

O-170-18

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3161115,
BY TELEGRAPH MEDIA GROUP LIMITED
TO REGISTER THE TRADE MARK**

BE:FIT

**IN CLASSES 5, 9, 16, 25, 32, 35, 36, 41, 43 & 44
&**

**IN THE MATTER OF APPLICATION No. 3161117,
BY TELEGRAPH MEDIA GROUP LIMITED
TO REGISTER THE TRADE MARK**

BE:FIT LONDON

**IN CLASSES 9, 16, 25, 35, 36, 38, 41, 42, 43 & 44
&**

**IN THE MATTER OF APPLICATION No. 3161373,
BY TELEGRAPH MEDIA GROUP LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 9, 16, 25, 35, 38 41, 42, 43 & 44

AND

**IN THE MATTER OF OPPOSITIONS THERETO
UNDER Nos. 407326, 407328 & 408230 BY
LIONS GATE ENTERTAINMENT INC.**

BACKGROUND

1) On 5 February 2018 I issued decision O-088-18. The opponent's opposition under Sections 5(2)(b), 5(3) and 5(4)(a) all failed. At the hearing Mr Tritton requested costs above the normal scale due to the manner in which the opposition had been conducted. As the applicant was not represented at the hearing I asked Mr Tritton to provide written submissions and a bill of costs. At paragraph 44 of my decision I stated:

“44) The opponent in its initial statement of grounds did not specify precisely which goods and services it thought were identical/similar to the goods and services applied for by the applicant and the reasons why it believed this such as trade channels etc. Prior to the hearing I wrote to the opponent, on 25 December 2017, instructing them to provide this information by Friday 5 January 2018. The opponent completely ignored this instruction and in its skeleton argument provided scant information and failed to identify in the precise terms required which goods and services it relied upon to oppose the goods and services applied for by the applicant. The opponent withdrew its ground of opposition under section 56 and its opposition to the goods in class 36 but did not withdraw the grounds of opposition under section 5(3) or 5(4)(a) despite it being clear that the evidence did not support either ground, and indeed the opponent did not even comment in its skeleton about the ground under section 5(3). As the opponent was not represented at the hearing it was not possible to put any of these issues to the opponent and possibly obtain the necessary information. Instead it was left to the applicant to have to provide a defence to all the grounds in its skeleton and also to plough through the lengthy specifications in an attempt to provide a defence against all of the opponent's goods and services and second guess what reasons the opponent might contend, instead of having to respond to a targeted list of goods and services with clear reasons why the opponent believed they were identical/similar. At the hearing the applicant requested that I consider an award of costs off the scale due to the manner in which the opponent have conducted the opposition. I therefore invite the applicant to provide, within two weeks of the date of this decision, their bill of costs for the instant case. The opponent will then have a week from receipt of the applicant's response to provide its submissions on the matter.”

2) On 13 February 2018 the applicant's Trade Mark Attorney provided both submissions and a bill of costs which they copied at the same date to the opponent's Trade Mark Attorney. I have delayed writing this supplementary decision in the, forlorn, hope that the opponent would reply, although given

their lack of response to my letter of Monday 25 December 2017 it is not surprising that they have maintained their silence.

3) The applicant submitted:

“3. The Applicant submits that this is a case where an award approaching full compensation should be made for the following reasons.

(a) The Opponent put forward grounds of opposition based on s.5(2), s.5(3), s.5(4)(a) and s.56. Of these grounds, the s.56 ground was withdrawn and the s.5(3) ground was not pursued. There was no explanation why these grounds were advanced in the first place and the s.56 ground (which relies upon the mark being well known within the meaning of Art.6bis Paris Convention) was plainly unsustainable. Whilst an opponent should not be dissuaded from withdrawing grounds, equally, they should not put forward grounds which are hopeless.

(b) The Opponent has relied upon EU 147477171 LIONSGATE BEFIT (“the Opponent’s Mark”) which has a very long specification. It was said that the goods and services for which protection was sought by the Applicant were identical or similar to that of the Opponent’s Mark. Manifestly, some were not.

(c) As said at ¶44 of the Decision, by letter dated 25 December 2017, the Opponent was requested to set out which goods and services of the Opponent’s Mark were similar to those of the Applicant’s Mark and giving reasons but this was wholly ignored and no reason was given for this.

(d) To compound the matter, in the Skeleton Argument of the Opponent, and despite this letter, there were bald statements in relation to very long specifications for each class that they were identical or highly similar when plainly they were not. In any event, as is now well-known law (and as recited at ¶24 of the Decision), an Opponent should provide evidence of similarity where such is not “self evident”. These failures are reprehensible given the letter of 25 December 2017.

(e) The Opponent filed substantial exhibit evidence which it said was “relevant to the UK market” as showing use of BEFIT. In the exhibit evidence, it was plain that many of the print outs of the webpages had nothing to do with the United Kingdom. The sole criteria it would appear for saying that they were “relevant to the UK market” was that the URL had a “.co.uk”. suffix. However, it is obvious that such by itself does not mean that a UK consumer or end user would have accessed or looked at the webpage. Indeed, a brief perusal of some of the webpage exhibit webpage demonstrate that. Thus, webpages were exhibited which were said to be “relevant to the UK market” when they solely concerned the United States e.g. competitions in the US or the offer for sale of DVDs suitably only for viewing in the United States. In other words, they plainly were not relevant to the UK market. At its highest, it is clear that the Opponent has taken no care over the preparation of this evidence-a witness statement which was attested by a statement of truth.

(f) The matter was compounded by the submission in the Skeleton Argument of the Opponent that the evidence above showed significant goodwill and reputation in the UK for BEFIT. There was no attempt to correct the misleading nature of the evidence of the Opponent.

4. The above matters demonstrates unreasonable behaviour by the Opponent as well as a flagrant breach of a direction from the Registry.

5. The Applicant has been put to considerable work here by reason of the above behaviour. It and its legal advisors have had to consider carefully the evidence put forward to show its misleading nature as well as to consider carefully the specification of goods and services to see how they could be said to be identical or similar. The Opponent had not set out how they were identical or similar prior to the hearing to allow a focussed debate and this meant that the Applicant had to “second guess” the arguments and carry out a very difficult task of considering each good and service in the Opponent’s mark and then try and “map” that to the goods and services of the Applicant’s Mark. As said at the hearing, the onus lies on the Opponent and neither the Applicant nor the tribunal should have to “second guess” which particular goods/services of the Opponent’s Mark were said to be identical or similar to particular goods/services of the Applicant.

6. In the circumstances, the Registry is invited to make an award of costs off the scale. A bill of costs has been provided to this end.”

4) The opponent’s behaviour in this case undoubtedly caused considerable additional work for the applicant. It is clear from my evidence summary in the interim decision that I agree with all of the applicant’s comments regarding this aspect of the case. The applicant has shown that its actual costs were £26,082.50. Some of this would relate to the normal costs of defending its applications for which normal scale costs would apply. I have therefore reduced the award accordingly.

5) I order Lions Gate Entertainment Inc. to pay Telegraph Media Group Ltd the sum of £18,000. 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 15th day of March 2018

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