. At the top of the page, the name BRIT STARS appears prominently in front of a partial union jack. A number of bullet points appear down the right hand side of the page. The first of these has the text “Wannabe Famous? Anyone can be a star!” A few pages further on, a page headed “SMS Showcall” also carries the text “Wannabe Famous? Enter here” There are no further references to WANNABE FAMOUS.

29) A more basic website of Britstar’s is exhibited at DKLT-11 relating to its get-up in 2001. The page dated 27 November 2001 carries the following banner text:

“ BRIT STARS.TV Britains biggest and most powerful online self-promotion tool. Wanna be famous? Le...”

30) A similar investigation of the archive history for PM-Global-Services.com (SpringboardUK) was also conducted by Mr Lee. This showed an active website operating between 11 March 2005 and 23 December 2007. The *Waybackmachine* search result is produced at Exhibit DKLT-12. Once again, Mr Lee provides extracts from one of the archived entries, this time for 18 August 2006. These extracts are at Exhibit DKLT-13 and, Mr Lee states that his investigations show that at that date the website had substantially the same

content as in all the earlier archive entries for the website. Of the twenty eight pages exhibited, only one features the words WANNABE FAMOUS and appears as follows:

“Wannabe Famous?!

Auditions and opportunities? Fed up with getting older and watching your chance of fame slowly slip away simply because you are lacking courage or motivation? Stuck in a dead end job with no prospects? Unemployed or drifting through school or college unfulfilled?

SpringBoard UK is a unique and exciting new service for people just like you wanting to become famous.

...”

31) Finally, at Exhibit DKLT-14, Mr Lee provides a single page from the website as it appeared On 11 March and 13 October 2005. Mr Lee claims that at these earlier dates, there was a heavy reliance upon the brand “Audition UK”. The page provided shows these words, as part of a composite mark, appearing at the top of the page. The term WANNABE FAMOUS does not appear.

Zen’s Evidence in reply

32) This is in the form of a further witness statement by Mr Simpson, dated 14 September 2009. Mr Simpson refers to specifically to Mr Lee’s Exhibit DKTL-3 and draws attention to the pages exhibited providing information regarding the technical reasons why sites may have all or some of their content missing. He also points out that the following disclaimer appears on the website:

“The Wayback Machine was not designed for legal use”

33) Mr Simpson then points out that Exhibit DKLT-7 of Mr Lee’s evidence shows incomplete information as Waybackmachine has failed to capture certain unspecified image and text. Mr Simpson states that, as a result, it is not possible to determine whether or not the mark “Wannabefamous” had been displayed on these web pages. Mr Simpson criticises Mr Lee’s Exhibits DKTL-8 and DKTL-11 in the same way.

DECISION

Section 5(4)(a)

34) I will consider the ground under Section 5(4) (a). That section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

35) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

36) To the above I add the comments of Pumfrey J (as he then was) in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case [2002] RPC 19, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade

as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

The Relevant Date

37) The relevant date for determining the opponent’s claim will be the filing date of the application in suit (*Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115), that is to say 5 September 2006. The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based).

Goodwill, Misrepresentation and damage

38) Creative does not claim any use itself and therefore I do not need to consider issues such as who is the senior user or the impact of concurrent trading. I will therefore begin by assessing if the opponent has acquired any goodwill and if so, what is the extent of this goodwill at the relevant date. As the three opponent companies are associated companies and trade as a group, I will consider the extent of the goodwill in the context of a single goodwill being shared equally by all three companies. This presents the opponent with its best chance of success and if it cannot succeed based upon this assumption, it cannot succeed where the goodwill may be divided between the opponent companies.

39) At point 2, page 7 of its statement of grounds, Zen states that it has used its sign in respect of goods and services in classes 9, 16, 35, 41 and 42 but does not specify what these goods and services are. The evidence filed in support of its case plainly does not support such a wide claim. What the evidence does show is that the opponent companies are involved in providing information to its customers to enable them to attend auditions and other casting events relating to opportunities for extras/actors, singers, fashion models, dancers and for those looking to become contestants on TV reality shows. These services are provided via mobile phone texts and also through its various websites.

40) Such services belong to either Class 35 (where the auditions relate to the recruitment of performers) or Class 41 (where the auditions relate to finding contestants for such events as game shows or talent contests). As such, I find that Zen’s claim to having used WANNABE FAMOUS, or any other sign for that

matter, in respect of goods in Class 9 and 16 or services in Class 42, to be unfounded. Further, insofar as Zen claim use in respect of services in Class 35 and Class 41, I find that such use is limited to the services identified above. That is what the business provided and that is what any goodwill will relate to. Some information is provided by Zen regarding the scale of its business. It discloses promotional spend, for the period 1 April 2001 to 31 March 2006, totalling nearly £69,000 in respect of Britstars Limited and nearly £133,000 in respect of Wannabefamous Limited. Further, Zen discloses that in June 2006, SpringboardUK had 6,642 paying subscribers. Whilst such figures provide an incomplete picture (for example, no turnover figures have been provided), when viewed in combination with the other evidence filed, they do show that the opponent companies all have a trading presence that has generated goodwill in respect of the services I identified earlier.

41) Having concluded that the applicant companies have a protectable goodwill, I must go on to consider by what distinguishing feature this goodwill is known. The provider of Zen's services is variously described as "fame-by-phone" (and its associated websites fame-by-phone.co.uk and famebyphone.co.uk), "britstars" (and its associated websites britstars.tv and britstars.com) and "SpringboardUK". The issue is far less clear in respect to the sign WANNABE FAMOUS. The term appears in the promotion of all three of Zen's providers, but the nature of this use is not persuasive.

42) I must consider the nature of use of the sign when assessing how an opponent's goodwill is distinguished. Guidance on this point can be found in Christopher Wadlow's *The Law of Passing Off* (Third Edition) at paragraph 8-1:

"...the misrepresentation is almost always made, or alleged to be made, by the defendant using in relation to his goods or business some matter such as a name, word, device, get-up or other sign which is deceptively similar to matter which the claimant claims to be distinctive of himself. If the claimant cannot prove the distinctiveness of the matter relied on then a passing-off action based on it must fail *in limine*."

43) In the current circumstances the sign in question is a contraction of the question "do you want to be famous?" and as such can be understood by Zen's customers and potential customers as being a non-distinctive term when promoting a service of providing information about events that can, indeed, lead to the customer becoming famous. As such, it is appropriate to consider here the guidance in Wadlow and to explore whether the use of the sign WANNABE FAMOUS, by Zen, is distinctive of its services.

44) The evidence, relevant to this point, can be conveniently considered in three distinct groups. Firstly, there are the exhibits showing promotional material for Zen's services. Secondly, there are invoices relating to this promotion and thirdly, there is one exhibit illustrating an Internet blog discussion regarding its services.

The first group of exhibits include advertisements placed in Stage magazine showing the term WANNA BE FAMOUS being used to ask a question of the reader. This is highlighted by the use of a question mark after the term. The contact is given as www.britstars.tv and it is this that indicates trade origin to the reader rather than the term WANNA BE FAMOUS which is used in a wholly non-distinctive way to ask a question to the reader. Similarly, the use of the term on the website www.fame-by-phone.com is in the form of a question to the reader. These examples are representative of the evidence filed illustrating Zen's promotional activities. Earlier in this decision, I included a copy of a business card used to promote the services of www.britstars.tv. This further illustrates the term being used as a question to Britstars' potential clients rather than to indicate the origin of the services. It is clear from the content on the card that the trade origin of the services is identified by the website address that incorporates the name Britstars. In all of these exhibits, the term WANNABE FAMOUS is always used to ask a question of the reader and the clients and prospective clients of Zen's services will not attach any significance regarding trade origin to the term WANNABE FAMOUS. All of the above examples relate to use of the term WANNABE FAMOUS followed by a question mark. However, there are a small number of exhibits, such as the copy of the first page of the SpringboardUK website where the term appears without a question mark. I do not see this as a critical point because the consumer is used to punctuation being used incorrectly or missing all together. The questioning nature of the term is not likely to be diminished by the absence of a question mark to any great degree.

45) The second group of exhibits are in the form of numerous invoices. Many, but not all, show the company being billed as either Wannabe Famous Ltd or Wannabe Famous. These invoices are in respect of adverts placed in the magazines Stage and New Musical Express, adverts placed on the online search engine Google and in respect of the purchase of items such as computer software and stationery. However, the traders that such invoices originate from are not the customer of Zen's services and therefore not part of the relevant class of persons for assessing the existence of goodwill and misrepresentation. As such, these invoices do not advance Zen's case that WANNABE FAMOUS is a distinguishing feature by which its goodwill is identified.

46) Finally, I turn to consider the one exhibit relating to an Internet blog discussion on the merits of Zen's services. This is the extract from www.ukscreen.com showing a discussion thread entitled "Wannabe famous (pm-global-services.com) – any good?". It would appear that the instigator of the thread, namely the person posting the original message, has referred to WANNABE FAMOUS in a manner that suggests some significance in identifying trade source. However, he has found it necessary to also refer to pm-global-services.com which, as Zen has explained, in the website through which SpringboardUK's services are accessed. This single and inconclusive example is simply insufficient to demonstrate that Zen's services are recognised as the distinguishing feature WANNABE FAMOUS. Without further corroboration it

cannot be accepted as being indicative of the perception of the relevant class of persons, namely Zen's clients and potential clients.

47) I should also make reference to Zen's intention to launch an online publication entitled WANNABE FAMOUS, as indicated in its letter to the DTI. This exhibit illustrates that Zen had an intention to trade under the sign, however, as I have already considered, none of its subsequent use has been such as the relevant class of persons will see the sign as indicating trade origin. Further, it is not clear to me whether this magazine was ever launched, or if it was, that use of the term WANNABE FAMOUS was in a way other than what has been shown in Zen's other exhibits. As such, I find that this exhibit does not advance Zen's claim in any way.

48) Taking all of the above considerations into account, and considering Zen's evidence in its totality, I find that its use of the sign WANNABE FAMOUS is in a non-distinctive manner. As such, it does not function to indicate the origin of Zen's services, but rather, only as a question to the relevant class of persons, being Zen's clients or prospective clients (*per* Lord Diplock in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 731)

49) Finally and for the sake of completeness, I should say that I have borne in mind the criticisms of Zen's evidence made by Creative and Zen's response to this, however, in light of my findings above, it has not been necessary for me to consider the merits of these.

50) In summary, whilst I have found that Zen is a group of associated businesses with goodwill in respect of the services identified in its evidence, the sign WANNABE FAMOUS has not been used as a distinguishing feature or identifying get-up for this goodwill (see *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341). As such, I find that Zen has failed to demonstrate that it has any protectable goodwill in the UK in respect of the sign WANNABE FAMOUS. Creative's use of the same sign cannot therefore amount to a misrepresentation. The opposition therefore fails in its entirety.

COSTS

51) The opposition having failed, Creative is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place but that it did file written submissions in lieu of a hearing. I award costs on the following basis:

Considering Notice of Opposition preparing statement in reply	£300
Preparing evidence & considering on other side's evidence	£800
Filing written submissions	£400
TOTAL	£1500

52) I order Zen Telecom Ltd, WannabeFamousLtd and MyFameTube Ltd, being jointly and severally liable, to pay Creative Fashion Limited the sum of £1500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11 day of February 2010

**Mark Bryant
For the Registrar,
the Comptroller-General**