

O-087-10

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF:

- 1) MR JOHN PEPIN'S OPPOSITIONS (NOS 95351A & 98132) TO TWO
TRADE MARK APPLICATIONS (2446109A & 2487699)
BY FREEMANTLEMEDIA LIMITED & SIMCO LIMITED
TO REGISTER THE TRADE MARKS:**



&

BRITAIN'S GOT TALENT

AND

- 2) FREEMANTLEMEDIA LIMITED & SIMCO LIMITED'S OPPOSITION (NO
98973) TO TRADE MARK APPLICATION 2506974
BY MR JOHN PEPIN TO REGISTER THE TRADE MARKS**

**Britains Got Talent
&
Britains got talent**

Background

1. These are consolidated proceedings involving Mr John Pepin on the one hand and Freemantlemedia Limited & Simco Limited (I will refer to them as “Freemantle” & “Simco” respectively) on the other. Of the three applications for registration being considered, the first to be filed was application no 2446109A¹. This was filed on 8 February 2007 by Freemantle and Simco. The application is for the following two marks (it is a series application):



Registration is sought in relation to the following services in class 41:

Education and entertainment services all relating to television, cinema, radio and theatre; production and presentation of radio and television programmes, films and shows; education by or relating to television and radio; entertainment by or relating to television and radio; organization of competitions (education or entertainment); interactive telephone competitions; publishing; production of cinematographic films, shows, radio programmes and television programmes; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the Internet; organization of shows; rental of sound recordings and of pre-recorded shows, films, radio and television performances; production of video tapes and video discs; radio entertainment; television entertainment; cinema entertainment; theatre entertainment; game shows; television entertainment services involving telephonic audience participation; interactive entertainment for use with a mobile phone; Internet based games; operation of lottery and games of chance; provision of video clips via mobile or computer networks for entertainment and/or educational purposes.

¹ The application was originally in more classes but it was divided during the proceedings (the opposition was not directed at the other classes) so allowing its sibling, 2446109B, to proceed unopposed.

2. Mr Pepin opposes application 2446109A under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Mr Pepin’s claim is that he has used the signs “BritainsGotTalent.com” & “britainsgottalent.com” since May 2006 to display other companies advertising for goods and services in the field of inventions, modeling and talent, as well as DVD’s toys and other goods. Mr Pepin only opposes the following services:

Provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the Internet; Internet based games; provision of video clips via mobile or computer networks for entertainment and/or educational purposes.

3. The next application filed was 2487699. It was filed on 16 May 2008 by Freemantle and Simco. The mark consists solely of the words BRITAIN’S GOT TALENT. Registration is sought in relation to:

Class 09: Cinematographic films; animated cartoons; film strips; movies; magnetic recordings; optical recordings; magneto-optical recordings; solid-state recordings; audio-visual teaching apparatus; amusement apparatus adapted for use with television receivers; electronic books and publications; electronic games; interactive games adapted for use with television receivers; electrical and video amusement apparatus and instruments; multi-media discs and publications; multi-media recordings and publications; laser-readable discs; video discs and publications; computer software; computer programs; digital recordings; media bearing, or for recording, sound and/or video and/or data and/or information; apparatus and instruments for recording and/or reproducing sound and/or video and/or information; holograms; floppy disks; sound recordings; pre-recorded disks; recording disks; compact discs; gramophone records; audio tapes; tape cassettes; video tapes; laser discs; compact discs-interactive CD ROMS; digital video discs (DVD); communications apparatus and instruments; telephones; mobile phones; chargers; chargers for mobile phones; hands-free apparatus for mobile phones; mobile phone games; karaoke machines; parts and fittings for all the aforesaid goods; digital games, mobile phone games; DVD games.

Class 16: Paper; cardboard; paper articles; cardboard articles; printed matter; books; annuals; publications; comic books; song books; magazines; newsletters; newspapers; albums; periodicals; journals; catalogues; manuals; maps; pamphlets; leaflets; posters; stationery; labels; office requisites; drawing and painting materials, apparatus and instruments; writing instruments; instructional and teaching materials; instructional and teaching materials in the form of games; book binding materials; book covers; book marks; printing sets; drawings; paintings; photographs; prints; pictures; calendars; pens; pencils; pencil top ornaments; paints; paintbrushes; paint kits; tags; gift wrap; gift wrap cards;

gift wrap tissue; gift boxes; wrapping paper; note pads; decalcomanias; paper napkins and other decorative paper items; paper party goods and paper party decorations; paper tablecloths and table covers; paper mats; paper party streamers; embroidery patterns; decorative transfers; rulers; erasers; greetings cards; stickers; paper signs; banners; charts; parts and fittings for all the aforesaid goods.

Class 25: Articles of clothing; footwear; boots; shoes; slippers; sandals; socks; hosiery; trainers; headgear; hats; caps; scarves; gloves; mittens; belts (being articles of clothing).

Class 28: Games, toys; playthings; gymnastic and sporting articles; electronic toys and electronic games; slot machines and gaming devices; dolls and dolls' clothing; teddy bears; playing cards; parts, fittings and accessories for all the aforesaid goods.

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; ingredients for food in class 29.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery; ices; honey, treacle; yeast, baking powder, salt, mustard, vinegar, sauces, condiments, spices, ice; essences for food stuffs; herbal infusions; ingredients for food in class 30.

Class 41: Education and entertainment services all relating to television, cinema, radio and theatre; production and presentation of radio and television programmes, films and shows; education by or relating to television and radio; entertainment by or relating to television and radio; organization of competitions (education or entertainment); interactive telephone competitions; publishing; production of cinematographic films, shows, radio programmes and television programmes; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the Internet; organization of shows; rental of sound recordings and of pre-recorded shows, films, radio and television performances; production of video tapes and video discs; radio entertainment; television entertainment; cinema entertainment; theatre entertainment; game shows; television entertainment services involving telephonic audience participation; interactive entertainment for use with a mobile phone; Internet based games; operation of lottery and games of chance; provision of video clips via mobile or computer networks for entertainment and/or educational purposes.

4. Mr Pepin opposes application 2487699 on the following grounds:

- Under section 3(1)(a) of the Act because the trade mark applied for does not distinguish itself from Mr Pepin's use of "BritainsGotTalent" and "BritainsGotTalent.com";
- Under section 3(6) of the Act because the application was made in bad faith as it covers classes and uses that could not possibly be within any reasonable use and that the applicant has ignored the fact that it is aware of the opponent's prior use;
- Under section 5(4)(a) because the signs "BritainsGotTalent" & "BritainsGotTalent.com" have been used on the Internet since 17 April 2006 in relation to [advertising] a range of goods and services, namely: electronic games; compact discs; compact discs-interactive CD-ROMS, digital video discs (DVD); mobile phone games; DVD games; games, toys; electronic toys and electronic games; interactive telephone competitions; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the Internet; organization of shows; provision of video clips via mobile or computer networks for entertainment and/or educational purposes; dissemination of advertising for others via the Internet. Mr Pepin argues that the use by the applicants of the applied for mark would amount to passing-off.

Mr Pepin opposes all of the goods and services of application 2487699.

5. The third and final application being considered is 2506974. This was filed on 22 January 2009 by Mr Pepin. The application is for the following two trade marks (it is a series application):

Britains Got Talent
britains got talent

Mr Pepin seeks registration for:

Class 35: Advertising of the goods or services of other vendors, enabling customers to conveniently view and compare the goods or services of those vendors; Dissemination of advertising for others via the Internet

6. Freemantle and Simco oppose Mr Pepin's application. They rely on their earlier trade marks (the ones being opposed by Mr Pepin) under sections 5(2)(a), 5(2)(b) and 5(3) of the Act. They also plead a ground under section 5(4)(a) in view of their use of the sign BRITAIN'S GOT TALENT since June 2007. Freemantle and Simco oppose all of the services that Mr Pepin seeks to register.

7. Given the relationship between the three sets of proceedings, the cases were consolidated. All parties were given ample opportunity to file whatever evidence they wished to in support of their respective claims and counterclaims. All evidence filed (even if it was initially filed on only one set of proceedings) will be treated as common evidence. The claims made on each of the oppositions will, though, be dealt with as pleaded.

8. Mr Pepin filed evidence as did Freemantle and Simco; this is summarised below. The matter then came to be heard before me on 14 January 2010 at which Mr Pepin represented himself and Mr Guy Tritton of Counsel, instructed by Marks and Clerk, represented Freemantle and Simco.

The evidence

First witness statement of John Pepin (9 December 2007)

9. Mr Pepin states that the “BritainsGotTalent.com” domain name was registered on 17 April 2006. Exhibit A is a *whois* print showing this to be correct; Mr Pepin is shown as the registrant. Mr Pepin explains that the web page linked to this domain name is located on the server of a company called *NameDrive* which provides advertising for a large range of companies and products ranging from modeling, talent shows, inventions, acting and others. Exhibit B shows a screen print from the web page. It is depicted later in this decision.

10. Mr Pepin explains that the advertising displayed on the web page changes every time someone visits it. *NameDrive* make a payment to him for every visitor who visits one of the advertised companies. Exhibit C is a letter from *NameDrive* (addressed “to whom it may concern”) confirming all this and that pay-per-click revenue has been generated. The rest of this first witness statement is more in the nature of submission (regarding the counterstatement of Freemantle/Simco) rather than evidence of fact. It will be borne in mind but not summarised here.

Witness statement of Isabelle Brender (26 February 2008)

11. Ms Brender is the trade mark manager of Freemantle. Ms Brender states that in 2005 Simco came up with the idea of a television talent show to be hosted by the entertainer Paul O’Grady. It was to be called “Paul O’Grady’s Got Talent”. Two trade marks were filed around this time by Freemantle and Simco, one for the words GOT TALENT (registration 2397928) and one for the words PAUL O’GRADY’S GOT TALENT (registration 2395562). The project involving Paul O’Grady was discontinued when he moved from ITV to Channel 4. The concept, though, was promoted in the U.S. and it was accepted by NBC. The AMERICA’S GOT TALENT programme was announced by NBC on 27 March 2006. At Exhibit IB3 is an extract announcing the show on a website called ABOUT.COM – it highlights that the show is to air next summer (summer 2007) and lists various venues where would-be participants may audition. Exhibit 1B4 gives details of a

US trade mark registration for AMERICA'S GOT TALENT dated 3 April 2006 in the name of what Ms Brender says is a company related to Freemantle.

12. Ms Brender states that Mr Pepin's domain name was filed just 3 weeks after the initial announcement of America's Got Talent. She also refers to a domain name for "europesgottalent.com" which was also registered on 17 April 2006 (a *whois* report is shown in exhibit IB5). She notes that it no longer stands in the name of John Pepin but is now in the name of an S.N. Pepin. Ms Brender also highlights a Nominet decision (DRS 04214) in connection with unrelated proceedings where John Pepin was found to be connected with SN Pepin. I note, though, that the address of SN Pepin for "europesgottalent.com" differs from that of John Pepin whereas in the Nominet decision John Pepin and SN Pepin had the same address (this was a strong influencing factor for Nominet when deciding that there was a connection between the two).

13. Ms Brender then refers to the BRITAIN'S GOT TALENT television programme. She states that it was aired on successive days from 9 June 2007 to 17 June 2007. The audience ranged from 5.2 million to 11.4 million per episode, representing an audience share of between 23.6% to 47.9% per episode. This equates to an average of 8 million viewers and a 33.6% audience share. Ms Brender provides in Exhibit IB7 an extract from the programme's website. It was clearly in place at the time of the 2007 airing as it refers to "get ready for the show" and that it will be aired between 9-17 June. Provided at IB8 is an extract from the *Guardian* dated 15 June 2007 about the show, it begins with the words "ITV1 has a new reality hit on its hands...". Another article from the *Guardian* is provided in IB9 entitled "I am LOVING Britains' got talent". A press release issued by the Northern Ireland television channel *UTV* is provided in IB10. The press release includes statistical information showing that the episode of Britain's Got Talent broadcast on 17 June 2007 was watched by 317,000 people equating to 52.6% of the viewing public [in Northern Ireland].

14. Ms Brender then refers to a number of facts which, she says, prove that Mr Pepin is a serial cyber-squatter. At IB11 is a WIPO Administration Panel decision involving Steven Ratner and "Buy this domain name (John Pepin)" where the registration of the domain name in question was held to be consistent with a party acting in bad faith. At IB12 is a decision of the National Arbitration Panel between City Group and John Pepin; Ms Brender says that Mr Pepin did not defend these proceedings claiming that someone else had registered the name without his knowledge. At IB13 there is an extract from a complaint by various Olympic organizing committees about a large number of domain names which include the word OLYMPIC. She highlights 13 of them which have the registrant listed as "BuyThisDomainName (additional John Pepin)". The outcome of this complaint is not disclosed. At IB14 there is an article dated 23 May 2001 from *www.theregister.co.uk* relating to what is referred to as political cyber-squatting. The article highlights that John Pepin owns *liberaldemocrat.co.uk* and *liberaldemocrat.org.uk*. At IB15 there is an extract from the TMDS database

showing a number of domain name registrations. She highlights 10 that stand in the name of John Pepin including ipodpornmovie, newscotland yard, nintendogames, surrypoliceauthority, volkeswagonshowroom. At IB16 there is a list from the Nominet register of domain names (although the data appears to have been held by *Marquesa*) where the registrant has various names such as J Pepin, John Pepin, John Pepin & Associates, Pepin & Co as well as J.Pepin trading as “buy this domain, contact registrant, great domain robbery”. She highlights a long list of registrations ranging from labourparty, royalcourts of justice, patentoffice, polandembassy etc. Exhibit 1B17 is a message posted by John Pepin on the website UK.LEGAL. He offers to sell domain names or to split the profit if anyone else can sell them – a large number are included. Ms Brender highlights some that relate to the names of barristers’ chambers and that Mr Pepin is also the owner of others including whowantstobeamillionaire, haveigotnewsforyou, drewbarrymore, cindycrawford and freddiemercury.

15. Ms Brender states that Mr Pepin’s evidence is that his website is a pay-per-click generator. She then refers to a decision of the WIPO Arbitration and Mediation Centre Administration Panel (case D2000-0101) (unrelated to Mr Pepin) where it was held that traffic to a website (the domain name in question included the word NOKIA) holding advertising space amounted to a free ride on Nokia’s goodwill. A similar decision (d2001-1020) is shown in IB19. The rest of Ms Brender’s evidence is submission rather than fact. I will not summarise it further but will, of course, take it into account.

Second witness statement of Mr John Pepin (1 July 2008)

16. Much of this is simply argument/submission rather than evidence of fact. I will, therefore, provide only a brief summary.

17. In relation to the domain names referred to by Ms Brender (her evidence of cyber-squatting) Mr Pepin does not consider such matters to be relevant to the issues to be determined in these proceedings. He highlights that each party has a “history” and refers to Exhibit PEP1 which are articles (the source is unclear) about proceedings in the High Court involving Freemantle/Simco and a claim that they had breached copyright regarding the format of one of their previous shows. The extract indicates that the proceedings were suspended pending negotiation. He says that the fact that he unfairly lost stevenratner.com has no bearing, particularly as it was more than 8 years ago.

18. Mr Pepin states that his domain name was registered for a *bona fide* reason and that it has accrued rights. He highlights that it was registered before the name was ever made public. He does not see the relevance of the history of the television programme including Paul O’Grady’s project or America’s Got Talent. He states that he is the owner of the Britain’s Got Talent domain name (a *whois* report is shown in PEP2) but that he is not Kevin Reid or SN Pepin (referred to in

Ms Brender's evidence). He states that his bristainsgottalent.com web page receives around 7000 visitors per month.

19. Mr Pepin says that click-through advertising is a worthwhile business which would accrue intellectual property rights. He highlights the *Google AdSense* business that does something which he says is similar. He highlights that ADSENSE is a registered trade mark (details are in PEP3). He says that he intends to develop his business and website further. He provides further prints from his website in PEP4, one of which says "Welcome to Britains got talent.com". He states that the click-through decision (the Nokia case referred to by Ms Brender) was about free-riding and not click-through advertising *per se* and that there is no free-riding here because his website was in use before the television programme came to be. He highlights visitor statistics to his website at PEP5. In January 2007 this ranged from 7-35 visitors per day with clicks (presumably click-throughs) ranging from 2-9 and revenue ranging from 0p to 0.79p per day. In May 2008 visitors ranged from 83 to 1305, clicks from 9 to 296 and revenue from 63p to £9.91. He states that the website is accessed either by conducting a search or by entering the URL directly – he highlights that users have been accessing his site since well before the television programme was launched.

20. Mr Pepin highlights that Freemantle/Simco have registered their own domain names (which end ".org" & ".biz") which ignore his rights and could confuse users.

First witness statement of Michael Lynd (1 October 2008)

21. Mr Lynd works for Marks and Clerk, the firm with conduct of these proceedings on behalf of Freemantle/Simco. He exhibits at MAL1 a Nominet decision involving bristainsgottalent.co.uk. There is no suggestion that this involves Mr Pepin. I note, though, that the registration was, as a result of this decision, transferred to Freemantle/Simco. I also note that the registration of the domain name was not held to be abusive at the time of its registration (the TV programme had not yet aired) but that its use was abusive in that it included footage from the TV show (and other talent shows) and that it carried banner advertising.

22. Mr Lynd refers to Mr Pepin's statistical information (his PEP5). He states that the website must have gone live on 4 January 2007 there being no hits on 1, 2 or 3 January. He states that he conducted a *Google* search for early references for the phrase "Britain's Got Talent". The earliest he found was on a *Google* group called "*rec.juggling*" dated 25 December 2006 which refers to the TV programme that is to be launched in spring 2007. He highlights that Mr Pepin's website goes live one week later.

23. Mr Lynd refers to Mr Pepin's May 2008 statistics. He maps these statistics against the airing of the television programme (Ms Brender only mentions the 2007 show so this must be a second series). Mr Pepin's visitor statistics rise and fall with the airing of the show.

Third witness statement of Mr John Pepin (19 January 2009)

24. Mr Pepin states that the decision referred to by Mr Lynd (his MAL1) is not relevant to these proceedings. He also highlights that the US Court of Appeal recently described such domain name dispute procedures as flimsy.

25. In relation to his website, he states that it went live on 17 April 2006 but he was simply unable to produce statistics from the earlier period (the web page was being hosted at this time by a different company called *GoDaddy*). He states that from 17 April 2006 it did carry advertisements as it does now. To illustrate the point, Mr Pepin registered the domain name "I registered this domain simply to show how adverts are placed immediately.com" and provides a print which shows advertisements placed on it straightway.

26. In relation to the message on "*rec.juggling*" he highlights that his domain name was registered before this message was posted and that this message has been posted on an extremely obscure message board. Mr Pepin states that he had never heard of the applicant's intended use prior to registering his domain name.

Fourth witness statement of Mr John Pepin (8 April 2009)

27. Much of this duplicates earlier evidence/submission. Of note, though, is a further letter from *NameDrive* (who own the server on which Mr Pepin's website is located). The letter gives a little more information than the previous letter – it says that *NameDrive* have hosted the site for over 2 years, that the range of advertisements are too numerous to list but include games, CDs, mobile phones etc. and products relating to modeling, inventions and talent. The letter also states that viewers of the website will have been in the UK with 68% coming from Europe and most probably the UK. The factors which influence the advertisements that appear include the domain name in question, the keywords used and the location of the website.

28. Mr Pepin provides further statistical information about his website in PEP3. It gives monthly figures from January 2007 to April 2009. Views range from 49 to 6169, clicks-throughs from 5 to 1595 and revenue from 30p to £94.12. He also provides further screen prints from his website showing the types of advertisements that it carries. He highlights some of the UK companies that advertise. He says that most that choose to advertise on his website are UK companies. He explains that companies set parameters for where the advertisements are placed, for what, and in which location. He says that between

April 2006 and January 2007 the site was hosted by *GoDaddy* (rather than *NameDrive*) and that similar advertisements were displayed.

29. A variety of web pages relating to the companies that advertise on his website are shown on PEP5 – they are varied in nature. He states that they include items detailed by Freemantle/Simco (I presume he means in its applications for registration). He refers to an unrelated application for the words GOT TALENT (PEP6) and wonders whether Freemantle/Simco got their idea from that – it is, therefore, not as unique as they claim.

Second witness statement of Michael Lynd (22 June 2009)

30. Mr Lynd responds to Mr Pepin's further statistical information (his PEP3). In 2MAL1, Mr Lynd, as he did with the earlier statistics, plots Mr Pepin's statistics against the broadcast of the Britain's Got Talent TV programme. It shows that the spikes in persons accessing Mr Pepin's web page match the broadcast of the 2007 & 2008 final broadcasts.

Third witness statement of Michael Lynd (10 August 2009)

31. This evidence is filed to introduce two WIPO decisions issued on 10 March 2009 and 22 December 2008 against John Pepin. The first (d20009-0041) found that John Pepin has used and registered the domain name *essque.com* in bad faith. A similar finding was made in case D2008-1560 in relation to the domain name *masdarcity.com.net*.

Fifth witness statement of Mr John Pepin (25 August 2009)

32. Mr Pepin states that the various references to domain names are not relevant. He does, though, say that many of those referred to in Ms Brender's evidence are not owned by him. He lists twenty that he does own which, he states, show no intention of cyber-squatting e.g. *savvymoney.com*, *smokingkillsyou.com*, *holidaycarrental.com*, *fluvaccine.com*, *4444.co.uk*. He states that the fact that he may have lost one or two domain names does not mean that his use is anything but genuine and that he registered the domain name in question with no prior knowledge of Freemantle's and Simco's use.

33. In relation to the two decisions referred to by Mr Lynd, he highlights that he has proceedings pending in the German Court regarding *essque.com* for which he holds a UK trade mark (JP6 refers). He states that proceedings are to be issued in the US regarding MASDAR which he expects to win.

34. At JP8 is a letter from *NameDrive*. It is the same as the one in his fourth witness statement. He also exhibits a worldwide *Google* search for *britainsgottalent.com* in which his website is listed first. I note that the search also reveals hits for the TV programme.

Preliminary issue

35. As a preliminary point, I dealt at the hearing with a request from Mr Pepin for certain parts of Freemantle's/Simco's evidence to be excluded. This relates to various lists of domain names said to belong to Mr Pepin. Some of this information has been taken from databases held by *Marquesa* and *Trade Mark Directory Services ("TMDS")* (Mr Pepin highlights that the representative of Freemantle/Simco, Marks and Clerk, part own TMDS). Mr Pepin states that both these databases have processed personal information without having notified the Information Commissioner which, in turn, is a breach of the Data Protection Act 1998. Mr Pepin states that a complaint has been made to the Information Commissioner regarding this.

36. My decision was to not exclude the evidence. The matter is one for the Information Commissioner not myself. Any penalty (if the complaint is upheld) will be against *Marquesa* and *TMDS* and not Freemantle/Simco (even if Marks and Clerks partly own *TMDS*). There is no reason to suspect that Freemantle/Simco have obtained the evidence in anything other than good faith. Mr Pepin claims not to own all of the domain names in question, whilst I will return to this point later, there is no evidence to support this counter-suggestion and, so, no reason to believe that the evidence, or the database it comes from, is erroneous. The databases presumably took information from other sources such as Nominet. If a decision to exclude the evidence had been made then Freemantle/Simco would simply have re-filed the information from another source (and I would have permitted such re-filing). I also agree with Freemantle's/Simco's argument that such material, being for use in legal proceedings, should not be excluded.

APPLICATION NOS 2446109A & 2487699 – MR PEPIN’S OPPOSITION

37. I will deal firstly with Mr Pepin’s opposition to the two applications made by Freemantle and Simco. Both applications are opposed under section 5(4)(a) of the Act. 2487699 is additionally opposed under sections 3(6) and 3(1)(a). I will deal firstly with the grounds of opposition under section 5(4)(a).

The section 5(4)(a) ground of opposition

38. Section 5(4)(a) of the Act reads:

“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.”

39. Although Mr Pepin’s opposition to application 2446109A does not specifically refer to the law of passing-off, his opposition to 2487699 does. I will proceed on the basis that both claims relate to the law of passing-off, it is difficult to see any other relevant rule of rule as the simple registration and use of a domain name does not represent a rule of law that would enable its proprietor to prevent the use of the applied for trade marks. Furthermore, Mr Pepin’s submissions at the hearing focussed on the possession of a goodwill.

40. The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“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 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 or services. Secondly, he must 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...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.”

41. For the benefit of Mr Pepin, who does not have professional representation, I highlight that the law of passing-off protects not the name itself but the property in a business or goodwill that could be injured by a relevant misrepresentation. It is not, therefore, a question about the proprietorship or the right to a name. Dates are also important in passing-off cases. Matters must be judged at a material date. Mr Pepin must have been able to succeed in a passing-off claim at such a date. In terms of the material dates in relation to Mr Pepin's oppositions, I note the judgment of the General Court² in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 where it was stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

42. The dates of filing of the opposed applications are, therefore, the material dates. However, if the opposed applications have been used prior to this then this must also be taken into account. It could establish that Freemantle/Simco are the senior users, or that there had been common law acquiescence, or that the status quo should not be disturbed which, in turn, could mean that the use of the applied for marks could not be prevented under the law of passing-off³. The

² The General Court (previously known as the Court of First Instance of the European Communities) is a court of binding precedent.

³ See, for instance: *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

material dates are, therefore, 8 February 2007 (in relation to 2446109A) and 16 May 2008 (in relation to 2487699). I note that the applied for mark has been used as the name of a television programme since 9 June 2007. This may, therefore, impact on Mr Pepin's opposition to application 2487699 but not on his opposition to 2446109A. Either way, I must begin by considering whether Mr Pepin had a goodwill at either of the material dates as without a goodwill there can be no misrepresentation or damage.

43. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first.”

44. I note from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature⁴. Mr Pepin referred to the judgment of the European Court of Justice (“ECJ”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 in relation to genuine use and, on this basis, he considered the nature and scale of his use to represent a genuine business. The judgment in *Ansul* relates to a quite different legal test from that of goodwill in a passing-off claim. That being said, it is clear that the establishment of goodwill must be dealt with on a case by case basis and, furthermore, that being a small player does not prevent the law of passing-off from being relied upon - it can be used to protect a limited goodwill⁵.

45. It is clear that Mr Pepin registered the domain name britainsgottalent.com on 17 April 2006. However, the mere owning of a domain name generates no goodwill. Mr Pepin says that from 17 April 2006 a web page underpinned the domain name and that it carried advertisements for other traders, including advertisements for modeling, talent shows, inventions, acting and other goods and services. There is, though, no information at all as to the manner or extent of use until, at the earliest, 4 January 2007. This is the date that the hosting of the web page moved from *GoDaddy* to *NameDrive*.

46. From 4 January 2007 information is provided in order to demonstrate that the web page has been accessed, that some accessors have clicked on the advertisements that appear on the web page, and that this has led to revenue

⁴ *Hart v Relentless Records* [2002] EWHC 1984

⁵ See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49).

from such click-throughs. By the first material date of 8 February 2007⁶ there had been in the region of 600 views with 95 click-throughs earning revenue of around £9.50. Given that I have estimated the February figures, the figures could be a little less or a little more, but they would not change the picture significantly. In terms of the material date of 16 May 2008, there had been 21500 views, with 3400 click-throughs earning Mr Pepin £325 in revenue.

47. There are a number of problems with Mr Pepin's evidence in terms of establishing a protectable goodwill. Firstly, in terms of revenue, even by the later of the material dates, this equated to a total of around £325. This hardly represents a real and tangible business. It is a trivial amount for a business that is claiming that it could be damaged by Freemantle's and Simco's alleged passing-off. It was even smaller at the first material date at a mere £9.50.

48. Members of the public have, though, accessed the web page with some of them going on to click-through onto one of the advertising links. That being said, simply stating that there has been a certain number of views tells me little as I do not know how many of these views came from unique visitors. Even if I accepted that a good proportion of the views were from unique visitors, the numbers are not particularly significant by February 2007. Whilst the figures are greater by May 2008, the significant point here is that by this time the Britain's Got Talent television programme had broadcast. It can clearly be seen (a point highlighted in Mr Lynd's evidence and a point highlighted by Mr Tritton at the hearing) that Mr Pepin's statistics have significant peaks when the programme was broadcast and that it has a much higher average set of statistics from first broadcast onwards. For example, in May 2007 there were 49 views, whereas in June 2007 (by which time series 1 had broadcast) there were 6159 views. There are then much higher average views which then rise significantly again in April, May & June 2008 when the programme was preparing (and no doubt advertising) for series 2. This is not a co-incidence. It is clear to me that those accessing Mr Pepin's web page are doing so not to avail themselves of Mr Pepin's advertising service, but instead are simply looking for information about the Britain's Got Talent television programme or looking for its official web site. Mr Pepin argued that some users may simply have been searching for information about talent due to talent in general having been promoted by the television programme. This may be so for some users but, I believe, this is likely to be the minority. Either way, the attractive force for these types of user does not exist in Mr Pepin's business.

49. The nature of Mr Pepin's business also needs analysis. A screen-print of the web page was provided by Mr Pepin in his first witness statement, it is reproduced below:

⁶ I have taken into account all of the January 2007 statistics, but only a proportion of the February 2007 ones given that the material date is 8 February.

BritainsGotTalent.com - Windows Internet Explorer

http://www.britainsgottalent.com/ Yahoo! Search

BritainsGotTalent.com

Related Searches: [Modelling Agency](#) [Magicians](#) [Movie Auditions](#) [Acting Auditions](#) [Acting Schools](#)

Related Searches

- Modelling Agency
- Magicians
- Movie Auditions
- Acting Auditions
- Acting Schools
- Talent Search
- Kids Acting
- Singing Lessons
- Dancing Lesson

Sponsored Listings

Modeling Agency
www.TalentText.com Open Auditions for Films, Soaps & Reality Television Shows.

Toys
www.ebay.co.uk Great deals on christening gifts Feed your passion on eBay.co.uk!

Websites for agents
www.metaclarity.com/AgentWeb Simple easy website creation. Update client CV's in minutes.

Done Internet 100%

start B D

BritainsGotTalent.com - Windows Internet Explorer

http://www.britainsgottalent.com/ Yahoo! Search

BritainsGotTalent.com

Pop-up blocked. Also, to help protect your security, Internet Explorer blocked other content from this site. Click here for options...

Search

Talent Q
www.talentqgroup.com Psychometric Assessment Level A & B Training

Babysitting Nationwide
www.sitters.co.uk Britain's favourite babysitting service, find out why.

Britain's Favourite View
www.britainsviews.com Visit the Official Website of the Brand New ITV Programme!

Talent Agency
www.TalentText.com Open Auditions for Films, Soaps & Reality Television Shows.

Websites for agents
www.metaclarity.com/AgentWeb Simple easy website creation. Update client CV's in minutes.

Done Internet 100%

start B D

50. As can be seen, the domain name is replicated on the web page so the sign is not used purely in the URL box. However, users access it by either entering the domain name in the URL box or by conducting a search on a search engine which then leads them to the web page. Mr Pepin makes no claim to promote or advertise his service. Therefore, I fail to see why anyone would enter his URL in order to access his web page or to specifically search for his web page - there is no reason to do so if they have not heard of it. Prior to June 2007 (when the television programme was launched) some users may have encountered the web page through an Internet search, perhaps because they have used search terms such as "talent" and/or "Britain" – the access is, though, inadvertent. From June 2007 onwards, it is safe to assume, as stated earlier, that the majority of users would be accessing the web page because they are looking for information about the television programme or its official web site. This is not only inadvertent access to Mr Pepin's web page but also access which is against the user's intention. None of this is a type of business that builds a strong case as to possession of a relevant goodwill.

51. Irrespective of the above, it could be argued that a user who has inadvertently accessed Mr Pepin's web page will, nevertheless, note the service being provided (the bringing together of advertising listings), together with the sign which is used on the web page, in order to use the service again. This could, therefore, generate goodwill. However, the nature of the web page is unlikely to strike the user as the website of a business. All they see is a duplication of the domain name (depending on the user's level of attention, some may not even notice this at all) and a list of sponsored advertising listings. The user is more likely to regard this as a dormant page that simply carries advertising relevant to their original search. They will not understand the web page to be a trade directory or a portal site which is being put together and maintained by BritainsGotTalent.com. In my experience, such web pages appear frequently on the Internet. Some users may click on an advertisement if it is of interest to them. Some users may return to the search engine they have used to look at other hits. Some users will re-type the URL to something else. What I am far convinced will happen is that a user will note that the web page carries the words britainsgottalent.com in order to return to it again so as to take advantage of its advertising listings.

52. Goodwill is concerned with the attractive force that brings in custom. On the basis of the analysis set out above, Mr Pepin does not have a business with a goodwill. There is no attractive force that brings in custom. In terms of his revenue, it is generated through inadvertent access or through the goodwill of Freemantle/Simco. Mr Pepin must show that the sign in question is distinctive of his business⁷. This highlights the problem, as I do not see how anyone will do so. Therefore, in relation to members of the public who may access Mr Pepin's

⁷ Mr Tritton cited Wilberforce J in *Norman Kark Publications v Oldams Press* [1962] 1wlr 360 to this effect

website, there is no goodwill from their perspective be it at either of the material dates.

53. In coming to the above view I have not ignored Mr Pepin's evidence that he has developed his web page further and that intends to further develop it. The evidence shows a web page similar to that shown above but including the words "Welcome to Britains Got Talent". However, there is no suggestion that this web page was in place before the relevant dates and, in any event, I do not consider that such use significantly changes the position from that set out above. Planned further developments are not relevant because they would not assist the position at the relevant dates.

54. At the hearing, Mr Pepin also claimed that he has a goodwill with the businesses that advertise on his web page and, also, a goodwill with those that host his web page. In relation to advertisers, it is Mr Pepin's own evidence that the advertisements change with each access of his web page. Further information from Mr Pepin and information contained in the letters from *NameDrive* demonstrate that the advertisers select parameters (by choosing keywords etc) which dictate on which web pages their advertisements appear. None of this suggests that an advertiser positively selects Mr Pepin's web page as the place where it wishes to advertise. There is nothing to suggest that any advertiser knows that their advertisement has been placed on Mr Pepin's web page. There is nothing to suggest that Mr Pepin's web page is promoted to potential advertisers as a good place for their advertisements to appear. In view of all this, there is, again, no attractive force that brings in custom. The advertisers deal with *NameDrive* and not Mr Pepin. Any goodwill will reside with *NameDrive* and any goodwill will not be associated with the sign britainsgottalent.com.

55. In relation to goodwill with the webhost, *NameDrive* (and before them *GoDaddy*), there is no information as to the manner in which the domain name and underpinning web page makes its way to *NameDrive's* server. The first letter from *NameDrive* refers to the domain name being "parked" on its server. It may be that the web page is simply uploaded to the server (for a fee) with *NameDrive's* computer programs then placing the advertising on to it. This suggests an automated process (the term "parking" re-enforces this). Although *NameDrive* has, retrospectively, been able to confirm that the web page has been on its servers and that it has generated income, there is nothing to suggest that any person consciously knew of the web page and domain name prior to being asked to confirm its existence and whether it has generated income. The question may have been answered by simply checking the relevant computer statistics. The further problem is that the webhost is not a customer of Mr Pepin, it is the other way around. Goodwill concerns the attractive force that brings in custom – I do not see how this can exist with Mr Pepin's webhosting company. My view is re-enforced by the evidence filed by Mr Pepin to illustrate that advertisements appear on a parked web page (this time it was parked on

GoDaddy's server) straightaway. He registered the domain name "I registered this domain simply to show how adverts are placed immediately.com" and parked it on the server. This demonstrates the ease and casualness of such parking. It does not appear to involve any form of business relationship or custom with GoDaddy.

56. Taking all of the above into account, my finding is that Mr Pepin did not have a protectable goodwill associated with the sign britainsgottalent.com at either of the relevant dates. Without a goodwill, the ground of opposition under section 5(4(a) of the Act must fail. There is no evidence that establishes an attractive force.

The section 3(6) ground of opposition – bad faith

57. I summarised the pleading earlier as:

“Under section 3(6) because the application was made in bad faith as it covers classes and uses that could not possibly be within any reasonable use and that the applicant has ignored the fact that it is aware of the opponent's prior use.”

This ground relates only to application 2487699.

58. Bad faith includes dishonesty and “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular field being examined”⁸. It is necessary to apply what is referred to as the “combined test”⁹. This requires me to decide what Freemantle and Simco knew at the time of making the application and then, in the light of that knowledge, whether its behaviour fell short of acceptable commercial behaviour. Bad faith impugns the character of an individual or the collective character of a business, as such it is a serious allegation. The more serious the allegation the more cogent must be the evidence to support it. In the context of Mr Pepin's claim, but particularly his claim that Freemantle/Simco applied for its marks in the knowledge of Mr Pepin's use, I note the decision of Arnold J. in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2008] EWHC 3032(Ch)¹⁰ where he held:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community

⁸ See *Gromax Plasticulture Limited v. Don and Low Nonwovens Ltd* [1999] RPC 367.

⁹ See the judgment in (1) *Barlow Clowes International Ltd. (in liquidation)* (2) *Nigel James Hamilton and (3) Michael Anthony Jordon v (1) Eurotrust International Limited (2) Peter Stephen William Henwood and (3) Andrew George Sebastian* Privy Council Appeal No. 38 of 2004 and also the decision in *Ajit Weekly Trade Mark* [2006] RPC 25.

¹⁰ Arnold J's judgment was recently upheld in the Court of Appeal - [2008] EWHC 3032 (Ch)

trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

59. Also, in *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* Case C-529/07 the ECJ, when considering the concept of bad faith, stated:

“40 However, the fact that the applicant knows or must know that a third party has long been using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith.....

46 Equally, the fact a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that that sign enjoys some degree of legal protection is one of the factors relevant to the determination of whether the applicant was acting in bad faith.

47 In such a case, the applicant’s sole aim in taking advantage of the rights conferred by the Community trade mark might be to compete unfairly with a competitor who is using a sign which, because of characteristics of its own, has by that time obtained some degree of legal protection.

48 That said, it cannot however be excluded that even in such circumstances, and in particular when several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration is sought, the applicant’s registration of the sign may be in pursuit of a legitimate objective.

49 That may in particular be the case, as stated by the Advocate General in point 67 of her Opinion, where the applicant knows, when filing the application for registration, that a third party, who is a newcomer in the market, is trying to take advantage of that sign by copying its presentation, and the applicant seeks to register the sign with a view to preventing use of that presentation.

50 Moreover, as the Advocate General states in point 66 of her Opinion, the nature of the mark applied for may also be relevant to determining whether the applicant is acting in bad faith. In a case where the sign for which registration is sought consists of the entire shape and presentation of a product, the fact that the applicant is acting in bad faith might more readily be established where the competitors' freedom to choose the shape of a product and its presentation is restricted by technical or commercial factors, so that the trade mark proprietor is able to prevent his competitors not merely from using an identical or similar sign, but also from marketing comparable products.

51 Furthermore, in order to determine whether the applicant is acting in bad faith, consideration may be given to the extent of the reputation enjoyed by a sign at the time when the application for its registration as a Community trade mark is filed."

60. In terms of the argument that Freemantle/Simco filed its application in the knowledge and face of Mr Pepin's previous use, there is little in the evidence to inform me as to the joint applicant's state of knowledge other than a bare statement by Mr Pepin that there was some pre-application contact (Mr Pepin adds in his skeleton argument that this was with Ms Brender) advising the joint applicants as to his existing use. I note, though, that there has been no challenge to this statement. Nevertheless, what was actually advised and when it was advised is not clear. Irrespective of that, even if the joint applicants' knew of Mr Pepin's use there is nothing to suggest that the application was motivated in order to compete unfairly with Mr Pepin. They were seeking to register the name of its television programme and associated goods and services. If the joint applicants' intention was to compete unfairly and the reason for filing the application was to prevent Mr Pepin's use then surely it would have applied in class 35 (where Mr Pepin's service has been filed) so as to make that outcome more likely. Furthermore, it is clear, on the basis of all the evidence presented, that they do not consider Mr Pepin to have a legitimate business conducted under the sign, a view that I have supported. All things considered, and considering the two judgments set out above, the first limb of Mr Pepin's argument must fail.

61. The second limb of Mr Pepin's argument relates to the breadth of the joint applicants' specification. Whilst the specification sought does go significantly wider than that of a television programme (an entertainment service) there is no

evidence from Mr Pepin that the joint applicants' have no intention to trade in the respective goods and services. Mr Pepin claims that the breadth of specification is more to do with blocking his legitimate and prior use, but, as stated already, I have found this not to be the case. The fact that the specification may include goods and services for which Mr Pepin's web page carries advertisements is a different matter altogether. In terms of the breadth of specification, there is nothing inherently unusual in an undertaking applying for registration for a wide range of goods and services which, in this case, may be used as a marketing or licensing opportunity connected with the television programme. Absent any compelling evidence to the contrary, I cannot regard the joint applicants' application to have been made in bad faith. The section 3(6) ground of opposition fails.

The section 3(1)(a) ground of opposition

62. This ground of opposition can be disposed of briefly. The ground is based on the joint applicants' trade mark not distinguishing itself from Mr Pepin's prior use. The claim is, effectively, a relative grounds claim and I have already concluded that Mr Pepin has failed on this point – the claim under section 3(1)(a) cannot, therefore, take him any further forward.

Conclusions on Mr Pepin's opposition

63. I have rejected all of Mr Pepin's grounds of opposition. This results in the two earlier marks of Freemantle/Simco being able to be relied upon in relation to their opposition to Mr Pepin's application for registration.

APPLICATION NO 2506974 – SIMCO/FREEMANTLE’S OPPOSITION

64. Freemantle/Simco oppose Mr Pepin’s application under sections 5(2)(a), 5(2)(b), 5(3) & 5(4)(a) of the Act. I will deal firstly with the ground under section 5(3).

The section 5(3) ground of opposition

65. Section 5(3)¹¹ of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

66. In order to succeed under this ground the earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 *Chevy* the ECJ stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

67. Mr Pepin’s application was filed on 22 January 2009. The earlier mark(s) must have a reputation at this point. The relevant public to consider will be the public at large given that the reputation claimed is in relation to the name of a television programme.

68. By the relevant date the first series of Britain’s Got Talent had been broadcast (June 2007). It is clear from the evidence that the programme was extremely popular and that it had a large share of the viewing audience in the UK. It also received press exposure (examples are shown from the *Guardian*). The second series was broadcast in June 2008. No audience figures are provided, but there is no reason to suggest that the second series was any less popular. The spikes in Mr Pepin’s web page access when the television programme was broadcast are as great, if not greater, for the second series. Given all this, I have no hesitation in concluding that the earlier mark will have been known by a significant (extremely significant in my view) part of the relevant

¹¹ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01).

public. It will be known as a successful and popular television programme. The one rider to this is that whilst the name itself has a reputation and this supports the applied for word mark, the stylised version is less supported by evidence. Although it appears on the website of Freemantle/Simco, there is nothing to suggest that it also appeared in the television programme itself. I will, therefore, focus on the word mark as this represents the best prospect of success for Freemantle/Simco.

69. In addition to having a reputation, a link must be made between the respective marks. In *Adidas-Salomon*, the ECJ stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

70. In *Intel Corporation Inc v CPM (UK) Ltd (C-252-07) (“Intel”)*, the ECJ provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”

71. Assessed against the factors outlined in *Intel* my views are:

The degree of similarity between the conflicting marks

72. Mr Pepin seeks to register:

Britains Got Talent

&

britains got talent

73. The earlier mark consists of the words BRITAIN'S GOT TALENT.

74. The marks are aurally and conceptually identical. There is a slight visual difference in that one has an apostrophe whereas the other does not and there are differences in casing. However, it is my view that these differences are so small that they would go unnoticed by the average consumer and, as such, the marks should be regarded as visually identical¹². The marks are, therefore, identical overall. If I am wrong on identity, then they are similar to the highest degree possible.

The nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

75. In relation to the service for which it has a reputation (an entertainment service in the nature of a television programme) I do not find this to be particularly similar to the services sought by Mr Pepin which relate, essentially, to advertising services. The nature and purpose of the respective services differ, as do the average consumers of such (the public at large against businesses who wish to advertise). That being said, individuals representing businesses are also part of the public at large so this does not rule out the possibility of a link being made. It is not as though the relevant public is made up of two different and distinct groups. Furthermore, there is at least some form of link between television programmes and advertising due to the necessity for commercial television to secure sponsors and advertisers, indeed, commercial television could not operate without sponsorship and advertising. There is, at least, some form of link between the two services.

¹² See the judgment of the ECJ in *LTJ Diffusion SA v Sadas Vertbaudet SA* (Case C-291/00).

The strength of the earlier mark's reputation

76. As stated earlier, I consider the earlier mark not only to have a reputation but a strong one at that in relation to its entertainment service in the nature of a television programme.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

77. From an inherent point of view I do not regard the earlier mark to be particularly distinctive given the obvious suggestive meaning behind the words that make up the mark, particularly in relation to a television programme relating to the discovery of talent acts (which, from the evidence, the television programme is). However, as with reputation, the earlier mark will have had its distinctive character enhanced due to the use that has been made of it.

The existence of a likelihood of confusion

78. Likelihood of confusion is a legal concept underpinning an objection under section 5(2) of the Act which requires a finding of, amongst other things, similarity of goods/services. As a similarity of goods/services is not required under section 5(3) then a likelihood of confusion cannot be found. However, to the extent that the average consumer could understand the mark as being the responsibility of the same or an economically undertaking regardless of a finding of goods/service similarity, it is my view that there is potential for an advertising service, particularly one that focuses on television or Internet advertising, provided under an identical or highly similar mark, to be confused as being provided by the same or an economically linked undertaken. The consumer may regard the advertising service offered as being in association with the popular television programme. Whilst I simply use the word potential, such potential means that this is relevant factor to bear in mind.

79. Taking the above into account I consider it inevitable that an average consumer encountering Mr Pepin's service under the trade mark Britains Got Talent, will, at the very least, bring the name of the television programme to mind. That is sufficient for the establishment of a link.

80. The link must, though, lead to one of the heads of damage set out in section 5(3). Although Mr Triton argued at the hearing that the joint applicants' would be able to succeed in relation to detriment to distinctive character (often referred to as "blurring"), the primary argument centred on unfair advantage (often referred to as "free-riding"). In Case C-487/07, *L'Oréal v Bellure*, the ECJ stated:

"49 In that regard, where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its

prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.”

81. Mr Triton argued that Mr Pepin’s trade mark would clearly take a free-ride from the fame and reputation of the joint applicants’ television programme. He argued that this was particularly clear when one has regard to the manner of use that Mr Pepin has so far undertaken which is to attract web-users to his web page in order for them to click-through to another website via an advertisement. Although Mr Pepin’s specification includes a wider range of advertising services than that, such a service would fall within the specification and can be taken as a paradigm example of his use. To that extent, a significant amount of those viewing his web page will only have got to it due to the reputation of the earlier mark and not through the efforts of Mr Pepin. This is demonstrated by the increased views of his web page since the show went live and the large spikes in his views matching key points in the television programme airings. This, in turn, would make advertisers more likely to want to advertise with Mr Pepin (if he ever offered a service which could positively be selected by a business as opposed to the ad-hoc way in which advertisements reach his website at the moment). All things considered, I believe this to be a clear example of an advantage that is being unfairly taken of the earlier marks reputation.

82. That, though, is not the end of the matter because Mr Pepin may be able to defend his application by identifying that he has a due cause to use his trade mark notwithstanding the fact that it may take an unfair advantage from the earlier marks reputation. Although he has not specifically stated as much, it is clear that much of Mr Pepin’s evidence and argument focuses on the fact that he registered his domain name and put it into use before the Britain’s Got Talent television programme was broadcast.

83. Due cause was considered by Neuberger J in *Premier Brands UK v Typhoon Europe* [2000] FSR 767. The following text is taken from the head notes for that case:

"(12) The meaning of the phrase "without due cause" in section 10(3), did not mean "in good faith" or "for good honest commercial reasons" as this meaning would render the effect of the section unpredictable and in some cases unfair. The phrase had to be read as not merely governing the words "the use of the sign" but also as governing the words "takes unfair advantage of, or detrimental to".

(13) If the situation was such that a user of a mark was under such a compulsion to use that mark that he could not honestly be asked to refrain

from so doing, regardless of the damage inflicted on the actual owner of the mark, then these circumstances would amount to "due cause" for the purposes of the section. Under this interpretation the defendant, though acting honestly, was acting "without due cause".

Lucas Bols v. Colgate-Palmolive (1976) 7 I.I.C. 420 referred to."

84. In the *Lucas Bols* case Neuberger J referred to, it was stated by the Benelux Court that:

"What this requires, as a rule, is that the user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damage the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark"

85. A claim to being the senior user of a trade mark and having an underpinning business with reference to it represents, at the very least, a potential for having a due cause. Such circumstances could create a compulsion to continue such use irrespective of whether it now takes unfair advantage. However, matters are not as straightforward as that in the case before me. Firstly, I have already characterised Mr Pepin's business as having no attractive force let alone one connected with the sign in question. All that is really being done is to use the domain name (with a duplication of it on a web page) in order to attract Internet traffic. Prior to the launch of the television programme, Mr Pepin had earned no more than £20 from click-throughs on his web page. This increased significantly once the television programme was broadcast. The pre-broadcast revenue can hardly be said to place Mr Pepin under such a compulsion to continue his use. The post-broadcasting use puts him in no better position because the vast majority of his revenue from that point on has been generated by the free-ride taken from the television programme.

86. In any event, Freemantle/Simco refer to Mr Pepin as a cyber-squatter. They suggest that his domain name was speculatively registered in light of the America's Got Talent television programme (speculation, presumably, that a Britain's Got Talent version would follow). Although Mr Pepin denies the allegation, there is ample evidence as to the domain names that he has registered. Whilst he states that he does not own them all, such large numbers have been set forth, with so many, on the face of it, appearing to be signs which Mr Pepin cannot possibly have a legitimate interest in using (other than use as web traffic generators or to sell to the legitimate owner). Even if he does not own them all, or no longer does so because they have been transferred to another owner, then the point is still good. Other evidence, such as his posting on UK LEGAL strengthens this view.

87. Mr Pepin, however, states that he owns other domain names which, on the face of it, have no relationship with known organisations, companies or people. Whilst this may be true, the majority of these other domain names still strike me as traffic generators rather than legitimate businesses conducted using the domain name. Furthermore, Mr Pepin has given no clear explanation as to why he chose britainsgottalent as a domain name and it not as though the domain name falls within the type of “innocent” names which he has registered, most of which carry simple descriptive wording that would generate web traffic via search engine keywords. In his evidence Mr Pepin states that he did not know that Freemantle/Simco intended to launch Britain’s Got Talent. At the hearing he gave that statement context when he stated

“Yes, thank you very much indeed. I take the point as regards Mr Tritton's comments on the domain name and why it was registered. I would point initially to Exhibit 15(k), which is an application in the USA for a mark GOT TALENT. I have been in business for 30 odd years. I am always looking for business and I happened across that. I cannot deny that, at some point in time, I did hear of AMERICA'S GOT TALENT, but that was not any deciding factor at all in registering a domain name. That was not in my mind. The other point I would make is that I was not aware at the time of registration at all of either PAUL O'GRADY'S GOT”

88. Mr Pepin was not at the hearing to give evidence. Nevertheless, his comments at least serve as an admission that he had heard of America’s Got Talent, even though he goes to say that this knowledge was not the deciding factor in registering the domain name. Taking all of this into account, the most plausible reason, on the balance of probabilities, is that Mr Pepin registered the domain name (and its subsequent use) as a speculative registration which, if a television programme was launched (I use the word “if” because I accept that Mr Pepin was unaware of a definite intention to launch), it may generate some form of revenue through click-throughs or onward sale. I am conscious that I am not here to decide whether the domain name itself was registered in bad faith, however, the circumstances are sufficiently clear for them to be factored in, at the very least, to the due cause aspect of this case. In all the circumstances, I cannot find that Mr Pepin has a due cause.

89. In view of my findings, Freemantle’s/Simco’s opposition under section 5(3) of the Act is successful.

The section 5(4)(a) ground of opposition

90. I will deal with this ground briefly in view of the finding I have already made. The legislation and case-law have already been set out. In terms of this opposition, the material date is the date of Mr Pepin's application namely 22 January 2009.

91. In terms of a relevant goodwill, I have no doubt that the television programme was well known by the relevant date. The sign BRITAIN'S GOT TALENT was the key aspect of its attractive force. Mr Pepin suggests that any goodwill will be owned by the presenters of the programme such as Simon Cowell. This, though, is not correct because the goodwill will be owned by the persons who produce and distribute the programme and this is, on the evidence, Freemantle and Simco jointly. I have no doubt that there is a protectable goodwill. The sign is distinctive of Freemantle/Simco in relation to an entertainment service in the nature of a television programme.

92. Having established a protectable goodwill associated with the sign, I must be persuaded that the use by Mr Pepin of his mark will be taken to be the use of Freemantle/Simco. This includes any form of use across the range of Mr Pepin's specification – it is not limited to the listing of sponsored advertising. In terms of misrepresentation, this relates to the deception of a substantial number of those persons who are aware of Freemantle's/Simco's goodwill¹³.

93. The current form of use that Mr Pepin undertakes may or may not lead to a misrepresentation. Some users accessing his website may see it as a web page trading off the reputation of Freemantle/Simco whilst appreciating that it is not actually connected with them. Others may assume that it is the same undertaking. However, given that Mr Pepin explains in his evidence that the web page will carry advertisements for talent related advertisers, and given that he states himself that he wishes to develop his web-page further, a notional view of such use would lead to a substantial number of persons believing that such a website was actually the responsibility of Freemantle/Simco. They could see it as an advertising off-shoot for the purpose of providing viewers of its television programme with an opportunity to visit recommended service providers in order to take their talent-based careers further forward. It would be seen as a clear adjunct. It would lead to a misrepresentation.

94. The misrepresentation must, though, lead to some form of damage. Lord Oliver, as quoted earlier, stated:

“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

¹³ See the findings of the Court of Appeal in *Neutrogena Corporation and Ant. V. Golden Limited and Anr.* [1996] R.P.C. 473

defendant's goods or services is the same as the source of those offered by the plaintiff”

95. It is also useful to consider the comments of Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 where he stated that the claimant must prove:

“That he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill attaches.”

96. In his skeleton argument, Mr Tritton referred to the judgment of Warrington J in *Ewing v Buttercup Margarine Co Ltd*, 34 RPC 232 where it was stated:

“To induce the belief that my business is a branch of another man’s business may do that other man damage in all kinds of ways. The quality of goods I sell; the kind of business I do; the credit or otherwise which I might enjoy – all those things may immensely injure the other man who is assumed wrongly to be associated with me.”

97. The position adopted in the above case is a reasonable one. There is a clear link between advertising and television programmes and the public are used to seeing sponsorship initiatives in support of a particular programme. To place your goodwill into the hands of another person is a dangerous position with such a linked business. Who knows what kind of advertisements and advertisers Mr Pepin may take on, indeed, he does not even control them himself – there is a clear potential for damage. The ground of opposition under section 5(4)(a) succeeds.

98. I mentioned earlier that prior use could, potentially, have an effect on a passing-off claim. Mr Pepin could claim to be the senior user. However, as I have found that Mr Pepin’s use generates no goodwill in association with the sign in question then it is not appropriate to consider such use in this case – in other words, there is no senior or concurrent goodwill.

The section 5(2) grounds of opposition

99. I do not intend to make a specific finding in relation to this ground. The opposition has succeeded under two grounds already and I cannot see how Freemantle/Simco can be in any better position here, not least because of the requirement to prove that the respective goods/services are similar.

Costs

100. At the hearing Mr Pepin wanted to refer me to correspondence that had been marked as “without prejudice save as to costs”. I declined to consider this prior to issuing this decision as to do otherwise would have meant that I had had sight of without prejudice material before coming to a conclusion on the substantive matters. Nevertheless, I agreed with both parties that such material would be considered and taken into account after the substantive decision had been issued. I agreed that both parties could make their submissions on costs in writing. I will allow a period of 28 days from the date of this decision in order for them to do so. I will then issue a supplementary decision dealing with costs. The appeal period for this substantive decision will run concurrently with the appeal period for my decision on costs.

Dated this 11 day of March 2010

**Oliver Morris
For the Registrar
The Comptroller-General**