

**O-329-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 3021757  
BY QUEENSBURY BOXING IP LIMITED  
TO REGISTER THE TRADE MARK  
QUEENSBERRY  
IN CLASSES 35 & 41  
AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 401559 BY  
QUEENSBERRY PROMOTIONS LIMITED**

## BACKGROUND

1) On 12 September 2013, Queensberry Boxing IP Limited (hereinafter the applicant) applied to register the trade mark QUEENSBERRY in respect of the following services:

- In class 35: Agency services for sporting and entertainment clients.
- In Class 41: Providing of training; provision of training for sports and general entertainment purposes; entertainment in the nature of boxing contests; organization of boxing matches; organisation of sporting events; entertainment; sporting and cultural activities; booking of seats for shows; entertainment information; presentation of live performances; organization of shows; organization of sports competitions; production of shows; timing of sports events; booking of sports facilities; providing facilities for sports tournaments; providing facilities for entertainment; providing facilities for sports events; provision of facilities for live band performances; provision of leisure facilities; leasing of sports facilities; advisory services relating to the organisation of sporting events; arranging of sporting events; rental of equipment for use at sporting events; entertainment services in the form of boxing events; organising of sporting activities, of concerts and of competitions; ticket information services for entertainment events; booking of sports personalities for events (services of a promoter); boxing promotion services (services of a promoter); organisation of events for cultural, entertainment and sporting purposes; live entertainment production services; live entertainment services; organisation of live shows; presentation of live performance; production of live entertainment; production of live performances; providing sports training facilities for ice hockey, boxing, soccer, basketball, track and field, and tennis; the production or co-production of sports and entertainment events, concerts, conventions and exhibitions, for public exhibition, viewing and for radio, television and pay-per-view television broadcast; provision and operation of fan clubs; provision of electronic games including through the Internet.

2) The application was examined and accepted, and subsequently published for opposition purposes on 18 October 2013 in Trade Marks Journal No.2013/042.

3) On 17 January 2014 Queensberry Promotions Limited (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

- a) The opponent has used the trade mark QUEENSBERRY PROMOTIONS since 27 August 2010 in respect of the following:

Agency services for boxers; entertainment in the nature of boxing contests; organisation of boxing matches; organisation of boxing events; booking of seats for boxing events; entertainment information; presentation of boxing events; production of boxing events; booking of boxing facilities; providing facilities for boxing events; advisory services relating to the organisation of boxing events; arranging boxing events; rental of equipment for use at boxing events; entertainment services in the form of boxing events; ticket information services for boxing events; booking of boxers for events (services of a promoter); boxing promotion services (services of a promoter); the production or co-production of boxing events, for public exhibition, viewing and for radio, television and pay-per-view television broadcast.

- b) The opponent is a professional boxing promoter t/a QUEENSBERRY PROMOTIONS. It has licensed two people, Frank Warren and Andy Ayling to use the name in the UK to arrange boxing promotions. In addition the opponent itself has arranged boxing promotions. All goodwill has accrued to the opponent. At the relevant date the opponent enjoyed a significant reputation in its mark. Use of the mark in suit will cause a misrepresentation which will damage the reputation of the opponent and cause it financial and non-financial loss. The mark in suit therefore offends against section 5(4)(a) of the Act.
- c) The opponent also contends that the application offends against Section 3(6) of the Act; stating:

“The applicant has no intention of providing the applied for services and has made the application in bad faith. The applicant’s group of companies, the Sports Direct group, is a retail operation and has no interest in promotions. At the date of the application, however, the applicant was fully aware of the opponent’s reputation in the name “QUEENSBERRY PROMOTIONS”. The application has been made because Mr Frank Warren, a former director of the opponent whose son is a director of the opponent, is a director of the successful claimant in the related Court proceedings, in which the applicant is a defendant. The application amounts to an attempt to prevent the legitimate use of the “QUEENSBERRY PROMOTIONS” name by the opponent in the course of trade, in order to exert pressure on Mr Frank Warren in the context of negotiations between the parties concerning those related proceedings. Accordingly, the applicant has not acted in accordance with the standards of acceptable commercial behaviour observed by reasonable and experienced persons in the relevant commercial field when applying for the registration. Consequently, the application was filed in bad faith to all services claimed and should be refused in its entirety.”

4) On 24 March 2014, the applicant filed a counterstatement. It puts the opponent to proof of its reputation and denies that its first use was 27 August 2010 as claimed as this is merely the incorporation date of the opponent. The applicant casts doubt on whether the opponent has used its mark in relation to all of the services claimed in paragraph 3 above. The applicant points out that the licenses to the two named individuals have not been filed and the relationship between Mr Frank Warren and the opponent is not explained as he was a director of the company when he is said to have been licensed by it to use the name. The applicant denies that it has no intention of using the mark applied for in relation to the services for which it sought to be registered. The applicant is the owner of UK registration No: 2491149 for the mark QUEENSBERRY BOXING 1867. The mark was applied for on 26 June 2008 and registered on 27 August 2010 in respect of classes 16, 35 & 41, and is thus an earlier right. The applicant denies that this case has anything to do with the High Court proceedings (HC12 804597) involving Boxing Brands Limited. The applicant points out that whilst Mr Frank Warren is related to a director of the opponent company this does not in itself create a commercial business relationship. It is claimed that Frank Warren has stated publicly that he has no connection to the opponent and is not a shareholder or director. If however there is a relationship as claimed by the opponent, the applicant requires it to be proved. Lastly, the applicant denies that the opponent has been successful in the Court proceedings relating to Boxing Brands Ltd as the case is under appeal.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 22 June 2015 when the opponent was represented by Mr Aikens of Counsel instructed by Messrs Gordon Dadds LLP; the applicant was represented by Ms Himsworth Q.C. instructed by Messrs Lane IP Ltd.

## OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 28 July 2014, by George Warren the Managing Director. He states that "in essence, we sign up boxers, arrange matches for them and promote those matches to the paying public both at the events themselves and on television". He states that the business was launched in September 2011 and that since then it has arranged high profile boxing promotions under the name QUEENSBERRY PROMOTIONS and has accrued goodwill. I note that in the various documents provided as exhibits the television coverage appears to be carried out under the name "BoxNation" which would appear to be owned by Mr Frank Warren. On page 8 of this exhibit in regard to one of the events, it states that tickets are available from Frank Warren Promotions Box Office by phone or online at [www.frankwarren.tv](http://www.frankwarren.tv).

7) Mr Warren states that boxing is, primarily, a niche sport which occasionally crosses into the mainstream. He states that the opponent's revenue comes from selling tickets to its boxing events and also from the broadcasting rights. He states that within the boxing business the "Queensberry Promotions" brand has had considerable exposure and is well known. He states that prior to the relevant date, 12 September 2013, all promotion work was via the Frank Warren Promotions website. This website was well known and viewed by over 170,000 users during the period August 2012-12 September 2013. In addition, Mr Warren's father (Frank) was a high profile boxing promoter and he and his team assisted the opponent to make a considerable impact in the boxing industry from its inception. He cites the press attention paid to "the sons of Frank Warren" i.e. the opponent and the fact that the events organised were broadcast via BoxNation which has an average subscriber base of 100,000. The average number of attendees at each boxing event has been over 1,000 persons. The Queensberry promotions name features on the canvas and also the corner posts (pages 21&23 of exhibit 1 refer). In total he states that there were ten events promoted prior to the relevant date, albeit that one actually took place just after the date. Mr Warren provides the following exhibits:

- GW1: The exhibit includes a number of press releases which emphasise the independence of Queensberry Promotions Ltd from Frank Warren and his companies. This includes a number of pages from various websites which shows that boxing events were organised in the following cities on the dates shown.

Location	Date
London	September 2011
London	October 2011
London	April 2012
Manchester	May 2012
London	May 2012
London	September 2012
Liverpool	November 2012
London	21 September 2013 (after relevant date)

- GW2: Copies of letters from the applicant's legal advisors. The first letter, dated 7 June 2013 is addressed to Queensberry Promotions Ltd and states that the applicant is the proprietor of registered trade mark 2491149 and draws particular attention to the following services for which the mark is listed: "Agency and business management services for sporting and

entertainment clients; provision of training for sports and general entertainment purposes; provision of sporting and cultural activities and entertainment. The letter then continues:

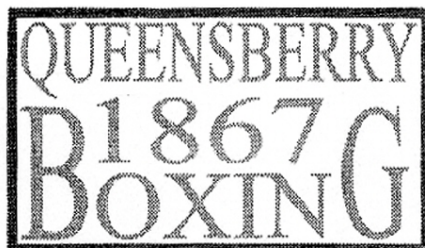
“It appears that Queensberry Promotions Ltd has been supplying services under the sign “QUEENSBERRY PROMOTIONS”. The services supplied by Queensberry Promotions Limited under the QUEENSBERRY PROMOTIONS sign include services that are identical and/or highly similar to those services covered by the trade mark.”

The letter includes screen prints from the website of Queensberry Promotions Ltd and Frank Warren showing various boxing matches arranged. There was also a report dated 3 September 2013 (at page 27 of the exhibit) which announced a joint venture between Mr Frank Warren, Queensberry Promotions and Bill Ives (described as a steel tycoon). The report states that the three parties “have signed an exclusive agreement to create a powerful, new, promotional organisation”. It also includes a draft legal agreement whereby Queensberry Promotions Ltd would agree to cease use of the sign referred to in the letter. On the same date a similar letter which included a copy of the letter sent to Queensberry Promotions Ltd was sent to Mr Frank Warren. The letter referred to use of the sign Queensberry Promotions by Mr Warren and contained the same request to cease use. A further letter was sent to both Queensberry Promotions Ltd and Mr Frank Warren on 26 September 2013 noting that a response had not been received and that the sign continued to be used by both parties. It noted that use of the sign on highly similar or identical services amounted to infringement and again threatened legal action.

## **APPLICANT’S EVIDENCE**

8) The applicant filed a witness statement, dated 20 November 2014, by Steve Lane the applicant’s Trade Mark Attorney. He states that contrary to the claims made in the opponent’s evidence the opponent company was dormant during the financial years ended on 31 March 2011, 31 March 2012 and 31 March 2013. The accounts were signed off by the Board of Directors in the first instance, which included Mr George Warren, and by George Warren himself on the latter two occasions. He also states that there is no evidence in the accounts of any licence agreements.

9) Mr Lane states that the applicant’s predecessor in business registered trade mark number 2491149. This mark was assigned to the applicant on 21 February 2012 together with all rights and goodwill. Around November 2012 Boxing Brands Limited issued proceedings against the applicant for trade mark infringement. At the time of his statement this case was ongoing. He states that given the uncertainty surrounding the assigned right the applicant sought to reinforce its position by filing the mark in suit, which differs from the assigned mark. At paragraph 8 he states: “The Applicant’s intention at the time of filing the Application was to ensure that the services covered were protected as they had not ruled out the possibility of moving into any of these services in the future (whether itself or through licensing third parties)”. He goes on to refer to the applicant’s earlier registration 2491149 for the following mark:



10) Mr Lane provides Exhibit SL1 which consists of copies of the annual accounts for Queensberry Promotions Limited for the years ending 31 March 2011, 31 March 2012 and 31 March 2013. Each set of accounts states that the company did not trade during the year covered by the accounts.

## **OPPONENT'S EVIDENCE IN REPLY**

11) The opponent filed a witness statement, dated 6 February 2015, by George Warren who has provided evidence earlier in these proceedings. He states that he makes the statement on behalf of the opponent, Queensberry Promotions Limited. He continues:

“3. As I believe my first witness statement made clear, I and the team at Frank Warren Promotions described in my first witness statement undertook considerable trading activities under the Queensberry Promotions mark in the field of boxing promotion between September 2011 and September 2013.

4. I wish to make it clear that in my first witness statement, where I referred to “the opponent” or “QPL”, prior to November 2013, I was referring to a business, rather than a specific legal entity, trading as Queensberry Promotions. The correct position is that Queensberry Promotions is a brand name that was used, among other brand names, by the business known as Frank Warren Promotions (“FWP”). Until November 2013, FWP was owned by W Promotions Ltd. However, in November 2013, the business and assets of FWP were transferred to QPL.

5. I apologise for any misunderstanding caused by any suggestion I may have made in my First Witness statement that the opponent/QPL was prior to November 2013 the owner of the goodwill generated in the Queensberry Promotions name. The purpose of my first witness statement was to demonstrate in evidence the activities carried out under the Queensberry Promotions brand and not the strict legal ownership of the goodwill in the brand, which prior to November 2013 belonged to W Promotions Ltd as legal owner of FWP.

6. Regarding Mr Lane’s evidence, as far as the filed accounts are concerned, it is correct that the money generated by our activities was not going into the opponent’s bank account and that the business was trading under the umbrella of FWP. However, that does not mean that we were not using the trading name Queensberry Promotions because clearly we were.

### **Assignments of goodwill to the opponent**

7. In August 2013, administrators to W Promotions Limited were appointed, and they licensed the business of FWP to be run as a going concern by the opponent.

8. On 29 November 2013, the opponent acquired the business and assets, including all intellectual property and goodwill of FWP, pursuant to a business sale agreement W Promotions Ltd (In Administration) and the Joint Administrators of W Promotions Limited. A copy of the signed Agreement for the sale of the business by Joint Administrators dated 29 November 2013 (“the agreement”) is at confidential exhibit GW3.

9. In the Agreement, the definitions of “Business” and “Name” make it clear that W Promotions Limited was carrying on the business of FWP as at the date of the agreement.

10. In the Agreement, “Intellectual Property” is defined to include “all trade and service marks (both registered and unregistered)” belonging to W Promotions Limited. By Clause 2.1.4 QPL purchased the Intellectual Property.

11. At exhibit GW4 is a copy of the Final Progress Report of the Joint Administrators of W Promotions Limited which (at section 4) confirms the sale of the business and assets of W Promotions Limited to the opponent on 29 November 2013.

12. A copy of the opponent's latest filed accounts for the year ended 31 March 2004 [sic] is at exhibit GW5. These accounts reflect the acquisition by the opponent of FWP during the financial year, on 29 November 2013.

13. If and to the extent that goodwill in the Queensberry Promotions name accrued to FWP, then such goodwill was transferred to Opponent [sic] under the Agreement.

14. If and to the extent that the goodwill generated by me for that business trading as Queensberry Promotions vested in me personally and not in FWP or the Opponent, I hereby assign that goodwill to the opponent."

12) Mr Warren also provided the following exhibits:

- GW3: This is a confidential exhibit and consists of a copy of the Agreement for the sale of a business between W Promotions Limited (In Administration), the Joint Administrators and the opponent. It provides the following definitions:

"Goodwill: Means the goodwill (if any) and connections of the Business together with the exclusive right as between the parties to represent the purchaser as carrying on the business in succession to the vendor and such right as the vendor may have to use the name."

"Intellectual Property: means, all inventions (whether patentable or not), patents, utility models, designs (both registered and unregistered and including rights in semiconductor topographies), copyright and related rights, database rights, trade and service marks (both registered and unregistered) and rights in confidential information, together with all applications for, rights to the grant of extensions of the same, and all other intellectual and industrial property including but not limited to all similar or analogous rights throughout the world, in each case for the full term of the relevant right."

"Name: means the name "Frank Warren Promotions" under which the Vendor has operated the business as at the completion date."

- GW4: This consists of a copy of the Administrator's Progress report in respect of W Promotions Limited in respect of the period 23 February 2014 to 26 June 2014. At page 60 of the exhibit it refers to the sale "of the Company's business and assets to Queensberry Promotions Limited ("Queensberry") concluded on 29 November 2013. At page 62 it states that during the administration the administrators "Granted a license to trade to Queensberry which enabled ongoing trade and maintained jobs of employees whilst the details of the sale were agreed".
- GW5: This is a copy of the abbreviated accounts for Queensberry Promotions Limited for the year ended 31 March 2014. Under the heading "Accounting Policies" it states: "Turnover: turnover represents net invoiced sales of goods, excluding value added tax" (my underlining); and "Goodwill: Goodwill, being the amount paid in connection with the acquisition of a business in 2013, is amortised evenly over its estimated useful life of three years".

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

## DECISION

14) The applicant requested to cross examine Mr George Warren on his evidence and permission was granted. However, two days prior to the hearing the opponent contacted the Registry to amend the pleadings by withdrawing the ground of opposition under section 5(4)(a), and making it clear that apart from exhibit GW2 it did not rely upon any of the evidence in Mr Warren's witness statements. It therefore requested that he no longer be subject to cross examination. The applicant accepted the amendment to the pleadings but contended that they still wished for the cross examination to go ahead. As the only part of the evidence relied upon by the opponent consists of four letters written by the applicant's legal advisors I agreed that Mr Warren should not face cross examination.

15) The only ground of opposition is under section 3(6) which states:

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

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

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

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

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

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

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



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

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

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

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

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

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

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

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

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

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

*"Lack of intention to use as a ground of bad faith: earlier case law"*

139. There have been a series of cases in which courts and tribunals have had to consider whether a lack of intention to use the trade mark on the part of the applicant constitutes bad faith within section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation. It should be noted at the outset that there are a number of variants of this question, including the following:

(1) whether the making of a declaration of intention to use the mark as required by section 32(3) of the 1994 Act, which is false because in fact the applicant did not intend to use the mark, amounts to bad faith;

(2) whether an intention to use the mark in relation to some goods covered the application, but not others - and hence a statement of intention to use that is true in relation to the former goods, but not in relation to the latter – amounts to bad faith; and

(3) whether a lack of intention to use amounts to bad faith if there are exacerbating factors, such as (a) an attempt to obtain protection for an unregistrable mark or (b) an attempt to block others from registering the mark by repeated applications.”

AND:

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

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

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

18) I also look to the comments in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others [2009] RPC 9 (approved by the COA in [2010] RPC 16), where Arnold J. stated that:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

19) The opponent referred me to Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I- 4893, where it was stated:

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

- the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;
- the applicant’s intention to prevent that third party from continuing to use such a sign; and
- the degree of legal protection enjoyed by the third party’s sign and by the sign for which registration is sought.”

20) The opponent also referred me to Case C-320/12 *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* [2013] Bus LR 1106. At [36] the court held as follows:

“...in order to determine the existence of bad faith, it is necessary to carry out an overall assessment, taking into account all the factors relevant to the particular case which pertained at the time of filing the application for registration, such as, inter alia, whether the applicant knew or should have known that a third party was using an identical or similar sign for an identical or similar product. However, the fact that the applicant knows or should know that a third party is using such a sign is not sufficient, in itself, to permit the conclusion that that applicant is acting in bad faith. Consideration must, in addition, be given to the applicant's intention at the time when he files the application for registration of a mark, a subjective factor which must be determined by reference to the objective circumstances of the particular case.”

21) For their part the applicant referred me to the comments of Mr Hobbs acting as the Appointed Person in *Ian Adam* trade mark [2011] RPC21 where he stated:

“35. In assessing the evidence, the decision taker is entitled to draw inferences from proven facts provided that he or she does so rationally and without allowing the assessment to degenerate into an exercise in speculation. The Court of Justice has confirmed that there must be an overall assessment which takes into account all factors relevant to the particular case: Case C-529/07 Chocoladefabriken Lindt & Sprüngli AG v. Franz Hauswirth GmbH [2009] ECR I-4893 at paragraph [37]; Case C-569/08 Internetportal und Marketing GmbH v. Richard Schlicht [2010] ECR I-00000 at paragraph [42]. As part of that assessment it is necessary as part of that approach to consider the intention of the applicant at the time when the application was filed, with intention being regarded as a subjective factor to be determined by reference to the objective circumstances of the particular case: Chocoladefabriken Lindt & Sprüngli GmbH (above) at paragraphs [41], [42]; Internetportal and Marketing GmbH (above) at paragraph [45]. This accords with the well-established principle that ‘national courts may, case by case, take account -on the basis of objective evidence -of abuse or fraudulent conduct on the part of the persons concerned in order, where appropriate, to deny them the benefit of the provisions of Community law on which they seek to rely’: Case C16/05 The Queen (on the applications of Veli Tum and Mehmet Dari) v. Secretary of State for the Home Department [2007] ECR I-7415 at paragraph [64].

36. The concept of assessing subjective intention objectively has recently been examined by the Court of Appeal in the context of civil proceedings where the defendant was alleged to have acted dishonestly: Starglade Properties Ltd v. Roland Nash [2010] EWCA Civ 1314 (19 November 2010). The Court considered the law as stated in Royal Brunei Airlines v. Tan [1995] 2 AC 378 (PC), Twinsectra Ltd v Yardley [2002] 2 AC 164 (HL), Barlow Clowes International Ltd v. Eurotrust International Ltd [2006] 1 WLR 1476 (PC) and Abu Rahman v. Abacha [2007] 1 LL Rep 115 (CA). These cases were taken to have decided that there is a single standard of honesty, objectively determined by the court and applied to the specific conduct of a specific individual possessing the knowledge and qualities that he or she actually possessed: see paragraphs [25], [28], [29] and [32]. This appears to me to accord with treating intention as a subjective factor to be determined by reference to the objective circumstances of the particular case, as envisaged by the judgments of the Court of Justice relating to the assessment of objections to registration on the ground of bad faith.”

22) The applicant also relied upon the following comments of Mr James in O-026-06 *NEW COVENT GARDEN* TM:

“65. In *Demon Ale* [2000] RPC 345, Mr Geoffrey Hobbs Q.C., as The Appointed Person, upheld a bad faith objection on the ground that the applicant for registration of a trade mark had no intention of using the mark in respect of the goods listed in the application, contrary to the statement on the form of application required by section 32(3) of the Act. The statement required is that:

The trade mark is being used by the applicant or with his consent, in relation to those goods or services (listed in the application), or that he has a *bona fide* intention that it should be so used.

66. Although section 3(6) is based upon Article 3(2)(d) of the Directive, section 32(3) does not come from the Directive. It is a home grown requirement. Nevertheless, Mr Hobbs saw no reason to doubt that section 32(3) was compatible with the Trade Mark Directive. He noted that the 8th recital to the Directive specifically confirms that “in order to reduce the number of trade marks registered and protected in the Community...it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation.”

67. In *Reckitt Benckiser (UK) Ltd v Robert McBride Ltd*, BL 0/355/04, Mr Arnold, sitting as The Appointed Person, similarly saw no incompatibility between section 32(3) and the Directive.

68. However, in *Knoll AG's Trade Mark* [2003] RPC 10, Mr Justice Neuberger (as he then was) appeared to believe that there may some tension between the requirement of section 32(3) of the Act and the provisions of the Directive. He said:

“33. ....there is force in Mr Campbell's submission that one must be a little careful about founding a conclusion of bad faith, for the purposes of s.3(6) on the basis of a statement made as a result of the requirements of s.32(3) of the 1994 Act. As I have mentioned, as a matter of basic EC law, the UK is bound to give effect to the Directive. While, as I have also mentioned, s.3(6) of the 1994 Act derives from, and is consistent with, Art.3(2)(d) of the Directive, there is no equivalent to s.32(3) of the 1994 Act in the Directive, as Jacob J. pointed out in *La Mer Technology Inc. v Laboratories Goemar* [2001] All E.R. 296 at para.19(e). Accordingly, as Jacob J. went on to explain, OHIM "are quite content to permit ... very wide specifications."

34. It may therefore be that, if a proprietor loses (or is refused) a UK trade mark, or, indeed a UK extension of an international registration, purely because of the width of the specification claimed, pursuant to the requirements of s.32(3) of the 1994 Act, that may be inconsistent with the Directive. Indeed, I think there may be an argument to the effect that the provisions of s.32(3) of the 1994 Act are of questionable validity in these circumstances, but that is not a point which it is appropriate for me to consider further in this application. All I would say is that the fact that there is no equivalent of s.32(3) of the 1994 Act in the Directive means that this Court should be reluctant, rather than eager, to find in favour of the sort of argument raised by the claimant here.”

69. Although he appears to have envisaged some results which could be incompatible with the Directive, the judge did not find the requirement for a statement under section 32(3) as such to be incompatible with the Directive. In this connection, I note that the fifth recital to the Directive states the member states remain free to set the procedures for obtaining registration. The judge's concern was that section 32(3) should not be viewed as introducing a further substantive ground for refusal for which there is no basis in the Directive. In order to meet this point it is necessary, when considering the interaction between sections 3(6) and 32(3), to focus on the question of whether the applicant made the statement required by section 32(3) in bad faith, rather than on simply the factual accuracy of the statement. I will approach the matter accordingly.”

23) At the hearing the opponent made a number of submissions. In addition, with my permission, the opponent also provided submissions, following the hearing in respect of the comments made in *Cipriani* and posted at paragraph 18 above. In its overall submissions the opponent pointed out that the comments in *Cipriani* and the various other cases cited are no bar to finding bad faith in this case as:

- The Applicant knew of the use of the name QUEENSBERRY PROMOTIONS by the Warren companies in relation to boxing agency and boxing promotion services at the date it filed the Application. This is clear from the Applicant's solicitors' letters to the Opponent and Frank Warren dated 7 June 2013, some three months before the Application's filing date (Exhibit GW2).

- Neither the applicant nor its predecessors in business have used the earlier registered mark 2491149 in relation to the services for which it is registered since April 2011. The applicant had no claim for passing off as it had not used its mark. The services for which the earlier trade mark is registered and the mark in suit is sought to be registered do not form part of the business plan of the opponent or any of the Sports Direct companies. Simply because it owned an earlier registration did not entitle the applicant to file the application in suit which would afford it wider protection when it had never used its existing trade mark for the goods/services for which it is registered.
- Given the history of the dispute between the parties, and the fact that the application in suit was filed just nine days after the announcement by the Opponent of major investment into its Queensberry Promotions boxing promotion business and a new collaboration with Frank Warren (see GW2), it is clear that the reason for the filing of the application was to prevent use of the trade mark QUEENSBERRY PROMOTIONS by the Warren companies and also to use the application in suit as a weapon or bargaining chip in the broader dispute and negotiations between the Sports Direct Companies and the Warren companies. The Applicant has never had any genuine intention to use the trade mark in relation to the services in the specification.
- The letters sent to the opponent and Frank Warren show that the applicant intended to enforce its rights and the applicant stated that one of its goals was to broaden its rights by the filing of the application in suit which expanded the services covered by its earlier registration. It is clear that the applicant's intention was to assert the application against third parties in the same way that it had asserted its rights in the earlier trade mark.
- In response to the allegation of bad faith the applicant chose to file only a witness statement by its legal representative, Mr Lane. There is no evidence from anyone at the Applicant itself responsible for making business decisions relating to the Applicant's areas of commercial activity. Mr Lane cannot give evidence regarding the applicant's intentions. In any event, all Mr Lane stated was that "[t]he Applicant's intention at the time of filing the Application was to ensure that the services covered were protected as they had not ruled out the possibility of moving into any of these services in the future (whether itself or through licensing third parties)." This confirms that the opponent had not provided services under the name QUEENSBERRY, it does not speak to any commitment to use the mark, but merely does not rule out the possibility of moving into a commercial field at some unspecified point in the future. Mr Lane also stated that the application in suit also helped to preserve its position, particularly against third parties who may have wished to expand their activities into the services covered by the Application. It confirms its intention to prevent others using QUEENSBERRY in relation to services in classes 35 and 41. Referring to the disputes between the Warren Group and the applicant (and the Sports Direct Companies) Mr Lane states: "[g]iven the continued uncertainty concerning the QUEENSBERRY brand, the Applicant sought to protect its rights in the QUEENSBERRY brand, by filing various trade marks for, or incorporating, QUEENSBERRY, including the Application." He also stated that the application was filed: "to reinforce and broaden its rights by filing the application for the QUEENSBERRY word mark as opposed to a logo and expanding the services covered by the specification of [the 149 Mark]." These statements confirm that the application was merely a bargaining chip in the dispute with the Warren Group.
- Article 107 applies to Community Trade Marks whereas the application in suit is for a UK registration.

24) Ms Himsworth pointed out that:

- The applicant already has rights in classes 35 & 41 under its earlier trade mark 2491149, and was merely extending these existing rights.
- The pleadings under this ground of the opposition referred to the reputation of the opponent in the mark QUEENSBERRY PROMOTIONS and stated that the applicant sought to prevent the opponent from using the mark. At the hearing the opponent was contending that the “Warren group of companies” would be adversely affected. It was also clear that the opponent is a legal entity which has no reputation in the mark Queensberry Promotions as it had not traded as at the relevant date. Further, Mr Frank Warren has, in various public statements included in the evidence of his son George Warren, made it clear that the opponent is an independent company with no legal link to him.
- The applicant stated that it intended to use the mark when it applied and a person is presumed to have acted in good faith unless the contrary is proved (Case T-136/11 *pelicantravel.com sro v OHIM* [2012] ECR II-0000 at paragraphs [21] and [57]) refers.
- At the date of the application the applicant had a legitimate self interest in filing the mark in suit as the applicant, together with Sportsdirect.com Retail Limited and Lilywhites Limited have been involved in litigation in the High Court against Boxing Brands Limited relating to various trade marks comprising of or including QUEENSBERRY. These proceedings are ongoing but have given rise to commercial uncertainty with regard to the QUEENSBERRY brand. The Applicant wished to ensure that the services covered were protected as they have not ruled out the possibility of moving into any of the services in the future (whether through itself or licensing third parties) and wish to preserve the commercial position in particular with respect to third parties.
- The parties involved in the High Court litigation are not the same as the parties involved in the instant case. In particular Frank Warren is not a party to any of the proceedings.
- The opponent has not provided any evidence to show that the applicant has no intention to use its mark. In the absence of any such evidence and given the statements made by the applicant’s legal representative confirming their intention to use the mark in suit, Ms Himsworth referred me to the comments of Mr Arnold Q.C. sitting as the Appointed Person in *Pan World Brands Ltd v. Tripp Ltd (EXTREME Trade Mark)* on unchallenged evidence. These views have been recently been confirmed by Arnold J in an Appeal from a decision of the Registrar to the High Court in *Dalsouple Société Saumuroise Du Caoutchouc v. Dalsouple Direct Ltd* [2015] ETMR 8 at paragraphs [60] to [63].
- The opponent has not sought to cross examine the applicant’s witness and the evidence of Mr Lane is not obviously incredulous. As such it should be accepted by the Registry.

25) The proximity of the date of filing of the application and the announcement of the opponent’s new venture with two further partners does seem coincidental and suggests that the application was a response to the opponent’s business plans. It is clear that the applicant knew that the mark QUEENSBERRY PROMOTIONS was being used, however it is also clear that the applicant was uncertain as to who had been using the mark. It sent identically worded letters to two distinct legal entities which began “It appears that” the recipient had been using the mark. It was effectively asking a question. It is understandable that the applicant was unsure who was using the mark as, from the

evidence of George Warren a director of the opponent, the opponent was also unsure about which legal entity was using the mark. Nor was it stated what name the new venture referred to in exhibit GW2 would trade under. Although the applicant already had registered rights in a similar mark for services in classes 35 & 41 it does not appear to be in the boxing agency/promotion business itself. Ordinarily the fact that the applicant stated that the application in suit filed to extend its earlier rights and strengthening its hand and the fact that it failed to file evidence from anyone in the business to state what its actual intentions were, would mean that there was no effective response to the opponent's prima facie case. However, the case as pleaded was that the opponent had reputation in the mark and would be prevented from continuing its business. Clearly, the opponent itself did not, at the relevant date, have reputation in the mark as it had not traded up to that point. The opponent had not established any legal rights to the QUEENSBERRY mark. By contrast, the applicant already had a legal right to the mark QUEENSBERRY, under its earlier trade mark number 2491149. The applicant knew that someone was using the mark QUEENSBERRY, and sought to buttress its existing legal rights as the applicant clearly believed that the opponent and/or others had already infringed those rights and intended to do so to a greater extent in the future. To my mind, there is no prima facie case of bad faith and so the applicant's failure to file evidence from an officer of the company is not fatal. The evidence of its legal representative, MR Lane, is clearly hearsay, and reeks of a tactical approach designed to avoid the applicant having to declare its intentions. Taking all of the above into account I find that the application was not made in bad faith. **The opposition under section 3(6) fails.**

## **CONCLUSION**

26) The opponent has failed in its opposition under Section 3(6).

## **COSTS**

27) As the applicant has been successful it is entitled to a contribution towards its costs. At the hearing both sides requested that I issue my decision and then allow them time to provide submissions on costs. The parties have three weeks from the date of this decision to provide such submissions.

**Dated this 14th day of July 2015**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**