

O/492/18

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3180360

BY BRUCE LEE ENTERPRISES, LLC

AND

OPPOSITION No. 409295

BY BARISONS THEATRE PRODUCTIONS LIMITED

AND

TRADE MARK APPLICATION 3210552

BY BARISONS THEATRE PRODUCTIONS LIMITED

AND

OPPOSITION No. 409685

BY BRUCE LEE ENTERPRISES, LLC

Background and pleadings

1. These consolidated oppositions are between Barisons Theatre Productions Limited (“Barisons”) and Bruce Lee Enterprises LLC (“BLE”). BLE applied on 15th August 2016 to register JUN FAN as a trade mark in relation a wide range of goods and services in classes 9, 11, 14, 16, 18, 20, 21, 24, 25, 28, 30 & 41.¹ The services in class 41 included “*theatrical shows.*”

2. Jun Fan is the given name of the famous deceased martial arts performer popularly known as Bruce Lee.

3. As a result of prior communications between them, initiated by Mr Brian Hill (the director of Barisons), BLE knew when it made its application that Barisons was planning to launch a musical show in the UK under the name JUN FAN with the strapline “The Bruce Lee Musical.”

4. Barisons claims that BLE’s application was filed without a genuine intention to use the trade mark and solely as a blocking tactic to prevent it from marketing an original theatrical production, which is based on the life and times of Bruce Lee.

Consequently, Barisons claims that the application was made in bad faith and should be refused under section 3(6) of the Trade Marks Act 1994 (“the Act”) to the extent that it covers:

Class 16: Art prints; posters; pens; books; cardboard stand-up cutouts featuring photographs or artwork; photographs.

Class 41: Theatrical shows; non-downloadable film clips; theatrical shows provided by a website; sporting and cultural activities.

5. BLE filed a counterstatement denying that its trade mark application was filed in bad faith. According to BLE, it had a *bona fide* intention that the mark should be used by it, or with its consent. BLE says that the application was filed “..to protect the intellectual property first created by Mr Bruce Lee in the 1960s and 1970s.” The application, and several others filed at the same time, was part of its strategy to

¹ The full list is at annex A

protect the mark *“having regard to its previous and future business expansion, current and prospective online sales into the United Kingdom and other EU countries, and its policing efforts.”*

6. On 3rd February 2017, Barisons applied to register Jun Fan the Musical in class 41 in relation to:

“West End Musical, Theatre Production, Musical Theatre, Musical recording, Live Musical Performance, Live Theatre Performance, Live recording of the musical, Studio recording of musical, Original Musical Composition, Original Songs, Original Script.”

7. BLE opposes Barisons’ application on three grounds. Firstly, on the basis of its own earlier application to register JUN FAN in relation to services in class 41, including *“education, training, theatrical shows”* and *“sporting and cultural activities.”* Secondly, on the basis of BLE’s common law rights in JUN FAN as a result of the use of that name in the UK for *“at least 30 years”* in relation to *“Martial arts regime, tuition and displays for entertainment.”* In this connection, BLE claims that the use of Barisons’ mark in relation to the services covered by its application would be a misrepresentation to the public. This is because it would indicate that (a) the services are provided by the opponent or with its consent, or (b) feature the work of Bruce Lee, or (c) BLE has a major role in the production of the services, or (d) there is a *“close relationship”* with BLE, which does not exist. Thirdly, BLE claims that Barisons’ application was filed in bad faith. This is because (a) BLE owns all the intellectual property rights of the estate of Bruce Lee, (b) Barisons was aware that BLE objected to its proposed use of JUN FAN The Bruce Lee Musical (its US lawyers having sent a cease and desist letter on 9th August 2016), and (c) a copy of an email from Robert Lee, Bruce Lee’s brother, which appeared to consent to Barisons’ use of the mark should not have been accepted by the Trade Mark Examiner as sufficient reason to accept the application.

8. BLE therefore claims that the registration of Barisons’ mark should be refused under s.5(2)(b), 5(4)(a) and/or s.3(6) of the Act.

9. Barisons filed a counterstatement denying the grounds of opposition to its application. In particular, BLE was put to proof of its earlier common law rights. Further, Barisons denied that its application was filed in bad faith. According to Barisons, the application was filed to protect its interest in an original work written over 5 years and completed in 2015.

Representation

10. BLE is represented by Lewis Silkin LLP. Barisons is not legally represented. A hearing took place on 13th July 2018 at which Ms Charlotte Blythe appeared as BLE's counsel. Mr Brian Hill of Barisons also took part via a telephone link.

The evidence

11. BLE's evidence consists of a witness statement by Ms Shannon Lee (with 10 exhibits). Barisons' evidence consists of two statements by Mr Brian Hill (with 18 exhibits). The second of Mr Hill's statements was filed in reply to Ms Lee's statement. I have read all the evidence.

12. Mr Hill claims to have been using the mark Jun Fan the Musical in the UK since 2013 in relation to promotional gifts, theatrical shows and theatrical shows provided via a website. No actual sales of goods or services have occurred to date. However, Mr Hill claims that £40k was spent between 2013 – 2017 promoting the goods/services. This includes pre-production costs, recording of promotional clips, website design, trade mark application costs, the cost of promotional travel and materials, script translation and musical arrangement.

13. So far as I can see, the only outward manifestation of this 'promotion' was the setting up of a website in 2015. Initially, this seems to have focused on the title 'The Bruce Lee Musical'. However, in 2016 the working title seems to have changed to 'JUN FAN the Bruce Lee musical'. There is no evidence as to the number of visitors to this website.

14. Mr Hill emailed BLE in May 2015 saying that he was a Bruce Lee fan and was working on a musical for London's West End.² The purpose of the email appears to have been to find out if Ms Lee would endorse the show, or even co-produce it. Mr Hill continued to email BLE and subsequently, in July 2015, he received a request for more information. Later, in February 2016, Mr Hill sent the script, lyrics and music to BLE. A few days later he received a 'cease and desist' email from Christina Nahas, Director of Licensing and Business Affairs at BLE.³ The letter referred to previous emails and stated that:

"To be clear, we do not fund or sponsor projects like this, and it is not something Shannon Lee, Bruce Lee Enterprises or the Bruce Lee Foundation will participate in at this time."

15. Following subsequent emails in which Mr Hill asserted his right under UK law to produce a musical about Bruce Lee without BLE's consent, Mr Hill received an email on 29th April 2016 saying that BLE was investigating the law in the UK. Without prejudice to its right to continue to object to the proposed musical, BLE asked Mr Hill to send a financial proposal for Ms Lee's involvement in the project. Mr Hill did so on 6th May 2016. Further chasing emails were met with a letter dated 9th August 2016 from BLE's lawyers in California. The letter asserted wide ranging rights in the name, image and persona of Bruce Lee. It complained that Barisons' *"..production goes too far and implies endorsement or sponsorship by BLE."* It required Barisons to stop using Mr Lee's voice, image and [unidentified] logos owned by BLE and to take down all links and banners to websites affiliated to BLE. Mr Hill responded to this letter on 12th August 2016 denying that he was trying to imply that BLE endorsed Barisons' musical, agreeing to remove offending material/links and asking, inter alia, for details of BLE's IP rights in the countries where such rights were claimed *"...so that I know that I am not intruding on [them]."*

16. BLE's UK trade mark application was filed three days later.

² See exhibit 4 to Hill 1

³ See exhibit 7 to Hill 1

17. Later, in March 2017, after Barisons' own trade mark application had been filed, Mr Hill contacted Mr Robert Lee, Bruce Lee's brother. He was more receptive to the project agreeing to the use of the name 'Jun Fan the Bruce Lee Musical', and also agreeing to be part of the production team.

18. Ms Lee is the CEO of BLE. She says that Bruce Lee was born Jun Fan Lee. She says that it is common for actors to use stage names where it is not desirable to use their birth name. The name 'Bruce' was thought to have greater commercial appeal than Jun Fan. Bruce Lee founded his own martial art called JEET KUNE DO, which is a form of Kung Fu. Ms Lee says that it is now commonly known as JUN FAN JEET KUNE DO. Bruce Lee founded his own martial arts school in the USA in 1963. It was called JUN FAN GUNG FU INSTITUTE OF SEATTLE. He used the same name (minus the geographical indication) for two further such schools he later founded in California. Mr Lee went on to make films in Hong Kong and Hollywood. These films sparked a surge of interest in the West during the 1970s in Chinese martial arts. The film 'Enter the Dragon' was released in 1973. It went on to become Bruce Lee's most successful picture, grossing more than \$200m. Unfortunately, Mr Lee died just a few days before the film was released.

19. According to Ms Lee, BLE is the successor to Mr Lee's estate, including his intellectual property rights. This is not disputed.

20. Ms Lee states that given Mr Lee's Asian heritage, China and Hong Kong were identified as key territories for trade mark protection, including for Mr Lee's birth name JUN FAN. Accordingly, the mark JUN FAN JEET KUNE DO was registered in Hong Kong in 1997/1998 in classes 16, 25 & 41. That mark, JUN FAN, and JUN FAN GUNG FU INSTITUTE, were also registered in China in 1998. Each registration covered one class of goods/services, always class 16 (printed matter), 25 (clothing) or 41 (education, entertainment, sporting and cultural activities).⁴ In 1999 an application was made to register JUN FAN JEET KUNE DO in the USA, again for goods in class 25. Ms Lee says that this was because the USA had been identified

⁴ See exhibit SL-3. The schedule does not identify any specific goods/services. The descriptions shown in brackets in paragraph 20 are therefore only general indications of the goods/services in those classes.

as a key territory requiring trade mark protection. BLE identified the UK as another key territory where trade mark protection was required “in 2016.” Consequently, it applied to register JUN FAN in relation to goods/services in 12 classes (including classes 16, 25 & 41).

21. Ms Lee’s evidence (in February 2018) is that BLE has released a range of Bruce Lee related merchandise. She does not say when this merchandise was released or what it consisted of. However, she says it proved to be very popular with UK consumers. Ms Lee provides a spreadsheet setting out the volume of sales of merchandise in the UK.⁵ The spreadsheet is said to be confidential. It is sufficient to record that it shows the sale of a small number of T-shirts. However, like Ms Lee herself, the spreadsheet is silent on the dates of these sales. There are also pictures in evidence of some garments (mostly T-shirts) bearing the words JUN FAN as part of the name JUN FAN GUNG FU INSTITUTE. Ms Lee’s statement identifies no other use of JUN FAN in relation to any other merchandise.

22. BLE does not spend money advertising its goods. It relies on Bruce Lee’s substantial fan base and social media. Ms Lee points out that searches for JUN FAN on YouTube brings up almost 400 fan based videos, with many JUN FAN JEET KUNE DO [martial arts] training pages. She exhibits two examples.⁶

23. Ms Lee also exhibits copies of UK press articles and online reviews which mention the JUN FAN name.⁷ This material occupies 21 pages of articles and print-outs. It is not clear that they are all from UK publications or websites. Where JUN FAN is used it is generally as part of the name of the martial art JUN FAN JEET KUNE DO. At the hearing, Ms Blythe drew my attention to an article that appeared in the Bury Free Press on 25th January 2017. This article was about a sale of Bruce Lee memorabilia, including “*authentic Jun Fan Gung Fu Membership Cards.*” However, from looking at the whole article one can see that this was obviously a sale of historical material, not merchandise.

⁵ See exhibit SL-4

⁶ See exhibit SL-8

⁷ See exhibit SL-5

24. Ms Lee also points out that (a) biographies of Bruce Lee would include his birth name,⁸ and (b) Bruce Lee biographies are read by Bruce Lee fans. Therefore, fans of Mr Lee will know that his birth name was JUN FAN [LEE]. Further, the Bruce Lee Foundation published a newsletter for 2 years during the 1990s under the title 'Knowing is not enough: The Official Newsletter of Jun Fan Jeet Kune Do'. Copies of it are in evidence.⁹ It appears to have been a quarterly US publication. I note that JUN FAN is again used as part of Jun Fan Jeet Kune Do, i.e. a name used for the form of Kung Fu established by Bruce Lee.

Barisons opposition to BLE's application on the ground of bad faith

25. The notice of opposition is not entirely clear, probably because Barisons is not legally represented. Applying common sense and making the best of it I can, I understand that the opposition is directed at the following (underlined) services.

Class 41: Education; training; seminars; theatrical shows; non-downloadable film clips and information on education, training, seminars and theatrical shows provided by a website; sporting and cultural activities.

Section 3(6) of the Act states:

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

26. 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* as follows:¹⁰

“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

⁸ Some examples are in exhibit SL-6

⁹ See exhibit SL-7

¹⁰ [2012] EWHC 1929 (Ch)

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 Plasticulture 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)."

27. Additionally, I note that in *Lindt v Hauswirth* the CJEU stated that:

"51. Furthermore, in order to determine whether the applicant is acting in bad faith, consideration may be given to the extent of the reputation enjoyed by the sign at the time when the application for registration as a Community trade mark is filed.

52. The extent of that reputation might justify the applicant's interest in ensuring wider legal protection for his sign."

28. Ms Blythe also drew my attention to the judgment of Arnold J. in *Sky Plc v Skykick UK Ltd*¹¹ in which the judge again summarised the present state of the law on bad faith. I note the following part of his judgment.

¹¹ [2018] ETMR 23

“224. I draw the following conclusions from this review of the case law.

225. First, although there is no express requirement of an intention to use in either the Regulation or the Directive, and a registered trade mark cannot be revoked for non-use until five years have expired, the jurisprudence of the CJEU and the General Court suggests that, at least in certain circumstances, it may constitute bad faith to apply to register a trade mark without any intention to use it in relation to the specified goods or services.

226. Secondly, the case law indicates that it is not sufficient to demonstrate bad faith that the applicant has applied to register the trade mark in respect of a broad range of goods or services if the applicant has a reasonable commercial rationale for seeking for such protection having regard to his use or intended use of the trade mark. Nor is it sufficient to demonstrate bad faith that the applicant only has a contingent intention to use the trade mark in relation to certain goods or services in the future.”

29. The *Skykick* case is primarily about the width of specifications, which is not the issue in this case. However, I will keep in mind the point made in paragraph 226 of the provisional judgment, i.e. that an application will not usually be held to have been filed in bad faith where the applicant had “*a reasonable commercial rationale*” for it. This point plainly overlaps with the CJEU’s guidance in *Lindt v Hauswirth* that “*consideration may be given to the extent of the reputation enjoyed by the sign at the time when the application for registration... is filed.*”

30. As BLE’s position is that it filed its trade mark application partly to protect its existing rights in the mark JUN FAN, I will start by considering whether BLE had any such rights, business or reputation in the UK under the mark JUN FAN at the relevant date of 15th August 2016.

31. Ms Blythe relied on three things. Firstly, the residual goodwill associated with Bruce Lee as a martial arts performer, trainer and entertainer. Secondly, the business carried on by BLE and its predecessors since Bruce Lee died in 1973. Thirdly, the fact that Jun Fan was Bruce Lee’s given name at birth.

32. So far as the business now conducted by BLE is concerned, I find that there is no evidence of any business conducted in the UK prior to the relevant date. The only evidence of merchandising of goods bearing the name JUN FAN GUNG FU INSTITUTE in the UK is Ms Lee's evidence (given in February 2018) about the sale of a small number of T-shirts. However, Ms Lee conspicuously avoids claiming that these sales pre-dated BLE's application. Nor are the dates of the sales apparent from the supporting documents provided. In these circumstances, it is entirely possible that these sales postdate BLE's application, and possibly Barisons' application too.

33. So far as martial arts training is concerned, the only relevant evidence from Ms Lee is about Bruce Lee's establishment of three martial arts schools in the USA in the 1960s under the name JUN FAN GUNG FU INSTITUTE. However, Ms Lee does not claim that BLE (or its predecessors) continued these schools after Mr Lee's death. In any event, this evidence relates to services provided in two States of the USA, not in the UK. Further, the name used for these schools was not the mark applied for - JUN FAN – but JUN FAN GUNG FU INSTITUTE.

34. Turning to the question of whether there was any residual goodwill in the UK at the relevant date, I have no doubt that Bruce Lee's popularity with UK audiences in the 1960s and 1970s would have been sufficient to have generated goodwill in the UK as a martial arts performer and entertainer sufficient to entitle him to protection under the law of passing off.¹² Further, it is well established that goodwill can survive for a period after a trader ceases to carry on his trade.¹³ It is not obvious to me why Mr Lee's goodwill as a performer would still exist 45 years after his death, despite the absence of any commercial activities that would be apparent to UK consumers (apart from repeats of the films in which the performer appeared). Ultimately, the continued existence of such goodwill is a question of fact. I find that even if such a residual goodwill existed at the relevant date, JUN FAN was not distinctive of it. Rather, I accept the submission made on behalf of Barisons that JUN FAN is not well known in the UK as the real given name of Bruce Lee. I therefore reject BLE's submission that JUN FAN is well known to Bruce Lee fans because of biographies

¹² See, for example, *Irvine v Talksport Ltd* [2003] F.S.R. 35

¹³ See the well-known case of *Ad Lib Club Limited v Granville* [1971] FSR 1

written about him and/or occasional articles which mentioned Bruce Lee's real given name as a matter of historical fact.

35. I do not consider that this finding is undermined or contradicted by Ms Lee's evidence that references are made to 'Jun Fan Jeet Kune Do' on social media, including in videos posted on YouTube. Firstly, the number of these references is not vast. Secondly, they appear to be references to the form of Kung Fu established by Bruce Lee, not to Mr Lee himself. Not everyone who knows that 'Jun Fan Jeet Kune Do' is a form of Kung Fu will know that Jun Fan [Lee] was Bruce Lee's birth name. And even to those who know that Jun Fan was Bruce Lee's given name at birth, the use of those words in the term 'Jun Fan Jeet Kune Do' would still be a reference to the form of Kung Fu he established rather than to Bruce Lee himself.

36. I do not therefore consider that BLE has shown that JUN FAN had a reputation in the UK at the relevant date, or that it was distinctive of any goodwill owned by BLE in the UK.

37. Ms Blythe submitted that the UK application represented a natural progression of business conducted by BLE overseas to the UK. She relied on two things. Firstly, the pattern of applications to register marks consisting of, or including, JUN FAN in other territories. Secondly, Ms Lee's evidence that BLE decided in 2016 that the UK was a key territory. I do not accept that the UK trade mark application can properly be regarded as part of a pattern of international trade mark applications to register JUN FAN. Rather, the evidence indicates that there was a small spate of trade mark applications in Hong Kong, China and the USA in 1997 – 1999. The last of these applications was filed 17 years before the UK filing. Further, only one of the earlier applications (in China) was for the mark JUN FAN itself. The other marks were for JUN FAN GUNG FU INSTITUTE or JUN FAN JEET KUNE DO. As regards Ms Lee's evidence that the UK was identified as a key territory for protection in 2016, this begs the question "why?" If the only reason the UK became a "key territory" was because BLE wanted to block Barisons' proposed musical, then this does not assist BLE's case so far as the opposed goods/services in classes 16 and 41 are concerned.

38. Next, there is the question of whether the fact of JUN FAN being Bruce Lee's given name at birth itself provided "*a reasonable commercial rationale*" for BLE to make the application. In my view, this is a relevant fact, but not a decisive one. In circumstances where Bruce Lee was commercially known by his stage name, rather than his birth name, I am not persuaded that this fact alone provided BLE with "*a reasonable commercial rationale*" for applying to register the mark in the UK in relation to the opposed goods/services.

39. For the reasons given above, I do not accept that BLE has shown that it had "*a reasonable commercial rationale*" for making the application. However, that is not the end of the matter. Although it is necessary, it is not sufficient for Barisons to show only that BLE had no "*reasonable commercial rationale*" for making the application (to the extent opposed). Barisons must also show that *prima facie* the application was filed for an impermissible purpose and was therefore made (to the extent opposed) in bad faith.

40. Barisons claims that the 'impermissible purpose' is the use of the trade mark merely to block its proposed musical theatre production. The following facts strongly support such a conclusion:

- BLE knew that the musical was to be called 'JUN FAN, the Bruce Lee musical';
- BLE had told Mr Hill in April 2016 that it was investigating the law in the UK in the context of personality rights;
- Personality rights, as such, do not exist under UK law;
- BLE's application covers, inter alia, *theatrical shows*, the very services Barisons proposed to provide under the mark;
- There is no evidence that BLE's trade mark applications in any other territory covered *theatrical shows* in class 41 (as opposed to, for example, martial arts training);
- There is no evidence that BLE provides *theatrical shows* services anywhere in the world and no evidence that it has any intention (contingent or otherwise) of doing so.

41. I therefore find that insofar as it covered *theatrical shows* in class 41, BLE's trade mark was purely a blocking mechanism to obstruct Barisons' proposed musical. On the balance of probabilities, the same motive was behind the application to register the mark in relation to *non-downloadable film clips and information on theatrical shows provided by a website*. In the absence of any intention to use the mark itself, BLE's behaviour fell below accepted standards of commercial behaviour and amounted to an act of bad faith.

42. I have not found it straightforward to decide on the applicability of the bad faith objection in relation to the other opposed goods/services; namely, *sporting and cultural activities* in class 41 and *art prints, posters, pens, books, cardboard stand-up cutouts featuring photographs or artwork, and photographs* in class 16. It seems possible that the trade mark applications made in China and Hong Kong in the 1990s may have covered similar goods and services. Also, as I noted above, the fame of Bruce Lee as a martial arts performer is a relevant (albeit not decisive) factor when it comes to assessing whether BLE's UK application to register his given name in relation to *sporting activities* was made in bad faith. However, in the light of (a) the long time gap between, on the one hand, the Chinese/Hong Kong/US trade mark applications in 1997 – 1999 and BLE's UK trade mark application (2016), (b) the close proximity between the dates of the parties' communications about Barisons proposed musical theatre production and BLE's UK trade mark application, I find that the application to register the mark in relation to all the opposed goods/services was likely to have been part and parcel of the same blocking tactic. The purpose of applying to register the mark in relation to "*sporting activities*" (which is arguably wide enough to cover sporting entertainment services) being to help block the musical. The purpose of applying to register the mark for the class 16 goods being to obstruct the commercialisation of the musical by complicating Barisons use of JUN FAN in relation to published promotional materials.

43. BLE's application will therefore be refused under s.3(6) of the Act because it was filed in bad faith insofar as the goods/services specified in paragraph 25 above are concerned.

BLE's opposition to Barisons' application

44. BLE's opposition to Barisons application is based on grounds under sections 5(2)(b), 5(4)(a) & 3(6) of the Act. Ms Blythe was correct to accept that BLE's opposition under s.3(6) could not succeed independently of the ground under s.5(4)(a) based on BLE's common law rights. Therefore, it is only necessary, in practice, to consider the grounds under s.5(2)(b) and s.5(4)(a).

The section 5(2)(b) ground

45. BLE relies on the services covered by class 41 of its own application as the basis for the s.5(2)(b) ground of opposition. However, the effect of my decision on Barisons' opposition to that application is that BLE is left with the following services in class 41.

“Education; training; seminars; non-downloadable film clips and information on education, training and seminars provided by a website.”

46. Barisons' application covers:

“West End Musical, Theatre Production, Musical Theatre, Musical recording, Live Musical Performance, Live Theatre Performance, Live recording of the musical, Studio recording of musical, Original Musical Composition, Original Songs, Original Script.”

Only services fall in class 41. Therefore, the descriptions “original songs, original script” must be understood as meaning song writing and script writing services.

Similarity of services

47. Ms Blythe submitted that *training services* covers martial arts training services. She argued that these are similar to theatrical services because the latter may feature martial arts. For example, the public may believe that the user of BLE's trade

mark trains the performers who appear in the musical theatrical services to be provided under Barisons' mark.

48. Mr Hill submitted that the services are different in nature and purpose, and appeal to different audiences.

49. In the judgment of the CJEU in *Canon v MGM*,¹⁴ the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

50. I accept that martial arts training services are different in nature to theatrical performance services. The one is an educational service in which users undertake and practice physical activities and thereby acquire particular physical skills. The other is an entertainment service which users normally just watch and listen to for their enjoyment. It follows that the purpose and method of use of the services is also different. The services are not in competition. The substance of Ms Blythe's submission is that the respective services are complementary.

51. In *Kurt Hesse v OHIM*,¹⁵ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,¹⁶ the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that

¹⁴ Case C-39/97

¹⁵ Case C-50/15 P

¹⁶ Case T-325/06

customers may think that the responsibility for those goods lies with the same undertaking”.

52. In *Sanco SA v OHIM*,¹⁷ the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is therefore to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:¹⁸

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

53. It cannot be excluded that some theatrical services, including musical theatrical services, such as a show based on the life of a martial arts performer, may involve choreographed sequences in which performers simulate the use of martial arts. I also accept that it is possible that a party putting on such a show may require the services of a person or party who can help train the performers so that they can present a credible display of the relevant martial art within their theatrical performance. It is therefore possible that, on occasions, martial arts training may be important for the production of theatrical performance services.

54. On the other hand, training the performers is but a small part of what is required to provide a theatre entertainment service. Further, in this scenario the training service would be provided to the party staging the theatrical performance, rather than to the public. Overall, the respective services are so different that it seems very unlikely that the public would expect a provider of martial arts training to be responsible for theatre entertainment services (even if they included scenes with

¹⁷ Case T-249/11

¹⁸ BL-0-255-13

martial arts sequences) or vice-versa. I do not therefore accept that these services are complementary within the meaning of the case law. If I am wrong about this, then any such complementarity is to a very low degree.

55. I have not overlooked the fact Bruce Lee established martial arts training schools (in the USA) and was also an entertainer. However, this appears to be very much the exception rather than the rule. There is no evidence that parties who provide martial arts training services normally provide entertainment services of any kind, let alone musical theatre.

56. I therefore find that BLE's services are not similar to live theatre performances. Barisons other services are further removed from BLE's services. I therefore find that BLE's services are not similar to:

“West End musicals, theatre production services, musical theatre services, musical recording services, live theatre performances, live musical performances, live recording of musicals, studio recording of musicals, original musical composition, original song writing services, original script writing services.”

The average consumer

57. The average consumer of both parties' services is likely to be a member of the general public. In the case of the particular type of training services that BLE relies on, this is likely to be a person with an interest in martial arts and/or self-defence. Users of theatrical and/or musical entertainment services may also have some degree of interest in martial arts, although the majority of such users will not be martial arts enthusiasts and many will have no such interest.

58. Users of theatrical and/or musical entertainment services are likely to pay an average degree of attention when selecting a service provider.

The distinctive character of the earlier mark

59. The words JUN FAN will be unfamiliar to the UK public, except perhaps to some Kung Fu enthusiasts familiar with the form known to them as JUN FAN JEET KUNE DO. Those who recognise it as part of the name of a type of Kung Fu are unlikely to regard it as particularly distinctive for martial arts training services. Those consumers who have not come across JUN FAN before will not see any descriptive significance for martial arts training (or other) services. To these consumers the mark will seem like an unusual combination of meaningless words. It will therefore have an above average degree of inherent distinctiveness to them.

60. There is no evidence that the distinctive character of JUN FAN had been enhanced through use prior to the date of Barisons' trade mark application ("the second relevant date").

The similarity of the marks

61. The marks are plainly highly similar.

Global assessment – likelihood of confusion

62. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

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

(g) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(h) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

63. In my view, there was no likelihood of confusion at the second relevant date despite the high similarity between the marks. This is mainly because the services in class 41 for which the earlier mark will proceed to registration are not similar, or not sufficiently similar, to the services covered by Barisons' application for average consumers to believe that they are the services of the same, or economically linked, undertakings. In reaching this conclusion I have kept in mind that although JUN FAN is a mark with an above average degree of inherent distinctiveness to UK consumers, it is not a mark which has acquired a reputation and enhanced distinctiveness in relation to martial arts training services (or anything else). It is not, therefore, a mark of the highest level of distinctiveness. Consequently, even if there is a scintilla of similarity between some of BLE's services, e.g. *training services* and certain of BLE's services, e.g. *live theatre performances*, I do not consider that it is sufficient to cause average consumers to believe that the marks at issue are used by the same or connected undertakings.

The passing-off right ground of opposition: section 5(4)(a)

64. Section 5(4)(a) states:

"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."

65. In the *Jif Lemon* case,¹⁹ Lord Oliver set out the requirements for establishing a successful passing off right, as follows:

¹⁹ *Reckitt & Coleman Products Ltd v Borden* [1990] RPC 341 HL

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services.

Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to the belief that the goods or services offered by him are the goods or services of the plaintiff.

Thirdly, he must demonstrate that he suffers or, in a *quia timet* action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

66. BLE submits that the relevant date is the date of Barisons’ trade mark application on 3rd February 2017. I agree.

67. BLE claims to own a goodwill under the name JUN FAN as the result of the use of that name in the UK for “*at least 30 years*” in relation to “*Martial arts regime, tuition and displays for entertainment.*” I find that BLE has not established that it, or its predecessors in business, conducted any trade in the UK under the name JUN FAN prior to the relevant date. It follows that the s.5(4)(a) case falls at the first hurdle insofar as it is based on BLE (or its predecessors) having customers (and therefore goodwill) in the UK.

68. At the hearing, Ms Blythe also relied on the goodwill associated with Bruce Lee himself as a martial arts performer. My attention was drawn to several false endorsement cases including *Fenty v Arcadia Group Brands Limited*.²⁰ That case

²⁰ 2015 EWCA Civ 3

concerned the retailer Topshop's use of a picture of the popstar Rihanna on T-shirts. Miss Fenty (i.e. Rihanna) had not consented to the use. Miss Fenty had worked with Topshop in the past. Further, the picture used by Topshop was similar to one used on the popstar's most recent album. At first instance, Birss J. held that the use of the picture was a misrepresentation to the public and Topshop was liable for passing off. On appeal, Kitchen L.J. said:

“34. It is of course inherent in these propositions that, registered trade marks aside, no-one can claim monopoly rights in a word or a name. Conversely, however, no-one may, by the use of any word or name, or in any other way, represent his goods or services as being the goods or services of another person and so cause that other person injury to his goodwill and so damage him in his business. Further, it is enough that the goods or services are represented as being in some way connected or associated with that other person provided that the connection is a material one in the sense that it has caused or is likely to cause him such damage in his business.

35. The particular kinds of connection and association relevant to the present proceedings are those which arise in cases of character merchandising and endorsement. Laddie J. provided this explanation of the distinction between them in *Irvine v Talksport Ltd* [2002] EWHC 367 (Ch), [2002] 1 WLR 2355 at [9]:

“... When someone endorses a product or service he tells the relevant public that he approves of the product or service or is happy to be associated with it. In effect he adds his name as an encouragement to members of the relevant public to buy or use the service or product. Merchandising is rather different. It involves exploiting images, themes or articles which have become famous. To take a topical example, when the recent film “*Star Wars Episode I*” was about to be exhibited, a large number of toys, posters, garments and the like were put on sale, each of which bore an image of or reproduced a character or object in the film. The purpose of this was to make available a large number of products which could be bought by members of the public

who found the film enjoyable and wanted a reminder of it. The manufacture and distribution of this type of spin-off product is referred to as merchandising. It is not a necessary feature of merchandising that members of the public will think the products are in any sense endorsed by the film makers or actors in the film. Merchandised products will include some where there is a perception of endorsement and some where there may not be, but in all cases the products are tied into and are a reminder of the film itself. An example of merchandising is the sale of memorabilia relating to the late Diana, Princess of Wales. A porcelain plate bearing her image could hardly be thought of as being endorsed by her, but the enhanced sales which may be achieved by virtue of the presence of the image is a form of merchandising.”

36. This explanation reveals that character merchandising and endorsement are rather different in nature. As its name suggests, character merchandising encompasses a range of activities which share the common feature that they involve the licensing of the names or likenesses of famous characters, whether real or fictional. For example, it may be that there is a relatively simple licence in place, including, possibly, a licence of copyright material. Endorsement, on the other hand, describes one particular kind of relationship between the characters (or their creators) and the goods which bear their names or likenesses, and it implies authorisation and approval.”

69. BLE claims that the use of Barisons’ mark in relation to the services covered by its application would be a misrepresentation to the public. This is because it would indicate that (a) the services are provided by the opponent or with its consent, or (b) feature the work of Bruce Lee, or (c) BLE has a major role in the production of the services, or (d) there is a “*close relationship*” with BLE, which does not exist.

70. So far as (b) is concerned, I see no reason why the use of JUN FAN THE MUSICAL (or even BRUCE LEE THE MUSICAL) would be taken to mean that the services provided under the mark feature the work of Bruce Lee. Barisons’ mark makes no such claim.

71. I have a number of difficulties with the other aspects of BLE's case on misrepresentation. Firstly, Mr Lee himself died in 1973. Therefore, no one had any reason to believe that Mr Lee endorsed Barisons' services at the relevant date. Secondly, there is no evidence that BLE or its predecessors had carried on a merchandising business in the UK at the relevant date, or a business providing commercial endorsements of any sort, or provided any martial arts training or entertainment services. Consequently, even if they knew that JUN FAN was Bruce Lee given name at birth, there is no reason why the UK public should have expected the user of that sign to be endorsed by BLE. In this respect the facts in this case are closer to those in *Elvis Presley TMs*²¹ than *Fenty v Arcadia Group Brands Limited* or *Irvine v Talksport Ltd*. Thirdly, there is no evidence that JUN FAN was in fact distinctive of Bruce Lee to the UK public at the relevant date. The fact that during his professional career Mr Lee himself used the name 'Bruce Lee' is a strong indication that JUN FAN was unlikely to have been distinctive of him to the UK public some 43 years after his death. I see no contradiction between this conclusion and the applicant's proposed use of JUN FAN THE MUSICAL. In this connection, I note that the sign used on Barisons' website is actually JUN FAN, the Bruce Lee musical, indicating that some explanation of JUN FAN was thought to be necessary to explain that the show is about Bruce Lee.

72. Therefore, whether or not the goodwill generated by Bruce Lee's martial arts performances still existed in the UK at the relevant date, I find that the use of JUN FAN THE MUSICAL would not have constituted a misrepresentation to the public.

73. The s.5(4)(a) ground fails accordingly.

Outcome

74. Barisons' partial opposition to application 3180360 is successful. The application will therefore be refused in relation to *Art prints; posters; pens; books; cardboard stand-up cutouts featuring photographs or artwork; photographs* in class 16. It will be registered in class 16 for the remaining unopposed goods.

²¹ [1999] RPC 567 CA

75. The trade mark will be refused in class 41, except for: *Education; training; seminars; non-downloadable film clips and information on education, training and seminars provided by a website.*

76. The mark will be registered for all the goods covered by classes 9, 11, 14, 18, 20, 21, 24, 25 & 28 of the application, none of which were opposed.

77. BLE's opposition to Barisons' application fails. Barisons' application will be registered for the services shown at paragraph 56 above.

Costs

78. Barisons' partial opposition to BLE's application has succeeded. BLE's opposition to Barisons' application has failed. Therefore, Barisons is entitled to a contribution towards its costs.

79. As Barisons is not legally represented, it was sent a costs pro-forma and asked to provide a breakdown of the time spent on these proceedings. The purpose of this was to ensure that any costs awarded did not exceed Barisons actual costs. No such information was provided. In these circumstances I assess costs as follows:

£200 for filing the Notice of Opposition to BLE's application;

£300 for considering BLE's evidence and filing evidence in response;

£50 for taking part in the hearing.

80. I therefore order Bruce Lee Enterprises LLC to pay Barisons Theatre Productions Limited the sum of £550. This to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 8th day of August 2018

**Allan James
For the Registrar**

ANNEX A

Class 9: Earphones; headphones; USB flash drives; mobile phones; mobile phones cases; computer games; games for mobile devices; decorative magnets; eyewear (glasses & sunglasses); eyeglass cases; cases and covers for laptop computers; protective articles for use in martial arts; mouse mats, mobile phone accessories, computer games equipment; screen saver software.

Class 11: Lamps; book lights; incandescent light bulbs; fitted vinyl films known as skins for covering and protecting flashlights; lighting and illuminating apparatus and devices and parts and fittings therefor.

Class 14: Watches; jewelry; commemorative coins; lapel pins; rubber or silicon bracelets; clocks; cufflinks; jewelry in the nature of dog tags for wear by humans for decorative purposes; jewelry boxes; silver wrist cuffs; tie clips.

Class 16: Art prints; posters; pens; calendars; trading cards; books; photographic prints; stationery; notebooks; daily desktop organizers; memo pads; stickers; writing paper; envelopes; greeting cards; postcards; and cardboard stand-up cutouts featuring photographs or artwork; photographs; diaries; instructional and teaching materials.

Class 18: Backpacks; sports bags; wallets; handbags; baggage tags; satchels; all-purpose carrying cases; clips that attach to bags or purses as a decorative accessory; umbrellas; all-purpose carrying bags; beach bags; cosmetic or toiletry bags sold empty; business card cases; coin purses; diaper bags; duffel bags; purses; leather credit card holders; luggage handle wraps; luggage tags; messenger bags; pet clothing; pet collars; reusable shopping bags; wine bottle tote bags; luggage.

Class 20: Plastic key chains; plastic cake decorations; mirrors; decorative boxes of wood; non-metal hooks used to hang a purse or bag from a flat surface; non-metal key hangers; photo frames; pillows.

Class 21: Beverage glassware; cups; mugs; lunch boxes with drinking cups; beverage ware; bottle chillers specially adapted for use with wine bottles; bottle stoppers specially adapted for use with wine bottles; candle holders; charms for attachment to beverage glassware for identification purposes; coasters not of paper and not being table linen; cocktail plates and serving platters; cocktail shakers; containers for household or kitchen use; cutting boards; decorative ceramic tiles not for use as building materials; pet feeding dishes; flasks; milk bottles sold empty; oven mitts; potholders; recipe boxes; serving trays; drinking steins; tea tumblers in the nature of insulated drinking containers with infusers for brewing tea; teapots; thermal insulated bags for food or beverage; thermal insulated can wraps for keeping contents hot or cold; thermal insulated containers for food or beverage; travel mugs; water bottles sold empty.

Class 24: Plastic banners and plastic car flags.

Class 25: Clothing; headwear; footwear.

Class 28: Toys; action figures; athletic equipment; Christmas tree decorations; puzzles; playing cards; modeled toy figurines; toy balloons; games and playthings; fitness and exercise equipment; protective vests for martial arts; gymnastic and sporting articles and equipment.

Class 30: Coffee; tea; fruit tea; tea-based beverages; candy; edible cake decorations; confectionery; snack foods made from cereals or rice or mixtures thereof; milk products, namely, ice cream, ice milk, and frozen yogurt; salad dressings, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery; cookies and biscuits; ices; honey, treacle; yeast, baking-powder; salt, mustard, vinegar and condiments; cereal-based snack foods; rice-based snack foods; wheat-based snack foods.

Class 41: Education; training; seminars; theatrical shows; non-downloadable film clips and information on education, training, seminars and theatrical shows provided by a website; sporting and cultural activities.