



Neutral Citation Number: [2022] EWHC 434 (Ch)

Case No: CH-2021-000159

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)

ON APPEAL FROM THE UNITED KINGDOM INTELLECTUAL PROPERTY
OFFICE relating to UK Trade Mark Application No.3452217 and Opposition No.
OP000420864

Royal Courts of Justice
Rolls Building, Fetter Lane, London, EC4A 1NL

Date: 02/03/2022

Before :

THE HONOURABLE MR JUSTICE MICHAEL GREEN

Between :

DC COMICS (PARTNERSHIP)

Appellant

- and -

UNILEVER GLOBAL IP LIMITED

Respondent

Jonathan Moss (instructed by **Allen & Overy LLP**) for the **Appellant**
Denise McFarland (instructed by **Gowling WLG (UK) LLP** and **Lane IP Limited**) for the
Respondent

Hearing date: 11 February 2022

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

.....
THE HONOURABLE MR JUSTICE MICHAEL GREEN

Covid-19 Protocol: This judgment was handed down remotely by circulation to the parties' representatives by email, release to BAILII and other websites. The date and time for hand-down is deemed to be 10am on 2 March 2022

Mr Justice Michael Green :

Introduction

1. Would the words WONDER MUM on a shampoo bottle or other bath, shower or hair products be likely to confuse the average consumer into thinking that they are linked to or associated with the trade mark WONDER WOMAN or the fictional superhero character, Wonder Woman? Ms Judi Pike, a Hearing Officer of the UK Intellectual Property Office (**IPO**) concluded that they would not and she rejected all the grounds of opposition put forward by the Appellant, DC Comics (partnership) (**DC**), the owner of the trade mark WONDER WOMAN, to the registration of the trade mark WONDER MUM by the Respondent, Unilever Global IP Limited (**Unilever**).
2. This is therefore an appeal by DC against Ms Pike's decision made on 21 June 2021 (the **Decision**). Before Ms Pike, DC was opposing, on various grounds, Unilever's application to register the trade mark WONDER MUM for goods in class 3. DC owns the earlier EU registered trade mark (No.14275739) – WONDER WOMAN, which protects the name of their superhero comic book character.
3. In her careful Decision, Ms Pike rejected the three grounds of opposition put forward by DC under ss.5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the **Act**). At the heart of DC's appeal, as was made clear by the submissions of DC's counsel, Mr Jonathan Moss, is their concern about Ms Pike's finding that they had not established on the evidence a sufficient reputation in the UK of the WONDER WOMAN mark or of goodwill in WONDER WOMAN generally for the purpose of establishing a passing off claim. While I understand the commercial imperatives of seeking to overturn those findings, it does not remove the underlying basis for the Decision that there is no likelihood of confusion.

Role of the appeal court

4. DC appeals as of right to the High Court. It is accepted that this is a true appeal, not a re-hearing and so is limited to a review of the Decision. In *Apple Inc v Arcadia Trading Limited [2017] EWHC 440 (Ch)*, Arnold J, as he then was, approved as applicable to High Court appeals the principles set out by Mr Daniel Alexander QC as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd (O/017/17)* where he said:

“(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF*, *BUD*, *Fine & Country* and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view

expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find mis-directions warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson and others*).”

5. DC do not say that Ms Pike set out the applicable legal principles incorrectly. Rather their case is that she made fundamental failures in applying those legal principles leading to a faulty evaluation of the facts. They recognise that due weight should be given to the expertise of the IPO and Ms Pike in being able to assess where the line should be drawn in intellectual property cases which are commonly fine questions of degree on which different judges can legitimately differ. Ms Denise McFarland appearing for Unilever emphasised the multifactorial value judgment involved in the Decision which should not be overturned on appeal unless it contained a distinct and material error of law or principle.

Background

6. The background is straightforward. Unilever applied on 17 December 2019 to register the trade mark WONDER MUM (No. 3452217) for the following goods in Class 3:

Soaps; perfumery; essential oils; deodorants and antiperspirants; hair care products; hair colorants, hair dyes, hair lotions, hair waving preparations, shampoos, conditioners, hair sprays, hair powder, hair dressings, hair lacquers, hair mousses, hair glazes, hair gels, hair moisturisers, hair liquid, hair preservation treatments, hair desiccating treatments, hair oils, hair tonic, hair creams, preparations for the bath and/or shower; non-medicated toilet preparations; skin care preparations; cosmetics.

7. On 30 July 2020 DC filed their Form TM7 Notice of Opposition and Statement of Grounds. For the purposes of their opposition under ss.5(2)(b) and 5(3) of the Act, DC rely on their EUTM for the words WONDER WOMAN which has been registered in classes 3, 9, 16 and 41 for various different goods and services. In relation to their opposition under s.5(4)(a) of the Act, DC stated as follows in their Statement of Grounds:

“14. [DC] owns goodwill in the United Kingdom in WONDER WOMAN and the WONDER WOMAN character more generally as a result of its use in connection with a range of goods and services for an extensive merchandising programme linked to films, publications and entertainment services.”

8. The relevant date for testing the opposition is the filing date of 17 December 2019.
9. DC filed evidence to support their opposition in the form of a witness statement from Mr Jay Kogan dated 20 November 2020. Mr Kogan is a Senior Vice President, Legal Affairs at DC in California. He exhibited to his witness statement documents said to prove reputation and goodwill in the UK.
10. Unilever sought an extension of time to file their evidence in answer but this was refused by Ms Pike. They therefore had no evidence in answer but put DC to proof of their opposition. However, Ms Pike did allow in a letter dated 11 February 2021 from Unilever's then trade mark attorneys, Murgitroyd and Company, which contained their criticisms and observations on Mr Kogan's evidence. Despite pointing out certain respects in which DC's evidence was lacking, DC never sought to put in any more evidence. Mr Moss said that there is a 300 page limit on evidence in these applications but accepted that DC could have applied to have exceeded that limit. Mr Kogan's witness statement and exhibits amounted to 279 pages. There was an application by DC at the beginning of the hearing before Ms Pike to allow in some evidence as to Unilever's activities in the United States, but this was disallowed.
11. The hearing took place on 22 April 2021 by video conference and the Decision was released 2 months later.

Grounds of Appeal

12. There are six Grounds of Appeal:
 - (1) Errors relating to the approach to similarity under s.5(2)(b) of the Act;
 - (2) Failure to apply the interdependency principle in s.5(2)(b) of the Act;
 - (3) Failure to find reputation for comics for the purposes of s.5(3) of the Act;
 - (4) Failure to find a reputation for entertainment for the purposes of s.5(3) of the Act;
 - (5) If Ground 4 is successful, failure to find a link for the purposes of s.5(3) of the Act; and
 - (6) Failure to find goodwill for the purposes of passing off under s.5(4)(a) of the Act.

I will take them each in turn.

Ground 1: Errors relating to the approach to conceptual similarity under s.5(2)(b) of the Act

13. Section 5(2)(b) of the Act provides 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 and services identical with or similar to those for which the earlier trade 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.”

14. In [15] of the Decision, Ms Pike set out accurately and fully the relevant case law and legal principles in relation to determining the various elements of s.5(2)(b). In particular she said the following:

“(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 the 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;

...

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

15. Mr Moss referred to *Sabel BV v Puma AG* [1998] RPC 199 for the uncontroversial proposition that the comparison is made by considering “*the overall impression given by the marks*”. That is traditionally done by looking at the visual, aural and conceptual similarity of the marks, as was described in [15(d)] of the Decision, set out above.

16. Ms Pike compared the marks in [27] to [36] of the Decision. She found “*no more than a medium degree of visual and aural similarity between the marks*”, that is, WONDER WOMAN and WONDER MUM [31]. She then analysed a conceptual comparison between the marks concluding in [36] as follows:

“36. There is, therefore, some conceptual similarity in that both marks convey the impression of someone female who is very good or effective at something. Given the particular connotations of ‘mum’, which are absent from the opponent’s mark, I find that the marks are conceptually similar to a low degree; i.e. there is more that is different about the respective concepts of the marks than is the same.” (underlining added)

17. Mr Moss accepted that if the Decision had stopped before the underlined passage, then the conclusion of a low degree of conceptual similarity could not have been challenged

on appeal, even if DC had disagreed with the conclusion. Mr Moss however submitted that the underlined passage undermined the basis for that conclusion and constituted an incorrect application of the law. He said that Ms Pike wrongly considered the marks to be both similar and dissimilar, when the only question for her was how similar the marks were. It was improper in trade mark law, said Mr Moss, to hold that something can be both similar and dissimilar at the same time. The underlined words indicated that Ms Pike did just that instead of weighing the overall comparison and concluding, one way or the other, whether they were similar or dissimilar.

18. I disagree with that characterisation of Ms Pike’s presumed thought-process. I think she properly concluded that there was a low degree of conceptual similarity and then went on to explain partly how she got there by reference to the respective differences between the marks. Mr Moss has overinterpreted the underlined words to eke out a point of law when none really exists.
19. Furthermore I do not accept that this affected her later finding on likelihood of confusion. Mr Moss submitted that her finding at [40] of the Decision that she “*identified significant conceptual differences between the marks which would mean that different conceptual ‘pictures’ would be kept in the minds of average consumers*” showed that she had actually made a finding of conceptual dissimilarity. Again, all she was doing was highlighting why she had come to the conclusion of a low degree of conceptual similarity.
20. Accordingly I reject Ground 1.

Ground 2: Failure to apply the interdependency principle under s.5(2)(b) of the Act

21. The interdependency principle was explained in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] RPC 117 at [17] as follows:

“17. A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa.”
22. Ms Pike was well aware of the interdependency principle. At [39] of the Decision, she said:

“Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa.”

This was a repeat of what she had said earlier in [15(g)] of the Decision.

23. Mr Moss submitted that Ms Pike failed to apply the interdependency principle properly. He said that she had found that some of the goods were identical (at [22]); some were highly similar (at [23]-[24]); and some were of medium similarity (at [25]). She also

found that the purchasing route would be “*overwhelmingly visual*” (at [26]) but by that I believe she meant that the decision to purchase would be based predominantly on what was written on the goods.

24. Mr Moss submitted that having found some of the goods to be identical, Ms Pike should have analysed better how identical goods and medium visual and aural similarity did not lead to a likelihood of confusion. However she did perform that analysis in [40] of the Decision:

“40. I do not consider that there is a likelihood of direct confusion, even in relation to the goods which are identical. Although a finding of identical goods is a factor in the opponent’s favour, the results of the other comparisons I have made point less strongly towards confusion. The earlier mark is distinctive to an average degree, but no more than that, whilst the high point of the mark comparison resulted in medium visual and aural similarity, but no higher. Importantly, I identified significant conceptual differences between the marks which would mean that different conceptual ‘pictures’ would be kept in the minds of average consumers. This is unlikely to result in the type of imperfect recollection which typically leads to direct confusion. Average consumers will notice the difference between the marks, even in relation to goods entailing no more than a normal attention level during purchase. The marks will not be directly mistaken for one another.”

25. Ms Pike was clearly balancing a finding of identical or similar goods with her findings in relation to the levels of similarity between the marks. At best to DC would be a balance between identical goods and medium level (“*but no higher*”) visual and aural similarity but, as Ms Pike reasoned, there still needs to be brought into account, in the overall assessment, the fact that there was only a low degree of conceptual similarity. Even with identical goods, this would not sufficiently offset against the low to medium degree of similarity of the marks so as to lead to a finding of likelihood of confusion. Ms Pike’s analysis is, in my view, a reasonable application of the interdependency principle.
26. Ms Pike also continued in [41] to [43] of the Decision to consider the likelihood of indirect confusion. But her analysis and conclusion in respect of that are not criticised on this appeal.
27. I therefore reject Ground 2.

Ground 3: Failure to find a reputation for comics for the purposes of s.5(3) of the Act

28. Section 5(3) and 5(3A) of the Act provides as follows:

“(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 the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

29. Ms Pike accurately set out the legal principles in relation to s.5(3) of the Act in [46] of the Decision. She summarised them in [47], as follows:

“47. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark is similar (or identical) to the applicant’s mark. Secondly, the earlier mark must have achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the relevant public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary that the goods and 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.”

30. Ms Pike was well aware of the burden on DC to prove reputation of its mark in the UK/EU. She correctly required there to be actual evidence as to reputation in the UK/EU and that generalised statements about Wonder Woman, such as being “*the most famous female comic book hero in the world*” as stated by Mr Kogan in his witness statement, did not discharge that burden. At [49] of the Decision, Ms Pike said:

“49. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public (*General Motors*)¹. It also requires a reputation as a trade mark in relation to the goods and services for which the earlier mark is registered and upon which the opponent relies, not some general reputation. Mr Kogan, in the first page of his witness statement, says “This statement explains the strong reputation of the WONDER WOMAN character since her launch in 1941”.

31. The reputation that must be proved to exist in the UK/EU must be in relation to the goods and services covered by DC’s earlier trade mark. It does not have to be the same goods and services as the later mark (as made clear by s.5(3A) of the Act) but a generalised reputation is not good enough. This Ground of Appeal is concerned with Ms Pike’s findings in relation to the reputation of WONDER WOMAN in class 16 goods which is described as follows:

“Class 16: printed matter and paper goods, namely, books featuring characters from animated, action adventure, comedy and/or drama features, comic books, children’s books, strategy guides, magazines featuring characters from animated, action adventure, comedy and/or drama features, coloring books, children’s activity books.”

32. Mr Moss submitted that Ms Pike erred in [55] of her Decision in failing to find that WONDER WOMAN has a reputation for comics (or any other class 16 goods). He said that Ms Pike’s finding was “*totally perverse*” and was one “*that no reasonable Hearing*

¹ A reference to the CJEU judgment in *General Motors* [1999] ETMR 950.

Officer could come to on the evidence before her.” This seems to be on the basis that DC had produced evidence that “*Wonder Woman is the most famous female comic book hero in the world with nearly 80 years of continuous use since her comic book debut in December 1941*”. However, reliance on these generalised statements was rightly criticised by Ms Pike. She was looking for specific evidence of comic sales in the UK to support the claimed reputation of the mark in the UK for comics and the like.

33. Ms Pike analysed the evidence of comic sales in Mr Kogan’s witness statement. In [27] of his witness statement he said as follows:

“27. Sales of WONDER WOMAN comics have generated significant revenues for DC Comics. The following are approximate figures for the worldwide revenue generated in the period 2009 to 2019 (the United Kingdom revenue figures will of course be less, but nevertheless a notable proportion of the whole)...”

There was then a table showing approximate worldwide revenues in US dollars for each year, ranging from US\$1m in 2009 to a high of US\$7.5m in 2017. The total for those 11 years was US\$37.4m.

34. Ms Pike was concerned about the lack of figures for the UK. It is mystifying why DC did not produce those figures. At [55] of the Decision, Ms Pike said this:

“55. Mr Kogan states “(the United Kingdom revenue figures will of course be less, but nevertheless a notable proportion of the whole).” At best, this is Mr Kogan’s opinion, that a proportion of sales attributable to the UK are “notable”. It is not fact. UK/EU figures are important, yet this is a comment relegated to brackets, following the provision of global figures. There are no corroborative figures indicating what the level of sales of comics in the UK/EU has been, or whether the comics were Wonder Woman comics, as opposed to comics which featured the Wonder Woman character. There are too many gaps in the evidence to make a finding that at the relevant date the earlier mark had a qualifying reputation in the UK and/or the EU in comics or any of the other class 16 goods of the registration which are relied upon.”

35. Mr Moss severely criticised Ms Pike’s reference to Mr Kogan giving opinion evidence rather than factual evidence. He said that Mr Kogan had made a factual statement that UK sales were a “*notable proportion*” of the worldwide sales and he did not need to provide actual detailed figures for the UK. He also went on to make the unattractive submission that the evidence before Ms Pike should be “*considered in the light of the strict 300-page limit on exhibits*.” DC was on notice that their evidence was said to be deficient in this and other respects from Murgitroyd and Company’s letter of 11 February 2021 but did nothing to remedy this.

36. As to the core complaint in this respect that Ms Pike wrongly dismissed Mr Kogan’s evidence as merely his opinion, I do not accept this. Mr Kogan was giving his opinion that UK sales were a “*notable proportion*” of worldwide sales. What notable means in this context and whether a particular proportion is notable are matters of opinion. Does he mean that it was 5%, 20% or 50% of worldwide sales that were attributable to the UK? It is impossible to know as there are no underlying figures. Other people may disagree, once they know the actual figures, that they form a notable proportion. In short, Mr Kogan’s evidence was so lacking in detail in this respect as to be almost

worthless in demonstrating that there were a significant number of sales of comics in the UK such that a reputation in the mark was established for that class of goods.

37. I therefore reject Ground 3.

Ground 4: Failure to find a reputation for entertainment for the purposes of s.5(3) of the Act

38. This Ground of Appeal concerns Ms Pike's findings in relation to reputation of the mark in the UK/EU in respect of entertainment-related goods and services in classes 9 and 41.

39. Mr Moss focused particularly on the release in 2017 of the high-profile film, Wonder Woman, starring Gal Gadot as the eponymous superhero, and which grossed some £19.5m at the UK box office alone. There were also two other Warner Bros.' films in that period featuring Wonder Woman, although her name did not appear in the title of the film. These were: *Batman v Superman: Dawn of Justice*, released on 25 March 2016 with UK gross receipts of over US\$53m; and *Justice League*, released on 17 November 2017 with UK gross receipts of over US\$24m.

40. Mr Moss suggested that those facts alone demonstrated that Ms Pike must have been wrong to conclude that WONDER WOMAN has no reputation in the UK. However I do not think that that was what Ms Pike found. Nor is it the relevant question. She held that the evidence adduced by DC did not prove a sufficient reputation in the trade mark WONDER WOMAN as used in the UK/EU in relation to the class 9 goods and class 41 services. As she said at [61] of the Decision, a key issue is the use of WONDER WOMAN as a trade mark and she compared that to it being used as the title of an artistic work. This is highly relevant to establishing the link in the relevant public's minds between the earlier and later marks. Mr Moss accepted that this is about whether the mark has been used as a badge of origin and whether the average consumer would assume that goods or services using the mark came from a single source.

41. Mr Moss took me through Mr Kogan's witness statement and some of the exhibits. However this was all carefully analysed by Ms Pike in [56] to [60] of the Decision including the figures for the feature films, the reviews and publicity in the UK in relation to the films and the UK sales figures for DVDs, Blue-ray and other digital formats in relation to the various WONDER WOMAN films including an animated film, the 1970s TV series WONDER WOMAN, and a game called LEGO Dimensions: DC WONDER WOMAN Fun Pack (2015). Ms Pike clearly took all the evidence into account.

42. But in [61] to [65] of the Decision, Ms Pike tested that evidence against what DC had to prove, and she found it wanting. She even went so far as to say, in response to a suggestion on behalf of DC that more evidence could be provided (saying that they had limited the evidence in the interests of proportionality) that "*more pages of ill-focused evidence will not do the job any more effectively.*" In other words, she found that the evidence was not directed at the relevant question as to whether WONDER WOMAN had been used by DC as a trade mark such that it indicated to the relevant public its commercial origin.

43. Ms Pike referred to *Danjaq LLC v EUIPO* Case T-435/05 (commonly referred to as the “Dr. No” case) in which the court did not accept that the use of “*Dr No*” as the title of a film was use as a trade mark. Rather “*James Bond*” was the trade mark that indicated the commercial origin of the series of James Bond films of which Dr No was part. In [25] of the *Danjaq* case, this was explained:

“25. However in the present case, an examination of the documents submitted by the applicant shows that the signs Dr. No and Dr. NO do not indicate the commercial origin of the films, but rather their artistic origin. For the average consumer, the signs in question, affixed to the covers of the video cassettes or to the DVDs, help to distinguish that film from other films in the ‘James Bond’ series. The commercial origin of the film is indicated by other signs, such as ‘007’ or ‘James Bond’, which are affixed to the covers of the video cassettes or to the DVDs, and which show that its commercial origin is the company producing the films in the ‘James Bond’ series. Moreover, even if the profits that the film *Dr. No* had generated within the Community are capable of showing the commercial success of the film in that territory, the fact remains that they cannot show that the signs in question are used as indicators of origin.”

44. Mr Moss criticised the final sentence of [62] of the Decision which stated as follows:

“As in the *Danjaq* judgment (paragraph 25), WONDER WOMAN may distinguish the 2017 WONDER WOMAN film as an artistic work from other titles in the DC Comics series, but it does not indicate its commercial origin.”

45. Mr Moss submitted that that conclusion was wrong in law. He said in his skeleton argument at [45]:

“The average consumer is aware that film titles can also act as badges of origin even if they describe one of the characters contained in the movie. Consumers, particularly consumers of blockbuster franchise movies such as WONDER WOMAN know that such movies are widely licensed. Therefore the average consumer knows that WONDER WOMAN is both the name of a character and also at the same time acts as a badge of origin, in the same way as JAMES BOND is both a character name and a badge of origin, as set out in the *Danjaq* decision.”

Mr Moss continued to speculate in [46] and [47] of his skeleton argument as to what the average consumer would know about the single source of the Wonder Woman film and any merchandising associated with the film. He concluded in [48] by saying that the average consumer “*axiomatically know that it acts as a badge of origin.*”

46. Ms McFarland objected to these paragraphs on the basis that DC had not adduced evidence from consumers so as to be able to judge what the average consumer would know. I accept however what Mr Moss told me that such evidence is never adduced on these applications and that it is difficult to see what form such evidence would take.
47. Ms Pike evaluated the evidence that had been adduced by DC in particular whether the sales figures for DVDs etc. demonstrated that the average consumer considered the title WONDER WOMAN denoted a trade mark and badge of origin or whether it simply indicated the subject matter of the film. She decided that the evidence was inconclusive. In [63] of the Decision she said:

“I find that the figures are not explained in such a way that I can decide whether the DVD, Blu-ray and digital sales had come to denote a series, and trade mark use, or whether because of the release dates and the way in which the *LEGO* title is presented that they were seen as one-off titles or descriptive of the content.”

She said in conclusion in [65] that:

“the shortcomings and lack of UK/EU focus in that evidence means that I am unable to conclude that the opponent had a sufficient reputation in the earlier mark in relation to the Class 9 and 16 goods and the class 41 services relied upon, either in the UK or the EU, at the relevant date.”

48. While that may be a surprising conclusion and one that DC is concerned about for wider commercial reasons, it is important to recognise that Ms Pike was not deciding that the Wonder Woman film was not a success or that Wonder Woman the fictional character is not well-known. She was deciding whether the trade mark WONDER WOMAN had a relevant and qualifying reputation in the UK/EU at the relevant date amongst a significant part of the relevant public in respect of the registered classes of goods and services i.e. 9, 16 and 41. She found that the evidence was insufficient to establish this and that was, in my view, a conclusion open to her.

49. In any event, Ms Pike went on to find that (in [66] of the Decision):

“However for the purposes of section 5(3), without a qualifying reputation in the goods and services relied upon for this ground, there can be no link made by the UK relevant public. Without a link, there can be no damage to the earlier mark or unfair advantage to the applicant.”

What she is saying there is that the real point of s.5(3) of the Act and the proof of a qualifying reputation in the earlier mark is that when the consumer is confronted with the later mark, in this case WONDER MUM, they will link it to the earlier mark of WONDER WOMAN. Whether they do so is dependent on a number of factors including the strength of the reputation in the earlier mark.

50. Accordingly I reject Ground 4.

Ground 5: Failure to find a link under s.5(3) of the Act

51. DC accept that if I am against them on Ground 4, then it is unnecessary to consider Ground 5. That is because they would have to succeed on both Grounds 4 and 5 in order for Ms Pike’s decision in relation to s.5(3) of the Act to be overturned.

52. It is interesting however to look at this Ground 5 because this is what Ms Pike said at the end of [66] in the Decision:

“For completeness, even if I had found a qualifying reputation in relation to films, TV and comics, I would have rejected the section 5(3) claim because the relevant public would not make a link between WONDER WOMAN and WONDER MUM. The differences between the marks and the goods and services are too great. The section 5(3) ground fails.”

53. The appeal on this Ground was on the basis that Ms Pike had earlier concluded that the marks were similar and was therefore bound to find a link. This harks back to Ground 1 and Ms Pike’s reasoning as to the differences between the marks. For the same reason, I do not think there is anything in this Ground of Appeal and I would have rejected it, if I needed to rule on it.
54. DC saw fit to seek to appeal this alternative finding in the event that they succeeded on Ground 4. This should be compared to their appeal under Ground 6, where they have not sought to appeal the alternative finding made by Ms Pike under s.5(4)(a) of the Act. I deal with this below.

Ground 6: Failure to find goodwill for the purposes of passing off under s.5(4)(a) of the Act

55. Section 5(4)(a) of the Act provides as follows:

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

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

(b) ...

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

56. The requirements of passing off, as correctly stated by Ms Pike in [69] of the Decision, are (i) goodwill or reputation; (ii) misrepresentation leading to deception or a likelihood of deception; and (iii) damage resulting from the misrepresentation. It is for DC in this case to establish all three elements. Ms Pike’s main finding was that DC had not proved sufficient goodwill in the UK attached to the words WONDER WOMAN.
57. In appealing that finding, I think that Mr Moss has fallen into the same trap of making generalised statements about the goodwill or reputation that must undoubtedly exist in such a successful franchise and which therefore should have led any reasonable IPO hearing officer to conclude that DC had established sufficient goodwill in the name WONDER WOMAN in the UK. He said that the threshold for establishing goodwill is low and that: “*A member of the relevant public would know that the WONDER WOMAN comics and movies, amongst other things, designate a certain commercial origin. They know the WONDER WOMAN character and they know that those stories come from a certain source.*” But that is assertion, not evidence.
58. It is important to keep in mind the way DC put their case on passing off. I have quoted this above but it is worth repeating:

14. [DC] owns goodwill in the United Kingdom in WONDER WOMAN and the WONDER WOMAN character more generally as a result of its use in connection with a range of goods and services for an extensive

merchandising programme linked to films, publications and entertainment services.”

Thus, DC was relying only on their “*extensive merchandising programme linked to films*” etc., not the films themselves, and this shaped the way Ms Pike dealt with the claim to goodwill.

59. In [73] to [83] of the Decision, Ms Pike exhaustively analysed Mr Kogan’s evidence in support of the claimed goodwill which consisted mainly of listings of merchandise on amazon.co.uk and a Brand Assurance Report. She found that many of the products did not even have the words WONDER WOMAN on them – they instead employed the logo or other get-up of the character – and when they did have those words, that they were more decoration than indicating the commercial origin of the goods. There was no information as to how many of such goods were sold in the UK.
60. Mr Moss criticised one sentence in [84] of the Decision where Ms Pike said “*The use is not of a sign which denotes commercial origin in the UK*” and she referred to para. 8-128 of the 5th Edition of a textbook by *Professor Christopher Wadlow* entitled *The Law of Passing-Off: Unfair Competition by Misrepresentation*. It seems to me clear from the context that by mistake the words “*in the UK*” should have come after the word “*sign*” rather than at the end. If they are put there it makes sense and would be consistent with what she had been saying. Of course Mr Moss is correct to say that for the purposes of goodwill in passing off, the goodwill must exist in the UK but the origin of that goodwill can be from overseas. As Ms McFarland pointed out, the passage in *Wadlow* referred to was dealing with whether the title of a book can lead to an action for passing off. Ms Pike’s findings in relation to goodwill were all directed at whether such goodwill was established in the UK, so I think it is beyond doubt that “*in the UK*” was simply misplaced in the sentence.
61. The real basis for Ms Pike’s conclusion on the s.5(4)(a) of the Act objection is contained in [87] and [88] of the Decision. There she explained the essential core of a passing off claim which was not present in this case. She said as follows:
- “87. I conclude that the opponent’s claim to goodwill is unsubstantiated. Stepping back from this, overarching all of the various goods and services for which the opponent claims goodwill and misrepresentation, is the same issue the opponent faces under section 5(2)(b). This ground is not about whether the later mark will bring to mind the earlier mark; instead, it is necessary for a substantial number of the opponent’s customers, or potential customers, to believe that the applicant’s goods are those of the opponent or an undertaking which is commercially linked to the opponent...
88. ...Given the entertainment sector’s commercial practice of merchandising, impressive use in relation to the goods and services relied upon might have been a factor outside of those considered under section 5(2)(b), despite the distance between some of the parties’ goods and services. As it is, the opponent has failed to make out its case. The burden is on the opponent to show that its business had sufficient goodwill which was distinguished by use of WONDER WOMAN at the relevant date so that it can be concluded that misrepresentation would occur and damage follow. It has not done that...”

62. The way DC framed their case on passing off specifically in relation to merchandising linked to films and other entertainment services together with their lack of evidence as to sales of such merchandising in the UK and whether goodwill had been established as a result of such trading in the UK led to the conclusions that Ms Pike made. To a certain extent she has elided the two elements of goodwill and misrepresentation but what she was effectively saying is that there was insufficient evidence that the use of WONDER WOMAN on merchandising in the UK has led to DC's customers or potential customers being misled into thinking that goods with WONDER MUM on them are commercially linked to DC. Inadequate evidence of goodwill in relation to merchandising meant that there could have been no such misrepresentation.
63. Ms Pike's conclusion on this involved a multifactorial assessment and evaluation of DC's evidence in relation to goodwill in the UK through their merchandising programme. I do not detect that she made any distinct and material error of law or principle. As such, an appellate court should be slow to interfere in her decision and I do not propose to do so.
64. That leads to an important final point concerning [89] of the Decision. Ms Pike said that even if she had found goodwill, she would still have rejected the s.5(4)(a) ground of opposition because there was no likelihood of deception. She said:
- “89. Even if I had found that the opponent had established goodwill attached to WONDER WOMAN, given the difference between the earlier sign and the contested mark, it is unlikely that the opponent's customers or potential customers would believe that WONDER MUM class 3 goods were those of the opponent, or from the same source as the WONDER WOMAN films, comics or merchandise, or that they featured the opponent's copyright works featuring WONDER WOMAN.”
65. DC did not appeal this finding. Mr Moss submitted that it was purely *obiter* and so they did not need to appeal it. He said that, even though this was not mentioned in the Grounds of Appeal or his skeleton argument, if I had overturned Ms Pike's findings in relation to goodwill then either I could proceed to come to my own conclusion on misrepresentation and damage or I could remit the matter back to the IPO for determination. Mr Moss argued that misrepresentation and likelihood of deception are dependent on the actual findings in relation to goodwill, in particular how strong the goodwill is found to be.
66. Like they did under Ground 5 in relation to s.5(3) of the Act, I think DC should have appealed [89] of the Decision if they wanted to succeed on their appeal on the s.5(4)(a) ground. Ms Pike made a clear finding that if she was wrong on goodwill, there was in any event no misrepresentation or likelihood of deception. That finding is consistent with the theme running through the Decision and which in my view is a reasonable one for her to have formed, that an average consumer or a customer or potential customer of DC would not be confused or misled by the use of the WONDER MUM mark into thinking that it was linked to or associated with WONDER WOMAN or DC as its commercial origin.
67. Accordingly I reject Ground 6.

Conclusion

68. I have rejected all the Grounds of Appeal and so I dismiss this appeal.