

O/672/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003449536

BY CHRISTINA WHITE

TO REGISTER THE TRADE MARK:

Miss WorldClass

IN CLASS 41

AND

OPPOSITION THERETO NO. 419458

BY MISS WORLD LIMITED

BACKGROUND AND PLEADINGS

1. On 5 December 2019, Christina White (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 13 December 2019 and registration is sought for the following services:

Class 41 Entertainment; Entertainment by means of concerts; Entertainment by means of roadshows; Entertainment by means of television; Entertainment by means of theatre productions; Entertainment in the nature of beauty pageants; Entertainment in the nature of dance performances; Entertainment in the nature of fashion shows; Entertainment in the nature of live dance performances; Entertainment in the nature of live performances and personal appearances by a costumed character; Entertainment in the nature of live performances by musical bands; Entertainment in the nature of theater productions; Entertainment provided by cable television; Entertainment services; Entertainment services by stage production and cabaret; Beauty contests (Arranging of -); Beauty contests (Conducting of -); Beauty contests (Organising of -); Beauty pageants (Conducting of -); Beauty pageants (Organising of -).

2. On 13 February 2020, Miss World Limited (“the opponent”) opposed the application based upon sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3), the opponent relies on the following trade marks:

MISS WORLD

UKTM no. 1278551

Filing date 1 October 1986; registration date 13 August 1993

Relying on some services for which the mark is registered, namely:

Class 41 Services for the organisation of contests, beauty pageant services; all included in Class 41.

(“the First Earlier Mark”)

MISS WORLD

EUTM no. 151282

Filing date 1 April 1996; registration date 21 January 1999

Relying on some services for which the mark is registered, namely:

Class 41 Entertainment services; organisation [...] running of beauty contests; beauty contests.

(“the Second Earlier Mark”)

3. Under section 5(2)(b), the opponent claims that the parties' marks are similar and that the services are identical or similar, meaning that there will be a likelihood of confusion.

4. Under section 5(3), the opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

5. Under section 5(4)(a), the opponent relies upon the sign **MISS WORLD** which it claims in its Form TM7 to have used throughout the UK since 1994 (although I note that in the opponent's evidence it claims use from as early as 1951) in relation to “beauty contest services”, “entertainment in the nature of beauty contests”, “services and events ancillary to contests, such as physical, health and fitness services and events, dance services and events, talent services and events, charity and charitable services”.

6. Under section 3(6), the opponent claims that, given its reputation, it is inconceivable that the applicant was not fully aware of the earlier marks, of the opponent, and the opponent's success in the UK. The opponent claims that it is for this reason that the applicant has filed the application; attempting to register a mark which is close to that of the opponent in order to wrongfully compete. The opponent claims that the application was filed in bad faith.

7. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

8. Both parties filed evidence in chief. The opponent filed evidence in reply. A hearing took place before me on **5 July 2021**, by video conference. The opponent was represented by Sam Carter of Counsel, instructed by Bear + Wolf (UK) LLP. The applicant has represented herself throughout these proceedings and was self-represented at the hearing.

EVIDENCE AND SUBMISSIONS

9. The opponent filed evidence in chief in the form of the witness statement of Stephen Douglas Morley dated 4 December 2020, accompanied by 81 exhibits. Mr Morley is the Events Director for the opponent.

10. The applicant filed a witness statement dated 9 February 2021, which is accompanied by 19 exhibits.

11. The opponent filed evidence in reply in the form of the second witness statement of Mr Morley, accompanied by 31 exhibits.

12. The opponent's evidence in reply was accompanied by written submissions dated 26 April 2021.

13. Whilst I do not propose to summarise the evidence and submissions here, I have taken them into account and will refer to them below where necessary.

DECISION

Section 5(2)(b)

14. Section 5(2)(b) of the Act reads as follows:

“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.”

15. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had completed their registration process more than 5 years prior to the application date for the applicant’s mark, they are subject to proof of use pursuant to section 6A of the Act.

16. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Proof of Use

17. I will begin by assessing whether there has been genuine use of the earlier marks. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A(1) This section applies where

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

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

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

(5A) [...]

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

18. Section 100 of the Act is also relevant, which reads:

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

19. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the date of the application in issue i.e. 6 December 2014 to 5 December 2019.

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*

[EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an

outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21. As the Second Earlier Mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining

genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

At paragraphs 57 and 58, the court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

22. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. At the relevant date, the UK was a member of the European Union and, consequently, use in the UK will be relevant to the question of whether there has been use in the EU. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them; and
- e. The geographical extent of the use shown.

23. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

24. Mr Morley gives evidence that the MISS WORLD contest was started in the UK in 1951. The contest has run each year since that date. Mr Morley states that the opponent has always had offices in London. Mr Morley explains that each year the opponent grants licenses to various national licensees (such as MISS ENGLAND, MISS WALES etc.). Thousands of contestants enter these national competitions each year and compete across various categories (such as contribution to charity, talent, modelling etc.). The winner of each national heat then goes on to compete in the global final for the title of MISS WORLD for that year, the final being held between October and December each year.

25. I note documents show some of the national heats as being “Miss World Spain 2019”, “Miss World Germany 2018”, “Miss World Portugal 2019” and “Miss World Poland 2015”.¹ Mr Morley confirms that the UK national contests have been running on a yearly basis since 1954 (MISS ENGLAND), 1961 (MISS SCOTLAND), 1961 (MISS WALES) and 1980 (MISS NORTHERN IRELAND) respectively. Up until 2000, the opponent ran these national contests itself, but started operating these via licenses after that date. A sample license from 2008 has been provided and I note that Mr Morley gives evidence that the same terms applied from 2000 onwards (and so I will proceed on the basis that the same terms applied during the relevant period).² The license includes the following terms:

“9.1. The Licensee shall not use the Intellectual Property Rights except as permitted under this agreement.

9.2 The Licensee acknowledges and agrees that Miss World Limited is the exclusive owner of the Commercial Rights and the Intellectual Property Rights

¹ Exhibit SDM4

² Exhibit SDM10

and that all rights in the Mark and/or Logo and all rights in the Miss World Products shall at all times vest in and belong to Miss World Limited. The Licensee shall not, by virtue of this agreement, obtain any right title or to the Intellectual Property Rights.

[...]

9.4 the Licensee acknowledges and agrees that the benefit of any and all use of the Mark and the logo by the Licensee shall at all times vest in and inure to the benefit of Miss World Limited.

[...]

9.8. The Licensee may:

- i. Use the Mark and the Logo in the National Area and in connection with the National Contest only in the form stipulated from time to time by Miss World Limited and only as is necessary to comply with the Licensee's obligations under this agreement to publicise the National Contest.
- ii. Subject to Miss World's prior written consent which may be withheld at its absolute discretion, use the Mark in the title for the National Contest in the National Area only."

26. The term "Intellectual Property Rights" is defined as:

"Intellectual Property Rights" means any and all intellectual property rights throughout the world subsisting in the Miss World Contest, the Mark, the Logo, the Continental Queen of Beauty title and any other intellectual property rights owned by Miss World Limited, including without limitation any patent, petty patent, copyright or related rights (including moral rights), database rights, registered design or other design right, utility model, trade mark (whether registered or not and including any rights in get up or trade dress), brand name,

service mark, trade name, business name (whether registered or not), Internet domain name, format rights and any other rights in respect of any other intellectual property, whether registered or not and including all renewals, extensions and revivals and all rights to apply for any of the foregoing rights.”

27. The term “the Mark” is defined as:

“Mark’ means the MISS WORLD mark, including all trade mark applications and registrations for that mark and any similar rights as may exist anywhere in the world, whether registered or unregistered and which belong to Miss World Limited.”

28. The applicant submits that the opponent cannot rely upon use by third parties, even if those third parties are licensees. However, as Mr Carter noted at the hearing, it is well established that a proprietor of a trade mark can rely upon use of its mark by its licensees.³ Consequently, I am satisfied that the opponent can rely upon any use of the earlier marks made by the national licensees.

29. I note that not all references to the national contests refer to the marks relied upon by the opponent. However, I note the following:

- a. A print out from the MISS WALES website dated 20 March 2018 which states “Miss Wales represents Wales at Miss World annually”.⁴
- b. A photograph shows the winner of MISS NORTHERN IRELAND 2017 standing in front of a screen which displays the words “Miss World Northern Ireland 2017”.⁵
- c. An extract from a brochure which Mr Morley dates as 2018 and confirms was distributed in the UK is entitled “My Year as Miss England” and begins “four

³ *Einstein Trade Mark*, [2007] RPC 23

⁴ Exhibit SDM12

⁵ Exhibit SDM12

years ago I started a journey with aspirations of one day walking the Miss World stage representing my country”.⁶

- d. An extract from a brochure which Mr Morley dated as being circulated in the UK prior to July 2019 displays both the words MISS ENGLAND and MISS WORLD.⁷
- e. A ticket from the 2018 MISS ENGLAND final also displays the words MISS WORLD 2018.⁸

30. Mr Morley explains that the finals for the 2015, 2016, 2017 and 2018 Miss World competitions were held abroad. However, the national competitions for those events still ran in the UK.

31. The opponent has elected not to provide certain pieces of information as it did not want the information to be available to the applicant. For example, Mr Morley states that the opponent has decided not to disclose the amount that has been earned by the opponent through license fees. However, Mr Morley does confirm that the amount received for the UK national licensees alone (four licensees, each year, for five years) has been over one hundred thousand pounds. Mr Morley states that the opponent’s fees to licensees abroad is much higher and total well over a million pounds each year.

32. Mr Morley notes that the opponent also receives licence fees charged to television, online and other broadcasters wishing to broadcast the MISS WORLD final, as well as the national and UK national heats. However, Mr Morley has declined to provide the amounts received, or even, to provide approximate figures.

33. I note that the opponent has operated its website – missworld.com – since the mid-1990s.⁹ The opponent also owns a .co.uk domain name, which automatically redirects to the .com website. Mr Morley states that the opponent’s websites receive hundreds

⁶ Exhibit SDM13

⁷ Exhibit SDM14

⁸ Exhibit SDM15

⁹ Exhibit SDM3

of thousands of hits from UK users, and users abroad, each year. I note that the opponent also has social media accounts including Facebook, Instagram and Twitter. Mr Morely has enclosed an email from the operator of the opponent's voting platform which confirms that between 2015 and 2019 the UK national contests received 496,000 votes from UK fans through the opponent's voting platform.¹⁰ However, I note that these figures are not provided under a signed statement or accompanied by a statement of truth and no supporting documentation is provided as to how these figures were calculated.

34. Mr Morley has provided a Social Report for the years 2014 to 2019 which confirms that the MISS WORLD competition received 2 billion views on social channels during this period from UK viewers.¹¹ This includes 376million views of the opponent's MISS WORLD Facebook page, 587million of the opponent's voting platform and 698million visits to the opponent's MISS WORLD website.

35. Mr Morley confirms that the MISS WORLD finals were held in the UK in 2014 and 2019 (both on 14 December). Mr Morley has provided screenshots of two television promotions for the 2014 final, that went out on London Live.¹² The show itself was sold out (over 3,000 seats). The mark MISS WORLD was displayed on the ticket for the event and the brochure which was distributed to all attendees and the opponent's mailing list in advance of the show.¹³ It also appeared across the back of the stage, on signage and posters and the winner wore a sash displaying the mark.¹⁴ Mr Morley states that the final was broadcast on London Live and E Channel, and attracted "many thousands" of viewers in the UK. Mr Morley notes that, although the 2019 final took place after the relevant period, much of the publication for the event took place beforehand. The mark MISS WORLD appeared on promotional materials distributed prior to the event and on a television advert (for London Live) which was played several times a day in the weeks leading up to the final.¹⁵ Again, the event was sold out (over

¹⁰ Exhibit SDM35

¹¹ Exhibit SDM36

¹² Exhibit SDM44

¹³ Exhibits SDM47 and SDM48

¹⁴ Exhibits SDM49 and SDM50

¹⁵ Exhibits SDM62 and SDM63

3,000 seats). Mr Morley states that the final on London Live was watched by 117,000 viewers.

36. The marks are used in the evidence as registered. Clearly, this will be use upon which the opponent can rely. There are also examples of the marks being used in slightly stylised fonts or in different colours. In my view, this will be covered by notional and fair use of the word marks relied upon and is used of the marks as registered.¹⁶

37. Clearly, there are issues with the opponent's evidence. For example, some pages do not reference the mark relied upon at all. Further, the opponent has made a decision not to provide certain pieces of information (such as total revenue and advertising expenditure). However, based upon the information I do have before me, I am satisfied that the opponent has put the mark MISS WORLD to genuine use in the UK. Clearly, there has been a reasonable amount of promotional activity surrounding the 2014 and 2019 events (which took place in the UK) and these were viewed both by the 3,000 people that attended the shows and by those watching through the television channels referred to above. Although the 2015, 2016, 2017 and 2018 shows took place abroad, there was clearly still promotion of this in the UK through the national contests. Although not all of the evidence relating to the national contests mention the marks relied upon, a sufficient amount do, that I am satisfied that there is at least some use of the marks relied upon in conjunction with those events. The opponent's social media channels, which promote its activities under the mark MISS WORLD, have been viewed 2billion times by UK viewers. I note that in addition to the use in the UK there is some (albeit limited) evidence of use in other EU member states. Taking all of this into account, I am satisfied that the opponent has demonstrated proof of use of the earlier marks in the EU and UK during the relevant period.

38. I must now consider whether, or the extent to which, the evidence shows use of the earlier marks in relation to the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

¹⁶ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

40. The services for which the First Earlier Mark is registered and upon which the opponent relies are “Services for the organisation of contests, beauty pageant services; all included in Class 41”. As set out above, the contests organised by the opponent under the earlier marks are limited to beauty pageants. I accept that there is evidence of sporting rounds, charitable competitions etc. but these form part of the overarching beauty pageant being operated. Consequently, I consider a fair specification for the First Earlier Mark to be:

Class 41 Services for the organisation of beauty contests, beauty pageant services; all included in Class 41.

41. The services for which the Second Earlier Mark is registered and upon which the opponent relies include “organisation [...] running of beauty contests” and “beauty contests”. Clearly, the opponent can retain these terms. The opponent also relies upon the term “entertainment services”. However, as Mr Carter acknowledged at the hearing, this is a very broad term. It could cover anything from organisation of sporting events, to the operation of cinemas to the offering of theatre productions. Mr Carter submitted that the opponent’s use encompasses a broad range of activities such as talent show elements, dance elements, producing documentaries and films and charity work. Charity work does not, in my view, fall within the definition of entertainment. In any event, all of these elements are provided in the context of a beauty pageant; none of the opponent’s activities appear to me to be outside of that field. I consider that the

opponent has shown use only in relation to a discreet sub-category of these entertainment services and I do not consider that it should retain the broader term. Consequently, I consider a fair specification for the Second Earlier Mark to be:

Class 41 Organisation [...] running of beauty contests; beauty contests.

42. As a result of this finding, the opponent will only be able to rely upon these services for the purposes of the sections 5(2)(b) and 5(3) grounds.

Section 5(2)(b) – case law

43. The following principles 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 greater 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 to mind the earlier mark, 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.

Comparison of services

44. As a result of my findings above, the competing services are as follows:

Opponent's services	Applicant's services
<p data-bbox="193 250 796 291">First Earlier Mark</p> <p data-bbox="193 293 796 336"><u>Class 41</u></p> <p data-bbox="193 338 796 504">Services for the organisation of beauty contests, beauty pageant services; all included in Class 41.</p> <p data-bbox="193 571 796 611">Second Earlier Mark</p> <p data-bbox="193 613 796 656"><u>Class 41</u></p> <p data-bbox="193 658 796 779">Organisation [...] running of beauty contests; beauty contests.</p>	<p data-bbox="798 250 1398 291"><u>Class 41</u></p> <p data-bbox="798 293 1398 1668">Entertainment; Entertainment by means of concerts; Entertainment by means of roadshows; Entertainment by means of television; Entertainment by means of theatre productions; Entertainment in the nature of beauty pageants; Entertainment in the nature of dance performances; Entertainment in the nature of fashion shows; Entertainment in the nature of live dance performances; Entertainment in the nature of live performances and personal appearances by a costumed character; Entertainment in the nature of live performances by musical bands; Entertainment in the nature of theater productions; Entertainment provided by cable television; Entertainment services; Entertainment services by stage production and cabaret; Beauty contests (Arranging of -); Beauty contests (Conducting of -); Beauty contests (Organising of -); Beauty pageants (Conducting of -); Beauty pageants (Organising of -).</p>

45. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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 für 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.”

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

- (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. The applicant has submitted that the parties’ respective target markets are different. She notes that the ways in which they advertise differ and the services they actually provide differ, with the opponent targeting unmarried, childless ladies and the applicant targeting anyone of any relationship or parental status. At the hearing, the applicant explained that the opponent is “an elite pageant”, whereas she described her own venture as being “on the bottom rung”. However, this is not relevant to my

assessment. I must consider all of the ways in which the marks could be used within the scope of their specifications. For example, either party may choose to change their target market or the services they provide in the future. Consequently, these submissions do not assist the applicant.

48. The term “services for the organisation of beauty contests, beauty pageant services” in the specification of the First Earlier Mark and the terms “organisation [...] running of beauty contests” and “beauty contests” in the specification of the Second Earlier Mark fall within the broader categories of “entertainment” and “entertainment services” in the applicant’s specification. These services are, therefore, identical on the principle outlined in *Meric*

49. The same terms in the specifications of the First and Second Earlier Marks are self-evidently identical to the terms “entertainment in the nature of beauty pageants”, “beauty contests (Arranging of -)”, “beauty contests (Conducting of -)”, “beauty contests (Organising of -)”, “beauty pageants (Conducting of -)” and “beauty pageants (Organising of -)” in the applicant’s specification.

50. The remaining terms in the applicant’s specification are all types of entertainment services (other than beauty pageant services). They will all overlap in nature and method of use with the opponent’s services as they are all provided through the same mediums (stage or television). There is overlap in purpose as they are all intended to provide light entertainment to the viewer, albeit in different forms. There is overlap in user as all may be purchased by members of the general public. There may be some limited overlap in trade channels as tickets for such events may be purchased through the same retailers of entertainment performances. There may be a degree of competition as users may choose different types of entertainment shows to view. Taking all of this into consideration, I consider the services to be similar to at least a medium degree.

The average consumer and the nature of the purchasing act

51. 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 the services are likely to be selected by the average consumer. 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.”

52. The opponent submits that the average consumer will be a member of the general public, whereas the applicant claims that the average consumer is limited to those who compete in beauty pageants. I agree with the opponent. Whilst the competitors will also be average consumers, the general public that view the pageants on television or through live events will also be included. The price of the services are unlikely to be particularly high for the purchaser, although I recognise that they will not be at the lowest end of the scale and the price could vary. However, even where the price is relatively low, various factors will still be taken into consideration such as type of performance and ease of access. Taking all of this into account, I consider that a medium degree of attention will be paid during the purchasing process for the services.

53. The services are likely to be purchased following perusal of adverts on television, the internet or on billboards and the like. Where the average consumer will need to purchase tickets, they are likely to be purchased online or from a physical retailer, which will inevitably involve perusal of physical (or virtual) signage. Consequently, I consider that visual considerations will dominate the purchasing process. However, I recognise that aural considerations cannot be discounted given that word-of-mouth recommendations may be made.

Comparison of trade marks

54. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, 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.”

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

56. The respective trade marks are shown below:

Opponent’s trade marks	Applicant’s trade mark
<p style="text-align: center;">MISS WORLD (the First and Second Earlier Marks)</p>	<p style="text-align: center;">Miss WorldClass</p>

57. The First and Second Earlier Marks consist of the words MISS WORLD. There are no other elements to contribute to the overall impression which lies in the combination of these words. The applicant’s mark consists of the word “Miss” and conjoined words “WorldClass”. There are no other elements to contribute to the overall impression, which lies in the combination of these words.

58. Visually, the marks overlap to the extent that they both begin with the words MISS WORLD/Miss World. I recognise that the opponent's marks are presented in upper case, whilst the applicant's mark is presented in title case. However, as registration of a word only mark covers use in any standard typeface, these differences will be of no impact on my assessment. The point of visual difference is the addition of the word "Class" at the end of the applicant's mark which has no counterpart in the opponent's marks. Taking all of this into account, I consider the marks to be visually similar to a medium degree.

59. Aurally, the marks overlap to the extent that the words "MISS/Miss" and "WORLD/World" will be pronounced identically in both marks. The point of aural difference is the addition of the word "Class" at the end of the applicant's mark, which will be given its ordinary English pronunciation, but has no counterpart in the opponent's marks. Taking all of this into account, I consider the marks to be aurally similar to a medium degree.

60. Conceptually, the opponent submits that the marks are identical. In its written submissions, the opponent states:

"133. The Applicant dissects MISS and WORLD into its various components, stating that MISS means a young, unmarried or divorced female [...] and that world means a physical place.

134. None of that is relevant to the issue of whether the marks are similar. They are highly similar, if not identical."

61. I disagree. The marks will overlap to the extent that the use of the word MISS/Miss at the start will indicate a particular individual by that title. The word WORLD in the opponent's marks will convey its ordinary dictionary meaning i.e. the planet we live on.¹⁷ The conjoined words "WorldClass" in the applicant's mark will be recognised as separate dictionary words. There is some overlap created by the common presence

¹⁷ <https://www.collinsdictionary.com/dictionary/english/world>

of the word WORLD. However, when combined with the word CLASS this may convey the impression of a person who is among the best in the world.¹⁸ This does, in my view, create a point of conceptual difference between the marks. Taking all of this into account, I consider the marks to be conceptually similar to a medium degree.

Distinctive character of the earlier marks

62. 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-2779, 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).”

63. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

¹⁸ <https://www.collinsdictionary.com/dictionary/english/world-class>

of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

64. I will begin by assessing the inherent distinctiveness of the First and Second Earlier Marks. The applicant argues that the earlier mark is “completely generic”. At the hearing, the applicant explained that she had not meant to use any legal terminology when saying this, but rather was referring to a type of mark that she considered was used frequently in the pageant industry i.e. marital prefix plus physical place term. Of course, the validity of the earlier mark has not been challenged and must be attributed at least some degree of distinctiveness by virtue of its registration pursuant to section 72 of the Act. In any event, there is no evidence that the mark has become generic and, rather, my understanding is that the applicant uses the word ‘generic’ to suggest that this form of mark in the pageant industry is low in distinctiveness. In this regard, the applicant has filed evidence in the form of a list of other beauty pageants which use a similar format, such as Miss Planet International, Miss United Continents and Mrs. Universe.¹⁹ However, there are issues with this evidence. Importantly, I have no information about the jurisdiction in which these marks are used. This makes it very difficult to assess whether the UK or EU average consumer would be familiar with beauty pageants being called names based upon this format.

65. In my view, the words MISS WORLD are, in themselves, an unusual combination. I do not consider them to be descriptive. However, for beauty pageant services and beauty contests they are, in my view, allusive to a worldwide competition that involves unmarried women. Consequently, I consider the earlier marks to be inherently distinctive to between a low and medium degree.

66. I have set out a summary of the opponent’s evidence of use above in relation to the period 2014 to 2019. I also note that there is evidence of the 2018 Miss World winner being interviewed on *Good Morning Britain* on 2 July 2019.²⁰ There are also references to the earlier marks in publications such as:

¹⁹ Exhibit CGW1

²⁰ Exhibit SDM69.1

- a. An article in *The Scottish Sun* dated 2 July 2017 which states “The [MISS SCOTLAND] finalists hope to follow in the footsteps of 2016 winner Lucy Kerr, right, and go on to take part in Miss World”.²¹
- b. An article from *Wales Online* dated 9 April 2017 which states “This Cardiff University graduate has been crowned Miss Wales 2017”.²² It continues that she “will now go on to represent the country at Miss World”.

67. In addition to this I note the following from previous years:

- a. The list of contestants dates back to 1951;²³
- b. An advert for a dress designer described as “bespoke designer dress sponsor for Miss England in Miss World 2012”;²⁴
- c. An article from *The Daily Mail* dated 2 September 2010 discusses the winner of Miss England and notes that she will go on to compete at the Miss World contest for that year in China;²⁵
- d. The 1971 Miss World contest was held in the Royal Albert Hall, the 1999 Miss World contest was held in Olympia, London and the 2002 Miss World contest was held in Alexandra Palace;²⁶
- e. An article from *The Mail Online*, the date of which is unclear although the print date appears as 2013, confirms that 20.76million viewers watched the 1970 Miss World contest and 22.66million viewers watched the 1967 Miss World contest, both of which were shown on BBC1;²⁷

²¹ Exhibit SDM5

²² Exhibit SDM76

²³ Exhibit SDM3

²⁴ Exhibit SDM11

²⁵ Exhibit SDM11

²⁶ Exhibit SDM18

²⁷ Exhibit SDM19

- f. In 1998, *The Express On Sunday* and *The Mirror* both ran articles about Miss World;²⁸ and
- g. Programmes for the 1986 and 1988 Miss World contests are in evidence, which confirms they were held at the Royal Albert Hall.²⁹

68. As noted above, there are clearly issues with the opponent's evidence. It is certainly extensive. However, it is not targeted, with many pages not referring to the marks relied upon at all and a fair amount of duplication. As set out above, despite the opponent has elected not to provide certain information which would have assisted it in demonstrating enhanced distinctiveness. Nonetheless, I am required to assess the evidence as a whole. The opponent's use has clearly been long-standing, with contestant records dating back to 1951. The yearly contest has taken place in some high profile locations in the UK over the years, although I note that this has become less frequent in recent years. The contests for 1967 and 1970 attracted significant audiences. For more recent events, such as those in 2014 and 2019 (which took place in the UK), the shows have been attended by 3,000 people, as well as being available to view via television. As set out above, the opponent's social media channels have been viewed 2 billion times by UK viewers between 2014 and 2019. I note that the physical shows appear to be focused mainly in London, although the viewing of these events via television would expand the geographical reach to the rest of the UK. In reaching my decision, I bear in mind that no overall turnover or advertising expenditure figures have been provided. Taking all of this into account, I am satisfied that the distinctiveness of the earlier mark has been enhanced through use to between a medium and high degree in relation to beauty pageant services and beauty contests.

Likelihood of confusion

69. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

²⁸ Exhibit SDM21

²⁹ Exhibit SDM28 and SDM29

exists down to the responsible undertakings being the same or related. There is no scientific formula to apply; rather, it is a global assessment where 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 marks may be offset by a greater degree of similarity between the goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

70. I have found the marks to be visually, aurally and conceptually similar to a medium degree. I have found the earlier marks to be inherently distinctive to between a low and medium degree, which has been enhanced through use to between a medium and high degree in relation to beauty pageants. I have found the purchasing process to be predominantly visual, although I do not discount an aural component. I have found that the average consumer will be members of the general public, as well as contestants, who will pay a medium degree of attention in the selection of the services. I have found the services to vary from similar to a medium degree to identical.

71. Taking all of this into account, particularly the addition of the word CLASS in the applicant's mark, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other. I do not think it likely that the presence of the word CLASS will be overlooked by the average consumer and, consequently, do not consider there to be a likelihood of direct confusion. However, I consider that the common use of the words MISS WORLD, combined with the enhanced distinctiveness of the earlier marks, will lead the average consumer to conclude that they originate from the same or economically linked undertakings. In my view, this is likely to be seen as a sub-brand. I recognise that the addition of the word CLASS may create a different conceptual meaning i.e. that something is world class, but I do not consider this sufficient to offset the visual and aural similarities when considering the enhanced distinctiveness of the earlier marks. Consequently, I consider there to be a likelihood of indirect confusion.

72. The opposition based upon section 5(2)(b) succeeds in its entirety.

Section 5(3)

73. Section 5(3) of the Act states:

“5(3) A trade mark which -

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

74. As noted above, the marks relied upon qualify as earlier marks pursuant to section 6. The opponent has satisfied the proof of use requirements in relation to “services for the organisation of beauty contests, beauty pageant services” for the First Earlier Mark and “organisation [...] running of beauty contests; beauty contests” for the Second Earlier Mark. It is upon these terms that the opponent may rely, subject to demonstrating the requisite reputation, for the purposes of its section 5(3) opposition.

75. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks are similar to the applicant’s mark. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming the first and second conditions have been met, section 5(3)

requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

76. The relevant date for the assessment under section 5(3) is the date of the application i.e. 5 December 2019.

Reputation

77. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

78. In determining whether the opponent has demonstrated a reputation for the services in issue, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with the services. In reaching this decision,

I must take all of the evidence into account including “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.” As the First Earlier Mark is a UKTM it is necessary for the opponent to establish a reputation in the UK; for the Second Earlier Mark, which is an EUTM, it must establish a reputation in the EU.

79. I have summarised the opponent’s evidence of use above and do not propose to reproduce it here. In my view, the length of the opponent’s use, the considerable television audiences for earlier contests, 3,000 people attending yearly contests and the number of views by member of the UK public of the opponent’s social media accounts is sufficient to establish a reputation in the UK. I bear in mind that, at the relevant date, the UK was still a part of the EU and, consequently, all use in the UK can be taken into account for the purposes of demonstrating a reputation in the EU. I also note that, in addition to the UK use, there is use in other EU member states (albeit limited). Consequently, I am also satisfied that the opponent has established a reputation in the EU. For both, I consider the reputation to be reasonably strong in relation to beauty contests and beauty pageant services.

Link

80. As I noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

I have found the marks to be visually, aurally and conceptually similar to a medium degree.

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

My assessment of the average consumer set out above will also apply to the relevant public for the purposes of section 5(3).

I have found the services to vary from being similar to a medium degree to identical.

The strength of the earlier mark's reputation

I have found the opponent's reputation to be reasonably strong in relation to beauty pageant services and beauty contests.

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

I have found the earlier marks to be inherently distinctive to between a low and medium degree, which has been enhanced through use to between a medium and high degree in relation to beauty pageant services and beauty contests.

Whether there is a likelihood of confusion

I have found there to be a likelihood of indirect confusion.

81. In my view, taking into account the similarities between the marks, the strength of the opponent's reputation and the similarity of the services, I consider that a significant part of the relevant public will make a link between the marks in use.

Damage

82. I must now consider whether any of the types of damage pleaded will arise.

Unfair Advantage

83. In the form TM7 the opponent states:

“The use of the Application will clearly take unfair advantage of the distinctive character and reputation in and under the Earlier Marks, all of which have been carefully built up by the Opponent over the course of many years and at the significant time and investment of the Opponent.

The result of that time and investment by the Opponent has been to build a distinctive character and reputation in the Earlier Marks that identifies the Opponent, and no-one else, as the source of the Opponent’s services, and those of no-one else.

The use of the Application – which is nothing more than deliberately confusing to the Opponent’s famous Earlier Marks would therefore be deeply unfair.

It would enable the Applicant, at no cost or investment to itself, to attract interest and trade from consumers encountering the Application in use, thereby spring-boarding off (or “riding on the coat tails of”) the Opponent’s distinctive character and reputation as carefully built up over decades of successful trade.”

84. I bear in mind that unfair advantage has no effect on the consumers of the earlier marks’ services. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the services of the later mark than they would otherwise have been if they had not been reminded of the earlier marks.

85. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant’s intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant’s conduct is

most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

86. To the extent that the relevant public believe that the services of the applicant originate from the opponent there will clearly be unfair advantage. However, even if they do not consider that the services originate from the same undertaking, I consider that the applicant will still gain an unfair advantage. This is because the parties are operating within the same or similar fields and the relevant public will be instantly more familiar with the type of services offered by the applicant without the applicant having to incur the costs of informing the public herself, thus gaining a marketing advantage. Consequently, I consider that damage is made out.

87. As damage is made out on the basis of unfair advantage, I do not consider it necessary to consider the other heads of damage.

88. The opposition based upon section 5(3) succeeds in its entirety.

Section 5(4)(a)

89. Section 5(4)(a) of the Act states as follows:

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

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

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

90. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

91. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

92. The prima facie relevant date is the date of the application i.e. 5 December 2019. There does not appear to be any suggestion that the applicant was already using her

mark prior to that date and, consequently, the prima facie relevant date is the only date I need consider.

Goodwill

93. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

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

94. In *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.”

95. 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.”

96. I have summarised the opponent's evidence of use above. Clearly, the opponent has been trading in the UK in the field of beauty pageants for a long time. The contestant lists date back to 1951 and shows have been held in prominent venues and aired on television since that time. In more recent years, the opponent continues to hold shows in the UK and has a significant social media presence. Taking all of this into account, I consider that the opponent had a reasonably strong goodwill in the UK, identified by the sign MISS WORLD, at the relevant date in relation to beauty contest services and entertainment in the nature of beauty contests.

Misrepresentation and damage

97. 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.”

98. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here. Whilst I note that the services relied upon under section 5(4)(a) are slightly different in terms of wording than those relied upon under section 5(2)(b), I do not consider that this will make any difference to the outcome. I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant's services in the mistaken belief that they are the services of the opponent. Damage through diversion of revenue is easily foreseeable.

99. The opposition based upon section 5(4)(a) succeeds in its entirety.

Section 3(6)

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

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

101. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law

namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]".

102. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

103. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani*

(Grosvenor Street) Limited and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

104. In its Form TM7, the opponent states:

“53. As above, the Earlier Marks carry an extremely substantial and valuable reputation amongst the relevant UK public and are well-known to that public, in particular but without limitation in relation to the services advanced in this Opposition.

54. Given the UK and international fame and reputation of the Opponent (as well as the MISS WORLD contests as a whole), it is inconceivable that, as at the filing date, the Applicant was not fully aware of the Earlier Marks; of the Opponent; and of the Opponent’s substantial success in the UK (and elsewhere) under those marks, as outlined above.

55. In all those relevant circumstances [...] it is in turn clear that the Application was filed in bad faith. There can be no other sensible reason for why a mark consisting almost wholly of MISS WORLD is filed in class 41, for various entertainment and beauty contest services. To find otherwise would be to find that to be a coincidence impossible to credit. The reality is that the Applicant has merely tacked CLASS onto the end of the Earlier Marks, in an attempt to register a mark close to those of the Opponent, and then wrongfully use the same to wrongfully compete with the Opponent.

56. In this regard it should be noted, and will be detailed at the appropriate stage in argument and evidence, that the Opponent routinely encounters, both in the UK and elsewhere, third parties filing similar marks to those of the Opponent, with or without additional or different verbiage, yet all (apparently coincidentally, but in fact deliberately) including elements of the Opponent’s marks such as (without limit) MS, MISS, MRS, WORLD and so on; all of which the Opponent is compelled to oppose and/or take legal action against.

57. For all of those reasons and pending any further or better information from the Applicant (or as becomes available to the Opponent), the Opponent therefore submits that the filing of the Application fell well below the normal standards of acceptable commercial behaviour, judged both objectively and subjectively, and was therefore made in bad faith.”

105. In summary, the opponent claims that the applicant had prior knowledge of its trade mark and that registering a similar mark falls below the standards of acceptable commercial behaviour.

106. I accept that prior knowledge of a trade mark may amount to bad faith in some circumstances. For example, if the application is made with the intent of blocking another business’ legitimate activities. However, the case law is clear that mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton*.

107. There does not appear to be any suggestion of blocking or any other intention on the part of the applicant, other than a knowledge of the opponent’s trade mark. This is not, in my view, sufficient to make out a prima facie case for bad faith. The applicant had not filed the same mark, but a similar one. I note that the applicant states that she believed her mark to be suitably different to the opponent’s mark that it would not give rise to an issue. The fact that the opponent has had to take action against unrelated third parties is not, in my view, relevant.

108. I note that in its written submissions the opponent states that the conduct of the applicant goes beyond mere knowledge of another party’s trade mark; rather the applicant has applied for the mark “carefully and deliberately to compete with the Earlier Marks of the Opponent, both in registration and in use, for identical or highly similar services”. I do not consider that this takes the opponent any further and, in any event, I do not consider the evidence sufficient to make out a prima facie case of bad faith.

109. The opposition based upon section 3(6) of the Act is dismissed in its entirety.

CONCLUSION

110. The opposition is successful, and the application is refused.

COSTS

111. The opponent has been successful and is entitled to a contribution towards its costs. At the hearing, as foreshadowed in Mr Carter's skeleton argument, the opponent requested that costs be awarded off the scale. The opponent claims that the applicant's approach to this opposition has been unreasonable leading to increased costs incurred by the opponent in the filing of evidence for the following reasons:

- a. Putting the opponent to proof of use of the earlier marks and not admitting the opponent's reputation and goodwill in them despite having admitted that the opponent has "somewhat of a goodwill presence felt in the UK" and "of course I knew of the Miss World pageant prior to my application. I don't live under a rock";
- b. Asserted that the opponent's mark is generic in the field of beauty pageants despite acknowledging the opponent's use;
- c. Denied likelihood of confusion/misrepresentation/link and damage, without (the opponent claims) a bona fide belief in their truth.

112. Further, the opponent claims that the applicant acted unreasonably by:

- a. Seeking to rely upon 'survey' evidence without permission to do so;
- b. Concluding her statement by saying that the last few paragraphs contained "tongue in cheek humour" with the result that almost nothing in the statement could be taken at face value;

- c. Making reference to numerous irrelevant matters such as decisions in other contexts and/or other jurisdictions which have no bearing on the matters in dispute;
- d. Making various claims about the opponent's business and conduct in these proceedings.

113. A number of these points, in my view, simply point to misunderstandings made by an unrepresented litigant. It is not, in my view, appropriate to penalise an unrepresented party for raising points that qualified representatives may recognise as being irrelevant or outside the scope of the rules of evidence, when there is no suggestion or evidence that that has been done with the intention of frustrating proceedings.

114. With regard to the applicant's statement that the opponent has "somewhat of a goodwill presence felt in the UK" it is, in my view, important to read this in the full context in which it was used:

"Indeed I am aware of the MISS WORLD contest being registered in the UK in 1999 but which is usually held outside of the UK having only been held in the UK 6 times in the last 3 decades since its registration. This is another reason that the strength of the mark is weak as although there is somewhat of a goodwill presence felt in the UK by word of mouth and the fact that we do send contestants from the UK and the UK equivalent competition are held under a different trademark name such as MISS ENGLAND, MISS WALES, MISS SCOTLAND AND MISS NORTHERN IRELAND, not 'MISS WORLD – MISS ENGLAND'. In fact the last competition held in the UK was on 14th December 2019, the day after my application was published in the journal and this competition was held exactly 5 years to the day after the previous one held in the UK on 14th December 2014. I'm not so sure that using a Trademark once in the 5 year term really constitutes proper use of a trademark so I would request that this is looked into as it is an ambiguous detail in token trademark usage which furthermore adds to my argument that MISS WORLD is in fact a very weak mark on the face of it despite the opponents arguments to the contrary."

115. When reading this passage in its entirety, it seems entirely clear to me that the applicant is accepting that there has been some use, whilst maintaining that that use is not sufficient to meet the standards required (whether it be in relation to proof of use, reputation or goodwill). It is well established that a business may have goodwill, but that goodwill is of such a trivial degree that it is not protectable. Consequently, I see nothing in this passage to suggest that the applicant believed that the opponent did, in fact, have a protectable goodwill and the applicant was entitled to request proof of the same from the opponent.

116. Similarly, the comment “of course I knew of the Miss World pageant prior to my application. I don’t live under a rock” referred to by the opponent should be read in context:

“Of course I knew of the Miss World pageant prior to my application. I don’t live under a rock. I wasn’t aware, however that it was ‘established’ in the UK until these proceedings, I was though aware, of the lack of presence in the UK except for the national competitions of Miss England etc. That is why I went the official route of applying for the trademark in the first place as I am unaware of the exact law regarding similarities etc but I was also aware of many other similar sounding pageant names so surmised that there might not actually be an issue here but figured this route would be the simplest way of finding out if my chosen word was lawful or not.”

117. This passage suggests to me that the applicant recognised that the opponent was an established brand, but links in with the comments from the previous passage that she had doubts as to whether there had been actual (or sufficient) use in the UK, particularly given the opponent’s system of running national competitions under different names i.e. MISS ENGLAND etc. Further, the applicant suggests that her understanding was that a number of pageants use similar names (such as a title prefix followed by a physical place), so considered that the addition of the word CLASS and the impact upon the meaning of the mark would be sufficient to distinguish between them. Whilst I have not found that to be the case, I do not consider the applicant’s position to be unreasonable.

118. In light of the applicant's position regarding the effect of the addition of the word CLASS on the meaning of her mark overall and her comments about the use of the earlier mark in the UK above, I do not consider it unreasonable for the applicant to have put the opponent to proof of use, reputation and goodwill or to have denied that a likelihood of confusion, link or misrepresentation and damage would occur. Indeed, the opponent has not been successful in proving use, goodwill or reputation for the full extent of its specifications relied upon and, consequently, I see no unreasonable behaviour on the part of the applicant in this regard.

119. When referring to unevidenced criticisms of the opponent's business, my understanding is that the opponent has referenced, in particular, the following paragraphs of the applicant's evidence:

"55. [...] Notably again Miss World is a generic term for a pageant, the case facts are not the same and this situation is not the same. 'Miss World' does not have distinctive character as a trademark and neither are its services distinctive from any other beauty pageants' so therefore I contend that Section 5(3) does not apply as the earlier mark lacks distinctive character and distinctive reputation. Can anyone who isn't involved in the pageant industry name Miss World's reigning Queen? The answer is no. The reputation of Miss World is mostly down to the scandals that have surrounded it over the years when elsewhere pageantry has seen an increase in hobby interest and a decrease in general public interest."

"78. [...] The opponent could have contacted me to address the situation prior to going straight ahead with opposing the application as is provided for and recommended by the IPO office but alas they did not so any complaints about the legal and cost repercussions following that inaction is their own doing. I am not an unreasonable person and feel that we may perhaps have been able to come to an agreement or compromise but the opponents attitude from the beginning has been very hostile and off putting so perhaps there would not have been a way to compromise should they have attempted to contact me in the first instance anyway."

120. With regard to the applicant's comment regarding "tongue in cheek humour", her statement contained the following passage:

"I'm sorry if my tongue in cheek humor in the last few paragraphs of my statement is inappropriate but really as a lay person the submission of the opponent dragged on more than was needed, was unnecessarily repetitive and haughty and a bit toxic and so I felt a bit of levity might be welcome at the end of it all. Have a nice day."

121. The "tongue in cheek humour" referred to is apparent in comments such as:

"93. I have never alleged that I sent contestants to Miss World (Paragraph 116(b) of opponents evidence.) Just one more bizarre statement from the opponent."

94. [...] Not everything is done in such a negative manner as the opponent would assume. Pageantry is about finding the best in any given topic but Miss world and Mr Morley seems to be convinced that everything is done for self serving reasons absent of any evidence. I'm not really sure this attitude really belongs in pageant world so perhaps they should take a look in the mirror?

95. I do wish the opponent would stop assuming to know my intentions when no attempt to contact me to find them out has been made. It's quite tedious to keep reading the same nonsense repeated over and over again in the oppositions statement.

96. [...] I had hoped to have this matter put to bed way before the date planned for my first event in order to mitigate any loses [sic] or costs in changing any names but the opponent has seen fit to drag it out as far as possible and to make such a mountain out of a mole hill that I'm almost bored to tears reading the opposition and the witness statements. No one is concerned with Miss World as the opponent is and it shows. They do say empty vessels make the most noise..."

99. Archetype??? Come on man...”

122. I do not consider that these comments call into question the reliability of the applicant’s evidence. Clearly, in both the comments made at paragraphs 55 and 78 of the applicant’s evidence and the use of “tongue in cheek humour” the applicant’s frustration at the circumstances in which she finds herself is apparent. I note that a similar tone is apparent in the opponent’s own written submissions, for example:

“121. The allegation that the Opponent’s registration of trade marks corresponding to its famous brand is ‘bad faith’ or ‘trade mark bullying’, ‘in order to stop others from using them legitimately for other commercially exploitable benefits’ is categorically denied; unsupported by any evidence whatsoever; another instance of hyperbole; and should be ignored. The Applicant is stating what she may prefer to be the case, but is in fact not the case. Indeed it reveals a lack of understanding that the very purpose of a trade mark is to afford its proprietor exclusive rights – a fact apparent from the educational public materials freely available on the UKIPO’s own website [...] which the Applicant failed to consult.”

“289. [...] Maybe the Applicant should not have filed and started using the Application without consent.”

“388. [...] Why the Applicant thinks that is hostile is beyond the Opponent. Notice also that no approach has been made to the Opponent at that point in time to say “oh, sorry, I notice you’ve opposed, what can we do”. Neither has there been any compliance with cease and desist correspondence, requesting withdrawal of the application. How extraordinary – if the Applicant is now suggesting that she “would have” complied then, why does she not now? It is not because of sunken legal costs, because she says she has no representation. It can therefore only be sheer intransigence.”

“456(b). [...] The Applicant appears to complain about being opposed at all, which is bizarre.”

“466. Re 100(e), perhaps in future the Applicant should refrain from filing and using the marks of well-known brands without consent when she knows there is a possibility that they’re similar. Perhaps she should read the publicly available guidance on the UKIPOs website and contact the owner of the prior right first as the same advises, before complaining that her contest has been delayed now and she could have changed the name. Except the Applicant still hasn’t.”

“468. So the Applicant saves her punchline to the last.”

“484. [...] But of course the Applicant didn’t. Bad faith filers don’t.”

123. Making such comments in evidence or submissions is not, in my view, appropriate; proceedings of this kind should be taken seriously and, whilst emotions inevitably run high, parties should avoid making disparaging comments about each other and focus upon the matters in hand.

124. In my view, both sides could have been more helpful in the way that these proceedings have been pursued. As noted above, despite a Case Management Conference in which directions were given to assist the opponent in reducing their evidence from the originally filed 780 pages, its evidence was not targeted, with many pages not referring to the marks relied upon at all and a fair amount of duplication. Despite the fact that the opponent requested a hearing, it filed written submissions extending to over 80 pages in length. Further, I note that one of the criticisms levelled at the applicant is that she filed “hearsay evidence without notice”. This criticism is set out in the opponent’s written submissions in reply and is listed as one of the actions on the part of the applicant that is deemed to be unreasonable. However, I note that the opponent has itself filed a number of documents which are hearsay evidence in the form of letters prepared for the purposes of these proceedings from third parties which are neither in the correct format, nor accompanied by a statement of truth. Whilst they may disagree, I do not consider that either party has been worse than the other in the conduct of these proceedings. Consequently, I do not consider it appropriate to depart from the usual scale.

125. In reaching this conclusion, I have borne in mind the judgment in *Trump International Ltd v DTTM Operations LLC* [2018] ETMR 36, to which Mr Carter referred me to at the hearing:

“60. I note that the Applicant is without legal representation in this case, but relies on its own legal department. Nonetheless, the companies of Mr Gleissner, who is the Applicant’s sole director, undoubtedly have extensive experience of trade mark disputes and I find that there are aspects of the case where the Applicant can have had no bona fide belief that its defence of the Opponent’s claim was soundly based.

61. For example, although my decision did not resolve the s.5(2)(b) claim, it is plainly not credible to maintain that there is no likelihood of confusion between “TRUMP TV” for such services in class 41 [...] where the Opponent holds an earlier mark for TRUMP for services in class 41 [...], which are plainly identical or highly similar. Yet the Applicant denied the grounds, [...]

62. The adoption of such an indefensible position illustrates to me a flagrant degree of cynicism on the part of the Applicant, where other related companies have demonstrated a pattern of similar behaviour (as shown in Exhibit DM10) including a disdainful disregard for the opposition costs of the other side.

63. In considering whether off-scale costs are here warranted, I particularly bear in mind the well-evidenced pattern of abusive behaviour on the part of Mr Gleissner and his related companies as shown [...].

64. I also particularly bear in mind that the Applicant applied for a TRUMP TV trade mark, with no evidenced intention to use as a trade mark in trade, at a time when the businessman and TV personality Donald Trump Jr had gained especial global prominence in light of his final states of presidential campaigning. This obvious coincidence appears calculated to maximise potential interference with the Trump brand in which the Opponent has a central interest, and which is an illegitimate purpose.”

126. I recognise that the pursuit of a defence which the applicant ought to have known had no merits was a factor in that case. However, I have already explained why I do not consider that her defence was entirely without merit (even if I have found against her on a number of grounds). Further, there were various other factors which led to an award of off-scale costs being made in that case such as the pattern of abusive behaviour, the fact that whilst the applicant was unrepresented they had extensive experience of disputes of this nature and a lack of any intent to use the mark applied for. None of these latter factors, in my view, are present in this case and I see no reason to draw an analogy with the *Trump* judgment.

127. Taking all of this into account, I consider an award on the usual scale to be appropriate. I therefore award the opponent the sum of **£2,050** based upon the scale set out in Tribunal Practice Notice 2/2016, calculated as follows:

Preparing a statement and considering the applicant's statement	£350
Preparing evidence and considering and commenting upon the applicant's evidence	£800
Preparing for and attending the hearing	£700
Official fee	£200
Total	£2,050

128. I therefore order Christina White to pay Miss World Limited the sum of £2,050. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of September 2021

S WILSON
For the Registrar