

**O-172-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION No. 3267851**

**FOR THE TRADE MARK**

**MASTERCHEF**

**STANDING IN THE NAME OF**

**SHINE TV LIMITED**

**AND**

**IN THE MATTER OF A REQUEST FOR A DECLARATION**

**OF INVALIDITY THERETO UNDER No.502400**

**BY MANA Y.A. LIMITED**

**AND**

**IN THE MATTER OF APPLICATION No. 3324139**

**BY MANA Y.A. LIMITED**

**FOR THE TRADE MARK**



**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER No. 414218**

**BY SHINE TV LIMITED**

## BACKGROUND

1) The following trade mark is registered in the name of Shine TV Limited (hereinafter STL):


Mark	Number	Filing & registration date	Class	Specification
MASTERCHEF	3267851	02.11.17 30.03.18	29	Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products; Edible oils and fats.
			30	Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastries and confectionery; Edible ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces [condiments]; Spices; Ice.

2) By an application dated 12 December 2018 Mana Y.A. Limited (hereinafter MYA) applied for a declaration of invalidity in respect of this registration. The grounds are, in summary:

- a) On 9 March 2012 STL registered two UK trade marks, 2596545 in respect of classes 11, 29, 31, 32 & 33; and 2596542 in respect of class 30. On 10 March 2017 MYA filed revocation actions against these marks on the basis that they had not been put to genuine use in the UK in the five years since being registered. On 3 July 2018 the IPO issued its decision which revoked the majority of the goods in classes 29 and 30 of these marks. Prior to the decision being issued STL filed the application in suit. MYA points out that the goods registered under the mark in suit were all part of the specification cancelled under the marks 2596545 & 2596542. Because of the revocation action STL were aware of MYA's intention to use a similar mark upon the goods which were part of the revocation action. STL's actions in filing the mark in suit were simply to prevent MYA registering its mark, and, as shown by the revocation action, STL had no intention of using the mark on the goods for which it is registered. The mark was therefore applied for in bad faith and offends against section 3(6) of the Act.

3) STL provided a counterstatement, dated 20 February 2019, which basically denies the allegations made by MYA. It states that it was not aware of any use of a mark similar to its own in the UK or EU by MYA prior to its filing the mark in suit. It also states that prior non-use does not equate to a lack of intention to use.

4) On 12 July 2018 MYA applied to register the following trade mark:

Mark	Number	Filing	Class	Specification
	3324139	12.07.18	29	Meat, fish, poultry and game; meat extracts; vegetable extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; prepared meals; semi prepared meals; meat jus; broths; broth concentrates; soups, preparations for making soups and potato crisps; desserts made wholly or principally of dairy products; fruit desserts; meat products containing sauces.
			30	Coffee, tea, cocoa, sugar, rice, risotto, tapioca, sago, couscous, artificial coffee; flour and preparations made from cereals, pasta, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); chutneys; spices; ice; sandwiches; prepared meals; semi prepared meals; pizzas, pies and pasta dishes; puddings [desserts]; frozen desserts; non-dairy frozen dessert products; preparations for making desserts; ice cream desserts; prepared desserts [pastries]; mixes for making bakery products; mixes for making breakfast foods; mixes for making cakes; mixes for making puddings; mixes for preparing sauces; mixes for the preparation of

				bread; sauce mixes; seasoning mixes; garden herbs, preserved [seasonings]; spice mixes; dried herbs; preparations for making sauces.
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5) The application was examined and accepted, and subsequently published for opposition purposes on 27 July 2018 in Trade Marks Journal No.2018/030.

6) On 29 October 2018 STL filed a notice of opposition. STL is the proprietor of the following trade marks:

Mark	Number	Filing & registration date	Class	Specifications relied upon
MASTERCHEF	EU8316135	22.05.09  Not yet registered as opposed	8	Cutlery; kitchen knives, can openers, knife sharpeners, pizza cutters, ice picks, meat choppers, nutcrackers, oyster openers, scissors, cheese slicers, spatulas, vegetable choppers, slicers and peelers.
			21	Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
			29	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
			30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey,

				treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
MASTERCHEF	UK 2563306	04.11.10 29.08.14	8	Cutlery; kitchen knives, can openers, knife sharpeners, pizza cutters, ice picks, meat choppers, nutcrackers, oyster openers, scissors, cheese slicers, spatulas, vegetable choppers, slicers and peelers.
MASTERCHEF	EU 9505066	08.11.10 Not yet registered as opposed	43	Restaurant, cafes; snack bars; provision of food and drink; provision of temporary accommodation.
MASTERCHEF	UK 2596545	03.10.11 09.03.12	29	Edible oils: gravy; stock
MASTERCHEF	UK 3267851	02.11.17 30.03.18	29	Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products; Edible oils and fats.
			30	Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastries and confectionery; Edible ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces [condiments]; Spices; Ice.

7) The opposition grounds are, in summary:

- (a) STL contends that the mark in suit is similar to its earlier marks listed in paragraph 6 above, and that the goods and services for which these marks are registered / applied for are identical and/or similar to the goods of the mark in suit. STL contends that there is a likelihood of confusion on the part of the average consumer and that therefore the mark in suit offends against section 5(2)(b) of the Act.

(b) STL relies upon its marks shown below. All are for Masterchef /MASTERCHEF in relation to a range of services in class 41 for which it claims it has a reputation through use. STL claims that use of the mark in suit will take unfair advantage of its reputation by riding on STL'd coat-tails; be detrimental to the distinctive character of STL's registrations by eroding and blurring them. Meaning that they will no longer be immediately and exclusively associated with STL; and as STL will have no control over MYA's use of the mark or the quality of its goods use of the mark in suit will be detrimental to STL's reputation. All the above will lead to a change in the economic behaviour of the average consumer of the goods and services for which STL's marks are registered without due cause. The mark in suit therefore offends against section 5(3) of the Act.

Number	Filing & registration date	Class 41 Specifications relied upon
EU 6952733	30.05.08  02.02.09	The production, presentation and distribution of audio and video works and materials including television programmes, radio programmes and films and the provision of information relating thereto.
EU 8316135	22.05.09  Not yet registered as opposed	Organising events for entertainment, recreational, educational or training purposes; organising competitions.
UK 2563306	04.11.10  29.08.14	The production, presentation and distribution of television programs; entertainment services, namely, a television series in the reality genre in the field of cooking and food; publishing of web magazines; production and presentation of competitions, games and studio entertainment.
EU 9505066	08.11.10  Not yet registered as opposed	Educational and entertainment services; the production, presentation and distribution of audio and video works and materials including television programs, radio programs and films; the distribution of audio and video works and materials including television programs and films; providing non-downloadable on-line electronic publications; providing educational and entertainment websites; publishing of web magazines; organising live entertainment events, exhibitions and roadshows; interactive television entertainment; provision of interactive games; interactive entertainment; production and presentation of competitions, games and studio entertainment.

(c) STL contends that it has goodwill from 1990 in the UK in respect of the sign MASTERCHEF in relation to entertainment services, in particular a television series in the reality genre of cooking and food. Use of the mark in suit would cause deception and damage to STL's goodwill. As such use of the mark in suit offends against section 5(4)(a) of the Act.

8) On 2 January 2019 MYA filed a counterstatement basically denying all the grounds of opposition and putting STL to strict proof of use.

9) Both sides filed evidence. Both sides ask for an award of costs. The matter came to be heard on 5 February 2020 when Ms Blythe of Counsel instructed by Messrs Wiggin LLP represented STL; MYA was represented by Mr Traub of Messrs Pinsent Masons LLP.

### **STL's Evidence**

10) STL filed a witness statement, dated 17 July 2019, by Frances Adams, the Group Director of Brand Strategy which is part of the group of companies which includes STL, a position she has held for seven years. She states that, in the five years prior to 27 July 2018, the mark MASTERCHEF had been put to genuine use in the UK on television programmes, edible oils, gravy and stock. She contends that STL has a reputation in the mark in the UK and EU in relation to television programmes, live events and merchandising. She also claims that STL had a bona fide intent to use the mark in relation to the goods for which it sought registration on 2 November 2017. She states that the group, of which STL is a part, produce a large number of award-winning television programmes which are sold all round the world. In the UK the programme called MASTERCHEF was broadcast from 1990-2003 and then 2005 to date. There have been spin-off series as well, such as Junior Masterchef, Celebrity Masterchef etc; thus far there have been 42 series of programmes.

11) Ms Adams states that there have been other spin-offs such as live events (2011 & 2018), pop restaurant and mobile kitchen (2014) and official merchandise. She declines to provide turnover figures for the television programmes simply stating: "suffice to say that the MASTERCHEF programme is one of the biggest brands owned by ESG [the parent company]". She provides a table which shows that in the years 2014-2018 MASTERCHEF television programmes and spin off programmes were shown for a total of 215,000 hours mostly on BBC channels with millions of viewers watching each episode. The programmes have also been aired extensively in the EU. The programmes have also been extensively advertised in magazines and national newspapers in the UK. The programmes have also won numerous awards and received significant press and media attention.

12) Ms Adams states that it is common for television shows to sell merchandising instancing:

- Top Gear: which sells dvds, magazines and a games (exhibit FA 34).

- Dr Who: which sells bags, clocks, mugs, artwork, homeware, cards, keyrings, T-shirts and stationery (exhibit FA35).
- Great British Bake-Off: offering books, aprons, tins, tea towels, oven gloves and recipes (exhibit FA36).
- The Hairy Bikers: offering mugs, cookware and spice racks (exhibit FA37).
- Iron Chef: A programme shown in 2010, with pages from 2019 but it is not clear the website is UK based or facing.

13) She provides copies of pages, dated September 2019, from the Amazon website showing MASTERCHEF branded merchandising stating that these were sold from the last quarter of 2018 which would be after the relevant date. She provides a table which states that items of cookware, knives, kitchen equipment and cook books have been licensed from at least 2012-2020 inclusive, whilst toys were licensed between August 2017 to date with sauces, gravies, spices and oils licensed between December 2012 – June 2016. On foodstuffs Ms Adams provides additional detail stating that STL entered into a license agreement with All About Food Ltd on 11 December 2012 to sell food under the MASTERCHEF mark, a redacted copy of the agreement, which expires in June 2016, is provided at exhibit FA 43. At exhibit FA 45 she provides a copy of a witness statement filed in the revocation actions against STL's marks 2596542 & 2596545 referred to earlier in this decision. The witness statement confirms that the mark MASTERCHEF was used in the UK in relation to rapeseed oil, beef gravy, chicken stock, beef stock, chicken gravy, extra virgin olive oil, chilli infused oil and onion gravy between 2 February 2014 and 8 June 2014 in branches of Tesco. She contends that STL has an intention to use the brand upon foodstuffs and points to exhibits 47-52 inclusive detailed later in this decision. In the exhibits a logo device is extensively shown and some of the packaging does not show use of the word "masterchef".

14) Ms Adams states that the food market is a difficult one in which to launch successfully and to date sales have been far below expectations and hopes, not helped by supermarkets concentrating on their own brands and extensions such as Tesco Finest and Sainsbury'S Taste the Difference. However, as other markets such Brazil, Italy and France have shown STL can sell food products under its MASTERCHEF brand. It has revamped its marketing strategy and with a new team in place it is looking at relaunching in 2020. She also provides the following exhibit:

- FA13: Copies of pages from the official MASTERCHEF store at Amazon, dated June 2019. The pages show saucepans, frying pans, knives, chopping boards, aprons and a pestle and mortar set offered for sale.



- FA 47: a consultancy agreement dated 2012 which resulted in a plan to use the mark upon a variety of foodstuffs (paragraph 2.1 specifically mentions food).
- FA 48: an internal strategy document from 2013 about the types of foodstuffs that could be offered for sale.
- FA 49: A presentation made to a potential UK supermarket partner in 2015, which shows specifically use of a logo mark upon ready meals.
- FA 50: Copies of an internal email regarding a MASTERCHEF food strategy dated November 2017 which mentions delivery boxes and ready meals.
- FA51: A presentation made to a third party regarding a partnership on MASTERCHEF food boxes on 16 May 2018.
- FA52: An internal document, dated 2018 regarding its food strategy.

### **MYA's Evidence**

15) MYA filed a witness statement dated 30 August 2019 by Matthew Thomas Gerard Harris MYA's Trade Mark Attorney. His statement basically is a repeat of the pleadings, setting out the history between the parties, reiterating that STL applied for its marks in bad faith as the result of a revocation action was pending at the point of the filing, and making various submissions.

### **STL's Evidence in reply**

16) STL filed a witness statement, dated 1 November 2019, by Peter Dawson its Trade Mark Attorney. The statement consists of submissions which I shall consider as and when necessary in my decision.

### **MYA's Evidence in reply**

17) MYA filed a witness statement, dated 25 November 2019, by Mr Harris who has previously provided a statement in this case. His second statement provides more submissions which I shall consider as and when necessary in my decision.

18) That concludes my summary of the evidence filed, insofar as I consider it necessary.

### **DECISION**

19) The relevant section regarding invalidity states:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if –

- (a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

20) The only ground of invalidity is under Section 3(6) which reads:

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

21) The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. (as he was) in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... 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)."

22) MYA referred me to the decision of the CJEU in *Lindt Goldhase* (12/03/2009, C-529/07), where in paragraph 38 it found that in order to assess bad faith, three factors need to be considered:

- "i) the fact that the applicant knows or must know that a third party is using an identical or similar Word Mark for an identical Word Mark for an identical or similar product capable of being confused with the Word Mark for which registration is sought;
- ii) the applicant's intention to prevent that third party from continuing to use such a Word Mark;
- iii) the degree of legal protection enjoyed by the third party's Word Mark and by the Word Mark for which registration is sought."

23) MYA also contended that "the CJEU clarified in *Sky plc and other companies v SkyKick UK Ltd and another company* (29/1/2020, C-371/18) that a trade mark application which was made with the intention either of undermining the interests of third parties, or of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark, the mark will be found to have been registered in bad faith and declared invalid (cf. paragraph 77 of the judgment). Setting out the test in more detail, the court ruled:

“Such bad faith may, however, be established only if there is objective, relevant and consistent indicia tending to show that, when the application for a trade mark was filed, the trade mark applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark.”

24) MYA maintains that it brought a revocation action against a previous identical mark for virtually identical goods registered in the name of STL. However, prior to the IPO issuing its decision STL filed the mark in suit. MYA contends that STL filed the application “with the full knowledge that the goods under the Earlier Registrations were highly likely to be revoked due to non-use in the UK.” The IPO decision did revoke the vast majority of the goods which were previously registered on the basis that STL had not shown that it had made genuine use of the mark in relation to most of the goods for which the earlier mark was registered.

25) MYA contends that:

“4.12 Applying the test set out in *Lindt Goldhase* (12/03/2009, C-529/07, at paragraph 60), Party A [STL] had no legitimate objective in pursuing the Party A Mark in Classes 29 and 30. Following the timeline of events of the Revocation Action and the filing of the Party A Mark, a finding of bad faith against the Party A Mark can be the only outcome and any other decision could lead to a number of parties congesting the register with registrations that they have no bona fide intention of using.

4.13 Applying the test set out in *Sky v Skykick* (29/1/2020, C-371/18, at paragraph 77), it is clear from the successful Revocation Action that Party A did not use the MASTERCHEF name in relation to relevant goods in Classes 29 and 30 for at least a five year period prior to the date when the Revocation Action was filed. It is inconceivable that Party A suddenly developed an intention to use the Party A Mark in relation to the goods in Classes 29 and 30, notwithstanding the fact that it had failed to build a sizeable market share in relation to these goods in the preceding years. From the circumstances, in pre-empting a negative outcome in the, at the time pending, Revocation Action, it is correct to assume that Party A's intention was to undermine Party B's [MYA] interests of obtaining the Party B Mark. Neither was Party A's conduct coherent with the functions of a trade mark, nor in a manner consistent with honest practices. Party A's conduct constituted bad faith and resulted in an abuse of the trade mark system.

4.14 Party A's bad faith conduct is also emphasised in the parallel opposition proceedings.

4.15 The Party B Mark was filed in good faith a few days after the decision on the Revocation Action and with a bona fide intention to use the mark in relation to all of the covered goods in Classes 29 and 30 in the UK market. In light of the successful Revocation Action and taking into account the grounds set out in the Invalidity Action, it is clear that the intention of Party A on filing the Opposition is to prevent Party B from duly registering and/or using the MASTERCHEF name (under the Figurative Mark) in relation to goods in Classes 29 and 30. We submit that Party A's endeavours to prevent Party B from duly registering and using the Party B Mark in relation to goods in Classes 29 and 30 are made in bad faith.”

26) For its part STL contends that:

- a) It has significant reputation in the MASTERCHEF mark in relation to its television shows and it has sought to license its mark in relation to a wide range of goods and services;
- b) It has already sold foodstuffs such as oils, stocks and gravies until 2016 (as shown in the revocation action) and engaged consultants to advise on further commercialisation in the food industry, and has carried out a presentation to a potential partner regarding MASTERCHEF food boxes (see exhibits 47-51);
- c) STL may not have been particularly successful in expanding into the UK food industry up till now but it still has ambitions in this area and the findings in the revocation action simply reflects this lack of success, not a lack of ambition;
- d) STL was aware of MYA's intentions with regard to the UK but believed that such use in the UK would cause confusion, or harm STL's reputation in its mark such that it would amount to passing off. STL also points out that, at the point of its filing the mark in suit, MYA had no legal protection in the UK and had not traded in the UK;
- e) The refiling was in relation to a reduced specification and reflected its genuine and reasonable commercial intention.

27) STL therefore contends that the application was not made solely to use its registration to stop legitimate third party use of the name MASTERCHEF, but was intended to provide protection for the direction of growth of its business and to stop the illegitimate and damaging use by MYA.

28) In earlier submissions MYA had contended that exhibits 47,48 & 49 were dated 2012, 2013 and 2015 respectively and were “outside an acceptable timeframe to evidence an intention to use the MASTERCHEF brand for foodstuffs within the UK”. MYA contends that exhibits 50, 51 & 52



refer to use of an “M” logo only not the sign registered and that exhibit 50 refers only to “ready meals” which MYA claims is not clear in meaning. It points out that none of these plans appears to have borne fruit.

29) At the hearing reference was made to a case before the Second Board of Appeal in EUIPO, R 1849/2017-2, concerning the EU trade mark registration MONOPOLY (the "**Monopoly Case**") which had not been mentioned in skeleton arguments but which the opponent felt was relevant. I gave both sides an opportunity to provide additional written submissions regarding the case in the week following the hearing.

30) MYA set out the background of the case thus:

*“The Board's Decision in the Monopoly Case*

2.4 The Board of Appeal stated that, at the time of Hasbro’s EU trade mark application in August 2010, Hasbro had on three previous occasions already filed and successfully registered MONOPOLY as an EU trade mark. It was therefore possible to assert that Hasbro had a dishonest intention at the time of filing the contested EU trade mark. In protecting the same mark over a period of fourteen years the EU trade mark proprietor improperly and fraudulently extended the five-year grace period indefinitely to evade the legal obligation of proving genuine use and the corresponding sanctions (para. 82 of the decision).

2.5 The Second Board of Appeal also took note of the fact that the contested EU trade mark covered a wider range of goods and services in relation to the earlier registrations. In this regard, the Board recognised and accepted that applying for a large variety of goods and services is a common and acceptable business practice. Nonetheless, the Board also noted that it is not acceptable to circumvent the use-requirement by simply disguising a re-filed EU trade mark through merely adding additional goods or services (para. 66 of the decision).

2.6 The Board of Appeal also referred to the criteria established by the Court of Justice in the *Lindt* case and confirmed that consideration must also be taken of the applicant’s intention when filing the EU trade mark. In determining this intention, the Board placed weight on a witness statement where the proprietor mentioned that “it was not unusual for companies to file further applications for trade marks already the subject of existing EU registrations and include in those new applications goods or services included in the earlier trade mark filings” (para. 77 of the decision).

2.7 On this point, the Board established that the simple fact that other companies may be using a specific filing strategy does not make that strategy legal and acceptable, especially if the lawfulness of such a practice has not been tested and approved before the Courts. Thus, when such strategy is used with the intention of circumventing the obligation to prove genuine use of the mark, it is not a legitimate business activity or follows commercial logic. On the contrary, is incompatible with the objectives pursued by the EUTMR and may be considered as an 'abuse of law' (para. 78 of the decision).

2.8 Consequently, the Board declared Hasbro's MONOPOLY mark invalid in relation to all goods and services which the Board considered identical or similar to those covered by the earlier trade marks. It allowed the mark to remain on the register for the goods and services not covered by the earlier marks."

31) MYA then contended:

"3.2 We would like to refer the Hearing Officer particularly to para. 78 of the Monopoly Case. During the Hearing, we discussed the perhaps prevalent practice of re-filing a trade mark that is subject to a revocation action. The Board made, however, very clear in its decision that a commonly used strategy does not make the same legal and acceptable. The Board then went on to say that in cases where "*such strategy is used with the intention of circumventing the obligation to prove genuine use of the mark, it is not a legitimate business activity or follows commercial logic. On the contrary, is incompatible with the objectives pursued by the EUTMR and may be considered as an 'abuse of law'*".

3.3 We submit that this goes to the heart of Party B's invalidity case. It is clear from the evidence and the circumstances of the case that Party A's sole intention in re-filing the MASTERCHEF trade mark in classes 29 and 30 was to pre-empt a likely scenario in which the contested registration was revoked for non-use. In other words, the re-filing of the Party A Mark (which is subject to Party B's invalidity application) was used with the intention of circumventing the obligation to prove genuine use of the mark in classes 29 and 30.

3.4 In line with the CJEU decision in *Lindt* and *Sky v SkyKick*, Party A's conduct was, in the absence of any legitimate reasons for the re-filing of the mark, incompatible with the main functions of a trade mark and the principles laid down in the Trade Marks Act and the EU Trade Mark Regulation. It therefore amounts to bad faith.

3.5 Finally, on the point that the refiled application for MASTERCHEF consisted of a slightly amended specification of goods in classes 29 and 30, we submit that this is irrelevant and does not change a finding of bad faith. As the Second Board of Appeal pointed out in the Monopoly Case, the refiled trade mark can still be declared invalid insofar there is an overlap with Hasbro's earlier registrations. This is the case in the Consolidated Proceedings where the goods included in the registration which was subject to the revocation action were identical or at least highly similar to the goods of Party A's Mark.”

32) In reply STL claimed:

“4. First, the facts of the Monopoly Case are very different from the facts here.

(a) In the Monopoly Case, Hasbro admitted that the contested EUTM registration was filed with the express (albeit not sole) intention of avoiding the requirement to prove use of its mark for its core goods and thus to make enforcement of its EUTM easier and less costly (see [75]).

(b) Hasbro maintained, however, that such a strategy was not in bad faith because: (a) it had plainly used its EUTM and so was not seeking to improperly avoid having to prove use, but rather to obtain a legitimate administrative advantage (e.g. consolidating multiple marks) (see [72]); and, (b) it was accepted industry practice when filing marks to cover new goods and services to also include a company's core area of interest, even if it was already protected by an earlier registration (see [77]).

(c) The Board of Appeal disagreed and found that an application for those reasons was in bad faith as the result was improperly and fraudulently to extend the five-year grace period indefinitely and to circumvent the legal obligation to prove use (see [82]).

(d) Thus, the Monopoly Case concerned the legitimacy of repeat filings made with the intention of avoiding having to prove use, i.e. evergreening. In contrast, here Party A filed the Contested Registration not to obtain a fresh five-year grace period artificially (per [48] of the Monopoly Case), but rather because Party A was about to lose an old registration but still had a provable intention to use the re-filed trade mark in accordance with its essential function.

(e) Thus, the only point of relevance established by the Monopoly Case is the fact that “where the proprietor of an EU trade mark files a repeat application for the same trade mark in order to avoid the consequences entailed by total or partial revocation of earlier trade marks for reasons of non-use, that fact is something which may be taken into account in order to assess whether the proprietor acted in bad faith” (see [45]). But it is already well established that a tribunal must take into account all the factors relevant to a particular case in assessing whether an applicant acted in bad faith (see *Lindt v Hauswirth*, C-529/07, at [37]).

5. Second, the Monopoly Case is a decision of the Board of Appeal of the EUIPO. It does not, therefore, bind the UKIPO.

6. Third, Hasbro Inc has appealed the decision to the General Court under Case No. T-663/19.

7. Fourth and finally, the decision of the Board of Appeal in the Monopoly Case was delivered on 22 July 2019. Since then, the CJEU has handed down two judgments on the issue of bad faith: *Koton*, C-104/18P, on 12 September 2019; and *Sky v SkyKick*, C-371/18, on 29 January 2020. The CJEU will therefore have had sight of the decision in the Monopoly Case at the time they issued both *Koton* and *SkyKick*. Thus, the leading cases on the issue of bad faith remain *Koton* and *SkyKick* and the key principles to apply are the ones set out in those cases, as summarised in Party A’s Skeleton at paragraphs 55 to 56.”

33) In determining the issue I also look to the case of *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHR 1929 (Ch), Arnold J. held that a possible or contingent intention to use the mark in relation to the goods/services covered by the application would normally be sufficient to prevent a finding of bad faith on the grounds of no intention to use the mark. He stated:

“161. If the UK's requirement for a declaration of intention to use is compatible with the Directive, and the making by the applicant of a false declaration of intent to use can amount to bad faith, the next issue concerns the intention which the applicant must have in order to be able to declare in good faith that he intends to use the mark in relation to the goods or services specified in the application in the UK. Counsel for the Defendants submitted that a concrete present intention was required, whereas counsel for Red Bull submitted that a possible or contingent future intention was sufficient.

162. In *Knoll* Neuberger J. said that "whether a contemplated use, or a possible or conditional intention to use, can suffice must depend upon the circumstances". In that case, he found that the proprietor had had a definite intention to use the mark in relation to pharmaceutical preparations for the treatment of obesity and contemplated that it might use the mark in relation to other pharmaceutical products. In those circumstances he held that it was unarguable that the proprietor had acted in bad faith by making a false declaration that it intended to use the mark in relation to pharmaceutical preparations and dietetic substances. In *32Red* the Court of Appeal appears to have accepted that a possible future use of the mark in relation to the services applied for was enough to defeat an allegation of bad faith on the ground of lack of intention to use in the circumstances of that case, albeit without any detailed consideration of the law.

163. Neuberger J's statement in *Knoll* appears to me to be not only correct in principle, but also supported by the subsequent jurisprudence of the CJEU in *Lindt v Hauswirth* and *Internetportal v Schlicht*. I therefore conclude that a possible or contingent intention to use the mark at some future date may suffice. Whether it does suffice will depend on all the circumstances of the case, and in particular whether there are other factors present of the kind mentioned in paragraph 139 above". [i.e. whether the application is an attempt to gain protection for an unregistrable mark or to block others from using the mark]

34) I look to *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12, where the CJEU held that merely knowing that a trade mark was in use by another in another jurisdiction did not amount to bad faith under Article 4(4)(g) of the Directive (s.3(6) of the Act). The court found that:

"2. Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that, in order to permit the conclusion that the person making the application for registration of a trade mark is acting in bad faith within the meaning of that provision, it is necessary to take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration. The fact that the person making that application knows or should know that a third party is using a mark abroad at the time of filing his application which is liable to be confused with the mark whose registration has been applied for is not sufficient, in itself, to permit the conclusion that the person making that application is acting in bad faith within the meaning of that provision.

3. Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that it does not allow Member States to introduce a system of specific protection of foreign marks which differs from the system established by that provision and which is based on the fact that the person making the application for registration of a mark knew or should have known of a foreign mark.”

35) Whilst in *Daawat Trade Mark* [2003] RPC 11, Mr Geoffrey Hobbs QC, as the Appointed Person, upheld a decision to invalidate a registration under s.47 and s.3(6) of the Act. He did so on the basis that it had been established that the application for registration was:

- made in the knowledge of the applicant’s trade in identical goods under an identical mark in other markets, and
- motivated by a desire to pre-empt the applicant’s entry into the UK market in order to secure a commercial advantage in negotiations with the trade mark holder.

36) By contrast, in *Wright v Dell Enterprises Inc.* (HOGS AND HEFFERS), BL O/580/16, Professor Ruth Annand, as the Appointed Person, upheld the registrar’s decision to reject an opposition on the ground that the applicant had copied a trade mark with a reputation the USA (but not in the UK) and applied to register it in relation to the same services. Professor Annand ruled that, given the territorial nature of IP rights, the mere appropriation of a name registered/used abroad was not enough under UK law: there must be something else involved before this can justify a finding of bad faith.

37) In the instant case MYA has not provided any evidence that it uses a mark MASTERCHEF (or derivative of such a mark) on goods or services in any market. Whilst STL accepted that it knew of MYA’s interest in using the mark, hence the revocation action, such interest does not appear to be based upon any existing trade in such a mark. The only party in the instant case with a reputation in the word MASTERCHEF is STL. The evidence filed by STL shows that it has had for some considerable time an intention or wish to use its brand upon foodstuffs as it is a logical extension of its reputation in television programmes about cookery. MYA criticised some of STL’s evidence, but in particular exhibits 47-52 which were provided by STL to show it had made efforts to enter into the foodstuffs market. In my opinion, given that STL’s application was filed on 2 November 2017 I do not accept that a presentation given to a potential partner in 2015 (exhibit 49) is “outside an acceptable timeframe”. To my mind, the exhibits show that, over a number of years, STL had an intention to use its mark on foodstuffs and thereby exploit its brand whilst it still had currency. It

partly succeeded, on edible oils, gravies and stock but other ventures have yet to come to fruition. However, this lack of success does not equate to a lack of intention to use. In my opinion, STL was clearly aware that the revocation action brought by MYA would, for the most part, succeed as it had not managed to actually get its mark into the marketplace. However, it still had the intention of cashing in on its reputation by finding a partner to push a line of ready meals and /or food boxes. It also, understandably, wished to protect its reputation by ensuring that others did not use marks similar to its own for foodstuffs over which it had no quality control in case issues arose with the products which would sully its reputation for television programmes regarding cookery.

38) I find that STL did not apply for its application in bad faith as it clearly had the intention of using its mark upon the goods for which it sought registration. **The invalidity under section 3(6) therefore fails.**

39) I now turn to consider the opposition filed by STL in respect of the application made by MYA. The first ground of opposition is under section 5(2)(b) which reads:

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

(a) .....

(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.”

40) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

41) STL is relying upon its trade marks listed in paragraph 6 above which are clearly earlier trade marks. My finding under the invalidity action above means that STL can rely upon its mark UK 3267851. MYA's application was published on 27 July 2018 and so any of STL's marks registered five years prior (27 July 2013 or before) to this are subject to Proof of Use. The only mark which falls within this period is mark UK 2596545 which was recently the subject of a revocation action where its specification was reduced to "Edible oils, gravy and stock" in class 29. STL has filed the same evidence of use as that provided to the Registry during the revocation action and it was accepted at the hearing that STL had shown proof of use upon these goods.

42) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;



(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **The average consumer and the nature of the purchasing decision**

43) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of

that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

44) The goods in the instant case cover, inter alia, food and beverages. To my mind, the average consumer for these goods would be the general public, including businesses. Such goods would be sold in a wide variety of ways such as retail outlets, the internet and brochures. However, it is likely that the initial selection will be a visual one as it is most likely to be viewed in store, on-line or via advertising, although I must also take into account word of mouth recommendations, and discussions with shop staff. Therefore, whilst I consider the visual aspect as being the most important in selection, aural considerations also apply. The prices of the goods will vary enormously as will the level of attention which the average consumer will pay to the selection. This is particularly so given the level of allergies that seem to abound these days. **To my mind, it will range from a low to medium degree of attention.**

### **Comparison of goods**

45) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

46) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

47) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

48) Clearly, the opponent’s strongest case is under its mark UK 3267851. I shall there compare its specification to the mark in suit. The goods of the two parties are as follows:

MYA’s specification	STL’s specification
<p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products;</p> <p>vegetable extracts; prepared meals; semi prepared meals; meat jus; broths; broth concentrates; soups, preparations for making soups and potato crisps; desserts made wholly or principally of dairy products; fruit desserts; meat products containing sauces.</p>	<p>Class 29: Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products;</p> <p>Edible oils and fats.</p>

<p>Class 30: Coffee, tea, cocoa, artificial coffee; rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, ices; sugar, honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice;</p> <p>risotto, couscous,; pasta, chutneys; sandwiches; prepared meals; semi prepared meals; pizzas, pies and pasta dishes; puddings [desserts]; frozen desserts; non-dairy frozen dessert products; preparations for making desserts; ice cream desserts; prepared desserts [pastries]; mixes for making bakery products; mixes for making breakfast foods; mixes for making cakes; mixes for making puddings; mixes for preparing sauces; mixes for the preparation of bread; sauce mixes; seasoning mixes; garden herbs, preserved [seasonings]; spice mixes; dried herbs; preparations for making sauces.</p>	<p>Class 30: Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastries and confectionery; Edible ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces [condiments]; Spices; Ice.</p>
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49) Clearly, both the class 29 and 30 specifications have identical wording within them. I have isolated these are the beginnings of each specification for ease of reference. I will now turn to deal with the remainder of the applicant's class 29 goods.

MYA goods	STL goods	Result
vegetable extracts;	Preserved, frozen, dried and cooked vegetables;	Identical
meat jus;	Meat extracts	Identical
desserts made wholly or principally of dairy products;	Milk and milk products;	Identical

fruit desserts	Preserved, frozen, dried and cooked fruits	Identical
meat products containing sauces	Meat, Meat extracts	identical
preparations for making potato crisps.	Preserved, frozen, dried and cooked vegetables	identical
preparations for making soups	Meat extracts; Preserved, frozen, dried and cooked vegetables;	Highly similar
broths; broth concentrates; soups,	Meat extracts; Preserved, frozen, dried and cooked vegetables;	Highly similar
prepared meals; semi prepared meals;	Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables;	Highly similar

50) I next turn to the class 30 goods applied for by MYA which are not identically worded to those of STL.

risotto, couscous, pasta,	Rice; Tapioca and sago;	Highly similar
chutneys; spice mixes; dried herbs; garden herbs,	Salt; Mustard; Vinegar, sauces [condiments]; Spices;	Highly similar
puddings [desserts]; frozen desserts; non-dairy frozen dessert products; preparations for making desserts; ice cream desserts; prepared desserts [pastries]; mixes for making puddings;	Bread, pastries and confectionery; preparations made from cereals; Edible ices	Highly similar
mixes for making bakery products; mixes for making cakes; mixes for the preparation of bread;	Bread, pastries and confectionery; preparations made from cereals;	Highly similar
prepared meals; semi prepared meals; pizzas, pies and pasta dishes;	Rice; Tapioca and sago; Bread, pastries and confectionery; preparations made from cereals;	Highly similar
sandwiches;	Bread, pastries and confectionery	Highly similar
mixes for making breakfast foods;	preparations made from cereals;	Highly similar
preparations for making sauces. mixes for preparing sauces;	sauces [condiments];	Highly similar

## Comparison of trade marks

51) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

52) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

MYA's mark	STL's marks
	MASTERCHEF

53) In its skeleton MYA contended:

- a) The conflicting signs are no more than weakly similar: Notwithstanding the fact that the word MASTER CHEF is contained within the Party B Mark, the sign which is subject of the Party B Mark also contains a prominent device element which somewhat distracts from the word. The word element is also written in two words across two lines.

b) We submit that the word MASTERCHEF is, if at all, only weakly distinctive in relation to goods in class 29. The meaning of the term in the English language is "principal cook" which carries a descriptive connotation and is therefore non-distinctive.

54) Whilst at the hearing it expanded upon this, mentioning the colour difference, the size of the device element approximately 50% of the mark, the fact that the words MASTER and CHEF are written on two lines with the latter being in a significantly larger font than the former. Mr Traub accepted that there was a degree of similarity between the marks.

55) For STL Ms Blythe commented:

“Party B's mark, the Master Chef logo, is obviously a composite mark, but the only verbal element within that mark is the word or the words "Master Chef". Then you have the graphic images of the cutlery and black stylisation. We say that the word "Master Chef" being the only verbal element of that mark is, plainly, the distinctive element of the mark. On the *Wassen International Ltd v OHIM* case, it is by that name that the average consumer will refer to the goods. That is how they would ask for them in a supermarket and that is how they would refer to them when making a recommendation to a friend. We say that the word MASTERCHEF is, plainly, the distinctive element. We also say it is the dominant element of that mark. It is in prime position. Of course, we are not saying that the consumer would ignore the knife and fork but we say they would pay more attention to and see more clearly the name MASTERCHEF. That contrasts with the cutlery stylisation. Yes, it is visually noticeable. As I said, we do not ask you to disregard it but, in my submission, it has a very low distinctiveness. You eat food with a knife and fork. It would not be seen as a particularly eye-catching or memorable element of the mark. Overall, we say, therefore, that the comparison between the marks leads to a finding that there is a very high level of similarity. We say that aurally they are identical. They both are referred to as "MASTERCHEF". Conceptually, therefore, we say that they are also identical because the concept comes from the word MASTERCHEF. Visually, we say that there is substantial similarity. Obviously, they are not identical but we say they are still highly similar because of the identity of the word mark. We accept that there are visual elements that are not present in the word mark, but of course the word mark could be used in a variety of different styles.”

56) Later she also reminded me that under *F1* case principles the mark has distinctiveness, although she contended that STL's mark was of average distinctiveness. MYA's mark clearly has a very large device element at the top, however, a device element showing a fork, spoon and knife

is not particularly distinctive when used on products in classes 29 & 30 which are often consumed with such implements. The words MASTER and CHEF clearly allude to the suggested quality of the product, implying that the selection and / or production was overseen or approved by a culinary expert. Whilst the device element cannot be dismissed or overlooked it is independent of the words. It is clear that the distinctive and dominant element of the mark are the words MASTER and CHEF as this is the way that the mark will be articulated and remembered. If the mark is searched for on the internet, asked for in a shop, or recommended to a friend it will be under these words. Visually it is similar to an average degree to STL's mark, whilst aurally and conceptually they are effectively identical. **Overall, the marks are highly similar.**

### **Distinctive character of the earlier trade mark**

57) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

58) STL's mark consists of two well-known words albeit they are combined. They will be seen as referring to a culinary expert capable of taking normal ingredients and transforming them into an edible delight outside the abilities of normal cooks. When used on goods in classes 29 and 30 they suggest that such an individual has been involved in the selection/ manufacturing process and that



the product is of a superior quality. However, it is not directly descriptive of the goods but merely allusive and so it has an average degree of distinctiveness. The mark cannot benefit from enhanced distinctiveness as the opponent has not provided evidence of use on the identical or similar goods.

### **Likelihood of confusion**

59) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of STL's trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods is a member of the general public, including businesses, who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay a varying degree (ranging from low to medium) of attention to the selection of such goods.
- the marks of the two parties are highly similar (albeit visually it is similar to an average degree).
- STL's mark has an average level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- I found that the following goods applied for by MYA were identical to those of STL;

In Class 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; vegetable extracts; meat jus; desserts made wholly or principally of dairy products; fruit desserts; meat products containing sauces; preparations for making potato crisps.

In Class 30: Coffee, tea, cocoa, artificial coffee; rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, ices; sugar, honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

- I found that the following goods applied for by MYA were highly similar to those of STL;

In Class 29: Preparations for making soups; broths; broth concentrates; soups, prepared meals; semi prepared meals.

In Class 30: Risotto, couscous; pasta, chutneys; sandwiches; prepared meals; semi prepared meals; pizzas, pies and pasta dishes; puddings [desserts]; frozen desserts; non-dairy frozen dessert products; preparations for making desserts; ice cream desserts; prepared desserts [pastries]; mixes for making bakery products; mixes for making breakfast foods; mixes for making cakes; mixes for making puddings; mixes for preparing sauces; mixes for the preparation of bread; sauce mixes; seasoning mixes; garden herbs, preserved [seasonings]; spice mixes; dried herbs; preparations for making sauces.

60) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of

the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

61) I also consider the issue of indirect confusion, and take into account the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

62) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

63) In view of all of the above and allowing for the concept of imperfect recollection there is a likelihood of consumers being directly confused into believing that the goods (identified as identical or highly similar earlier in this decision) in MYA’s application are those of STL or provided by some undertaking linked to it. **The ground of opposition under section 5(2)(b) succeeds in respect of all the goods applied for in classes 29 & 30.**

64) I next turn to the ground of opposition under section 5(4)(a) which reads:

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

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

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

65) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

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

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

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

66) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

67) First, I must determine the date at which STL’s claim is to be assessed; this is known as the material date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

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

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

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the

opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

68) The mark in suit was applied for on 12 July 2018, and is, therefore, the material date. However, if MYA had used its trade mark prior to this then this use must also be taken into account. It could, for example, establish that MYA is the senior user, or that the status quo should not be disturbed; any of which could mean that MYA's use would not be liable to be prevented by the law of passing-off – the comments in *Croom's Trade Mark Application [2005] RPC 2 and Daimlerchrysler AG v Javid Alavi (T/A Merc) [2001] RPC 42* refer. As MYA has not provided any evidence of use of its mark then the date of application falls to be the material date. For the purposes of this ground of invalidity **the material date must be 12 July 2018.**

## Goodwill

69) I now turn to consider the evidence filed by STL to determine when it began use of its mark and upon which goods and services. In determining this I take into account of the guidance in the case of *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership) [2002] RPC 19 (HC)*, Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

70) However, in *Minimax GmbH & Co KG v Chubb Fire Limited [2008] EWHC 1960 (Pat)* Floyd J. (as he then was) stated that:



“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

71) From the evidence filed by STL it is clear that they have had goodwill in television broadcasting of cookery programmes since 1990. Given that these television programmes are broadcast on the BBC as well as other television stations in the UK **I conclude that STL has shown it has goodwill in the mark MASTERCHEF in respect of cookery television programmes shown in the UK.** At the hearing Mr Traub accepted that STL had goodwill and reputation in such television programmes.

### **Misrepresentation**

72) As part of the test under this ground of opposition I must take into account the distinctiveness of the sign being relied upon. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated 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.”

73) In the instant case I regard the mark relied upon MASTERCHEF as being distinctive for the services for which it has goodwill. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own

idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

74) In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

75) When considering misrepresentation it is the plaintiff’s customers or potential customers that must be deceived. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff’s customers or potential customers had been deceived for there to be a real effect on the plaintiff’s trade or goodwill.”

76) The customers of the plaintiff (STL) are the general public. The marks both consist of the words “MASTER CHEF” and whilst STL has a reputation in respect of cookery television programmes the mark in suit has been applied for in relation to goods in classes 29 and 30. However, it is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade (*Harrods Ltd v Harrodian School Ltd* [1996] RPC 697). I must therefore consider whether, despite the goods and services being dissimilar, there would be deception amongst a significant number of STL’s clients. To my mind, use of MYA’s mark upon food and drink goods in classes 29 & 30 would cause a misrepresentation to the viewers of STL’s television programmes. Such people would see the provision of food and drink under the same name of the well-known television programme to be a perfectly natural extension of STL’s business.

## Damage

77) In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

78) In a *quia timet* action it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* 56 RPC 429 Goddard L.J. stated:

“But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man's business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage.”

79) Consequently, in the instant case if STL has established a goodwill and shown deception/misrepresentation then damage can be considered as the automatic sequitur and the

three elements of the classic trinity of passing-off will have been established. **In the instant case the ground of opposition under section 5(4)(a) is successful in respect of all the goods applied for by MYA.**

80) Given this finding I do not need to consider the ground under section 5(3), although given my previous findings I have no doubt that this ground of opposition would also have been successful.

81) Lastly, MYA contended that:

“Finally, even in the event that the Hearing Officer was to find that Party A had successfully established one or more grounds for opposition, we submit that Party A should be estopped from succeeding under the opposition in light of its bad faith conduct as further explained in para. 4.15 [*of the skeleton*] above.”

82) Given that earlier on in this decision I found that STL did not act in bad faith I do not see how they are estopped. I reject this contention.

## CONCLUSION

83) The ground of invalidity under section 3(6) was unsuccessful. **The grounds of opposition under sections 5(2)(b) and 5(4)(a) succeed in respect of all the goods applied for in classes 29 & 30.**

## COSTS

84) As STL has been successful in both defending its mark against the invalidity attack and in its opposition to the mark in suit it is entitled to a contribution towards its costs. I note that the opponent was professionally represented.

Preparing a statement and considering the other side's statement x 2	£400
Expenses	£200
Filing of evidence and considering the other sides evidence	£800
Attendance at Hearing	£1200
TOTAL	£2,600

85) I order Mana Y. A. Limited to pay Shine TV Limited the sum of £2,600. This sum to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17<sup>th</sup> day of March 2020**

**G W Salthouse  
For the Registrar  
the Comptroller-General**