

O/098/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2509972

BY LUXURY YACHTS MEDIA GROUP LIMITED

TO REGISTER THE TRADE MARKS:

**SuperyachtLife
The London Superyacht
Show**

and

**SuperyachtLife.com
The London Superyacht
Show**

(A SERIES OF TWO TRADE MARKS)

IN CLASSES 35 AND 41

AND

THE OPPOSITION THERETO

UNDER NO 99482

BY BRITISH MARINE FEDERATION

1) On 27 February 2009 Luxury Yachts Media Group Limited (Luxury) filed an application for the registration of the trade marks:

SuperyachtLife
The London Superyacht
Show
and
SuperyachtLife.com
The London Superyacht
Show

(the trade marks). The trade marks were published in the *Trade Marks Journal* on 26 June 2009, for opposition purposes, with the following specification:

advertising, advertising services provided via the internet; production of radio and television advertisements; auctioneering; trade fairs; opinion polling; provision of business; advertising by mail order; dissemination of advertising matter and production of advertising matter; advertising services by means of television screen based text; advertising services provided by television; advertising services relating to the marine and maritime industry; advertising service (rental of); advertising space (rental of) on the Internet; arranging of competition for advertising purposes; arranging of competition for trade purposes; arranging of exhibitions for advertising purposes; arranging of exhibitions for business purposes; arranging of exhibitions for commercial purposes; arranging of trade fairs; arranging of trade shows; audio-visual displays for advertising purposes (preparation or presentation); brand creation services; cinematography film advertising; classified advertising; communications media (presentation of goods on) for retail services; competitions (organising of business); competitions (organising of trade); compilation of advertising for use as web pages on the Internet; compilation of company information; compilation of directories for publishing on the Internet; compilation of indexed addresses; compilation of direct mailing lists; compilation of information into computer databases; conducting of trade shows; data handling; data preparation; data processing; department store retail services connected with the sale of jewellery, clocks, watches, stationery, publications, leather goods and luggage; direct mail advertising; direct market advertising; directories; distribution of advertising brochures; distribution of advertising leaflets; distribution of promotional material; electronic shopping retail services connected with computer equipment; electronic storage and retrieval of information; electronic storage of technical information; employee record services; leasing of advertising space on pamphlets; mailing lists (compilation of); market research services relating to broadcasts media; marketing; outdoor advertising; presentation of goods on communication media, for retail purposes; press advertising services; video recordings for advertising purposes (production of); video recordings for marketing purposes (production of); video recordings for publicity purposes (production of) ; and all included in Class 35;

education; providing of training; entertainment; sporting and cultural activities; arranging and conducting of conferences; arranging and conducting of seminars; arranging and conducting of symposiums; booking of seats for shows; bookmobile services; books (publication of -); cinema presentations; competitions (organization of -) [education or entertainment]; competitions (organization of sports -); conferences (arranging and conducting of -); digital imaging services; education information; entertainment; entertainment information; exhibitions (organization of -) for cultural or educational purposes; electronic desktop publishing; film production; game services provided on-line from a computer network; information (education -); information (entertainment -); live performances (presentation of -); movie theatre presentations; museum facilities (providing -) [presentation, exhibitions]; music composition services; organization of competitions [education or entertainment]; photographic reporting; photography; production of radio and television programmes; production of shows; production (videotape film -); providing on-line electronic publications, not downloadable; publication of books; publication of electronic books and journals on-line; publication of texts, other than publicity texts; radio and television programmes (production of -); radio entertainment; recreation information; rental of sound recordings; rental of videotapes; scriptwriting services; seminars (arranging and conducting of -); Subtitling; television entertainment; television programmes (production of radio and -); texts (publication of -), other than publicity texts; texts (writing of -), other than publicity texts; videotape film production; and all included in Class 41.

The above services are in classes 35 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 26 August 2009 British Marine Federation (BMF) filed a notice of opposition to the registration of the trade mark. BMF relies upon sections 3(6), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

3) Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Section 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because -

.....

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

Section 5(3) of the Act states:

“(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 a Community trade mark or international trade mark (EC) 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.”

Section 5(4)(a) of the Act states:

“(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”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“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.”

4) In relation to the grounds of opposition under sections 5(2)(b) and 5(3) of the Act BMF relies upon the following United Kingdom trade mark registrations:

No 2217291 for the trade mark LONDON INTERNATIONAL BOAT SHOW, no 2217274 for the trade mark NATIONAL BOAT SHOW and no 2217288 for the trade mark LONDON BOAT SHOW. The applications for registration of the trade marks were all made on 16 December 1999 and the registration processes for all of the trade marks were completed on 2 November 2001. The applications proceeded to publication on the basis of distinctiveness acquired through use. The trade marks are registered for the following services:

advertising; preparation, updating and dissemination of advertising materials; provision of business management assistance and business consultancy services; organisation of exhibitions; public relations; publicity, and sales promotion; all relating to the maritime, nautical or nautical equipment fields, or to boating activities, or to the inland waterways;

provision of training and instruction services; provision of sporting activities; arranging conferences, seminars and symposiums; arranging competitions; organisation of shows and exhibitions; provision of information services relating to all of the aforesaid; all relating to the maritime, nautical or nautical equipment fields, or to boating activities or to the inland waterways.

The above services are in classes 35 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. As the trade marks had been registered for more than five years at the date of the publication of the application, they are potentially subject to proof of genuine use¹ for the period from 27 June 2004 to 26 June 2009.

No 2345824 for the trade mark SOUTHAMPTON BOAT SHOW and no 2345825 for the trade mark SOUTHAMPTON INTERNATIONAL BOAT SHOW. The applications for the registration of the trade marks were made on 13 October 2003 and the registration processes were completed on 6 May 2005. The applications proceeded to publication on the basis of distinctiveness acquired through use. The trade marks are registered for the same services as nos 2217291, 2217274 and 2217288.

No 2497726 for the trade mark SUPERYACHT UK. The application for registration was made on 15 September 2008 and the registration process was completed on 12 November 2010. The application proceeded to publication on the basis of distinctiveness acquired through use. The trade mark is registered for the following services:

advertising; preparation, updating and dissemination of advertising materials; provision of business management assistance and business consultancy

services; organisation of exhibitions; public relations; publicity, and sales promotion; all relating to the maritime, nautical or nautical equipment fields, or to boating activities, or to yachts and yachting; commercial information research studies, negotiating and representational services, all provided by a trade association;

yacht building, yacht design, maintenance and repair of yachts, provision of shipyard facilities for yachts, provision of information relating to yacht building or yacht repair, provision of facilities for building or repair of yachts, provision of consultancy services relating to all of the aforesaid, provision of the services of a trade association relating to all of the aforesaid, provision of information relating to all of the aforesaid, provision of advisory services relating to all of the aforesaid;

technological consultation services; professional consultation services, all provided by a trade association for its members; engineering design work; computing services; conducting research into social welfare; industrial research;

legal research; legal services; health, safety and environmental consultation services; quantity surveying services; conducting research into legal matters as they affect Trade Association members and their organisations; providing of legal services and advice and assistance on such matters to trade association members and their organisations; dissemination of legal information and lobbying of relevant authorities on all the aforesaid matters; legal services; legal representation of trade association matters; legal research; lobbying of relevant authorities on trade association matters; health and safety representation and assistance.

The above services are in classes 35, 37, 42 and 45 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

5) BMF claims that it has used the above trade marks in respect of all of the services for which they are registered and that it enjoys a reputation in respect of them in relation to all of the services. It claims that all of the services of the application are similar to the services of its registrations. It bases its claim under section 5(4)(a) of the Act on its trade mark registrations and claims a reputation in respect of all of the services encompassed by the registrations.

6) BMF states that it is a trade association for the leisure and small commercial marine industry. It has around 1500 members from throughout the United Kingdom marine supply chain. BMF states:

“SUPERYACHT UK was first used as an identifier for a marketing initiative on behalf of members of the Opponent in at least 2000. It has been used

as the formal name of an association or grouping of members of the Opponent since at least 2004. The name SUPERYACHT UK has been used consistently throughout the United Kingdom since that date and has been used and promoted outside the United Kingdom to identify those members of the Opponent who are engaged in the manufacture or supply of yachts exceeding 24 meters (the so called “Super Yacht” category) or whose businesses support vessels in that category.”

7) BMF states that it has used the trade marks LONDON BOAT SHOW and LONDON INTERNATIONAL BOAT SHOW since 1970 in respect of all of the services of the registrations. It states that it has used the trade mark NATIONAL BOAT SHOW since 1954 in respect of all of the services of the registration. BMF states that it has used the trade marks SOUTHAMPTON BOAT SHOW and SOUTHAMPTON INTERNATIONAL BOAT SHOW since 1968 in respect of all of the services of the registrations.

8) BMF claims that LONDON BOAT SHOW, LONDON INTERNATIONAL BOAT SHOW, SOUTHAMPTON BOAT SHOW, SOUTHAMPTON INTERNATIONAL BOAT SHOW and NATIONAL BOAT SHOW constitute a family of trade marks in which it enjoys a reputation. It claims that this makes it more likely that confusion will arise based on the similarities that do exist, such as similarity of concept.

9) BMF claims that it has a substantial reputation in the “expression” SUPERYACHT UK.

10) In relation to the grounds under section 5(3) of the Act, BMF quotes from the Act but gives no detail of the precise nature of the claim.

11) BMF claims that Luxury is trying to take unfair advantage of its reputation and, consequently, that the application was made in bad faith.

12) Luxury filed a counterstatement. It denies all of the grounds of opposition. Luxury states that superyacht is merely descriptive of a type of boat and, in its use in the context of the trade marks, is necessary to indicate the purpose of the services to which it relates. Luxury claims that the term superyacht has been used throughout the United Kingdom for at least 5 years by other parties without objection. In relation to proof of use, Luxury has stated that it requires proof of “[t]he provision of a London show promoting Superyachts”.

13) Both parties furnished evidence. Neither party requested a hearing. BMF furnished written submissions in support of its position.

Evidence of BMF

14) Witness statements have been adduced from Richard Lloyd-Williams, Christine Smith, Martin Georgeson, Noel Smith and Chantelle Bates. They are all involved in the boating/marine industry. They all give evidence in a similar fashion to the following effect (as per the witness statement of Mr Georgeson):

“I do not associate the expressions THE LONDON SUPERYACHT SHOW or SUPERYACHT LIFE THE LONDON SUPERYACHT SHOW with anyone. However if I were invited to exhibit at a show held under the name THE LONDON SUPERYACHT SHOW I would expect the show to be organised by National Boat Shows.”

As neither trade mark is The London Superyacht Show, it cannot be seen what the relevance of the second sentence is. The comments of Lord Esher MR in *Re Christiansen's TM* [1885] 3 RPC 54 at 60 are noted also in relation to evidence that is in the same form:

"Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names to the bottom."

The best that can be said of this evidence is that five individuals involved in the boating/marine industry do not associate SUPERYACHT LIFE THE LONDON SUPERYACHT SHOW with anyone.

15) Tamzin Matthew has given evidence. Ms Matthew is company secretary of BMF.

16) Ms Matthew exhibits at TM1 copies of evidence which was filed in respect of application nos 2217274, 2217288 and 2217291 in order to overcome objections at examination stage. The evidence includes a witness statement by Nigel John who was, at the time, company secretary of the British Marine Industries Foundation, which changed its name to British Marine Federation. Ms Matthew states that Mr John also dealt with application no 2217286 to register the sign EARLS COURT BOAT SHOW. She states that the sign was associated with BMF and its predecessors and with the activities of “National Boat Shows”. The sign was accepted for registration and published for opposition purposes but the application was withdrawn consequent upon an agreement with the proprietors of the Earls Court Exhibition Centre.

17) The first NATIONAL BOAT SHOW was organised by the Ship & Boat Builders National Federation (SBBNF) (a predecessor to BMF) in 1954. It was sponsored by the *Daily Express*, which continued to sponsor the event until 1988. In 1960 the NATIONAL BOAT SHOW moved from Olympia to Earls Court; attendance at this show was 320,000. In 1961 the show was billed as the INTERNATIONAL BOAT SHOW. By 1970 the show had become the LONDON INTERNATIONAL BOAT SHOW. In 1999 and 2000 the show was promoted as the LONDON BOAT SHOW. Mr John states “[r]esearch conducted by BMIF indicates that there are 500,000 boat owners in the United Kingdom and that each boat owner visits the show at least once every three years. Attendance for the years 1988 to 1995 was as follows:

1988	236,089
1989	214,352
1990	207,366
1991	231,963
1992	207,882
1993	184,950
1994	172,813
1995	185,867

There are a number of witness statements from persons in the trade, made in January and February 2001. The witnesses comment on the names EARLS COURT BOAT SHOW, LONDON BOAT SHOW, LONDON INTERNATIONAL BOAT SHOW and NATIONAL BOAT SHOW. In relation to the last sign, a large number of the witnesses identify it as the organiser of the LONDON BOAT SHOW, the LONDON INTERNATIONAL BOAT SHOW and the EARL’S COURT BOAT SHOW; all of which names refer to the same show.

18) Covers of catalogues for the first shows in London are exhibited; the earliest covers refer to the NATIONAL BOAT SHOW. Catalogues from 1961 refer to INTERNATIONAL BOAT SHOW. Spines shown for catalogues have references to BOAT SHOW, BOAT SHOW EARLS COURT, INTERNATIONAL BOAT SHOW, EARLS COURT BOAT SHOW and BOAT SHOW followed by the year; these catalogues range from 1962 to 1979. The latest 6 catalogues refer to EARLS COURT BOAT SHOW, followed by the year. Covers of catalogues from 1970 to 1976 refer to the show as the LONDON INTERNATIONAL BOAT SHOW, with prominence given to the words BOAT SHOW. Covers for catalogues for 1977 and 1978 refer to BOAT SHOW followed by the year. The cover of the catalogue for 1979 refers to the 25th London International Boat Show '79 Earls Court. Spines of catalogues from 1980 and 1989 show LONDON INTERNATIONAL BOAT SHOW, the number of the show, the year and Earls Court. The covers of the catalogues for 1980 and 1981 give prominence to the words BOAT SHOW and the year, the number of the show and London International being in much smaller type. Earls Court appears prominently on the covers. The covers for the 1982 and 1983 catalogues bear the name BOAT

SHOW and the year. Earls Court also appears upon the covers. The covers for the years 1984 to 1989 bear the name BOAT SHOW and the year in large print. In much smaller print LONDON INTERNATIONAL and the number of the show appears. Earls Court appears upon the covers. The spines of the catalogues for 1990 to 1998 show LONDON INTERNATIONAL BOAT SHOW, the year and the number of the show. The spines for 1999 and 2000 show LONDON BOAT SHOW and the year. The cover for the catalogue for the show for 1990 shows 36th INTERNATIONAL LONDON BOAT SHOW 1990. The covers of the catalogues for 1991 to 1998 show THE LONDON INTERNATIONAL BOAT SHOW and the year. The catalogue for 1999 shows BIG BLUE LONDON BOAT SHOW. The catalogue for 2000 shows LONDON BOAT SHOW 2000.

19) Media coverage, mainly from December 1994 and January 1995, primarily shows use of LONDON INTERNATIONAL BOAT SHOW but also shows use of LONDON BOAT SHOW. There are also numerous references to the venue ie Earls Court. In his witness statement Mr John identifies exhibit NJ20 as containing a “bundle of media items from 1994/1995 which continued to identify the exhibition as NATIONAL BOAT SHOW”. The extent of this material is a clipping for a competition from *The Oxford Times* of 30 December 1994 which identifies the LONDON INTERNATIONAL BOAT SHOW '95 but gives as part of a competition address “National Boat Show Competition”. An article from *The Sunday Independent* of 15 January 1995 refers to the LONDON INTERNATIONAL BOAT SHOW '95 and LONDON INTERNATIONAL BOAT SHOW; a reference is made to officials of National Boat Shows Ltd; which is not identifying the show as NATIONAL BOAT SHOW. A list of upcoming events from *Company Digest* of December 1994 refers to London International Boat Show being organised by National Boat Shows. An article from *Nordic Times International* of March 1995 has three references to the LONDON INTERNATIONAL BOAT SHOW. A quotation is given by a person who is identified as being the chairman of National Boat Shows. There are pages from what appears to be a publication in Greek. The final part of the exhibit is a page from *International Boat Industry* of an unknown date where National Boat Shows is identified as being the organiser of the LONDON INTERNATIONAL BOAT SHOW.

20) Exhibits NJ32-NJ34 identify press coverage but the actual coverage has not been adduced into the proceedings.

21) Ms Matthew states that the event now promoted as the LONDON INTERNATIONAL BOAT SHOW originated in 1954 as the NATIONAL BOAT SHOW. In 1961 it was billed as INTERNATIONAL BOAT SHOW and by 1970 had become LONDON INTERNATIONAL BOAT SHOW. Attendance figures at the LONDON INTERNATIONAL BOAT SHOW from 1996 to 2009 are as follows:

2009	112,000
2008	127,251

2007	130,051
2006	139,309
2005	154,041
2004	213,801
2003	145,845
2002	154,211
2001	158,515
2000	171,292
1999	153,917
1998	169,712
1997	162,035
1996	173,709

22) The operational cost of running the LONDON INTERNATIONAL BOAT SHOW for the years 2000 to 2009 was as follows:

	£
2009	5,161,081
2008	5,931,478
2007	5,676,314
2006	6,401,144
2005	6,634,792
2004	6,421,990
2003	5,560,310
2002	4,489,129
2001	4,134,746
2000	3,923,415

23) Exhibit TM2 consists of copies of press cuttings relating to the LONDON BOAT SHOW from 1999 or which refer to the LONDON INTERNATIONAL BOAT SHOW. Exhibit TM3 consists of a bundle of press clippings from 1999 which refer to the LONDON INTERNATIONAL BOAT SHOW. Exhibits TM4 and TM5 consist of press clippings which refer to the LONDON BOAT SHOW and the LONDON INTERNATIONAL BOAT SHOW, held from 7 January to 16 January 2000. Exhibit TM6 consists of press clippings which refer to the LONDON BOAT SHOW and, to a far lesser extent, to the LONDON INTERNATIONAL BOAT SHOW for 2001. Exhibit TM7 consists of press clippings referring to the LONDON BOAT SHOW, and to a lesser extent to the LONDON INTERNATIONAL BOAT SHOW for 2002. Exhibit TM8 consists of press clippings referring to the LONDON BOAT SHOW, and to a lesser extent to the LONDON INTERNATIONAL BOAT SHOW for the year 2003.

24) Ms Matthew states that for “many years” BMF has had a sponsorship arrangement in respect of the names LONDON BOAT SHOW and LONDON INTERNATIONAL BOAT SHOW. In 2003 the sponsor became the United Kingdom fund manager, Schrodgers. Exhibit TM9 contains press cuttings from

the *Financial Times* relating to the sponsorship of Schrodgers. Ms Matthew states that part of the sponsorship deal is that the sponsor is given consent to link its name to the trade marks LONDON BOAT SHOW and LONDON INTERNATIONAL BOAT SHOW. Ms Matthew is of the opinion that the relevant public will see SUPERYACHT LIFE and SUPERYACHTLIFE.COM as indicating sponsorship of THE LONDON SUPERYACHT SHOW, which she believes is likely to be linked to BMF.

25) Exhibit TM10 consists of press clippings showing use of the names LONDON BOAT SHOW, LONDON INTERNATIONAL BOAT SHOW, Schrodgers LONDON BOAT SHOW and Schrodgers LONDON INTERNATIONAL BOAT SHOW, during 2004. Exhibits TM11 and TM12 contain press cuttings from 2005 and 2006 in relation to LONDON BOAT SHOW and LONDON INTERNATIONAL BOAT SHOW, the majority of the references are to the former name.

26) Exhibit TM13 is a clipping from *Yacht Report* dated 1 February 2006. The clipping advises that "The London Boat Show is not an event that is traditionally linked with the superyacht market; however, this element is gradually on the increase at the show as boats get progressively larger." The article is headed "SUPERYACHTS AT LONDON".

27) Exhibits TM14 and TM15 contain press clippings from 2007 and 2008 relating to the use of the names LONDON BOAT SHOW and LONDON INTERNATIONAL BOAT SHOW (in relation to which there is one clipping from each year).

28) Exhibit TM16 consists of evidence filed in relation to application nos 2345824 and 2345825 in order to overcome objections raised at the examination stage. There is another witness statement from Mr John, dated 17 November 2004. The first SOUTHAMPTON BOAT SHOW was held in 1969. Mr John states that since 1978 the show has been billed as the SOUTHAMPTON INTERNATIONAL BOAT SHOW. Exhibited at NJ1 are copies of the covers of catalogues for the SOUTHAMPTON BOAT SHOW from 1973 to 1977. Exhibited at NJ2 are pictures of the spines of the catalogues for the shows from 1978 to 1995. SOUTHAMPTON INTERNATIONAL BOAT SHOW is shown upon the spines. Exhibited at NJ5 is a copy of a press release in relation to the 1992 show. The release advises that there will be 550 exhibitors and over 700 boats.

29) Mr John states that the SOUTHAMPTON INTERNATIONAL BOAT SHOW is organised on behalf of BMF by its wholly owned subsidiary, Southampton International Boat Show Limited. Attendance figures at the SOUTHAMPTON INTERNATIONAL BOAT SHOW from 1998 to 2003 were as follows:

1998	109,872
1999	111,176
2000	100,521

2001 116,904
 2002 129,984
 2003 133,697

30) Promotional expenditure of Southampton International Boat Show Limited for 1989 to 2003 was as follows:

1989 £85,033
 1990 £98,709
 1991 £154,727
 1992 £126,235
 1993 £155,973
 1994 £163,265
 1995 £144,298
 1996 £172,121
 1997 £171,109
 1998 £189,000
 1999 £188,921
 2000 £430,093
 2001 £312,612
 2002 £346,148
 2003 £400,112

31) Turnover of the SOUTHAMPTON INTERNATIONAL BOAT SHOW for the years ending 31 March 1989 to 2003 was as follows:

Year	Turnover £	Income derived from admission £
1989	1,152,589	334,667
1990	1,806,790	422,643
1991	1,901,894	435,136
1992	2,023,656	444,737
1993	2,074,767	443,359
1994	2,030,953	435,522
1995	2,198,513	484,750
1996	2,350,341	530,770
1997	2,442,490	556,051
1998	2,634,420	642,000
1999	2,969,058	641,398
2000	3,348,696	714,158
2001	3,417,666	684,812
2002	3,964,865	802,361
2003	4,264,859	931,093

32) Exhibited at NJ7 is a copy of an advertisement for the 1993 SOUTHAMPTON INTERNATIONAL BOAT SHOW from the guide for the East Coast Boat Show.

33) Exhibited at NJ8 are press cuttings which show use of SOUTHAMPTON BOAT SHOW in 2004. No use of SOUTHAMPTON INTERNATIONAL BOAT SHOW is shown in the material. Mr John lists a number of press cuttings as appearing in NJ8 which have not been adduced into these proceedings under this reference. Exhibited at TM17 are press cuttings from 2004. All but one refers to the SOUTHAMPTON BOAT SHOW; the one exception is from the Court Circular in *The Times*, which refers to SOUTHAMPTON INTERNATIONAL BOAT SHOW. Exhibit TM18 contains a variety of press cuttings; they are not all as described by Ms Matthew. Cuttings from 2005 refer to SOUTHAMPTON BOAT SHOW, there is one reference to SOUTHAMPTON INTERNATIONAL BOAT SHOW. The other material in the exhibit, which appears to derive from Mr John's NJ8 exhibit, is from 1999, 2000 and 2002. The majority of the references is to SOUTHAMPTON BOAT SHOW; there are 2 references to SOUTHAMPTON INTERNATIONAL BOAT SHOW. Exhibited at TM19 are press clippings from 2006 which show use of SOUTHAMPTON BOAT SHOW. Exhibited at TM20 are press clippings from 2007 which show use of SOUTHAMPTON BOAT SHOW. (Ms Matthew states that exhibits TM19 and TM20 show use of SOUTHAMPTON INTERNATIONAL BOAT SHOW but they do not.) Exhibit TM21 consists of press clippings from 2008 which show use of SOUTHAMPTON BOAT SHOW and SOUTHAMPTON INTERNATIONAL BOAT SHOW.

34) Attendance at the boat show using the names SOUTHAMPTON INTERNATIONAL BOAT SHOW and SOUTHAMPTON BOAT SHOW from 2004 to 2009 was as follows:

2009	121,671
2008	121,389
2007	127,345
2006	117,801
2005	123,325
2004	122,937

35) Operational costs for staging the SOUTHAMPTON INTERNATIONAL BOAT SHOW for the years 2004 to 2008 were as follows:

	£
2008	4,153,369
2007	3,825,733
2006	3,576,528
2005	3,334,341
2004	2,898,179

36) Ms Matthew states that NATIONAL BOAT SHOWS is a trading style under which BMF organises and promotes the LONDON INTERNATIONAL BOAT SHOW and the SOUTHAMPTON INTERNATIONAL BOAT SHOW events.

National Boat Shows Limited previously organised the LONDON INTERNATIONAL BOAT SHOW event and the SOUTHAMPTON INTERNATIONAL BOAT SHOW event. Subsequently, organisation of the SOUTHAMPTON INTERNATIONAL BOAT SHOW event was “channelled” through Southampton International Boat Show Limited. Ms Matthew states that the work of both National Boat Shows Limited and Southampton International Boat Show Limited is to co-ordinate by a single joint board the affairs of both “National Boat Shows and Southampton International Boat Show”. Ms Matthew states that the NATIONAL BOAT SHOWS name continues to be used and promoted as the organiser of these events and other events with which BMF has been involved over the years. Exhibited at TM22 is a screen print from britishmarine.co.uk upon which the words National Boat Shows and LONDON BOAT SHOW appear. No date can be seen upon the screen print. Also exhibited at TM22 is a screen print from islandpulse.co.uk. An article headed “National Boat Shows Offer Combi-Ticket” appears. It is dated 1 June 2007. The article begins:

“National Boat Shows, organisers of the London Boat Show at ExCel and Southampton Boat Show, today announces the launch of a brand new flexible Combi-ticket deal.”

37) Exhibits TM23, TM24 and TM25 are copies of the financial statements for National Boat Shows Limited for the periods ending 30 June 2006, 30 June 2007 and 30 June 2008. The principal activity of the company is the organisation of exhibitions in connection with the boating industry. Specific reference is made to the LONDON INTERNATIONAL BOAT SHOW.

“The immediate parent company and ultimate parent company is British Marine Federation (a company limited by guarantee) which is registered in England and Wales.”

The 2007 financial statement refers to the “Collins Stewart London Boat 2007”. It also refers to competition from the Whyte & Mackay Earls Court Boat Show”. The 2008 financial statement refers to the “Collins Stewart 2008 London Boat Show and Southampton International Boat Show”.

38) Exhibited at TM26 are screen prints from the website southamptonboatshow.com advertising the PSP SOUTHAMPTON BOAT SHOW, which was to take place from 11 to 20 September 2009. No date appears upon the screen prints, consequently, it is not possible to establish if the prints emanate from prior to the date of application for the trade marks. Exhibited at TM27 are pages from the website londonboatshow.com. They relate to the 2010 Tullett Prebon London International Boat Show; from the content it can be deduced that they emanate from after the date of application for the trade marks. Exhibited at TM28 are pages from londonboatshow.com emanating from 31 December 2005. At the bottom of the first page the rubric “brought to you by

National Boat Shows” appears. Exhibited at TM29 are pages from the same website, from 30 December 2006. They relate to the Collins Stewart London Boat Show which is “brought to you by National Boat Shows”. Exhibited at TM30 are pages from the same website, from 11 October 2007, which relate to the Collins Stewart London Boat Show. Reference is made to “brought to you by National Boat Shows” and “The home of the London Boat Show”. Exhibited at TM31 are pages from southamptonboatshow.com, from 8 December 2007. Reference is made to the SOUTHAMPTON BOAT SHOW which is “BROUGHT TO YOU BY National Boat Shows”.

Evidence of Luxury

39) This consists of a witness statement made by Andrew Thomas Selbey, dated 9 May 2011. Mr Selbey is the sole director of Luxury. He is the sole director of London Superyacht Show Ltd, which is a wholly owned subsidiary of Luxury. Mr Selbey states that SUPERYACHT LIFE THE LONDON SUPERYACHT SHOW is intended to become a part of a “suite” of trade marks owned by Luxury which is the owner of the following trade marks: SuperyachtStyle, SuperyachtLife and SuperyachtStudio.

40) Exhibited is a definition of superyacht from 5 November 2009 from superyacht.com. A superyacht is defined as being any yacht over 24 metres in length. There are several other references to superyacht. (Ms Matthew’s evidence, at TM13, shows that superyacht is a term that is used to define a particular type of yacht.) There are also definitions of boat. These define boat as small vessel for travelling over water, an inland vessel of any size, another word for ship, a ship or submarine.

41) Mr Selbey exhibits copies of e-mails from BMF to Luxury. In BMF’s evidence in reply Emily Barrow, of BMF, states that the e-mails from BMF emanate from e-mail accounts which send e-mails to anyone who subscribes to them. They are aimed at individual consumers, although anyone can sign up to them if they have a valid e-mail address.

42) Virtually all of the extensive evidence of Luxury emanates from after the date of the application. Luxury has subscribed to various publications and bodies but has not actually been involved in any business. The evidence in file 2 pages 118 to 128 shows this, emanating from 1 January 2011. At page 121 the following appears:

“The L.Y.M.G Is Currently Seeking ‘Seed Corn’ Venture Capital, To Enable It To Delivery Unique, World Class Superyacht: **Broadcast/Television/Exhibition & Financial Services** Solutions, To The International Superyacht Industry & All Global, Aspirational Luxury Lifestyle Communities.”

Findings of fact

43) The evidence of Luxury, as well as being virtually all after the date of application for registration, does not show any actual use in a business that is functioning. The evidence is aspirational rather than actual. In relation to the definition of boat, it is clear that boats will include superyachts, as shown in both Mr Selbey's own definitions and the clipping exhibited at TM13. The evidence of Luxury has no pertinence in these proceedings.

44) There is a complete absence of evidence to substantiate the claim that BMF, in relation to SUPERYACHT UK, has a reputation for the purpose of section 5(3) of the Act or a goodwill for the purpose of passing-off. (Moreover, the statement of grounds of BMF shows that the trade mark has been used by a variety of undertakings and any reputation and goodwill would be likely to accrue to them.) The statement of grounds also accepts that superyachts are a type of yacht that is over 24 metres in length. It is noted that the registration proceeded upon the basis of distinctiveness acquired through use but that evidence has not been adduced into the proceedings. Findings in this decision can only be made upon the basis of the evidence adduced in these proceedings. **In relation to the claims under sections 5(3) and 5(4)(a) of the Act in relation to the trade mark SUPERYACHT UK, BMF has neither established a reputation nor a goodwill and the claims are, consequently, dismissed.**

45) In relation to boats, boating and associated goods and services SUPERYACHT UK, combining a type of vessel and the name of a country, has the most limited of distinctiveness. The distinctiveness rests in the trade mark in its entirety; each separate element being completely descriptive.

46) Registration no 2217291 for the trade mark LONDON INTERNATIONAL BOAT SHOW, no 2217274 for the trade mark NATIONAL BOAT SHOW and no 2217288 for the trade mark LONDON BOAT SHOW are all subject to proof of use. Luxury has limited its requirement for proof of use to "[t]he provision of a London show promoting Superyachts". There is no requirement for BMF to prove use in relation to such a specific service. It has clearly shown use of LONDON INTERNATIONAL BOAT SHOW and LONDON BOAT SHOW in relation to boat shows. A fair specification, in a proof of use case, must not be over pickyⁱⁱ. It is necessary to consider how the relevant public would describe the servicesⁱⁱⁱ. In this case a fair description in relation to the use shown would be boat shows at large; which will include shows in which superyachts are exhibited. Consequently, the specifications in their entireties must be considered in these proceedings.

47) The name NATIONAL BOAT SHOW has not been used in relation to the show in London since 1960. There is limited use shown of National Boat Shows and National Boat Shows Ltd as the organiser of the London boat show. The claim is to use of NATIONAL BOAT SHOW not National Boat Shows. (In relation

to section 5(4)(a) of the Act it was open to BMF to claim NATIONAL BOAT SHOWS as an earlier right; it did not do so.) The pluralisation does make a difference in concept and identity. The former identifies one particular show which has the status of being the show for the nation. The latter identifies a number of shows, not a particular one. For the purposes of section 5(3) of the Act BMF must establish that at the date of application of Luxury's trade mark that NATIONAL BOAT SHOW was known by a significant part of the public concerned by the services covered^{iv}. There are two relevant publics for the boat shows organised by BMF: the exhibitors and the visitors. Knowledge by one will be enough to satisfy the requirement. 49 years had passed between when the show in London was called the NATIONAL BOAT SHOW and the date of application for the trade marks. There is an absence of use of NATIONAL BOAT SHOW, even if there may be knowledge of National Boat Shows. BMF has failed to establish that NATIONAL BOAT SHOW satisfies the reputation requirement of section 5(3) of the Act. A sign can enjoy a residual goodwill, even after its use has ceased. Owing to the passing of 49 years, the use for 49 years of other signs in relation to the show in Olympia, Earls Court and then ExCel, BMF has not established that at the date of the filing of the application it had a protectable goodwill in relation to the sign NATIONAL BOAT SHOW.

48) BMF claims that its trade marks LONDON BOAT SHOW, LONDON INTERNATIONAL BOAT SHOW, SOUTHAMPTON INTERNATIONAL BOAT SHOW, SOUTHAMPTON BOAT SHOW and NATIONAL BOAT SHOW are a family of trade marks. In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-234/06 P* the Court of Justice of the European Union (CJEU) stated:

“63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or

‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.”

49) NATIONAL BOAT SHOW has not been used for many years. It has been decided that there is no residual goodwill in relation to this trade mark. This leaves LONDON BOAT SHOW, LONDON INTERNATIONAL BOAT SHOW, SOUTHAMPTON BOAT SHOW and SOUTHAMPTON INTERNATIONAL BOAT SHOW as allegedly forming a family of trade marks. These trade marks have been used in relation to boat shows. The family element is a geographical location and a description of the service. Effectively BMF is arguing that use of a geographical location and the words boat show in relation to boat shows in a geographical location will lead the relevant consumer to believe that the show is organised by it or an economically linked undertaking. This is based upon use in two locations, London and Southampton. BMF’s own evidence shows use of the East Coast Boat Show by another party. If a boat show is being organised in a geographical location and described by reference to that location the relevant consumer is most likely to view the term as being used as a descriptor rather than as an indicator of particular origin. If BMF had numerous boat shows in many geographical locations identified with it, there might be a basis for this claim. In *re Joseph Crosfield & Sons, Limited, re California Fig Syrup Company and re H N Brock & Co Limited* (1909) 26 RPC 846, the Court of Appeal stated:

“Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure.”

This claim to a family of marks is such an attempt to enclose part of the great common. The existence and use of the trade marks LONDON BOAT SHOW, LONDON INTERNATIONAL BOAT SHOW, SOUTHAMPTON BOAT SHOW and SOUTHAMPTON INTERNATIONAL BOAT SHOW for boat shows in London and Southampton will not have an effect upon the claims made by BMF in this case.

50) LONDON BOAT SHOW, LONDON INTERNATIONAL BOAT SHOW, SOUTHAMPTON BOAT SHOW and SOUTHAMPTON INTERNATIONAL BOAT SHOW have been used for a number of years in relation to boat shows. The evidence clearly establishes that both relevant publics, exhibitors and those interested in boating, will be aware of the shows. These trade marks have the requisite reputation for the purposes of section 5(3) of the Act and goodwill for the purposes of the law of passing-off. In the terms of the specifications of the trade mark registrations the reputation is for:

organisation of shows and exhibitions; all relating to the maritime, nautical or nautical equipment fields, or to boating activities or to the inland waterways.

51) It is noted that part of the reputation in relation to the show in London is also identified with a particular locations; firstly, Olympia, then Earls Court and now

ExCel. This is part of the attractive force. BMF clearly considered that this was the position, as it tried to include Earls Court in a trade mark registration; something successfully opposed by the owners of Earls Court. In terms of goodwill this is a form of cat goodwill, rather than dog goodwill, which is the basis of passing-off and trade mark reputation^v.

Bad faith – section 3(6) of the Act

52) The material date for bad faith is the date of the filing of the application for registration^{vi}. Bad faith cannot be cured by some action after the date of the application^{vii}. (It may be, however, that actions after the date of application cast light on the decision to make an application for registration.) 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^{viii}”. Certain behaviour might have become prevalent but this does not mean that it can be deemed to be acceptable^{ix}. Bad faith impugns the character of an individual or collective character of a business, as such it is a serious allegation^x. The more serious the allegation the more cogent must be the evidence to support it^{xi}.

53) In *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* Case C-529/07 the CJEU stated:

“39 First, with regard to the expression ‘must know’ in the second question, a presumption of knowledge, by the applicant, of the use by a third party of an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought may arise, inter alia, from general knowledge in the economic sector concerned of such use, and that knowledge can be inferred, inter alia, from the duration of such use. The more that use is long-standing, the more probable it is that the applicant will, when filing the application for registration, have knowledge of it.

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.

41 Consequently, in order to determine whether there was bad faith, consideration must also be given to the applicant’s intention at the time when he files the application for registration.

42 It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant’s intention at the relevant time is a

subjective factor which must be determined by reference to the objective circumstances of the particular case.

43 Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44 That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45 In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, *inter alia*, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).

46 Equally, the fact that 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.

52 The extent of that reputation might justify the applicant's interest in ensuring a wider legal protection for his sign.

53 Having regard to all the foregoing, the answer to the questions referred is that, in order to determine whether the applicant is acting in bad faith within the meaning of Article 51(1)(b) of Regulation No 40/94, the national court must take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration of the sign as a Community trade mark, in particular:

–the fact that the applicant knows or must know that a third party is 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;

–the applicant's intention to prevent that third party from continuing to use such a sign; and

–the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought.”

There is no issue here of Luxury attempting to try to prevent BMF from continuing to use the signs upon which it relies. The premise of BMF is that because Luxury would have known of its boat shows and because it considers the trade marks of Luxury similar, the application was made in bad faith. This clearly does not fall within the parameters of the judgment of the CJEU in *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* nor that of Arnold J in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* Arnold J [2008] EWHC 3032(Ch), 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 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.”

54) The argument of BMF is based on contingent findings as to the similarity of the trade marks. It is difficult to see how a finding of bad faith can be contingent on findings in relation to similarity of signs. The logic of BMF’s argument is that if an applicant knows of an opponent’s trade mark and there is a finding of likelihood of confusion, then the application is made in bad faith. The corollary of this is that if there is no finding of a likelihood of confusion there will not be a finding of bad faith. Bad faith is about the state of knowledge of the applicant when making the application and how the action of making the application would be viewed by reasonable and experienced men in the particular field being examined; this analysis cannot be contingent upon a finding in relation to a ground under section 5(2)(b), 5(3) or 5(4)(a) of the Act; although passing-off may go hand in hand with bad faith.

55) The ground of opposition under section 3(6) of the Act is dismissed.

The best case for BMF

56) As stated above SUPERYACHT UK for services relating or associated with boating has the most limited distinctiveness. Lord Simons in *Office Cleaning Services Ltd v Westminster Window & General Cleaners* (1946) 63 RPC 39 at 43:

“It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively

small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

Lord Davey in *The Cellular Clothing Company v Maxton and Murray* (1899) 16 RPC 397 at page 408 stated:

“But, my Lords, there are two observations upon that which must be made. One is that, as has been more than once said, particularly by Lord Justice Fry (then I think a Judge of First Instance) in the case of *Siebert v. Findlater*, a man who takes upon himself to prove that words, which are merely descriptive or expressive of the quality of the goods, have acquired the secondary sense to which I have referred, assumes a much greater burden, and indeed a burden which it is not impossible, but at the same extremely difficult to discharge - a much greater burden than that of a man who undertakes to prove that same thing of a word not significant and descriptive, but what has been compendiously called a fancy word.

The above judgments were in relation to the law of passing-off.

57) In *The European Ltd v The Economist Newspaper Ltd* [1998] ETMR 307 Millett LJ stated:

“Although he did not have the benefit of the decision, he did in my opinion faithfully carry out the instructions of the European Court of Justice in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1 to the effect that:

"The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind in particular their distinctive and dominant components . . . the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public. The more distinctive the earlier mark, the greater will be the likelihood of confusion."

The converse, of course, follows. The more descriptive and the less distinctive the major feature of the mark, the less the likelihood of confusion.”

58) However, it is necessary to bear in mind the judgment of the CJEU in *L’Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-235/05 P the CJEU stated:

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

45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

59) The co-incidence in the trade mark SUPERYACHT UK and the trade marks of the application relates to a totally descriptive term. Taking into account the nature of the SUPERYACHT element, no relevant consumer will consider that there is any economic connection or link between Luxury and BMF. The SUPERYACHT element of the trade marks of Luxury will be seen for what it is, an indication of the nature of the show in relation to which the services will be used. **As there will be no link or economic connection, BMF cannot succeed under sections 5(2)(b), 5(3) or 5(4)(a) of the Act and so the grounds of opposition based upon SUPERYACHT UK are dismissed.**

60) In terms of similarities and differences LONDON BOAT SHOW is the closest trade mark to the trade marks of Luxury. If BMF does not succeed in relation to this trade mark it will not succeed in relation to the other trade marks under

sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Consequently, consideration of the aforesaid grounds of opposition will be made upon the basis of this trade mark.

Likelihood of confusion - section 5(2)(b) of the act

Average consumer, nature of purchasing decision and standard for likelihood of confusion

61) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”^{xii}. The specification of the application is:

advertising, advertising services provided via the internet; production of radio and television advertisements; auctioneering; trade fairs; opinion polling; provision of business; advertising by mail order; dissemination of advertising matter and production of advertising matter; advertising services by means of television screen based text; advertising services provided by television; advertising services relating to the marine and maritime industry; advertising service (rental of); advertising space (rental of) on the Internet; arranging of competition for advertising purposes; arranging of competition for trade purposes; arranging of exhibitions for advertising purposes; arranging of exhibitions for business purposes; arranging of exhibitions for commercial purposes; arranging of trade fairs; arranging of trade shows; audio-visual displays for advertising purposes (preparation or presentation); brand creation services; cinematography film advertising; classified advertising; communications media (presentation of goods on) for retail services; competitions (organising of business); competitions (organising of trade); compilation of advertising for use as web pages on the Internet; compilation of company information; compilation of directories for publishing on the Internet; compilation of indexed addresses; compilation of direct mailing lists; compilation of information into computer databases; conducting of trade shows; data handling; data preparation; data processing; department store retail services connected with the sale of jewellery, clocks, watches, stationery, publications, leather goods and luggage; direct mail advertising; direct market advertising; directories; distribution of advertising brochures; distribution of advertising leaflets; distribution of promotional material; electronic shopping retail services connected with computer equipment; electronic storage and retrieval of information; electronic storage of technical information; employee record services; leasing of advertising space on pamphlets; mailing lists (compilation of); market research services relating to broadcasts media; marketing; outdoor advertising; presentation of goods on communication media, for retail purposes; press advertising services; video recordings for advertising purposes (production of); video recordings for marketing purposes (production of); video recordings for publicity purposes (production of) ; and all included in Class 35;

education; providing of training; entertainment; sporting and cultural activities; arranging and conducting of conferences; arranging and conducting of seminars; arranging and conducting of symposiums; booking of seats for shows; bookmobile services; books (publication of -); cinema presentations; **competitions (organization of -) [education or entertainment]; competitions (organization of sports -)**; conferences (arranging and conducting of -); digital imaging services; education information; entertainment; entertainment information; **exhibitions (organization of -) for cultural or educational purposes**; electronic desktop publishing; **film production**; game services provided on-line from a computer network; information (education -); information (entertainment -); live performances (presentation of -); movie theatre presentations; museum facilities (providing -) [presentation, exhibitions]; **music composition services; organization of competitions [education or entertainment]; photographic reporting; photography; production of radio and television programmes; production of shows; production (videotape film -)**; providing on-line electronic publications, not downloadable; publication of books; publication of electronic books and journals on-line; publication of texts, other than publicity texts; **radio and television programmes (production of -)**; radio entertainment; recreation information; rental of sound recordings; rental of videotapes; **scriptwriting services**; seminars (arranging and conducting of -); **Subtitling**; television entertainment; **television programmes (production of radio and -)**; texts (publication of -), other than publicity texts; texts (writing of -), other than publicity texts; **videotape film production**; and all included in Class 41.

62) In considering the nature of the terms in the specification, cognisance is taken of the judgment of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

63) It is considered that the highlighted elements of the specification represent services that will be provided to businesses. The other services might be provided to both businesses and the public at large. The highlighted services are certainly not the sort of services that will be purchased on impulse.

64) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* the General Court (GC) stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present

on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

65) The nature of all of the services is such that visual similarity will be of more importance than aural similarity.

Comparison of services

66) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade^{xiii}”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^{xiv}. Consideration should be given as to how the average consumer would view the services^{xv}. The class of the services in which they are placed may be relevant in determining the nature of the services^{xvi}. In assessing the similarity of services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{xvii}. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{xviii}. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* the GC explained when goods are complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

Services can be considered as identical when the services designated by the earlier trade mark are included in a more general category, designated by the trade mark application^{xix}.

67) With the exception of the terms rehearsed below, the services of the earlier trade mark are included in the services of the application or have numerous points of coincidence. With the exception of the services below, the respective services are deemed to be identical or are highly similar. The following services show no obvious coincidence, within the parameters of the case law, with the services of the earlier registration:

auctioneering; opinion polling; compilation of company information; compilation of directories for publishing on the Internet; compilation of indexed addresses; compilation of information into computer databases; data handling; data preparation; data processing; department store retail services connected with the sale of jewellery, clocks, watches, stationery, publications, leather goods and luggage electronic shopping retail services connected with computer equipment; electronic storage and retrieval of information; electronic storage of technical information; market research services relating to broadcasts media; presentation of goods on communication media, for retail purposes; bookmobile services; books (publication of -); cinema presentations; digital imaging services; electronic desktop publishing; film production; game services provided on-line from a computer network; movie theatre presentations; music composition services; photographic reporting; photography; production of radio and television programmes; production of shows; production (videotape film -); providing on-line electronic publications, not downloadable; publication of books; publication of electronic books and journals on-line; publication of texts, other than publicity texts; radio and television programmes (production of -); radio entertainment; recreation information; rental of sound recordings; rental of videotapes; scriptwriting services; Subtitling; television entertainment; television programmes (production of radio and -); texts (publication of -), other than publicity texts; texts (writing of -), other than publicity texts; videotape film production.

In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97 the CJEU stated:

“22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

The court required evidence of similarity to be adduced. This finding has been reiterated by the CJEU and GC, eg in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-316/07:

“43 Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are

identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P Alecansan v OHIM, not published in the ECR, paragraph 24; and Case T-150/04 Mülhens v OHIM – Minoronzoni(TOSCA BLU) [2007] ECR II-2353, paragraph 27).”

The above part of the *Canon* judgment has been more recognised in the breach than in the observance in this jurisdiction (and before OHIM). It may not always be practical to adduce evidence of similarity; it may be that the nature of the services is so well-known that it would be a waste of effort and resources to do so. However, the onus is upon an opponent at least to make submissions as to why services are similar. The extent of the argument of BMF is:

“The services sought to be covered by the Applicant’s Mark are identical to the services covered by the Opponent’s Marks, or are services likely to be associated with such services.”

BMF gives no basis to its claim of “association”. Moreover, association is neither the same as similarity nor a criterion for similarity. In the absence of any evidence, any coherent submissions and any obvious points of similarity, it is found that the services rehearsed above are not similar to the services of the earlier registration.

Comparison of trade marks

68) The trade marks to be compared are:

SuperyachtLife.com
The London Superyacht
Show

LONDON BOAT SHOW

SuperyachtLife
The London Superyacht
Show

69) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{xx}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{xxi}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably

well informed and reasonably circumspect and observant^{xxii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xxiii}.

70) In relation to the services of the earlier registration, the individual elements of the earlier trade mark and the elements together, in the absence of use, lack distinctive character. In the absence of use, there is no distinctive and dominant component. The distinctiveness lies in the trade mark as a whole, it has only been registered through its use as a boat show in London. In the comparison of the trade marks it is necessary to take into account, in relation to reputation (reputation requiring use), the judgment of the GC in *Ravensburger AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-243/08:

“27 It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51).”

(A finding of law that can also be found in *Accenture Global Services GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-244/09, *Lan Airlines, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-194/09 and *Ferrero SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-140/08.)

71) The London Superyacht Show is clearly descriptive for many of the services in relation to a show in London for superyachts. Consequently, it is an element of the trade marks that is neither distinctive nor dominant. SuperyachtLife.com and SuperyachtLife clearly have a reference to superyachts. However, the combination of Life.com and Life with the first element creates a whole that is not descriptive. Consequently, the distinctive and dominant components of the trade marks are SuperyachtLife.com and SuperyachtLife.

72) The trade marks coincide conceptually in that they identify a show for boats in London. They have the visual and aural similarities of the words London and Show. However, these elements are completely descriptive in so far as they relate to a show in London. The other elements of the trade marks of Luxury are alien to the trade mark of BMF.

Conclusion

73) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xxiv}. In this case certain of the services are identical and certain of them are highly similar. In relation to the services in relation to which similarity has not been established there cannot be a likelihood of confusion; as similarity of services is necessary.

74) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xxv}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xxvi}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xxvii}. The LONDON BOAT SHOW has gained some distinctiveness through use and will identify a particular boat show (reputation can be taken into account the likelihood of confusion but not in relation to similarity of trade marks, as above). However, owing to the extreme descriptiveness of the trade mark the penumbra of protection will be very limited. The relevant publics will be able to distinguish the trade mark from other trade marks by relatively small differences. In this case there are significant differences with the trade marks of Luxury. The findings of the CJEU in *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* must be born in mind; the question is one of confusion and not distinctiveness but the level of distinctiveness can have an effect on whether there is a likelihood of confusion. In *Bundesverband der Deutschen Volksbanken und Raiffeisenbanken eV (BVR) g Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle) (HABM) Case T-197/10* the GC considered the issue of similarity and likelihood of confusion where trade marks coincide in relation to descriptive or non-distinctive elements:

“48 Diese Rügen des Klägers können jedoch das Ergebnis der Beschwerdekammer nicht in Frage stellen, wonach zwar zwischen den einander gegenüberstehenden Zeichen eine „gewisse Ähnlichkeit“ auf begrifflicher Ebene vorliege, diese jedoch schwach bleibe. Genauso wie sich nämlich die Begriffe „Austria“ und „Leasing“ oder die Abkürzung „Gesellschaft m.b.H.“ jeweils auf Österreich, Mietkaufverträge oder eine Gesellschaftsform beziehen, verweist der Begriff „Raiffeisen“ in allerdings weniger offenkundiger, jedoch ebenso bedeutsamer Weise, was die Prüfung auf begrifflicher Ebene angeht, auf eine Art genossenschaftlicher Organisation im Bankensektor, die durch die von Friedrich Wilhelm

Raiffeisen im 19. Jahrhundert entwickelten Grundsätze geleitet wird. Zudem übernimmt die Beschwerdekammer zwar die Auffassung, dass das Wortelement „Raiffeisenbank“ der älteren Marke von den angesprochenen Verkehrskreisen als Hinweis auf den Namen „einer bekannten Gruppe regionaler Banken, die Raiffeisenbanken, verstanden“ werde, doch seien diese „Raiffeisenbanken“ dem Publikum nicht im Zusammenhang mit Österreich oder einer österreichischen Bankengruppe bekannt, die sich von den Ideen von Friedrich Wilhelm Raiffeisen leiten lasse. Bankengruppen nach dem von diesem erdachten Konzept gebe es in verschiedenen Ländern.

49 Der Begriff „Raiffeisen“ hat nämlich eine beschreibende Bedeutung, die auf eine Art genossenschaftlicher Organisation verweist und die für den Kläger in Deutschland ebenfalls Kennzeichnungskraft hat, denn die von dieser Organisation in diesem Land angebotenen Dienstleistungen werden durch eine Bildmarke gekennzeichnet, die diesen Begriff verwendet. Eine andere Bildmarke kann jedoch diesen Begriff ohne Weiteres enthalten, wenn dieser auf begrifflicher Ebene nur auf seine beschreibende Bedeutung oder zumindest auf einen Wirtschaftsteilnehmer, der mit dieser Art genossenschaftlicher Organisation in einem anderen Land als Deutschland tätig ist, hinweist.

.....

... 61 Außerdem kann sich die Beurteilung der Verwechslungsgefahr entgegen dem Vorbringen des Klägers nicht mit der Feststellung begnügen, dass der Begriff „Raiffeisen“ möglicherweise als dominierender Bestandteil der älteren Marke betrachtet, oder, wie der Kläger ausführt, einem Bestandteil gleichgestellt werden kann, der eine selbständig kennzeichnende Stellung in der angemeldeten Marke im Sinne des in Randnr. 56 des vorliegenden Urteils angeführten Urteils Medion hat. Aus dem Vorstehenden ergibt sich nämlich, dass die Beschwerdekammer davon ausgegangen ist, dass die anderen Elemente der älteren Marke und der angemeldeten Marke bei der Beurteilung der Verwechslungsgefahr eine Rolle spielten. Sie hat die einander gegenüberstehenden Bildmarken zu Recht insgesamt geprüft, ohne sie auf den einzigen Begriff zu reduzieren, der in jeder dieser Marken enthalten ist.

62 Überdies legt der Kläger, da es „Raiffeisen-Bankengruppen“ in verschiedenen Ländern, wie Österreich und Deutschland, gibt, nicht überzeugend dar, aus welchen Gründen die maßgeblichen Verkehrskreise, bei denen in Bezug auf die Finanzdienstleistungen ein höherer Grad an Aufmerksamkeit vorliegt (vgl. Randnr. 20 des vorliegenden Urteils), die in Deutschland niedergelassenen „Raiffeisenbanken“ gedanklich mit den in Österreich niedergelassenen „Raiffeisenbanken“ in Verbindung bringen könnten.

63 Im Ergebnis ist davon auszugehen, dass die Beschwerdekammer zu Recht aufgrund der Ausführungen in der angefochtenen Entscheidung zu dem Ergebnis gelangt ist, dass unter Berücksichtigung der maßgeblichen Verkehrskreise und trotz der Ähnlichkeit der beanspruchten Dienstleistungen die zwischen den Zeichen bestehenden Unterschiede in Anbetracht des Gesamteindrucks ausreichend sind, um jede Verwechslungsgefahr auszuschließen.”

75) Ms Matthew made reference in her evidence to the SuperyachtLife.com and SuperyachtLife elements of the trade marks as indicating the name of a sponsor and so increasing the likelihood of confusion. She made a comparison with the use of Schroder’s name as a sponsor of the LONDON BOAT SHOW. Ms Matthew’s submission appears, without referring to it, to pray in aid the judgment of the CJEU in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* Case C-120/04 (a case which is mentioned in the submissions of BMF):

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

Taking into account the differences in the trade marks and the limited distinctiveness of the earlier trade mark the overall impression is not likely to lead the relevant public to believe that the services of the application and the earlier registration come from economically linked undertakings. It is noted that the statements of Richard Lloyd-Williams, Christine Smith, Martin Georgeson, Noel Smith and Chantelle Bates refer to considering that the use of the sign THE

LONDON SUPERYACHT SHOW would lead them to believe that the show was organised by National Boat Shows. So, they were not referring to the trade marks of the application.

76) Taking into account the limited distinctiveness of the earlier trade mark, even with evidence of use, and the differences between the trade marks of the application and the earlier trade mark, there is not a likelihood of confusion either in the context of direct confusion or the relevant consumers believing that the respective undertakings are economically linked. **The ground of opposition under section 5(2)(b) of the Act is dismissed.**

Section 5(3) of the act

77) In *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07, the CJEU considered Article 4(4)(a) of Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive), which is the basis of section 5(3) of the Act:

“26 Article 4(4)(a) of the Directive establishes, for the benefit of trade marks with a reputation, a wider form of protection than that provided for in Article 4(1). The specific condition of that protection consists of a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, in respect of Article 5(2) of the Directive, *Marca Mode*, paragraph 36; *Adidas-Salomon and Adidas Benelux*, paragraph 27, and Case C-102/07 *adidas and adidas Benelux* [2008] ECR I-0000, paragraph 40).

27 The types of injury against which Article 4(4)(a) of the Directive ensures such protection for the benefit of trade marks with a reputation are, first, detriment to the distinctive character of the earlier mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark.

28 Just one of those three types of injury suffices for that provision to apply.

29 As regards, in particular, detriment to the distinctive character of the earlier mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

30 The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, *General Motors*, paragraph 23; *Adidas-Salomon and Adidas Benelux*, paragraph 29, and *adidas and adidas Benelux*, paragraph 41).

31 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

32 However, the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute, as was stated in paragraph 26 of this judgment, the specific condition of the protection of trade marks with a reputation laid down by that provision.....

37 In order to benefit from the protection introduced by Article 4(4)(a) of the Directive, the proprietor of the earlier mark must adduce proof that the use of the later mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.

38 The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.

44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique – that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets – it must be ascertained whether the earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, inter alia, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59).

58 However, as is apparent from paragraphs 27 to 31 of the judgment in *Adidas-Salomon and Adidas Benelux*, implementation of the protection introduced by Article 4(4)(a) of the Directive does not require the existence of a likelihood of confusion.

59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 4(4)(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark

must be assessed globally, taking into account all factors relevant to the circumstances of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.

64 The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services,

does not necessarily imply that there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.”

78) It has been established that BMF has the requisite reputation for the purposes of section 5(3) of the Act in relation to the trade mark LONDON BOAT SHOW for:

organisation of shows and exhibitions; all relating to the maritime, nautical or nautical equipment fields, or to boating activities or to the inland waterways.

79) Despite having a reputation, ie being known to a significant part of the persons concerned, the trade mark, owing to its highly descriptive nature, still has limited distinctiveness. The nature of the trade mark is such that it will only create a link with another trade mark where that other trade mark is exceptionally similar to it; that is not the case here. **A link will not be established with the trade marks of Luxury and so the ground of opposition under section 5(3) of the Act is dismissed.**

Passing-off – section 5(4)(a) of the Act

80) Reference has already been made to the judgment of Lord Simons in *Office Cleaning Services Ltd v Westminster Window & General Cleaners* (1946) 63 RPC 39 at 43:

“It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is

inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

This case sits fully within the finding of Lord Simons. The case for BMF is even weaker as there is an element of cat goodwill in its goodwill, as noted above. However, putting that to one side, the nature of the sign LONDON BOAT SHOW means that the relevant consumers will readily distinguish it from services supplied under the trade marks of the application. The sponsorship by Schroders, to which Ms Matthew refers, will lessen the chance of misrepresentation owing to the relevant public identifying a further sign with the show. It is noted that there have been a variety of sponsors, however, each of these brings an additional element of difference. There will be no misrepresentation. **The ground of opposition under section 5(4)(a) of the Act is dismissed.**

COSTS

81) Luxury has been successful and so is entitled to a contribution towards its costs. The evidence of Luxury was extensive but without pertinence. BMF filed a good deal of evidence, a large part adduced from other proceedings. BMF would have had to consider the evidence of Luxury; this balances against the consideration of the evidence of BMF by Luxury, taking into account the lack of relevance of that evidence. Consequently, no costs will be awarded in respect of the evidence filed by the parties. The only costs that will be awarded to Luxury are for preparing a statement and considering the statement of BMF, for which £400 is awarded.

82) British Marine Federation is to pay Luxury Yachts Media Group Limited the sum of £400. 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 5th day of March 2012

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

ⁱⁱ *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods?

Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

iii *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

iv *General Motors Corporation v Yplon SA* Case C-375/97.

v Primrose Mroczkowski, "The Cat, the Dog, the Rat and the Rabbit": Identifying and Valuing "Goodwill" after *FC of T v Murry* [1999] JIATax 18; (1999) 2(4) *Journal of Australian Taxation* 212:

“This is a reference to the zoological classification of custom (or goodwill) into those categories in *Whiteman Smith Motor Co v Chaplin* [1934] 2 KB 35, 42 ("Whiteman"). The cat, rat and dog classification appears to be the work of a counsel in the case, a Mr SPJ Merlin. Maugham LJ, a judge in *Whiteman*, introduced the rabbit classification. When referring to this classification. Rich J in *FC of T v Williamson* [1943] HCA 24; (1943) 67 CLR 561, 564 ("Williamson") held that "[t]he cat prefers the old home to the person who keeps it, and stays in the old home although the person who has kept the home leaves, and so it represents the customer who goes to the old shop whoever keeps it, and provides the local goodwill. The faithful dog is attached to the person rather than to the place; it will follow the outgoing owner if he does not go too far. The rat has no attachments, and is purely casual. The rabbit is attracted by mere propinquity. It comes

because it happens to live close by and it would be more trouble to go elsewhere. These categories serve as a reminder that the goodwill is a composite thing referable in part to its locality, in part to the way in which it is conducted and the personality of those who conduct it, and in part to the likelihood of competition, many customers being no doubt actuated by mixed motives in conferring their custom." In *Kirby v Thorn EMI Pty Ltd* [1987] BTC 462, 468. Thorn EMI's reputation in certain trades was described as "dog" goodwill as distinct from "cat, rat or rabbit" goodwill."

^{vi} *Hotpicks Trade Mark* [2004] RPC 42 and *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* Case C-529/07 paragraph 35.

^{vii} *Nonogram Trade Mark* [2001] RPC 21.

^{viii} *Gromax Plastics Limited v Don and Low Nonwovens Ltd* [1999] RPC 367.

^{ix} *Harrison v Teton Valley Trading Co* [2005] FSR 10. Full judgment to be found at the url:

<http://www.bailii.org/ew/cases/EWCA/Civ/2004/1028.html>

^x See *Royal Enfield Trade Marks* BL O/363/01.

^{xi} *Re H (minors)* [1996] AC 563.

^{xii} *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

^{xiii} *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{xiv} *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{xv} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

"In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use"

^{xvi} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{xvii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xviii} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

^{xix} See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

^{xx} *Sabel BV v Puma AG* Case C-251/95.

^{xxi} *Sabel BV v Puma AG* Case C-251/95.

^{xxii} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{xxiii} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xxiv} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xxv} *Sabel BV v Puma AG* Case C-251/95.

^{xxvi} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xxvii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.