

O-173-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3031504
BY QUEENSBURY BOXING LEAGUE LIMITED
TO REGISTER THE TRADE MARK**



**IN CLASSES 35, 41 & 42
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 401903 BY
QUEENSBERRY PROMOTIONS LIMITED**

BACKGROUND

1) On 20 November 2013, Queensberry Boxing League Limited (hereinafter the applicant) applied to register the trade mark shown on the page above in respect of the following services:

- In class 35: Advertising; Internet advertising campaigns; business management; Marketing; Distribution of printed advertising matter; Promotion online including social media websites; search engine optimisation services; advertising services provided via the Internet; accountancy data processing; provision of business information; retail services connected with the sale of dvd's, optical and magneto-optical discs; production of television and radio advertisements.
- In Class 41: Entertainment; sporting and cultural activities, promotion of live sports events including boxing, kickboxing, mixed martial arts, Thai boxing; promotion of televised sporting events; promotion of sporting events via the internet; live streaming of sporting events via the internet; publishing on the internet; Production of television programs, production of video content available online and on dvd and on optical and magneto discs.
- In Class 42: Development of new websites, developing and managing internet websites.

2) The application was examined and accepted, and subsequently published for opposition purposes on 20 December 2013 in Trade Marks Journal No.2013/051.

3) On 20 March 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; promotion of boxing events; booking of boxing facilities; providing facilities for boxing events; advisory services relating to the organisation of boxing events; arranging of 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 in respect of the services in classes 35 and 41 only 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. The opponent does not oppose the services applied for in class 42 or the

following services in Class 35: “accountancy data processing; provision of business information”.

4) On 28 May 2014, the applicant filed a counterstatement, subsequently amended. It states that whilst operating in the UK it does not trade in the promotion of “professional boxing”, and that it acts independently from the professional regulators (the BBBoC) and of the amateur regulators (the ABA). It states to have been using the name QUEENSBURY since August 2009 and have various documents which can show the use of the name. The opponent claims to have used the mark QUEENSBURY on social media such as Facebook, twitter and YouTube since August 2009, and launched a website under the same mark in September 2009. It has promoted DVDs under the name since August 2009 and has had its promotions televised under the QUEENSBURY name since September 2011. It contends it is the senior user.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard, only the opponent provided written submissions.

OPPONENT’S EVIDENCE

6) The opponent filed a witness statement, dated 5 December 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 in the UK and has accrued goodwill.

7) Mr Warren states that boxing is, primarily, a niche sport which occasionally crosses into the mainstream. He states that the true aficionado of boxing will know of the fighters and also the businesses involved, whilst the occasional viewer will not be aware of such information. 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 until the date of the application, 20 November 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 28 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 who, it is contended, all tend to be boxing aficionados. The average number of attendees at each boxing event in London 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 thirteen events promoted prior to the relevant date, although he only lists the following seven events:

York Hall, London: September 2011, October 2011, April 2012, May 2012 & September 2012.
Olympia, Liverpool: November 2012.
Olympic Park, London: September 2013.

8) He states that on 3 September 2013 the opponent announced a major new investment in the business by a steel stockholder company and a new comprehensive collaboration with his father, Frank Warren. He states that this garnered substantial press coverage for the opponent. 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 under the Queensberry Promotions logo:

Location	Date
London	October 2011
London	May 2012
London	September 2012
Liverpool	November 2012
Liverpool	June 2013
London	July 2013
London	21 September

- GW1 continued: The exhibit includes a blank form with the Queensberry Promotions logo which is said to be used to pay fighters their purse. Also included is a page from Google Analytics which shows that the Frank Warren Promotions website was viewed on 313,577 occasions by 172,845 internet users during the period 28 August 2012 to 12 September 2013. This was the website used by the opponent to promote its boxing matches. 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 in 2012, it states that tickets are available from Frank Warren Promotions Box Office by phone or online at www.frankwarren.tv.

APPLICANT’S EVIDENCE

9) The applicant filed a witness statement, dated 4 July 2015, by Alan James Foley the Promotions Director of the applicant company, a position he has held since September 2011. He states that he was also a partner in Queensbury Fight League from July 2009 when the company was first formed and traded as a partnership from July 2009 until its incorporation in September 2011. He states that the QUEENSBURY mark was first used in the UK when the Queensbury Fight League was formed in July 2009. He states that the business has been involved in promoting boxing events and promoting boxers who compete in the Queensbury Boxing League. This involves setting up boxing matches, booking suppliers for the events, producing tickets and promoting the events by way of press releases both in print and online, posters, flyers, leaflets and banners. It also includes producing DVDs, online videos and television coverage of the bouts. The bouts are broadcast on British Eurosport in the UK. Since 2009 over 35 events have been staged under the QUEENSBURY mark. Originally the company was called Queensbury Fight League, but in December 2010 the word FIGHT was changed to BOXING. He provides the following exhibits:

- QBL1-4 & QBL 7-9.1: these include tickets, DVDs, flyers, newspaper articles, photographs, screenshots and a program dated between 24 October 2009 and 27 March 2010. These use the mark Queensbury Fight League and logo.

- QBL 6: This is a page which shows the evolution of the applicant's mark through the three versions used from July 2009 to date. The exhibit is shown at annex 1.
- QBL 10: A selection of posters flyers and programs dated between March 2010 and June 2015. Items 1 & 2 dated March and June 2010 are posters for boxing events under the first mark shown in QBL6. Pages 3-9 all display the second logo shown in QBL 6. They are all posters for boxing events and are dated March 2011- March 2013. Pages 10 & 11 are dated May and June 2015 and refer to boxing events. Pages 11-13 are dated June 2010 - November 2010 and are flyers for boxing events. These all have the first logo shown in exhibit QBL6. Pages 14 & 15 are programs from boxing events dated March and April 2011 both have the second logo shown in exhibit QBL6.
- QBL11& 12: A copy of a post from the website of Samantha Wordie Photography which is dated 6 January 2010 and refers to dealing with Queensbury Boxing League. She has worked with the company photographing events and helping to create posters. The other exhibit is a photograph of an event which shows the name QUEENSBURY used on one of the corner posts.
- QBL 13: An article from the website Crowley News which is dated 3 December 2010 and refers to the Queensbury Fight League.
- QBL 14: An article from the website of the Surrey Mirror dated 18 March 2011 which refers to the Queensbury Boxing League.
- QBL 15: An article from the website of the Croydon Advertiser dated 12 November 2010 which mentions the Queensbury Fight League.
- QBL 16: An article from the website of the Surrey Comet dated 30 October 2010 which mentions the Queensbury Fight League.
- QBL 17: An article from the website of British Boxers dated 15 November 2011 which has a story which refers to the Queensbury Boxing League and which has a photograph of two boxers wearing T-shirts with the second version of the logo shown in QBL6.
- QBL 18: A page from the applicant's website dated March 2011 which shows details of the next boxing event and also the latest video available. The mark in suit is used on this webpage.
- QBL 19.1: A page from the WAYBACK website which shows that the website www.queensburyfl.co.uk was in existence as of 7 March 2010.

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

DECISION

11) The only ground of opposition is under section 5(4)(a) which reads:

“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.”

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

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

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

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

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

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

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

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

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

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

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

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

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

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

14) The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP)

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

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

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

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

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute*

and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

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

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

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

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

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

16) The filing date of the application is, therefore, the material date. However, if the applicant has used its trade mark prior to this then this use must also be taken into account. It could, for example, establish that the applicant is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that the applicant's use would not be liable to be prevented by the law of passing-off – the comments in *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer.

17) It is clear from the applicant's evidence, particularly exhibit QBL6 (reproduced at annex 1) that the applicant only started using the mark in suit as of March 2013. Prior to this date it used a variant of the mark which had the same wording but the device element was different. The relevant date, that is

the date of the application, is 20 November 2013, but I have to consider whether the applicant has shown use of the mark in suit in the period March 2013-November 2013, and possibly, whether the marks used prior to this date are different such as to alter the distinctive character of the mark sought to be registered.

18) I take account of the comments in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

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

19) I note that in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

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

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

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

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

21) I also note that in *Hart v Relentless Records* [2003] FSR 36, Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes

back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

22) However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

23) The applicant has shown that it has used three marks since its inception, see annex 1. I must consider whether use of the earlier marks equates to use of the mark now applied for. I accept that the earlier marks were not registered and therefore the following authority is not directly applicable but I believe that it will assist me in determining whether the applicant has, as it claims, an earlier right to a QUEENSBURY mark than the opponent to its QUEENSBERRY mark. I look to the comments in *Nirvana Trade Mark*, BL O/262/06, where Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

24) For ease of reference I reproduce the three marks used by the applicant below:

		
<p>August 2009 – November 2010</p>	<p>December 2010 – February 2013</p>	<p>March 2013 - date</p>

25) The first mark has a crown with ribbon devices either side of it, with below it the word "Queensbury" in a stylised font and underneath and in a smaller plainer font the words "FIGHT LEAGUE". The second mark has a different crown device with the word "Queensbury" below it in a different stylised font from the first mark. Underneath this word are the words "BOXING LEAGUE" in a plain font, with the whole mark underlined by a ribbon device. The third mark is the mark in suit. It has a crown device which is a simplified version of the crown used in the second mark. The differences are almost indistinguishable from arms-length when used in a normal size as a letter head for instance. Below the crown is the word "QUEENSBURY". It is a different font to the first two marks and is in capitals. Below this are the words "BOXING LEAGUE" which are again in a plain font, the only difference being that they are printed in red and gold against a black background rather than black on a white background. There is a simplistic underlining device.

26) To my mind, the distinctive and dominant features of all three marks are the word "Queensbury" and a crown device. The words "fight league" and "boxing league" would be viewed as descriptive by the average consumer, i.e. boxing fans. The differences in the crown devices cannot make a difference as the opponent's mark has no crowns in it. The only thing that the parties' unregistered marks have in common is that both marks use the word QUEENSBURY or QUEENSBERRY. This word is the dominant element in both brands and so the only thing that matters for this purpose is who first acquired goodwill under a QUEENSBURY / QUEENSBERRY mark.

In its evidence the applicant shows that it staged events in October 2009. It has provided copies of tickets, flyers, photographs, dvd and programme as well as newspaper articles referring to the event. There is also a wealth of evidence to show that further boxing promotions occurred early in 2010. This is sufficient to show that the applicant had goodwill in the word QUEENSBURY in October 2009 in respect of boxing promotions, and videos/dvds as a bare minimum.

27) Having determined the date at which the applicant has shown that it enjoyed goodwill in the word QUEENSBURY as of October 2009 I now turn to consider whether the opponent had goodwill in its mark, QUEENSBERRY, at this time. The opponent contended that the evidence provided "clearly demonstrates that, on the balance of probabilities the opponent's mark has become associated in the minds of substantial numbers of the purchasing public (i.e. boxing fans) specifically and exclusively with the opponent". In its pleadings the opponent contended that it had used its mark "Queensberry Promotions" in respect of:

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; promotion of boxing events; booking of boxing facilities; providing facilities for boxing events; advisory services relating to the organisation of boxing events; arranging of 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.

28) I note that the opponent states that the mark was used by Frank Warren and Andy Ayling under licence. However, no evidence of a licensing agreement was filed. The opponent contends that all goodwill accrued to it rather than those using the mark. The leading case on the identification of an owner of goodwill is *Scandecor Development v Scandecor Marketing* [1999] FSR 26. In *Wadlow on passing off*, 4th edition, at 3-134 the impact of that case is stated to be the following:

“...identifying the owner of goodwill is really a two stage process because of the dual character of goodwill as a reflection of a public state of mind on the one hand, and as legal property on the other... The two aspects are easily reconciled by saying that the initial vesting of goodwill in one trader or another is always a matter of fact; but that having vested there on its creation it may be transferred to another trader by prior or subsequent agreement, or by operation of the general law, always provided that the transfer does not offend against the rule prohibiting assignments in gross.

29) In respect of the initial ownership, Wadlow goes on to say at 3-135:

“Goodwill is legal property. It can be assigned by the owner, dealt with in other ways, and protected against damaging misrepresentations by the action for passing-off. Goodwill is created by trading activities, but it often happens that more than one business is involved in the sequence which results in goods or services being made available to the consuming public. If so, then the question arises of which of those businesses is the owner of goodwill which the law recognises as damaged when a person passes off his goods or business as those with which the public is acquainted. The problem arises in two main contexts. One is where two or more businesses which have previously worked together fall out. The other is where a passing-off action is brought by a claimant who considers himself damaged by the activities of the defendant but who is not, in law, the owner of any relevant goodwill.”

136. The factors which influence the ownership of goodwill were encapsulated by Lord Reid in *Oertli v Bowman* [1959 RPC 1, 7, HL]:

“Bowmans made and marketed the *Turmix* machines without the appellants [plaintiffs] having controlled or having had any power to control the manufacture, distribution or sale of the machines, and without there having been any notice of any kind to purchasers that the appellants had any connection with the machines.”

There are two distinct, and not necessarily consistent, standards in this passage. One is to ask who is in fact most responsible for the character or quality of the goods; the other is to ask who is perceived by the public as being responsible. The latter is (perhaps surprisingly) the more important, but it does not provide a complete answer to the problem because in many cases the relevant public is not concerned with identifying or distinguishing between the various parties who may be associated with the goods. If so, actual control provides a less decisive test, but one which does yield a definite answer.

3-137: The following questions are relevant as to who owns the goodwill in respect of a particular line of goods, or, mutatis mutandis, a business for the provision of services:

- Are the goods bought on the strength of the reputation of an identifiable trader?
- Who does the public perceive as being responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory?
- Who is most responsible in fact for the character or quality of the goods?
- What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? For example, goodwill is more likely to belong to the manufacturer if the goods are distributed through more than one dealer, either at once or in succession. If more than

one manufacturer supplies goods to a dealer and they are indistinguishable, the dealer is more likely to own the goodwill.”

30) I have no independent witnesses from the trade or indeed the relevant public stating who they regard as being responsible for the quality of the services provided under the opponent's mark. Prior to the relevant date of 20 November 2013 (based upon the application date) the opponent claims to have arranged thirteen boxing events. However, in the witness statement only seven were listed and the exhibits also only corroborate seven events (one shown having been cancelled and re-arranged). It is claimed that the average number of attendees in London has been over one thousand. Actual figures are not provided and no details as to income from ticket sales is provided. Indeed no financial information regarding use of the mark is provided, not even the amount spent publicising the various events. In its evidence the opponent states that it was launched in September 2011 and has evidence that it put on a boxing event in this month. I note that the applicant did not challenge this aspect of the case and so I am willing to accept that the goodwill accrued during the period that the opponent's mark, QUEENSBERRY, was used by others that the goodwill accrued to the opponent. The result of these findings is that whilst the opponent had goodwill at the date of the application the applicant had started using its mark in October 2009 compared to the opponent's first use in September 2011. **The applicant is therefore the senior user, with both parties having goodwill in the same activities.**

31) **The above finding determines that the opposition must fail.** However, in case I am wrong regarding the first use of the applicant's mark I will continue to consider the issues. Therefore, I now turn to consider the issue of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

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

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

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

And later in the same judgment:

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

32) In *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473, Morritt L.J. stated that:

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

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

The question does not cease to be a "jury question" when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself."

33) Both parties are clearly involved in the same activities of promoting boxing matches and the various goods and services that surround such an undertaking. The marks of the two parties both have as a dominant feature the word "Queensbury" and "Queensberry". The slight difference in spelling will pass most by unnoticed by most consumers. Both marks have additional words "Boxing league" and "promotions" which would be seen as descriptive of the activities undertaken by the parties. The applicant's mark does have a distinctive device element, but to my mind this is insufficient to differentiate the marks in the minds of most consumers who would undoubtedly be deceived into thinking that the goods and services of one party were those of the other and vice versa.

34) I now move onto the issue of damage. In *Harrods Limited V Harroddian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

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

35) In the instant case given the closeness of the activities and marks of the two parties, if there is confusion about an economic connection, then this could damage the opponent's goodwill if the goods and services offered were, for some reason, regarded as sub-standard.

CONCLUSION

36) Although there would be misrepresentation and damage the opposition under section 5(4)(a) must fail as the applicant is the senior user. The application will therefore proceed to registration.

COSTS

37) The applicant has been successful and as such it is entitled to a contribution to its costs.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering the evidence of the other side	£800
TOTAL	£1,000

38) I order Queensberry Promotions Limited to pay Queensbury Boxing League Limited the sum of £1,000. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of April 2016

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

Annex 1:

EXHIBIT QBL/6

The original company logo's from the first example produced in July 2009 through to its current version

1st logo produced by artist Richard Henderson in July 2009 and used from August 2009 until November 2010



2nd logo produced in December 2010 with the use of the word "Boxing" instead of "Fight". The design features the "Queensbury" mark and crown



3rd logo produced in March 2013 shows the current logo bearing the "Queensbury" mark which has been used from March 2013 until the present.

