

O-705-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3240031
BY WORLD MODELLING INDUSTRIES ASSOCIATION FOR THE TRADE MARK**



IN CLASS 41

AND

THE OPPOSITION THERETO UNDER NUMBER 410183

BY

MISS WORLD LIMITED

Background

1. On 27 June 2017, World Modelling Industries Association (“the applicant”) filed trade mark application number 3240031, for the mark shown on the cover page of this decision, in respect of services in class 41:

Organising and conducting of beauty contests, beauty pageants and beauty competitions; Education; providing of training; entertainment; sporting and cultural activities.

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 7 July 2017. Miss World Limited (“the opponent”) opposes the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For section 5(2)(b), the opponent relies upon three following earlier trade mark registrations in Class 41:

(i) European Union TM (“EUTM”) 151282

MISS WORLD

Entertainment services; production of television, films and video; organisation, sponsorship, running of contests; beauty contests; organisation of conferences and business meetings; organisation of exhibitions for cultural, educational and entertainment purposes.

Date of filing: 1 April 1996; completion of registration procedure: 21 January 1999.

(ii) 1278549



Organisation of contests; production of live entertainments; all included in Class 41.

Date of filing: 1 October 1986; completion of registration procedure: 22 March 1991.

(iii) 1278527



Registration of this mark shall give no right to the exclusive use of the words "Mrs World".

Organisation of contests; production of live entertainment; all included in Class 41.

Date of filing: 1 October 1986; completion of registration procedure: 12 February 1993.

3. The opponent claims that the marks are highly similar and that the parties' services are identical and highly similar, leading to a likelihood of confusion under section 5(2)(b) of the Act.

4. For section 5(3) of the Act, the opponent relies upon a reputation in marks (i) and (ii), claiming that use of the applicant's mark would take unfair advantage of the

distinctive character, and/or cause detriment to the distinctive character and repute of its mark. The unfair advantage claim appears to be predicated upon the fact that the opponent has not granted a licence to the applicant and so the applicant would be able to 'free-ride' on the reputation of the earlier marks. The opponent further claims that its ability to attract business will be damaged and diluted by the presence of competing contests under the applicant's mark. It also claims that the similarities between the marks will cause the relevant public to believe that they are either used by the same undertaking or that there is an economic connection between the users.

5. Under section 5(4)(a) of the Act, the opponent claims that use of the applicant's mark is liable to be prevented under the law of passing off, owing to its goodwill attached to signs corresponding to marks (i) and (ii), which it claims to have used throughout the UK since 1 January 1951 and 1 January 1986, respectively, in respect of broadly the same services covered by mark (i).

6. The applicant filed a defence and counterstatement, denying all the grounds and putting the opponent to proof of use of its earlier registered marks in the following manner:

Do you want the opponent to provide "proof of use"?

Yes No > GO TO Section 8

List of goods and/or services
List goods/ services for which you require 'proof of use'. Please use a continuation sheet if not enough space.

Note: If more than one trade mark is being relied upon by the opponent or cancellation applicant, please provide the number(s) of the trade mark(s) for which you would like the other party to provide "proof of use".

1) PLEASE PROVIDE PROOF OF USE OF TRADE MARK NO: 1278527 (MRS WORLD) FOR SERVICE IN CLASS 41 - ORGANISATION OF CONTEST, PRODUCTION OF LIVE ENTERTAINMENT, ALL INCLUDED IN CLASS 41.

2) PLEASE PROVIDE PROOF OF USE OF TRADE MARK NO: 1278549 FOR SERVICE IN CLASS 41 - ORGANISATION OF CONTEST, PRODUCTION OF LIVE ENTERTAINMENT, ALL INCLUDED IN CLASS 41.

3) PLEASE PROVIDE PROOF OF USE OF TRADE MARK NO: EUTM00151282 FOR SERVICE IN CLASS 41 - RUNNING OF CONTESTS, BEAUTY CONTESTS.

7. The opponent is represented by Bear & Wolf IP LLP, whilst the applicant is represented by Meng Long Feng. The opponent filed evidence and submissions.

Neither party chose to be heard. The opponent filed written submissions in lieu of a hearing. I make this decision having taken into account all the papers on file.

Preliminary remarks

8. In the counterstatement, the applicant said this:

“We submit that the trade mark (if registered) will be mainly used for services describe [sic] in Class 41 in China.”

9. The opponent filed written submissions with its evidence, and in lieu of a hearing, referring to this statement in the context of section 3(6) of the Act: that the application was filed in bad faith because there was no bona fide intention to use the trade mark in relation to the specified services in the UK. The opponent did not make a formal application to add the ground by filing statutory form TM7G, with the fee, as per the requirements of rule 62(1)(e)(i) of the Trade Marks Rules 2008 (as amended)¹. Furthermore, the opponent expanded upon this ‘pleading’ in its written submissions in lieu of a hearing to include submissions about the applicant applying for a mark which is similar to a mark which it knows others are using, citing the decision of the Court of Justice of the European Union (“CJEU”) in *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*.² This is inherently unfair; not only has the ground not been formally pleaded, the opponent has left it until the end of the proceedings – at the point of written submissions in lieu of a hearing to which there is no reply – to add a further aspect to its bad faith ‘pleading’.

10. In the absence of any formal application to add section 3(6) as a ground of opposition, the opposition will be decided on the grounds which are pleaded: sections 5(2)(b), 5(3) and 5(4)(a). In any event, I note that the applicant stated that the mark would be ‘mainly’ used in China. That does not mean that there will be no use in the UK (if registered); it signifies that its main market is in China.

¹ “Where an application is made to add grounds of opposition other than under subsections 5(1) or (2) of the Act, the application shall be made on Form TM7G.”

² C-529/07.

Relevant dates

11. The opponent's earlier marks had all been registered for more than five years on the date on which the contested application was published. They are, therefore, subject to the proof of use provisions under section 6A of the Act, and the applicant has requested proof in the manner set out above. The relevant date for this purpose is the five year period prior to and ending on the date of publication of the contested application: 8 July 2012 to 7 July 2017. The relevant date for the purposes of sections 5(2)(b), 5(3) and 5(4)(a) is the date the application was filed: 27 June 2017.

Evidence

12. The opponent's evidence comes from Steven Morley, who is the opponent's events director. His witness statement is dated 24 April 2018.

13. Mr Morley states that the Miss World Beauty contest was started by his father in London, in 1951, as part of the Festival of Britain. The winner was crowned "Miss World". Mr Morley states that a MISS WORLD competition has taken place annually ever since, being the oldest surviving beauty contest in the world. He refers to pages 19 to 63 as showing a list of all the winners, with locations. These are shown in pages from the website missworld.com. The opponent owns this website and also missworld.co.uk, which re-directs to the .com website. There were contestants from England, Wales, Scotland and Northern Ireland in the contest held in China in 2017. Between 1951 and 1988, all the finals took place in London. After that, London finals were held in 1990, at the London Palladium; in 1999, at Olympia; in 2000, at the Millennium Dome; in 2002, at Alexandra Palace; in 2011, at the Earls Court Exhibition Centre; and in 2014, at the Excel Auditorium.

14. Pages 70 to 74 of the evidence show the website as it looked in 2013, when the contest was hosted in Bali. Mark (ii) appears at the top, together with mark (i) beneath it. Mr Morley states that the website receives over 100,000 visitors per month, globally, increasing to over 300,000 around the time of the annual final. Pages 75 to 82 of the evidence are prints from the opponent's Facebook and Twitter accounts, again showing the combination of marks (i) and (ii). The Facebook

address is “en-gb.facebook.com”. These are dated “Fri 20 Apr”. The opponent also has a MISS WORLD app, which Mr Morley states has been downloaded thousands of times, “in the UK and elsewhere”. Images of this appear at pages 83 to 85 of the evidence. The combination of marks (i) and (ii) appear at the top, along with mark (i) by itself.

15. Mr Morley states that the opponent, its directors and managers have always run the contest from the UK. Each year, the opponent grants licences to various national licensees to conduct national heats to find, e.g. Miss France, Miss Brazil etc. The opponent works with the national licensees in organising and holding the national contests, including those for the four UK nations. Entrants to the heats compete on attributes such as beauty, culture and dance. The winner of each national heat then competes in the annual Miss World final, which is held in major world cities. Mr Morley states that the final is broadcast to “massive audiences worldwide”. A sample licence to the Indian licensee from 2018 is shown at pages 122 to 143 of the evidence.

16. Pages 144 to 155 of the evidence comprise prints from the current websites of the four UK national contests. The Miss England pages refer to the Miss England contest being the only route to entering Miss World. The Miss Scotland website refers to the winner having the chance to enter the 2017 Miss World contest in China. The Miss Wales website says that Miss Wales is automatically guaranteed a place at the Miss World contest. Mr Morley states that the references to Miss World are under licence from the opponent. Each of the four UK contests enters into licence agreements with the opponent. Examples are shown from pages 156 to 198 of the evidence. Only mark (i) is shown, not the globe marks (marks (ii) and (iii)).

17. Pages 200 to 211 of the evidence comprise copies of brochures for the contest held at the Royal Albert Hall in 1971 and 1975, televised on the BBC. Pages 212 to 219 comprise a press information brochure and souvenir programme from 1999. Mark (ii) is shown on the front cover and inside of the former, as are the words MISS WORLD and the footer of each page. The contest this year was held at Olympia, in London. The souvenir programme has a combination of marks (i) and (ii) on the front cover. The schedule says that the contest was live to the world at 8pm, but

does not say how, although I note that the front page says “LIVE ON 5” (the numeral 5 appearing inside a circle). Brochures from the 2002 and 2011 contests, held in London, are shown from pages 237 to 257 of the evidence. The words MISS WORLD appear on the front cover and inside, and a combination of marks (i) and (ii) appear inside. Again, the schedule refers to the event being “live to the world”. Mr Morley states that the brochures had a wide circulation in the UK, and have done so every year. However, he does not elaborate upon this assertion.

18. Pages 263 to 277 comprise extracts from brochures and promotional materials relating to the 2014 final, held in London. A combination of marks (i) and (ii) are in evidence in the promotional material and on the outside of the venue. Page 268 refers to a live stream of the event on E! Entertainment Television being advertised on a website called thepageantplanet.com. Page 297 shows a picture of ‘Miss World’ on stage, wearing a Miss World sash, with the words “Miss World 2016 Winner Puerto Rico London Live. Mr Morley explains that the broadcast went through London Live, an online broadcaster which he states has a broad circulation in the UK; however, there are no details about viewing figures.

19. A copy of an article from the Mail Online, dated 31 December 2013, is exhibited (pages 284 to 285) which refers to events which have attracted the largest television viewing figures in the UK. Miss World is listed as in the top 20 largest audience programmes, but this was in 1967 and 1970 (nearly 23 million viewers). Mr Morley states that Thames Television broadcast the contest from 1980 to 1988; prints from the TV Times from 1980 are shown at pages 286 to 289, although this regarded the airing of the (then) Miss United Kingdom contest. At this point in the contest’s history, viewing figures were about 12 million each year. Mr Morley refers to ITV, Sky (from 1997) and Channel 5 (from 1999). I note that page 296 of the evidence is a copy of an article from The Express on Sunday, 22 November 1998. It says:

“For a decade they languished in the TV wilderness, but now the world’s most beautiful girls will again parade across our screens. After disappearing to satellite amid accusations of being degrading to women, this year’s Miss World competition will be broadcast from the Seychelles by Channel 5.”

20. An article in the same paper a week later (page 297 of the evidence) reported that 3 million viewers watched the broadcast, there having been a 10-year gap since the contest was last aired on terrestrial television. That year's programme featured on the front page of the Daily Telegraph's seven-day television and radio guide.

21. Mr Morley refers to indicative pieces of typical UK press coverage at pages 330 to 341 of the evidence. The most recent of these is dated in November 2000. Mr Morley states that press coverage continues until "this day", but provides no examples.

23. Mr Morley states that the contest is growing in popularity, globally, but does not cite the UK as one of the countries where it is popular (he mentions China, South America, India and the Pacific Rim). Mr Morley states that the contest is not simply a 'beauty contest', as the individual and social aspirations of the candidates are measured. He refers to charitable work playing a central theme, "Beauty With A Purpose". The evidence shows that the winners spend several months assisting with charitable projects for children worldwide.

24. Mr Morley states that worldwide turnover figures are substantial, but does not reveal what they are, other than in the region of £5 to 10 million per annum, saying they are confidential. He states that although the business is global, all of its revenue is taxed in the UK. Mr Morley considers this fact shows that it does business in the UK.

25. Pages 348 to 353 comprise a copy of a judgment of the England and Wales High Court (Patents), given by Pumfrey J on 16 April 2007, granting an injunction against Channel 4 against broadcasting a programme called "Mr Miss World". The opponent was the applicant for the injunction. In the first paragraph, the judge refers to the opponent as being the organizer of "the well-known beauty pageant".

Decision

26. As set out earlier, the applicant has requested proof of use for all of the services registered under earlier marks (ii) and (iii), but only for some of the services registered under mark (i).

27. The services registered under mark (i) are:

*Entertainment services; production of television, films and video; organisation, sponsorship, **running of contests; beauty contests**; organisation of conferences and business meetings; organisation of exhibitions for cultural, educational and entertainment purposes.*

The applicant has requested proof of use for the terms I have shown in bold text. The consequence of its partial request for proof of use is that the opponent is entitled to rely upon all the other services in the specification of earlier mark (i) without having to prove that it has made genuine use of the mark in relation to them.

28. Section 6A of the Act states:

“(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

29. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case law on genuine use of trade marks:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 *P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein*

at [13]; Silberquelle at [17]; Leno at [29]; Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: Gözze at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: Ansul at [37]. Internal use by the proprietor does not suffice: Ansul at [37]; Verein at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71]; Reber at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

30. The onus is on the opponent, as the proprietor of the earlier marks, to show use because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

31. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself³. There is no use shown in the evidence of mark (iii) (the Mrs World composite mark). I do not agree with the opponent that the difference between Mrs World and Miss World is negligible. The words produce different concepts: one of married, compared to unmarried, status. Consequently, I find that the opponent has not shown genuine use of this mark and so is not entitled to rely upon it for the purposes of this opposition.

32. Mark (i) is for the word mark MISS WORLD. There are examples in the evidence of this mark in use by itself, as well as in combination with mark (ii) (the globe mark). This use is an acceptable variant of MISS WORLD, as per *Colloseum*

³ Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, GC.

Holdings AG v Levi Strauss & Co., Case C-12/12, which concerned the use of one mark with, or as part of, another mark. The CJEU found (emphasis added):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark

that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”.

33. Mark (i) is an EUTM. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create

or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

34. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

35. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the

use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is

that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

36. The GC restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

37. The opponent's evidence about worldwide use is not relevant to the question as to whether there has been use of mark (i) in the EU unless the evidence relates to the EU. Consequently, genuine use is not demonstrated by Mr Morley's assertion that the contest is more popular than ever in the Far East, South America, India and the Pacific Rim. Whether the use shown is sufficient depends on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- (v) The geographical extent of the use shown

38. I remind myself that the period during which genuine use must be shown is 8 July 2012 to 7 July 2017. A substantial amount of the opponent's evidence is

devoted to the history of the contest from several decades before the relevant period. In terms of use which falls within the relevant period, I note the following:

(a) a contest called MISS WORLD featuring young women competing has been held annually in various global countries. Its frequency is set as an annual event. This seems reasonable in the context of the market; it would be counter-intuitive to have beauty contests taking place all the time as it would reduce the impact of the event (in a similar way to major sports events which draw competitors internationally). The maximum number of such events that could potentially have taken place in the UK would therefore have been no more than five. In 2014, the contest was held in London. None of the finals in 2012, 2013, 2015, 2016 or 2017 were held in the UK or in any other EU member state. The evidence relating to the 2014 event shows a combination of marks (i) and (ii). This event was broadcast online, with a 'broad circulation in the UK', although there are no viewing figures.

(b) The website for the Miss Scotland contest in the relevant period referred to the winner gaining automatic entry to the Miss World contest in 2017. The most reasonable inference is that the Miss Scotland reference to the Miss World contest was in the relevant period, as the Miss Scotland contest had not yet taken place and it referred to the forthcoming 2017 Miss World final. Only mark (i) is shown.

39. Although the EU market at issue is not limited to or particularly concentrated in the UK, I find that the use of the earlier EUTM in the UK is sufficient to constitute genuine use of that mark in the EU given that this is an international event. It is also sufficient to constitute use of the UK mark (mark ii). Whilst the evidence for the EU and UK within the relevant period is scant and somewhat buried amongst the historical evidence of the contest, having extracted it and put it together, I consider that, in totality, it produces a picture of use within the relevant period. The next issue to decide is in relation to what services the marks have been used.

40. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark

has been used and which are not in substance different from them;
Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

41. Mr Morley states that the entrants to the competition compete on attributes such as beauty, culture and dance. I do not think that, to the extent that the opponent has been put to proof of genuine use, that the evidence supports a specification which is any wider than *running of beauty contests; beauty contests*. The contests are not dancing or culture contests. I think that the average consumer would fairly describe the services shown in the evidence as beauty contests, which is a category in its own right.

42. Bearing in mind the partial nature of the proof of use request in relation to mark (i), the opponent may rely on mark (i) in relation to *entertainment services; production of television, films and video; organisation and sponsorship of contests; running of beauty contests; beauty contests; organisation of conferences and business meetings; organisation of exhibitions for cultural, educational and entertainment purposes*.

43. The opponent may rely upon mark (ii) in relation to *organisation of beauty contests*. As stated earlier, the opponent cannot rely upon mark (iii).

Section 5(2)(b) of the Act

44. Section 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because –

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

45. The following principles are gleaned from the decisions of the CJEU 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) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) 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;

(h) 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;

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) 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.

Comparison of services

46. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“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.”

47. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

48. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

49. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

50. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert

sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

51. The services to be compared are shown in the table below.

Earlier marks	Application
<p><u>Mark (i)</u> Class 41: <i>Entertainment services; production of television, films and video; organisation and sponsorship of contests; running of beauty contests; beauty contests; organisation of conferences and business meetings; organisation of exhibitions for cultural, educational and entertainment purposes.</i></p>	<p>Class 41: <i>Organising and conducting of beauty contests, beauty pageants and beauty competitions; education; providing of training; entertainment; sporting and cultural activities.</i></p>
<p><u>Mark (ii)</u> Class 41: <i>Organisation of beauty contests.</i></p>	

52. *Organising and conducting of beauty contests, beauty pageants and beauty competitions* are identical to the opponent's *running of beauty contests; beauty contests* (mark (i)) and *organisation of beauty contests* (mark (ii)).

53. *Entertainment* is identical to the opponent's *entertainment services* in mark (i). In relation to the services covered by mark (ii), I find they are highly similar to the applicant's *entertainment*. A beauty pageant is a form of entertainment. The purpose of the opponent's services is to bring about that particular form of entertainment.

Whilst some of the users will be the entrants themselves, audiences watch beauty pageants as well as other forms of entertainment.

54. The law requires that goods and services also be considered identical where one party's description of its goods or services encompasses the specific goods or services covered by the other party's description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC. I find that the applicant's *sporting and cultural activities* covers the opponent's *organisation of exhibitions for cultural, educational and entertainment purposes* covered by mark (i). In relation to mark (ii), I find that the applicant's *sporting and cultural activities* are similar to a very low degree to the opponent's *organisation of beauty contests*. Whilst both share a degree of similarity of nature in that they are organising services, the subject matter of the activities being organised is very different. As said earlier, I do not think that the natural and core meaning of a beauty contest is that it is a cultural activity. It is not a sporting activity. The purpose is different, the users will be different, they are not in competition and are not complementary.

55. This leaves the applicant's *education; providing of training*. There is a degree of similarity here with the opponent's *organisation of exhibitions for educational purposes*. For example, museums provide educational services and organise exhibitions. The nature of the service is not exactly the same, but the end product of the organisation service is for educational purposes. That means that the purpose of the organising service and of the education service lead to a common result. I find that they are reasonably similar. There is little difference between 'education' and 'providing of training'; hence, the opponent's services are reasonably similar to the applicant's *education; provision of training*.

The average consumer and the purchasing process

56. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. The majority of the applicant's services are

aimed at the general public, whether as contestants or spectators. The opponent's services are also largely aimed at the general public. Although I do not discount an aural perception of the marks during selection of services, it appears to me that the services will be selected primarily via visual means e.g. after consulting websites. For example, the opponent's evidence suggests that entry to its contests takes place through the website, although telephone numbers are also provided. There is likely to be a reasonable level of attention paid if applying as a contestant to a beauty contest, but I think less attention will be paid by spectators, or television audiences of beauty contests. In relation to the other services, these will cause, on the whole, an average degree of attention to be paid to their selection.

Comparison of marks

57. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

58. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Opponent's marks	Applicant's mark
<p>Mark (i): MISS WORLD</p> <p>Mark (ii)</p> 	

59. The overall impression of the opponent's mark (i) resides in the phrase MISS WORLD, neither word dominating. The opponent's mark (ii) consists of a globe and a device curving around the top of the globe, which the opponent submits represents a crown. It appears more as the conjoined letters M and W above an indeterminate pattern, or as an abstract arrangement, than a crown, in my view. The eye is drawn marginally more to the globe than what is on top of it, but both components contribute roughly equal weight to the overall impression.

60. The applicant's mark is composed of a number of elements, the most dominant of which are the winged devices emanating from each side of the central globe. These are what first strike the eye before it takes in the globe, then moving up to the elaborate crown/tiara. The words Miss Beauty World are proportionately very small compared to the rest of the mark, appearing smaller than the oriental characters; although I note that they appear at the top and the bottom of the mark. Their relative size means that they carry less weight in the overall impression than the large winged devices and, to a secondary extent, the central globe.

61. The colours used in the applicant's mark are not a distinguishing feature because the earlier marks are registered in black and white, notionally covering

colour⁴. Although notional use does not cover complex arrangements of colour, one of the conventional colours for a globe is blue, so it is reasonable to infer, in any event, that notional use of the opponent's mark (ii) might extend to a blue globe.

62. The only visual similarity between mark (i) and the application is the words MISS WORLD. They appear in the application, but with the word BEAUTY between them. As said earlier, the words in the application are small. The applicant's mark is complex, with the other elements much more visually dominant. There is a very low degree of visual similarity between the marks.

63. Mark (i) and the application are aurally similar because the only words which would be pronounced in the application by the average UK consumer are the words Miss Beauty World. The first and last words in Miss Beauty World are the same as Mark (i). There is a medium degree of aural similarity between MISS WORLD and the application.

64. Conceptually, mark (i) is the personification of the world as an unmarried woman. The wording MISS BEAUTY WORLD creates an idea of a personified one-stop-shop for beauty requirements or products. The concepts created by the remaining features of the applicant's mark are elaborate wings, a tiara, a globe and oriental writing. The globe reinforces the concept of world in the opponent's mark, although does not link to the personification of the world. Weighing all the elements, the marks are conceptually similar to a low degree.

65. In relation to the comparison between the application and mark (ii), the high point for the opponent is that both marks include a globe. As said above, I do not see the arrangement on top of the globe in earlier mark (ii) as a crown. The marks have a low degree of visual and conceptual similarity, and no aural similarity. If I am wrong about the crown, the marks have a low to medium degree of conceptual similarity, and the crowns are so different that the visual similarity would still be low.

⁴ *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290 at paragraph 47

Distinctive character of the earlier marks

66. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁵ the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

67. Mark (i) has a meaning as a unit, rather than two separate, unrelated words. In the context of beauty contests, whilst the mark is not directly descriptive, it is not hard to grasp the idea of the contest being to search for the most attractive unmarried woman in the world. For other services covered by the earlier mark, the mark is not inherently descriptive or allusive. I find that the mark has a low degree of inherent distinctive character in relation to beauty contests, but a medium level in relation to the other services.

⁵ Case C-342/97

68. Mark (ii) is a device mark or a device mark with the stylised letters MW across the top. The mark does not directly describe the services which the opponent may rely upon, organisation of beauty contests, but the globe mildly alludes to an international dimension to the contests. The globe is the least distinctive of the elements of the opponent's mark which, overall, has a medium level of inherent distinctive character. The globe is the only point of similarity with the application.

69. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that 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. With this in mind, I need to assess whether the use made by the opponent of its marks has improved their inherent distinctiveness level. The relevant date for this assessment is the filing date of the contested application, 27 June 2017.

70. Distinctive character is a measure of how strongly the marks identify the services of the opponent in the UK, not simply that they are known. It includes taking into account, as set out in *Lloyd*, the inherent characteristics of the marks. I have found mark (i) to have a low degree of inherent distinctive character in relation to beauty contests, and a medium level in relation to the other services. Mark (ii) has a medium level of distinctive character. The evidence does not persuade me that these levels have been enhanced through use. Firstly, the evidence is all directed at beauty contests, there is no evidence relating to the other services relied upon under mark (i). Secondly, in relation to beauty contests, if the relevant date had been in the 1970s, or possibly the 1980s, I might have taken a different view. However, it seems to me on the evidence that the heyday of MISS WORLD, as far as the UK is concerned, has long since passed. It is of no relevance that the contest is increasing in popularity in other areas of the world. The opponent has taken the decision not to divulge turnover figures for the UK. There is little evidence of UK television coverage of the annual event which has been on a serious wane as far as television coverage in the UK is concerned. It had a revival in 1998, on Channel 5, after a ten-year absence from UK screens. It appears from the evidence that it is no longer broadcast in the UK on Channel 5, but is instead broadcast (or streamed) online. There are no details as to how many online viewers the 2014 UK contest had (which

was held in the UK), or how many UK viewers watched the event when it has been held elsewhere. The most recent piece of press coverage which the opponent has included in its evidence dates from 2000.

71. I have not forgotten the inclusion in the evidence of the High Court judgment, in which Pumfrey J characterised the opponent as being the organizer of the “well-known beauty pageant”. However, that was in 2007. That is a decade before the relevant date in these proceedings. If the opponent wishes it to be found that its marks were entitled to an enhanced level of distinctiveness at the relevant date, its evidence should have focussed on more recent times, not the distant past. All the evidence, when it is put together, paints a picture of a contest that may have been well-known some 40 or more years ago in the UK, but was not well-known in the UK in 2017. I consider that the evidence falls short in respect of both marks (i) and (ii). Although it has passed the proof of use hurdle, as set out above, it falls a long way short of proving an entitlement to enhanced distinctive character.

Likelihood of confusion

72. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa.

73. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said

in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

74. Simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ The globe is the least distinctive of the elements of the opponent’s mark (ii) which, overall, has a medium level of inherent distinctive character. For contests, a globe is low in distinctive character. The globe is the only point of similarity between the marks. Given the other differences between them, there is no likelihood of confusion between earlier mark (ii) and the application, even in relation to identical services. If I am wrong that the elements on top of the globe in mark (ii) would not be seen as a crown; i.e. that they would be seen as a crown or reminiscent of a crown, it would not alter my view because the ‘crown’ and tiara are so different, together with all the other differences between the marks.

75. I found that for beauty contest services, which are identical, mark (i) has a low degree of distinctive character. The marks are very low in similarity visually, aurally medium, and conceptually low in similarity. The purchasing process is predominantly visual. Putting all the factors together, there is no likelihood that the marks will be imperfectly recalled and mistaken for one another. They are simply too different for that to happen. Is there, however, a likelihood of indirect confusion? Indirect confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

76. The only point of similarity between the marks are the words MISS and WORLD. However, the concepts of MISS WORLD and MISS BEAUTY WORLD are not the same. It is unlikely that the average consumer would consider that these marks are economically linked because the much more complex mark does not include the same words (i.e. without modification) or an obvious extension of the idea. A mark as complex as the applicant's would need to include MISS WORLD or a sufficiently close concept in the context of the mark as a whole for the average consumer to consider that the marks have enough in common to be economically linked. MISS WORLD is not identical and is not a sufficiently close concept to MISS BEAUTY WORLD, even in relation to beauty contests, for which MISS WORLD is low in distinctive character. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion. I consider that to be the case here: at the very most, there may be a fleeting calling to mind. That is not enough for a finding of a likelihood of confusion.

77. Although mark (i) has a medium degree of distinctive character for services other than beauty contests, all else being equal, this is not enough to cause either direct or indirect confusion, for the reasons already given.

78. The opponent's section 5(2)(b) ground fails.

Section 5(3) of the Act

79. Section 5(3) states:

“(3) A trade mark which-

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

80. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective

marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in

particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

81. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks (i) and (ii) have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the three types of damage claimed (unfair advantage and detriment to distinctive character) will occur and/or that the relevant public will believe that the marks are used by the same undertaking or that there is an economic connection between the users. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

82. The first condition is reputation. For its section 5(3) ground, the opponent relies upon all the services of marks (i) and (ii). Owing to my earlier findings in respect of genuine use of the registration during the relevant period, the opponent is restricted to claiming a reputation for mark (i) in *entertainment services; production of television, films and video; organisation and sponsorship of contests; running of beauty contests; beauty contests; organisation of conferences and business meetings; organisation of exhibitions for cultural, educational and entertainment purposes*; and for mark (ii) in *organisation of beauty contests*. Whilst it was not required to prove genuine use in relation to the majority of its services for mark (i) and so was able to rely upon the for section 5(2)(b), the same is not true for section 5(3), for which there must be evidence of a reputation. The only use that has been shown is in respect of beauty contest and organization thereof.

83. The CJEU gave guidance in relation to assessing reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

84. His Honour Judge Hacon, in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) stated “Reputation constitutes a knowledge threshold”. It is a question of how many of the potential consumers of the services know of the earlier marks. The list of factors set out by the CJEU in *Intel*, to be taken into account in determining whether there is a link, includes, as separate factors, the strength of the earlier mark’s reputation and the degree of distinctive character, whether inherent or acquired by use. I have already said that the marks have not had their inherent levels of distinctive character (which are low and medium) enhanced through use. I also consider that it has not been shown that, at the relevant date, either earlier mark had a sufficiently strong reputation to cause a link to be made with the application. Even in relation to identical services, the evidence of use in the UK is too weak in the years leading up to the relevant date to bring the earlier marks to the mind of the relevant UK public. This is particularly so in relation to mark (ii) for which there is less evidence than for mark (i).

85. I have considered whether that is the case in relation to consumers who are older and might remember the MISS WORLD contests in their heyday (i.e. mark (i)). Firstly, I am doubtful that this would qualify as a “significant part of the [UK] public”. Secondly, the passage of time and the large amount of differences between the marks (especially for services in relation to which mark (i) is low in distinctive character), lead me to conclude that any calling to mind will be of the fleeting type. As I have already found no likelihood of confusion, the claim that the relevant public will believe that the marks are used by the same undertaking or that there is an economic connection between the users is facing an uphill struggle. The evidence does not assist because it is not strong enough to turn any fleeting bringing-to-mind into a positive enough link that damage might follow. The same is true in relation to the other heads of damage. Any link will be too weak to cause any damage to the earlier marks’ reputation and distinctive character and to give an unfair advantage to the later mark. This is the case for both marks (i) and (ii).

86. The section 5(3) ground fails.

Section 5(4)(a) of the Act

87. 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.”

88. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

89. I find that the opponent had sufficient goodwill in its signs (marks (i) and (ii)) in relation to *beauty contests and organisation thereof* at the date of application, which is the relevant date (there being no use by the applicant) to bring the complaint of passing off. However, the opponent does not appear to me to be in any better a position than in respect of the section 5(2)(b) ground. The opponent’s signs cannot be said, on the evidence, to enjoy such a level of reputation that the distance between the marks matters less. The level of goodwill at the relevant date was not strong, even taking into account past history. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5, in the Court of Appeal, Jacob LJ said:

“16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between “mere confusion” which is not enough, and “deception,” which is. I described the difference as “elusive” in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. I said this, [111]:

"Once the position strays into misleading a substantial number of people (going from 'I wonder if there is a connection' to 'I assume there is a connection') there will be passing off, whether the use is as a business name or a trade mark on goods."

17 This of course is a question of degree—there will be some mere wonderers and some assumers—there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.

18 The current (2005) edition of Kerly contains a discussion of the distinction at paras 15–043 to 15–045. It is suggested that:

"The real distinction between mere confusion and deception lies in their causative effects. Mere confusion has no causative effect (other than to confuse lawyers and their clients) whereas, if in answer to the question: 'what moves the public to buy?', the insignia complained of is identified, then it is a case of deception."

19 Although correct as far as it goes, I do not endorse that as a complete statement of the position. Clearly if the public are induced to buy by mistaking the insignia of B for that which they know to be that of A, there is deception. But there are other cases too—for instance those in the Buttercup case. A more complete test would be whether what is said to be deception rather than mere confusion is really likely to be damaging to the claimant's goodwill or divert trade from him. I emphasise the word "really."

90. The use of the application would not cause a substantial number of the opponent's customers to be misled into purchasing the applicant's services, believing that they are provided by the opponent. The section 5(4)(a) ground fails.

Overall outcome

91. The opposition fails in its entirety.

Final remarks

92. For the avoidance of doubt, even if I had taken mark (iii) into account (pleaded under section 5(2)(b) only), my conclusions would not have differed. MRS WORLD is even further away than MISS WORLD from MISS BEAUTY WORLD. An additional, crucial, factor is that the opponent has disclaimed rights to the exclusive use of the words MRS WORLD. The effect of disclaimers was explained in *Nestle SA's Trade Mark Application* [2004] EWCA Civ 1008. Mummery L.J., giving the judgment of the Court of Appeal, held that:

“An applicant who agrees that the rights conferred by registration shall be subject to a limitation is agreeing, in effect, that the use of the mark outside the limitation is not to be treated as an infringement of the mark notwithstanding that such use would, otherwise, fall within s.10 of the Act.”

In *Phones 4u Ltd v Phone4u.co.uk Internet Ltd*, [2006] EWCA Civ 244, Jacob. L.J. agreed with that approach noting that:

“...a disclaimer or limitation amounts to an unconditional binding acceptance by the proprietor that, notwithstanding the rights conferred by the infringement provisions, he cannot assert rights in breach of the condition or outside the limitation.”

93. Consequently, all that could have been taken into account with regard to mark (iii) are the other elements of the mark, which are the same as those comprising mark (ii), which has been considered.

94. In relation to the expanded bad faith ‘pleading’ in the opponent’s written submission in lieu of a hearing, this would not have succeeded in the face of a failure of the pleaded grounds. There can be no bad faith on the expanded reasoning basis, if there is no confusion.

Costs

95. The applicant has been successful and is entitled to a contribution towards its costs. The applicant has played little part in the proceedings, filing no papers other than its defence and counterstatement, which were resubmitted at the point at which the parties were invited to file written submissions in lieu of a hearing, with no commentary provided about the opponent's evidence. The applicant has communicated via Meng Long Feng, from the email address isolicitorpartners@gmail.com. This indicates legal representation, meaning that the scale of costs, published in Tribunal Practice Notice 2/2016, is applicable. On the basis of the scale, I award the applicant £300 as a contribution towards the cost of filing the counterstatement and reviewing the opponent's evidence and written submissions. £200 of that is for preparing a statement and considering the opponent's statement. The remaining £100 is less than the scale minimum for evidence; however, I consider this is fair since the applicant did not file evidence and did not make any comments about the opponent's evidence. The £100 reflects consideration of the opponent's evidence.

96. I order Miss World Limited to pay to World Modelling Industries Association the sum of **£300**. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of November 2018

Judi Pike
For the Registrar,
the Comptroller-General