

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2055617
BY MISSING IMPOSSIBLE LTD TO REGISTER
THE MARK MISSING IMPOSSIBLE IN CLASSES 9 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 45857
BY PARAMOUNT PICTURES CORPORATION**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2055617**
by Missing Impossible Ltd to register
the mark MISSING IMPOSSIBLE in Classes 9 and 41

and

10 **IN THE MATTER OF Opposition thereto under No 45857**
by Paramount Pictures Corporation

15 **DECISION**

On 6 February 1996 Missing Impossible Ltd applied to register the mark MISSING IMPOSSIBLE for specifications of goods and services comprising:

- 20 Class 9 - Video and audio tapes, CD-ROMS, Laser discs and electro-magnetic storage media.
- 25 Class 41 - Production, hire, rental and leasing of video tape films, instructional videos for sports training.

The application is numbered 2055617.

30 On 6 November 1996 Paramount Pictures Corporation of Los Angeles, California filed notice of opposition to this application in the following terms so far as specified grounds are concerned:

“The mark applied for offends against the provisions of Sections 3 and 5 of the Act.

35 Use of the mark applied for in the United Kingdom is liable to be prevented by the law of passing-off.

40 The opponent’s mark at the date of application for registration of the mark applied for was entitled to protection under the Paris Convention as a well-known mark. The mark applied for therefore offends against the provisions of Section 6(1)(c) of the Act.

45 The mark applied for offends against the provisions of Section 32(3) of the Act on the ground that there is no intention to use that mark in relation to all the goods and services covered by the application as filed.

The application fails to satisfy the requirements of the Act and should be refused in the exercise of the Registrar's power under Section 37(4)."

5 I should add that the opponents also refer to their being the owner of an application to register the mark MISSION IMPOSSIBLE in Classes 9, 14, 16, 25, 28 and 41 under No 2110805. However it is clear that this application is not itself an "earlier trade mark" for the purposes of Section 5.

10 The applicants filed a counterstatement denying the grounds advanced and putting the opponents to proof as to their goodwill and reputation. They say that they have "offered to limit their specification of goods in Class 9 as is inferred in Class 41 to the provision of videos etc relating to training programmes for sports...". They also comment that the opponents' mark is strongly associated with the well-known actor, Tom Cruise.

15 Both sides ask for an award of costs in their favour. Only the opponents filed evidence. The matter came to be heard on 10 November 1998 when the applicants were represented by Mr D Moore of Jensen & Son, Trade Mark Attorneys, and the opponents by Mr G Shipley of Counsel instructed by Wildbore & Gibbons, Trade Mark Attorneys.

20 Opponents' evidence

25 The opponents filed a statutory declaration dated 10 June 1997 by Michelena Hallie, the Vice President and Assistant Secretary of Paramount Pictures Corporation, a position she has held since 1993. She says that the mark MISSION IMPOSSIBLE was first used by Paramount in 1966, the year that the television series MISSION IMPOSSIBLE was first broadcast in the United States of America. This series was broadcast in the United Kingdom by the BBC in the early 1970s. A total of 54 episodes were broadcast on a weekly basis between 1970 and 1974 and repeats of this series were broadcast between 1986 and 1988. The second television series was screened by Channel 4 during the period October 1995 and September 1996.

30 In 1996 the movie MISSION IMPOSSIBLE was released in the United States and the United Kingdom and many other countries. This film starred Tom Cruise, Jon Voight and Emanuelle Beart.

35 Ms Hallie says that the MISSION IMPOSSIBLE television series and film have acquired a huge number of fans throughout the world. She exhibits (MH1) the book "The Complete MISSION IMPOSSIBLE Dossier". This book was first published in the United States of America under licence from Paramount in 1991 and pages numbered 156, 161 and 428 are said to demonstrate the fact that the television series is internationally famous.

40 The MISSION IMPOSSIBLE mark has been the subject of product licenses in respect of audio recordings featuring music from the motion picture, video tape and cassettes, audio cassettes of the novelisation of the screenplay, books, clothing, music guides, badges, posters etc (MH2). A page from Paramount Special Effects Catalogue (Winter 1990) offering
45 MISSION IMPOSSIBLE merchandise is exhibited at MH3 along with photographs of products bearing the mark (MH4).

Over the past five years Paramount's turnover in MISSION IMPOSSIBLE goods ie television series, the film and licensed products in the United Kingdom are said to have been as high as the figures given below:

5 **United Kingdom**

	<u>YEAR</u>	<u>Merchandising Revenue in US Dollars</u>
10	1996	3,100
	1997*	8,000

15 * Figures reflect period January 1997 to 26 April 1997

Worldwide

	<u>YEAR</u>	<u>Merchandising Revenue in US Dollars</u>
20	1994	2,960
25	1995	11,809
	1996	1,241,160
30	1997*	98,276

* Figures reflect period January 1997 to 26 April 1997

35 Ms Hallie expresses the belief that the applicants have deliberately chosen a mark for their products which is designed to benefit unfairly from association with Paramount's mark and that the applicants have deliberately endeavoured to gain maximum advantage from the reputation Paramount has built up in the mark MISSION IMPOSSIBLE.

40 Most of the rest of Ms Hallie's declaration is devoted to recording information relating to the corporate circumstances of the applicant company and database searches relating to the directors. Suffice to say that as a result of private investigators' reports it is said that the company did not trade during the years ended 31 July 1994 and 1995 and that there was no use of the mark prior to the filing date. A copy of a letter from the company's chartered accountants is exhibited (MH7) indicating their client's proposed future business activities. A copy of a before action letter from the opponents' trade mark attorneys is exhibited at 45 MH9. The letter requested, inter alia, withdrawal of the application. The opponents conclude from all this that the mark MISSING IMPOSSIBLE is not in use at the present time, was not

in use at the date of application and that there is no intention to use the mark on all of the goods and services covered by the application.

That completes my review of the evidence.

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I have quoted above the wording adopted by the opponents in their statement of grounds. At the hearing Mr Shipley provided some clarification of the nature of the objections and I will deal with this in the decision that follows. I do not propose to comment further on the reference to Section 37(4). That section sets out the procedure to be adopted by the registrar in examining an application. To the extent that there are grounds for refusal these must be considered under Sections 3 and 5. I propose to start with the objection that use of the mark applied for is liable to be prevented by the law of passing off. This goes to Section 5(4)(a) of the Act which reads as follows:

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“ (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 -

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(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)

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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.”

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A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The first of the three essential elements is that the opponents must establish that they have a reputation and goodwill in this country. Section 5(4)(a) is intended to implement Article 4(4)(b) of EC Directive 89/104. It is clear from the wording of the Directive that the right to prevent use of the mark applied for must have existed prior to the date of the application (there being no priority claim in this case). The opponents' position must, therefore, be considered as at the material date of 6 February 1996. The opponents' case rests on the reputation established by the television series, MISSION IMPOSSIBLE, the film of the same name and the sale of licensed products under the mark. The television series is said to have been first broadcast in this country in the early 1970s with repeats going out between 1986 and 1988. A second series was broadcast by Channel 4 between October 1995 and September 1996. The film was released in 1996 but no further details are given so it is not possible to come to a view on whether it is of assistance to the opponents given the material date in these proceedings of February 1996. Although some 54 episodes of the television series were broadcast between 1970 and 1974 no viewing figures have been given and no evidence has been filed by way of survey or questionnaire evidence to enable me to form a view on public awareness or perception of the mark. It is also evident from the above dates that the television series was out of the public eye for quite long periods. If there were sales of licensed products which helped keep the reputation alive it is not evident from information supplied (I will consider this evidence further below but suffice to say that no sales figures are given for the United Kingdom prior to 1996). Nevertheless I do not think it is necessarily fatal to the opponents' cause that there may have been gaps in usage. It is well established that residual goodwill can still exist (see *Ad-lib Club Ltd v Granville* 1972 RPC 673 and *Thermawear Ltd v Vedonis Ltd* 1982 RPC 44). It is really a matter for me to decide on the facts and circumstances of the case before me taking into account also the nature of the goods and services involved. It seems to me, for instance, that a residual reputation is more easily established in the context of goods or equipment for which there may be a continuing replacement parts, spares, or servicing business than say disposable consumer items where no such "after sales" trade exists. Whilst it is common practice for successful television series to be repeated I do not consider there is any absolute expectation that this will happen. Given also the ephemeral and changing nature of much television entertainment it seems to me that the case for the existence of a residual reputation is one that needs to be established with great care. The burden of proof must also, I think, increase the longer programme and/or associated merchandising items are unavailable or not being publicly promoted. In all the circumstances of this case I am unwilling to assume that the opponents have the reputation claimed on the basis of the television series.

However the opponents also put their case on the basis of sale of licensed products. It can be seen from the evidence summary that a wide range of goods is involved some of which (notably audio and video recordings) are natural spin-offs from the television programmes and film. It is not clear when such trade commenced. The only concrete information is the merchandising revenue figures referred to above which suggest sales of goods to the value of \$3,100 in the United Kingdom during 1996. As no further breakdown is given it is not possible to deduce what proportion of this sum (if any) relates to the period prior to the application filing date of 6 February 1996. The figure is also said to relate to all the licensed goods. Given the range of goods involved and (presumably a broad geographical spread) it seems to me that the sales are little more than at a de minimis level. In short the opponents

have in my view failed to substantiate their position in relation to the first leg of the passing off test.

5 In the light of my above finding I do not need to give detailed consideration to the issues of
misrepresentation and damage. However, against the possibility that this decision may be the
subject of an appeal, I will briefly record my view on the marks themselves. This is that,
whilst the marks are distinguishable on the basis of a careful visual comparison, such an
10 approach is artificially narrow. The marks are very close phonetically and differ only in ways
that would not survive the traditional tests of imperfect recollection and allowance for slurred
speech. Had the matter rested on the marks themselves, therefore, I would have come to the
clear view that, for the purposes of the test, they are sufficiently similar that a common trade
source would mistakenly be assumed. I bear in mind also in reaching this view that on the
15 basis of the specification before me there is a direct overlap between the applicants' goods
and services and those of the opponents. However for the reasons given in relation to the
matter of the opponents' reputation the action fails under Section 5(4)(a).

The opponents have also said that their mark is entitled to protection under the Paris
Convention as a well-known mark. On this basis they say the mark applied for offends
20 against Section 5(2)(b) so far as identical or similar goods or services are concerned and
Section 5(3) so far as dissimilar goods or services are concerned. These sections read as
follows:

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

- 25 (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,

30 there exists a likelihood of confusion on the part of the public, which includes the
likelihood of association with the earlier trade mark.

(3) A trade mark which -

- 35 (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to
those for which the earlier trade mark is protected,

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

The United Kingdom's obligations under Article 6 bis of the Paris Convention (the well-known marks provision) have been implemented by Section 56 and Section 6(1)(c) of the Trade Marks Act 1994. So far as is relevant to this action these read as follows:

5 “56.- (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who -

10 (a) is a national of a Convention country, or

 (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

15 whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.”

20 and

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

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

30 (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

35 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

40 I have already indicated in dealing with Section 5(4)(a) that I find the respective marks to be confusingly similar and that there is a direct overlap in terms of the goods and services. I should say in passing that the opponents refer to their ownership of an application to register MISSION IMPOSSIBLE. I understand that that application has now progressed to registration but it does not of course constitute an earlier trade mark within the meaning of Section 6(1)(a) as it does not have a filing date earlier than that of the mark under attack. Their claim to an earlier trade mark can only, therefore, be made on the basis that they are the proprietors of a well-known mark. I should say at this point that it was part of Mr Moore's submission at the hearing that MISSION IMPOSSIBLE was the name of a television

programme and film and was not being used as a trade mark. I have some sympathy with this view at least in relation to a number of the items depicted in the exhibits. Exhibit MH3, for instance, (quite apart from appearing to be a US publication) shows a number of goods such as clothing, mugs and a watch where it is at least arguable as to whether it is trade mark usage or merely as promotional material for the television programme. In relation to goods or services which would be considered identical or similar (videos etc) I do not think there is sufficient evidence to take an informed view of the matter. Even allowing for this area of doubt I have already concluded in relation to Section 5(4)(a) that the opponents have failed on the basis of use to establish their claim to a reputation in this country. In comparison it is apparent from Section 56 that a party claiming well-known mark protection does not need to carry on business or have any goodwill in this country. Nevertheless it seems to me that in the absence of such use very persuasive evidence indeed is needed if the claim to ownership of a well-known mark is to be upheld. Although the opponents refer in their evidence to worldwide merchandising revenue they do not say how this would have created an impact in this country over and above that generated by the United Kingdom television broadcasts and small amount of associated merchandising. I am not persuaded, therefore, that the opponents have made good their claim to a well-known mark for Section 5(2)(b) purposes. At the hearing Mr Shipley conceded that if he did not succeed under Section 5(2) or 5(4)(a) he was unlikely to be in a better position under Section 5(3) in relation to dissimilar goods. I confirm that that is also my view. I would simply add that, if Section 5(3) had played a more significant part in these proceedings, one of the issues I would have needed to consider is whether a well known mark needs to be registered in this country given the provisions of Article 16(3) of the TRIPS Agreement in relation to Article 6 bis of the Paris Convention. The opposition based on a claim to a well-known mark, therefore, fails in relation to both Sections 5(2)(b) and 5(3).

There remains the objection based on Section 3 of the Act. The opponents rely on two separate grounds of attack. Firstly, it is said that the applicants adopted the mark in bad faith to benefit unfairly from association with Paramount's mark and secondly, that there was no bona fide intention to use the mark in relation to all the goods and services. Both grounds go to Section 3(6) which reads:

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

In my view the first of the grounds, although touched on very briefly in the evidence, was not explicitly pleaded and relies on the general reference in the statement of grounds to Section 3. This is a somewhat unsatisfactory situation bearing in mind the comments of Mr Hobbs QC in relation to proper particularisation of pleadings in *WILD CHILD Trade Mark* 1998 RPC 455 at page 459 line 6 et seq. In any case I do not consider that the opponents have substantiated their case. The opponents fail in this aspect of their Section 3(6) attack.

The second matter, that is to say the question of intention to use was dealt with rather more fully in the evidence and in submissions at the hearing. I should say also that this objection is specifically referred to in the statement of grounds by reference to Section 32(3). Strictly speaking that section does no more than set out a requirement for an application to register a

mark. The trade mark application form (TM3) contains a statement which the applicant or a professional representative signs by way of compliance with the requirement. Any challenge that the statement was made in bad faith falls to be considered under Section 3(6) of the Act.

5 Mr Shipley made much at the hearing of the absence of any evidence of use by the applicants. However that does not necessarily weigh against the applicants given that it is perfectly permissible to file an application on the basis of an intention to use rather than actual use. The opponents have also filed evidence resulting from their investigations into the applicants' corporate circumstances. I have recorded brief details of this in my summary of the evidence.
10 Whilst this material cannot be conclusive as to the applicants' intentions at the filing date I would nevertheless have expected not merely a rebuttal by the applicants but some more concrete information in support of their position. In the event they have filed no evidence and so have not clarified their intentions so far as the full range of goods and services is concerned. At the hearing Mr Moore, for the applicants, confirmed that they were proposing
15 to produce videos, etc for sports training and instructional purposes. In particular they planned a range of such goods covering initially golf and tennis but extending possibly to other sports as well. This is broadly consistent with the following extracts from the counterstatement:

20 "... The Applicant has offered to limit their specification of goods in class 9 as is inferred in class 41, to the provision of videos etc. relating to training programmes for sports such as golf and tennis but as yet no reply has been received from the Opponents."

25 and

"... The Opponents goods relate purely to the provision of entertainment while the Applicant's goods relate to the provision of training/education in a specific area."

30 Whilst Mr Moore did not go so far as to rule out any intention on the part of the applicants to trade outside the area indicated I understood him to say that there is no settled intention to do so. I am, therefore, left with the impression that the applicants had no present and definite intention at the time of filing to use the mark across the full range of goods and services covered by the specification set out at the start of this decision. I accept also Mr Shipley's
35 observations as to an element of ambiguity in the Class 41 specification in so far as the qualification "for sports training" does not clearly apply to the services as a whole. In the event the opposition succeeds to the extent that the applicants have not persuaded me that they had an intention to use their mark in relation to the full range of goods and services.

40 As grounds for refusal exist only in respect of certain goods and services the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a TM21 restricting the specification as follows:

45 Class 9 - Video and audio tapes, CD-ROMS, laser discs and electro magnetic storage media; all relating to sports training.

Class 41 - Production, hire, rental and leasing of instructional videos for sports training.

5 The application will be refused so far as the remainder of the specification is concerned.

If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

10 As the opponents have been successful they are entitled to a contribution towards their costs.

15 I note that the specification proposed above is broadly in line with an offer made by the applicants and recorded in the counterstatement. The opponents' agents initially contacted the applicants' agents with a warning letter dated 22 October 1996 but subsequently filed the opposition without further ado shortly after the period set for response to their letter had expired but before the end of the opposition period. The applicants' offer was said at the hearing to have been made on 24 November 1996. Making the best I can of these circumstances I consider that a reduced award of £375 is appropriate if the applicants accept my above proposal and I so order. If the applicants decline to do so the opposition will have succeeded in its entirety and I will order the applicants to pay the opponents the sum of £750.

20 **Dated this 30th day of November 1998**

M REYNOLDS

For the Registrar

25 **the Comptroller General**