

O/1018/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003610540 BY
WORLD BOOK OF RECORDS LIMITED
TO REGISTER:

WORLD BOOK OF RECORDS LIMITED

AS A TRADE MARK IN CLASSES 9, 16, 35 & 41

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 426097 BY
GUINNESS WORLD RECORDS LIMITED

BACKGROUND AND PLEADINGS

1. On 16 March 2021, WORLD BOOK OF RECORDS LIMITED (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods and services:

Class 9: Mobile app's; Mobile software; Software; Computer hardware; Mobile phones; Tablet computers; Electronic paper (display devices)

Class 16: Books; Magazines; Stationery; Covers [stationery]; Files [stationery]; Pens; Writing implements [writing instruments]; Cards; Greeting cards; Printed awards; Printed award certificates; Directories; Classified directories; City directories.

Class 35: Online advertising; Advertising agencies; Newspaper advertising; Magazine advertising; Marketing information; Marketing research; Marketing analysis; Marketing consultancy; Event marketing; Promotion of special events; Arranging and conducting of marketing events; Arranging and conducting of promotional events; Arranging and conducting of advertising events; Conducting employee incentive award programs; Promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with awards programs; Providing marketing information via websites; Providing business information via a website; Compilation of business directories; Providing commercial directory information via the Internet; Providing an on-line commercial information directory on the internet.

Class 41: Online electronic publishing of books and periodicals; Educational services; Training; Providing online electronic publications; Providing online videos, not downloadable; Entertainment

services; Television entertainment; Live entertainment; Entertainment information; Organising sporting events; Organising dancing events; Organisation of musical events; Conducting of educational events; Organising of recreational events; Organisation of cultural events; Organization of sporting events; Organisation of educational events; Issuing of educational awards; Awarding of educational certificates; Arranging of award ceremonies; Organisation of competitions and awards; Arranging and conducting award ceremonies; Hosting [organising] awards relating to videos; Hosting [organising] awards relating to television; Hosting [organising] awards relating to films; Certification in relation to educational awards; Arranging of award ceremonies to recognise achievement; Arranging of award ceremonies to recognise bravery; Providing facilities for sporting events, sports and athletic competitions and awards programmes; Publication of printed directories; Publication of online guide books, travel maps, city directories and listings for use by travellers, not downloadable; Online entertainment services; Online education services; Online publication of electronic newspapers.

2. The applicant's mark was published for opposition purposes on 14 May 2021 and, on 10 August 2021, it was opposed by Guinness World Records Limited ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). In respect of the 5(2)(b) and 5(3) grounds, the opponent relies on the following mark:

GUINNESS WORLD RECORDS

UK registration no: 901532670

Filing date 29 February 2000; registration date 1 August 2001

3. The opponent relies on all of the goods and services for which its mark is registered. These are set out in full at **Annex 1** of this decision.

4. Under its 5(2)(b) ground, the opponent claims that due to the high level of similarity between the parties' marks and the identity and/or similarity of the goods and services at issue, there exists a likelihood of confusion on the part of the relevant public, which includes the likelihood of association.
5. Under its 5(3) ground, the opponent claims that it has obtained a global reputation (especially in the UK) in its mark and use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character or the repute of the opponent's mark.
6. Under its 5(4)(a) ground, the opponent claims to have obtained goodwill in the unregistered sign 'GUINNESS WORLD RECORDS' which it has been using throughout the UK since as early as February 2000 for the goods and services listed in **Annex 2** of this decision. Under this ground, the opponent argues that it has obtained a very substantial goodwill in connection with the sign relied upon and that use of the applicant's mark in the UK would constitute a misrepresentation as it would lead the relevant public to believe (erroneously) that there is a commercial connection between the parties or that the services of the applicant derive from the opponent. This, the opponent argues, would lead to damage to the opponent and its goodwill meaning that the opponent is entitled to prohibit use of the applicant's mark under the law of passing off.
7. The applicant filed a counterstatement denying the claims made.
8. The opponent is represented by Mischon De Reya LLP and the applicant is unrepresented. Both parties filed evidence in chief and the opponent filed further evidence in reply. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The

provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

10. As above, both parties filed evidence. The opponent's evidence in chief came in the form of the witness statements of Raymond Marshall and Nicholas Bitel, both of which were dated 3 February 2022. Mr Marshall is General Counsel of the opponent, a position he has held since 1 December 2016, prior to which he was Head of Legal and Business Affairs of the opponent. Mr Marshall's evidence is accompanied by 35 exhibits, labelled Exhibits RM1 to RM35. Mr Bitel is the Chief Executive of the London Marathon, a position he has held since June 1995. Mr Bitel's statement is accompanied by three exhibits, labelled Exhibits NB1 to NB3.

11. The applicant's evidence in chief came in the form of the witness statement of Santosh Shukla dated 4 May 2022. Mr Shukla is the Director of the applicant, a position he has held since 9 October 2019. Mr Shukla also held this position between the dates of 15 March 2017 and 15 October 2017. Mr Shukla's statement is accompanied by 11 exhibits, labelled Exhibits SS1 to SS11.

12. The opponent's evidence in reply came in the form of the witness statement of David Rose dated 6 July 2022. Mr Rose is employed as a partner at the opponent's representative firm and his statement is accompanied by nine exhibits, labelled Exhibits DR1 to DR9.

13. I will refer to points from the evidence or submissions where necessary.

PRELIMINARY ISSUES

14. In its counterstatement, the applicant made reference to the existence of a number of UK trade mark registrations that include the words 'WORLD RECORD' and 'RECORDS'. The applicant argues that these marks are already being used

without any confusion, disadvantage, inconvenience or loss to any party in the UK. I note that the opponent sought to respond to these points in its own evidence and that the applicant expanded upon this argument further in its evidence in chief. In its evidence, the applicant raised a number of additional businesses that use the words 'WORLD RECORD' or 'WORLD RECORDS' and provided print-outs from the websites of those businesses.¹ I note that these print-outs all have a print out date of 4 May 2022. Despite the applicant's claims, there is no evidence regarding any actual use of these marks or activities of these businesses and neither is there any evidence of how they operate in the marketplace to the extent that they would be viewed in proximity with the opponent's mark. On this point, I note that one example relates to the 'World's oldest record shop' so would, clearly, be of no relevance to the opponent's mark. In any event, the existence of any confusion, disadvantage, inconvenience or loss regarding the marks referred to is not relevant to the assessment I must consider in the present case. Those marks, while having some words in common, are not at issue in these proceedings.

15. In addition to the above, I have given consideration to this argument in respect of the possibility that it was raised in support of an argument that the evidence points towards a weakened distinctive character of the opponent's mark. On this point, I refer to the case of *Zero Industry Srl v OHIM, Case T-400/06*, wherein the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by

¹ Exhibit SS11

analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71). “

16. The fact that there may be a number of entities that have trade marks in the register that include the words ‘WORLD RECORD’, ‘WORLD RECORDS’ and ‘RECORD’ is not a relevant factor to the distinctiveness of the opponent’s marks. While I appreciate that print-outs from some of these businesses’ websites have been provided, this is not sufficient to demonstrate that these marks are actually in use in the marketplace to the point that they would give rise to the weakening of the distinctive character of the opponent’s mark.

17. For the avoidance of doubt, the outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors and the evidence referred to here is not relevant to that assessment.

DECISION

Section 5(2)(b): legislation and case law

18. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

19. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

20. The trade mark relied on by the opponent qualifies as an “earlier trade mark” for the purposes of the claimed grounds since it was applied for at an earlier date than the applicant’s mark.² While the opponent’s mark had completed its registration processes more than five years before the filing date of the applicant’s mark, the applicant did not request that the opponent provide proof of use for its mark. As a result, the opponent’s mark is not subject to proof of use pursuant to section 6A of the Act. Therefore, the opponent can rely upon all of the goods and services for which its mark is registered.

21. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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:

(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

² See Section 6(1)(a) of the Act

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 goods and services

22. The applicant's goods and services are set out in paragraph one above. The opponent's goods and services are set out in **Annex 1** of this decision.

23. When making the comparison assessing the similarity of the goods or services, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"[...] 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".

24. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

25. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (although it equally applies to services) are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

26. In its submissions, the opponent filed detailed arguments in respect of the identity and/or similarity of the goods and services at issue. I have reviewed these in full and refer to them below to the extent I consider it necessary.

27. I note that the opponent's goods and services all include the following limitation:

“all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, but excluding any of the above which fall exclusively within alcoholic or non-alcoholic beverages of any kind.”³

28. I do not intend to reproduce this limitation throughout the following comparison; but I will keep it in mind.

³ For the purpose of the assessment of the services below I will take the reference to 'aforementioned goods' to be a typographical error that is meant to read as 'aforementioned services'.

Class 9

29. While the opponent's term "computer programs including computer programs for games, searching directories, managing databases, electronic publishing, verifying data and presenting information" specifically lists the range of goods that the term may include, it is not exclusionary. Therefore, the term is not limited to those specific goods listed but, instead, covers all types of computer programs, albeit bearing in mind the limitation referred to above. That being said, even taking the limitation into account, I find that these goods fall within the broader term of "software" in the applicant's specification. This is on the basis that computer programs and software are terms that are used interchangeably to refer to the same type of goods. Further, the applicant's term is not limited in any way and may, therefore, cover the same purposes covered by the opponent's limitation. As a result, I consider that these goods are identical under the principle outlined in *Meric*.

30. While "mobile app's" and "mobile software" in the applicant's specification are specifically reserved for use on mobile devices, this does not mean that they are not computer programs. Based on this logic, it follows that the opponent's term, being "computer programs including computer programs for games, searching directories, managing databases, electronic publishing, verifying data and presenting information" can include programs used on mobile devices. Even taking into account the limitation, I consider that these terms are identical on the basis that the applicant's goods can include the opponent's goods. As a result, I find that these goods are identical under the principle outlined in *Meric*. In the event that I am wrong to find that the applicant's terms are computer programs, meaning that there is no shared overlap in nature or method of use (as the applicant's terms cover mobile software used on mobile devices), then I find that the goods are similar to at least a medium degree. This is on the basis that they overlap in user, purpose and trade channels and are also likely to share a competitive relationship in that a user may elect to use a computer program or download an app on their mobile device, or vice versa.

31. “Computer hardware” in the applicant’s specification can cover a range of internal components and peripheral devices for computers. The opponent submits that these are identical or highly similar to the opponent’s computer program goods. While these submissions are noted, I do not consider that this is the case. However, this is not fatal to the opponent’s position on the basis that it is open to me to consider alternative comparisons. I note that the opponent’s term includes terms such as “equipment for measuring world record times”, “apparatus for electronic publishing” and “apparatus for the verification of information”. It is my view that these goods include types of peripheral devices that are used with computers and are, therefore, items of computer hardware. Even taking into account the limitation of the opponent’s goods, they all fall within the applicant’s broader category and, as a result, these goods are identical under the principle outlined in *Meric*.

32. The opponent submits that “mobile phones” in the applicant’s specification is identical or similar to its computer program goods and, in doing so, relies on previous decisions of the Tribunal that found a level of similarity between mobile telephones and computer programs (both recorded and downloadable), data-processing equipment and computers.⁴ While the reference to the previous decision is noted, I am not bound by it. Further, I note that the comparison is not on all fours with the present situation in that the aforementioned comparison included additional goods and, also, the opponent’s terms at issue are limited. I appreciate that there are circumstances in which computer programs can be similar to mobile phones on the basis that there is an overlap in user and trade channels in that a producer of mobile phones is also likely to create the software for running the device. I also appreciate that this may, in turn, give rise to a level of complementarity. However, in the present case, I do not consider that the same applies in respect of the overlap in trade channels or the existence of complementarity. This is on the basis that a producer of mobile phones is, in light of the limitation of the opponent’s term, unlikely to also produce computer programs for those specific purposes. As a result, I do not consider that there is a level of similarity between these goods.

⁴ The opponent refers to decision BL O/041/18 which, in turn, refers to decision B1818726 of *SMS GmbH v Simage Technologies*

33. I note that the opponent also argues that the applicant's "mobile phones" is identical or similar to "magnetic data media including video tapes, audio tapes, floppy disks and magnetic media for recording, storage and retrieval of audio or visual data" and "optical data media including compact discs, CD-ROMs, Digital Video Discs, holograms and optical media for recording, storage and retrieval of audio or visual data." I have given consideration to these terms on the basis that it is common for mobile phones to include hard drives (which, as far as I am aware, can either be magnetic or optical storage components) and that the user may record and store audio or visual data on them such as music and videos. However, I am of the view that this is not sufficient to give rise to a finding of similarity. On this point, I bear in mind that just because a particular good is used as a component of another does not in itself mean that those goods are similar.⁵ I find that this is particularly the case at present in that the opponent's limitation takes it further away from being the type of hard drive that is likely to be used as a component in the applicant's mobile phone device. As a result, I also find that these goods are dissimilar.

34. The opponent argues that "tablet computers" in the applicant's specification is either identical or highly similar to its computer program goods. Following the same reason set out at paragraph 32 above, I do not consider that this is the case. Further, I have also given consideration to the position in respect of the opponent's goods discussed at paragraph 33 above and, for those same reasons, do not consider there to be any sufficient level of similarity between "tablet computers" and those goods of the opponent. As a result, I consider that these goods are dissimilar.

35. I note that the opponent argues that "electronic paper (display devices)" in the applicant's specification is identical or highly similar to the same goods as argued in respect of the applicant's mobile phones and table computer terms. In addition, the opponent submits that this term is identical to its other class 9 goods, being "books, magazines and other publications provided in electronic format" and

⁵ *Les Éditions Albert René v OHIM*, Case T-336/03

“books” in class 16. It is my understanding that the applicant’s term is a small electronic device that is used to display electronic books or other electronic publications. While it is a device similar to a tablet computer, it is my understanding that this good has no other functionality other than to read books or other publications electronically. It is my view that this good shares a level of similarity with “books, magazines and other publications provided in electronic format”. While the nature, method of use and purpose of the goods differ, the user of an electronic paper device is also likely to be the user of the opponent’s goods. Further, it is my understanding that electronic paper device providers will also provide electronic publications that are to be read on the devices and I consider that this applies to even where the opponent’s goods are limited to relating to world records. Ordinarily, I would consider these goods to have a complementary relationship but due to the specific limitation of the opponent’s term, I do not consider that to be the case here. This is because I do not consider that the opponent’s term is important or indispensable to the applicant’s electronic paper device on the basis that it is so specifically limited that it does not cover all types of electronic publications.⁶ Overall, I consider that there is a low degree of similarity between these goods.

Class 16

36. “Books” and “magazines” are present in both parties’ specifications. While I acknowledge that the opponent’s goods are limited, I consider that they are identical under the principle outlined in *Meric*. This is on the basis that the applicant’s terms have no limitation and may, therefore, include goods for the same purpose as the opponent’s.

37. The opponent’s submissions in respect of “stationery”, “covers [stationery]”, “files [stationery]”, “pens”, “writing implements [writing instruments]”, “cards” and “greeting cards” in the applicant’s specification are that they are identical or highly similar to the opponent’s “books, magazines, journals, almanacs” on the basis that they are clearly highly complementary. While noted, I do not consider this to be the

⁶ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

case. I accept that the first limb of the test for complementarity may be satisfied in respect of journals (insofar as journals cover blank journals for the user to write in, much like a diary) and stationery goods in that stationery and other writing implements are important to the use of journals. However, the second limb will not be satisfied as I do not consider that the average consumer will believe that the goods originate from the same undertaking, particularly given the limitation in the opponent's specification. Further, the goods are clearly different in nature, purpose and method of use and are not in competition. I am of the view that there is some overlap in user, however, this will be superficial on the basis that the user for both sets of goods will be members of the general public at large. As for trade channels, I accept that there may be producers of journals that also produce various stationery and writing implements, I have nothing to suggest that it is common in the trade and, again, I consider this unlikely to be the case in light of the opponent's specification. While I acknowledge the superficial overlap in user, I do not consider it sufficient to warrant a finding of similarity between the goods at issue. They are, therefore, dissimilar.

38. While the opponent's submissions in respect of "classified directories" and "city directories" in the applicant's specification are included together with the goods discussed at paragraph 37 above, the opponent also specifically mentioned that these goods are also similar to "computer programs including computer programs for games, searching directories" as per the principles set out in *Sanco*.⁷ The opponent did not elaborate on this argument. I note that in the case of *Sanco*, the GC 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 is to assess whether the relevant public are liable to believe that responsibility for the goods lies with the same undertaking or with economically connected undertakings. Firstly, the applicant's terms that relate specifically to classified directories and city directories have nothing to do with the

⁷ *Sanco SA v OHIM*, Case T-249/11,

specific purpose of the opponent's goods, so I fail to see how the average consumer would think that the undertaking responsible for the goods was the same or economically linked. I do not think that the average consumer would believe that the same or economically linked undertakings were responsible for both the physical directories of the applicant and the computer program for searching directories. This is particularly the case given that the goods of the opponent are limited to use for searching directories for specific purposes whereas the applicant's goods cover a broad range of physical directories and not the software used to search electronic versions of them. I see no obvious reason as to why these goods would share any degree of overlap in nature, method of use, purpose, user or trade channels. As a result, I consider these goods to be dissimilar.

39. "Directories" in the applicant's specification is, in my view, a printed publication that will be used to access a wide range of different type of information. It is my view that the most common form of directory will be a phone book or business listings. However, it is possible that a printed directory is something that can be used to list various other types of facts, such as facts relating to world records. On this basis, I consider that it is similar to the opponent's "books", particularly given the limitation in the opponent's specification. I make this finding as a result of a likely overlap in nature and method of use due to the fact that a directory can be published in the form of a book. Further, the purposes may overlap, so too will the user and trade channels. There may also be a competitive relationship between the goods in that a user may wish to purchase a directory instead of a book, or vice versa. Overall, I consider that these goods are similar to a high degree.

40. In making its submissions, the opponent included the applicant's "printed awards" and "printed award certificates" with those same goods discussed at paragraph 38 above. However, it also submitted there to be a level of similarity with its class 41 services, being "organisation, production and presentation of competitions, games, quizzes, shows, audience participation events relating to world records or outstanding achievements". While it did not elaborate on this position, I suspect that the argument is that the opponent's services, in presenting awards for world records or outstanding achievements, printed certificates will be provided. In my

view, the limitation of the opponent does not affect the present comparison on the basis that the opponent's service itself specifically relates to world records. I accept that the provider of the opponent's services is likely to also provide physical certificates or awards at the events organised. I also accept that the user of the opponent's services is also likely to be the consumer of the applicant's class 16 goods in that someone looking to put on an event for a world record attempt is also likely to wish to have awards or certificates available in the event that the record is broken. From this, it follows that I find that there is an overlap in user and trade channels. However, I do not consider that there is any overlap in nature, method of use or purpose. Lastly, in considering complementarity, I accept that the provision of awards/certificates is likely to be important to the presentation of the various events for world record attempts as covered by the opponent's service. It is my view that the average consumer of the goods and services is likely to think that the awards/certificates are provided by the same undertaking as that which organises the event, therefore resulting in a degree of complementarity between the goods and services. Overall, I consider that these goods and services are similar to a medium degree.

Class 35

41. The opponent's position in respect of the applicant's advertising, marketing, promotional, events and exhibits services is that they are identical or, in the alternative, highly similar to its own "organisation of exhibitions for commercial or advertising purposes", "advisory services" and "advertising on a data communication network". I am of the view that the comparison of these services is too broad to assess together so will separate the terms out so far as necessary.

42. The term "advertising on a data communication network" in the opponent's specification is broad enough include "online advertising" and "providing marketing information via websites", both of which are found in the applicant's specification. However, bearing in mind the opponent's limitation, I am of the view that it takes the opponent's term away from being one that entirely covers the applicant's terms, meaning that they are not identical under the principle outlined in *Meric*. On this

point, I do not consider that the applicant's terms can be said to cover the opponent's on the basis that they cover a narrower range of services. Having said that, the applicant's terms can be used for the same purposes and are, in my view, similar to the opponents. This is on the basis that the services overlap in nature and method of use in that, at their core, they all cover advertising services. As for the purpose, even acknowledging the limitation of the opponent, the applicant's terms can still be used for the same purpose, meaning that there is some overlap here, albeit not outright. As for users and trade channels, I consider that there is some overlap also in that someone looking for the opponent's service may also use the applicant's, however, this is limited somewhat due to the fact that someone looking to use the applicant's services that fall outside the opponent's limitation will not seek them from the opponent. Lastly, I consider that there is a degree of competition between the services in that a user looking to advertise for the opponent's term's purposes may elect to use the more specific services of the opponent or the broader, full-service ones of the applicant. Overall, I consider that these services are similar to a medium degree.

43. Moving to the applicant's services of "arranging and conducting of marketing events", "arranging and conducting of promotional events" and "arranging and conducting of advertising events", I am of the view that they are all broad services that can be said to include the organisation of exhibitions for advertising purposes. I note that the opponent's specification includes "organisation of exhibitions for [...] advertising purposes" and while this is limited, there is nothing in the applicant's specification that prevents the services listed above from being used for the same purposes. As a result, I consider that these services are identical under the principle outlined in *Meric* on the basis that the opponent's service falls within the applicant's services.

44. I have no submissions as to what "advertising agencies" in the applicant's specification covers. In the absence of such, it is my understanding that an advertising agency is a business that offers a complete range of advertising services. I consider that the applicant's term covers all of those services that would be offered by such an advertising agency. This includes, but is not limited to,

services such as “organisation of exhibitions for commercial or advertising purposes” and “advertising on a data communication network”, being those terms in the opponent’s specification. While the opponent’s terms consist of a limitation, this does not mean that they are not services that fall within the applicant’s broader term. As a result, I consider that these services are identical under the principle outlined in *Meric*.

45. As for “newspaper advertising” and “magazine advertising”, I am of the view that they are similar to “advertising on a data communication network” in the opponent’s specification. While the adverts being provided at the conclusion of the services will be displayed via different communication platforms, the services will generally be sought in the same way and the ultimate nature of the services is similar in that they all provide for advertising, albeit via different platform. As for the purposes, there is also some overlap here in that the general purpose of all services is to advertise, albeit via different platforms. As for user, the services are likely to overlap in that someone seeking advertising via data communications networks may also seek advertising in newspapers and magazines. On this point, I am of the view that where the users do not overlap, the services are competitive in that the user may elect to advertise via data communication networks (which include online) in preference over newspapers and magazines, or vice versa. Lastly, I consider that there is also an overlap in trade channels as an undertaking providing one specific type of advertising is likely to also provide advertising via other means. Overall, I consider that these services are similar to a high degree.

46. “Marketing information”, “marketing research”, “marketing analysis” and “marketing consultancy” in the applicant’s specification are all services that can be said to relate to advertising. While that may be the case, I consider that they have different natures, methods of use and purposes than those advertising services in the opponent’s specification, namely “organisation of exhibitions for commercial or advertising purposes” and “advertising on a data communication network”. I accept that the services may share the same users in that a user of the applicant’s services may also seek to organise an exhibition for advertising purposes or advertise via a data communication network. Further, I accept that such services are likely to be

provided by the same undertakings. I do not consider the services to be complementary or competitive in nature. It is my view that the overlaps in user and trade channels result in a finding that the services are similar to only a low degree.

47. “Event marketing”, “promotion of special events” and “promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with awards programs” in the applicant’s specification are services that are, generally speaking, advertising services. The opponent’s specification consists of advertising services such as “organisation of exhibitions for commercial or advertising purposes” and “advertising on a data communication network”. Firstly, I consider that the nature and methods of use of the parties’ services differ. However, there is an overlap in user in that the user of the opponent’s services is also likely to seek the wide range of services covered for by the applicant’s terms. Further, general advertising agencies tend to offer a wide range of advertising services that is likely to cover the parties’ terms, so they overlap in trade channels also. Lastly, I am of the view that the aim of all of these services is to advertise, promote or market the users’ goods or services, albeit via different methods. This results in a general overlap in purpose between the parties’ goods. Overall, I am of the view that these services are similar to a medium degree.

48. I see no reason why “conducting employee incentive award programs” shares any level of similarities with any of the goods or services of the opponent. While I appreciate that the goods and services of the opponent relate to world records, the awards covered by the applicant’s term are in relation to employee incentives, not record breaking attempts, achievements or occurrences. These services are, in my view, dissimilar.

49. “Providing business information via a website” in the applicant’s specification is a term that allows for the provision online of information about or for businesses. I see no reason why this service would share any level of similarity with any of the opponent’s goods or services, particularly given that all of the opponent’s terms are limited to those relating to world record achievements, events or occurrences.

This has nothing to do with the provision of business information. These services are, therefore, dissimilar to the opponent's goods and services.

50. Lastly, I note that the opponent submits that "compilation of business directories", "providing commercial directory information via the Internet" and "providing an on-line commercial information directory on the internet" in the applicant's specification are all similar to its own goods, namely "computer programs including computer programs for games, searching directories, managing databases, electronic publishing, verifying data and presenting information" and "books, magazines, journals, almanacs". The opponent submits that as the computer programs cover directories and as a directory can be a printed publication, these goods are similar. While I appreciate that there is scope for such an argument, I note the specific nature of the applicant's terms in that they relate to business and commercial directories and also that the opponent's terms are all limited to directories relating to world record achievements, events or occurrences. Ultimately, the goods and services at issue do not, in my view, share any overlap of factors and are, therefore, dissimilar.

Class 41

51. "Educational services", "training", "conducting of educational events", "organisation of educational events" and "online education services" in the applicant's specification are all broad types of educational services that can include services provided by radio, television or the internet (I note that the latter term is expressly reserved for the internet only whereas the other three can cover all of these). The opponent's specification consists of the term "education, instruction, tutoring and training by means of radio, television and Internet". As above, the opponent's class 41 services contain the exact same limitation as that discussed throughout this comparison. While that may be the case, the applicant's services can be used for the same purposes as covered by the limitation meaning that the opponent's services fall within the applicant's. As a result, these services are identical under the principle outlined in *Meric*.

52. It is my view that the opponent's "services provided online from computer databases or web-sites, all relating to [...] publishing" covers online publishing services. This can cover the publishing of any type of electronic publication including books, periodicals and even online videos. I make the latter finding on the basis that it is possible for audio-visual content to be included in the form of media that can be published. To further support this finding, I refer to the dictionary definition of 'publish' in the Oxford English Dictionary which is, simply, 'to *make public*'.⁸ While I am cautious of relying on dictionary definitions, I am minded to do so here on the basis that I have no submissions from the parties on this point. Further, I do not consider it to be a point of serious dispute. The aforementioned definition is not limited to what type of media may be considered published or not. While the opponent's term is limited to the purpose for which the publishing service is provided, the applicant's publishing services, namely "online electronic publishing of books and periodicals", "providing online electronic publications", "providing online videos, not downloadable" and "online publication of electronic newspapers" are not limited and can, therefore, cover the opponent's terms. This results in a finding that the services are identical under the principle outlined in *Meric*.

53. "Publication of printed directories" in the applicant's specification is broad enough that it can cover the publication of directories that list world record breaking achievements or records. As a result, this services shares a level of similarity with the opponent's term "services provided online from computer databases or web-sites, all relating to [...] publishing". While the opponent's service is provided online, meaning that there is no overlap in method of use, the natures overlap somewhat in that, at their core, both are publishing services. Further, I consider that there is also a degree of overlap in their purposes in that they can both be used to publish world record breaking achievements or record. As for user, they are also likely to overlap as a user is likely to wish to publish their directory via both methods. Moreover, the services may also be competitive as a user may wish to publish their works either only via printed directories or only online. Lastly, I do not consider that

⁸ <https://www.oed.com/view/Entry/154072?rskey=pyXOfC&result=1#eid>

an undertaking that provides the actual publishing services of printed materials such as directories will also offer online publication services. Taking all of the above into account, I consider that these services are similar to between a low and medium degree.

54. While I have found identity or similarity for the above publication services, this was because there is nothing in the applicant's terms preventing them for use for the same purposes as that covered by the opponent's limitation. However, I do not consider that this is the case for "publication of online guide books, travel maps, city directories and listings for use by travellers, not downloadable" in the applicant's specification. This is on the basis that the applicant's term is specifically reserved for use in the travel industry, which the opponent's terms do not cover. Having said that, there is some overlap in that the nature and method of use of the services is the same in that they are online publication services that will be sought in the ordinary way. Further, the core purpose of the services also overlaps to some degree in that both aim to publish the user's publications, albeit being those used for different end purposes. I do not consider that the users of online publication services for world record related publications will be the same as those looking for the online publication of travel maps or city directories. Therefore, I find no overlap in user. As for trade channels, I do not consider that an undertaking offering the opponent's services will also over the applicant's, and vice versa. Lastly, I do not consider that there is any competitive or complementary relationship. Taking all of this into account, I find that the services are similar to a medium degree.

55. "Entertainment services", "television entertainment", "live entertainment", and "online entertainment services" in the applicant's specification are all broad types of entertainment services. While two of these services are expressly reserved for services via television or online, the remaining services can cover services provided by any means, including radio. As I have already discussed on a number of occasions, the applicant's term can cover those for the same purpose as the one included in the limitation that is found throughout the opponent's specification. This applies here. As a result, I consider that the applicant's services are broad enough to cover "entertainment [...] by means of radio, television and Internet" in

the opponent's specification. These services are, therefore, identical under the principle outlined in *Meric*.

56. "Entertainment information" in the applicant's specification also appears in the opponent's specification, albeit as part of a wider term, being "education information, entertainment information and recreation information". The fact it is in the broader term does not mean that the opponent cannot solely provide entertainment information. As a result, and even in light of the opponent's limitation, the opponent's term falls within the applicant's on the basis that the applicant's term is not limited in any way. These services are, therefore, identical.

57. I note that the applicant's specification has a range of services that are for the organisation of various events, namely "organising sporting events", "organising dancing events", "organisation of musical events", "organising of recreational events", "organisation of cultural events", "organization of sporting events" and "providing facilities for sporting events, sports and athletic competitions and awards programmes". It is my understanding that world records span a great range of topics that can include records in any of the fields covered by the applicant's specification. Further, the above services can, in my view, be classed as either entertainment or cultural events. While I do not consider these services to be identical with either "organisation, production and presentation of events for [...] cultural, or entertainment purposes" or "organisation, production and presentation of competitions, games, quizzes, shows, audience participation events relating to world records or outstanding achievements" in the opponent's specification, I do consider that they are similar. I am of the view that these services overlap in nature and method of use in that they are all organisational services that will be sought in the same way. Further, their core purposes overlap also in that they are to organise an event albeit for potentially different end purposes. As for user, I am of the view that the user looking for organisation of an event is likely to also seek a range of the parties' services, meaning that there is overlap here also. On this point, I acknowledge that a user may also elect to choose the specific service of the opponent or the broader ones of the applicant, therefore meaning that there is a level of competition between the services. As for trade channels, I am of the view

that the providers of the broader services of the applicant are likely to also provide the more specific events of the opponent. Overall, I consider that these services are similar to a high degree.

58. While I have submissions from the opponent regarding what it refers to as the 'awards element' of the applicant's specification and how there is identity with or high similarity to its own term of "organisation, production and presentation of competitions, games, quizzes, shows, audience participation events relating to world records or outstanding achievements", I have no explanation as to how this applies to "issuing of educational awards", "awarding of educational certificates" and "certification in relation to educational awards" in the applicant's specification. The applicant's terms are purely for the provision of educational awards, whereas the terms raised by the opponent are not. I note that the opponent's specification includes a number of services that relate to education, such as the following:

"Education, instruction, tutoring and training by means of radio, television and Internet" "services provided online from computer databases or web-sites, all relating to education", "production and presentation of events for educational, cultural, or entertainment purposes", "organisation of exhibitions relating to world records or outstanding achievements for cultural or educational purposes", "production and presentation of educational and instructional information" and "education information"

These services are all limited to those relating to world record achievements, events or occurrences. None of the services are, in my view, for the provision of educational awards and while there may be some overlap in trade channels as the educational awards are likely to be provided for by the provider of the education service itself, I do not see any other levels of overlap in factors. The nature, methods of use and purpose of the services are all different. As for user, I am of the view that the user looking for the applicant's services is unlikely to be the user of the opponent's specific educational services relating to world records. Without any further explanation from the opponent, I am unable to find any level of similarity between these services and find that they are, therefore, dissimilar.

59. “Arranging of award ceremonies”, “organisation of competitions and awards”, “arranging and conducting award ceremonies” and “arranging of award ceremonies to recognise achievement” in the applicant’s specification can cover shows relating to world records or outstanding achievements. For this reason, it is my view that these services encompass the opponent’s service of “organisation, production and presentation of [...] shows [...] relating to world records or outstanding achievements” meaning that they are, therefore, identical under the principle outlined in *Meric*.

60. “Hosting [organising] awards relating to videos”, “hosting [organising] awards relating to television” and “hosting [organising] awards relating to films” in the applicant’s specification are all types of industry award shows to recognise achievements in those specific industries. I note that the opponent’s limitation sets out that its services can relate to ‘outstanding and unusual achievements’ and I have given consideration as to whether these ‘outstanding and unusual achievements’ could cover awards relating to videos, television or films on the basis that awards in these industries are commonly given for outstanding achievements. However, the limitation relates to both ‘outstanding and unusual achievements’ and while it may be said that awards in these industries are outstanding, I do not consider that, on the ordinary reading of the limitation, it would cover such awards. While I accept that there may be world records relating to these industries (such as records for the world’s highest grossing film, for example), this is not what the applicant’s services cover. I therefore disagree with the opponent’s submissions that these services are identical or highly similar to its own term of “organisation, production and presentation of [...] shows [...] relating to world records or outstanding achievements”. The parties’ terms are specific as to what industries and awards they cover and while there may be superficial overlaps in core nature and purpose in that they are for the organisation of award shows, their ultimate nature and end purpose are entirely different. I do not consider that any of the remaining factors overlap. Without anything further from the opponent, I am unable to accept that the simple fact that the services involve award shows is

sufficient to warrant the services being similar. I therefore find that these services are dissimilar.

61. Following the same logic set out in paragraph 60 above, I am of the view that “arranging of award ceremonies to recognise bravery” is also dissimilar to the opponent’s goods and services.

62. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods and services I have found to be dissimilar will fail.⁹ For ease of reference, the opposition under the 5(2)(b) ground fails against the following goods and services:

Class 9: Mobile phones; tablet computers.

Class 16: Stationery; covers [stationery]; files [stationery]; pens; writing implements [writing instruments]; cards; greeting cards; classified directories; city directories.

Class 35: Conducting employee incentive award programs; providing business information via a website; compilation of business directories; providing commercial directory information via the Internet; providing an on-line commercial information directory on the internet.

Class 41: Issuing of educational awards; awarding of educational certificates; certification in relation to educational awards; hosting [organising] awards relating to videos; hosting [organising] awards relating to television; hosting [organising] awards relating to films; arranging of award ceremonies to recognise bravery.

⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

63. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

64. The average consumer for the goods and services at issue is likely both to be members of the general public at large (for goods such as books and mobile apps and services relating to education, for example) and business users (for certain types of software goods and for the range of organisation of event services for example). The goods are, for the most part, likely to be available via retailers in physical stores and their online equivalents. Where a business user is involved, I am of the view that this may include specialist retailers and, again, their online equivalents. Regardless of the nature of the retailer, the selection of the goods will, ultimately, be the same. In stores, the goods will be displayed on shelves and be self-selected by the consumer after a visual inspection. A similar process will apply when the goods are selected online in that the selection will follow a visual inspection of an image of the goods. I consider that the visual component will dominate the selection process of the goods at issue but I do not discount an aural component playing a role in circumstances where the consumer seeks advice from sales staff.

65. Turning to the selection process for the services at issue, these are more likely to be available via specialist providers (regardless of who the consumer is) that will offer their services via physical stores and online. In physical stores, the services will be displayed on lists, signs or placards. As for the online process, I am of the view that the services will be provided on a list or menu that is displayed on a webpage. I consider that the selection process will, for the most part, be primarily visual (although not discounting an aural element via advice from sales assistants and/or word of mouth recommendations) but I acknowledge that for some services (such as those selected by business users, being organisation services for example), they will be selected after having had a discussion with a sales assistant. Even in such a scenario, the consumer will visually inspect the services at issue, meaning that the selection process will be both visual and aural.

66. As for the level of attention paid, I am of the view that for the goods at issue, this will be medium, even when considering the different types of average consumer. The factors that the consumer will consider are likely to vary depending on the nature of the goods sought. For example, the computer software goods are likely to be selected after the consumer has considered the compatibility, ease of use and functionality of the goods whereas, for the class 16 goods, the consumer is likely to select them having considered the materials used, information provided within and suitability of the goods. As for the services at issue, the considerations will also vary on the basis that the services cover a wide range of areas such as education, entertainment and publishing. Where the average consumer is a member of the general public selecting educational services, they are likely to consider factors such as the expertise of the staff, the length of the education course, the type of assessment required (be that written test or simply completing various courses, for example) and the qualifications offered upon conclusion. In my view, the level of attention for such services is likely to be medium. While I appreciate that educational services may be important to the user, I make this finding on the basis that these factors will be considered in full but are not, in my view, likely to warrant any detailed considerations. As for the services that will be selected by business users, I am of the view that these too will vary in what factors

are considered. For example, a publisher will look to ensure that the materials used are of sufficient quality and whether the provider can meet its demand whereas a business looking to arrange an award show will want to ensure that the venue and any potential hosts or presenters are all suitable and that the show will run smoothly. For these users, I am of the view that the degree of attention paid will be higher than medium (but not high) on the basis that the selection will be important to the operation of their business.

Distinctive character of the opponent's mark

67. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

68. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent's submissions argue that its mark is both distinctive and famous as a result of its extensive use in the UK over many years. On this point, I note that the opponent has filed evidence of use. Before considering the issue of enhanced distinctiveness, I will first consider the inherent distinctive character of the mark.

69. The opponent's mark is a word only mark consisting of the words 'GUINNESS WORLD RECORDS'. I note that the applicant submits that 'WORLD RECORDS' suggests the business of the opponent meaning that 'GUINNESS' is the prominent part of the mark. From an inherent perspective, I agree with the applicant and find that 'GUINNESS' is the dominant and distinctive element of the opponent's mark with 'WORLD RECORDS' being descriptive. This is particularly the case given the limitation across the entirety of the opponent's specification in that all the goods and services relate to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences. 'GUINNESS' neither alludes to nor describes the goods and services of the opponent and is, in my view, likely to be viewed as either a relatively uncommon surname or a made-up word with no obvious meaning. It is my view that, inherently, 'GUINNESS' enjoys a higher than medium (but not high) degree of distinctive character. Given what I have said above with regard to 'WORLD RECORDS', I do not consider that they contribute to the distinctiveness of the mark to any material degree that would take the distinctiveness beyond that which lies in the word 'GUINNESS'. Consequently, I find that the opponent's mark is inherently distinctive to a higher than medium degree (but not high).

70. Turning to consider the position in respect of enhanced distinctive character, I note that the opponent has filed a significant amount of evidence. I note that the opponent's evidence refers to the global history of its brand since 1955 and

includes a timeline taken from the opponent's website in support of its history.¹⁰ I do not intend to go into full detail with regard to the history of the opponent's publications but note that the first edition of the 'Guinness Book of Records' was published in 1955. It wasn't until 1999 that the opponent renamed its books from 'Guinness Book of Records' to 'Guinness World Records'. In 2000, I note that 'Guinness World Records 2000' was printed and, in a single run, sold 2,402,000 copies. At this time, the opponent began broadcasting a TV programme in the UK called 'Guinness World Records'. It appears from the timeline that by 2007, Guinness World Records' content on YouTube surpassed one million views and that by 2011, this number was at 100 million views. The time also makes references to the fact that by 2016, the opponent sold over 136 million copies of its books and that this number had increased to over 143 million by 2019. It is not clarified in the evidence whether this figure relates to just those books sold under the name 'Guinness World Records' and without such clarification, I must take it as meaning the totality of the books sold by the opponent, including those sold prior to 1999 under a different name.

71. While global evidence is helpful in painting a picture of the opponent's success, the assessment I must make under enhanced distinctive character is based on the understanding of the UK consumer. On this point, I note that the opponent has a section of its evidence which covers the trading activity in the UK prior to the relevant date. The opponent's evidence sets out that in each year since 2000, the opponent has published its 'Guinness World Records' book and, in the UK, this book regularly features in the top 10 seller lists. Evidence is produced that shows the 2022 version of the book as being number 9 on WHSmith's best seller list for non-fiction books.¹¹ While this evidence relates to publications after the relevant date, I note that the narrative evidence confirms that it is the witness's understanding that this is consistent with listings prior to the relevant date. On this point, I note that the applicant has not sought to challenge this narrative evidence and in light of the fact it is accompanied with a signed statement of truth, I have no reason to doubt the accuracy of this.

¹⁰ Exhibit RM2

¹¹ Exhibit RM5

72. The evidence goes on to say that the 'GUINNESS WORLD RECORDS' book is sold online and via bricks and mortar retailers such as Amazon, WHSmith, Waterstones, Asda, Sainsbury's, Tesco and Costco Wholesale. The opponent's evidence does not seek to provide further information about these retailers. However, while I am conscious not to assume my own knowledge is more widespread than it is, I do not consider it to be a point of serious dispute to suggest that these are UK-wide retailers that will be well known to the general public at large.¹²

73. In terms of book sales in the UK, I note that between 2016 and 2020, being the five years prior to the relevant date, the opponent sold the following volume:

Year	2016	2017	2018	2019	2020
Volume	544,768	515,751	528,906	398,848	349,537

74. I note that the above accounts for the sale of 2,337,630 books over a five year period. In addition, I note that the opponent's turnover for between 1 January 2016 and 31 December 2020 has been provided and this is as follows:

Year	2016	2017	2018	2019	2020²
Turnover	£21.58M	£22.30M	£22.17M	£22.39M	£17.49M

75. The above figures in respect of turnover are taken from the opponent's accounts filed at Companies House, copies of which have been provided in the evidence also.¹³ The figures are noted but represent a global figure, the total of which stands at £105,930,000. That being said, I note that this is broken down to relate to the UK, as follows:

¹² *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

¹³ Exhibits RM6 to RM9.

Year	2016	2017	2018	2019	2020
UK turnover	£6.129M	£6.678M	£5.595M	£5.504M	£4.185M

76. This totals a turnover of £28,091,000 in the UK for the years 2016 to 2020. The evidence then goes on to set out that between 2016 and 2020, the UK turnover made up between 23.92% and 29.94% of the opponent's global turnover. The narrative evidence sets out that this confirms that the UK is a major market for the opponent.¹⁴ The turnover is not broken down into specific goods and services covered but, given the focus on book sales, it is reasonable to infer that at least a large portion stems from sales of those goods.

77. The evidence then goes on to discuss television broadcasts. In respect of UK specific broadcasts, I note that the opponent has, since 2012, broadcast via ITV a show called 'Totally Bonkers Guinness World Records'. It lasted three seasons and some episodes are still available via the ITV Hub, being ITV's online streaming service. The opponent also broadcasts videos via its Facebook account on 'Facebook Live'. Between 11 November 2016 and 9 April 2020, the Facebook Live videos have accrued 27,428,436 unique viewers. The opponent's position is that it is reasonable to infer that a significant number of these viewers would have been in the UK.

78. Turning to consider the YouTube evidence, I note that up to and including 12 March 2021, there were 13,596,276 views of the opponent's videos by users in the UK in 2021 alone, with a total of 452,891 hours watched. These figures were taken from the opponent's own records and additional yearly breakdowns of the UK viewers of the opponents' YouTube channel for the years 2015 to 2021 have been provided as follows:

¹⁴ Paragraph 3.9 of the Witness Statement of Raymond Marshall

Year	Number of views
2015	6,077,221
2016	9,431,956
2017	10,220,682
2018	15,403,962
2019	16,429,234
2020	11,476,913
2021	13,596,276

79. Based on the narrative evidence I have discussed above, the 2021 figures are only those up to 12 March 2021 so are, therefore, before the relevant date. These figures total a number of 82,635,244 views in the UK.

80. Evidence of social media accounts has also been provided. I note that the opponent's social media followers in the UK were, as of March 2021, 319,012 for Facebook, 117,759 for Instagram, 573,243 for TikTok and 351,457 for Snapchat. On the point of the UK-based follower figures, I note that these are approximate and were prepared by the opponent's finance team who used the percentage of UK followers (as at the relevant date) on the assumption that it was the same as the previous year.

81. Global figures have been provided for its Twitter account which shows that it had 310,612 global followers as of 28 February 2021 and, for LinkedIn, this stood at 19,841 global followers as of 15 March 2021. The opponent's position is that the global figures are made up of a significant numbers of UK followers on the basis that it is very well known in the UK and that the UK is one of its major markets.

82. The opponent, in February 2020, commissioned a brand recognition survey from what it refers to as, the well-known survey firm, YouGov. During the survey, 2,088 UK-based respondents were asked two questions, being "when you think about world records in general, what is the first organisation that comes to mind?" and "which, if any, of the following products and/or services from Guinness World Records have you heard, seen, read or experienced in the last 3 years (since February 2017)?" the respondents were provided with a list of responses to

choose, including “GUINNESS WORLD RECORDS BOOK” and “GUINNESS WORLD RECORDS TV SHOW”. The conclusion to this survey sets out that 76% of respondents answered the first question with ‘GUINNESS WORLD RECORDS’. However, in the report provided I note that while some of the answers were for ‘GUINNESS WORLD RECORDS’ (and various misspellings of the same), the overwhelming majority of answers provided just referred to ‘GUINNESS’ (and various misspellings of the same) and that some also answered ‘GUINNESS BOOK OF RECORDS’,¹⁵ being the previous iteration of the opponent’s book. In respect of the second question, I note that 53% answered that they had heard of the Guinness World Records Book and 17% answered that they had heard of the Guinness World Records TV Show. With additional numbers also having heard of the opponent’s live events (5%), website (6%), kids’ website (1%), YouTube account (4%) and social media accounts (4%). In respect of this evidence, I acknowledge that it is a survey, however, it is not survey evidence in the same sense as was discussed in the case of *esure Insurance Limited v Direct Line Insurance Plc*¹⁶ as it does not pertain to a survey of confusion of the consumer but instead, is simply a survey regarding the awareness of the opponent’s brand. It is, therefore, of relevance to these proceedings insofar as it assists in determining the position regarding the average consumer’s awareness of the opponent’s mark. However, I note that the amount of people surveyed, being 2,088, is a tiny proportion of average consumers.

83. Examples of the opponent’s presence in the UK press are also provided. I do not intend to go over this in any great detail but note that after a search of ‘GUINNESS WORLD RECORD’ and ‘GUINNESS BOOK OF RECORDS’ within the headline and first paragraph of UK broadsheet newspapers, there were over 2,000 results and a selection of the same have been provided which include 58 pages worth of content.¹⁷ I note that the examples that the opponent expressly quotes cover articles from 1991, 1996, 2014 and 2015 and include UK-wide publications such as The Guardian, The Independent and The Times.

¹⁵ Pages 18 to 49 of Exhibit RM24

¹⁶ [2008] EWCA Civ 842

¹⁷ Exhibit RM25

84. Turning now to consider the opponent's marketing in the UK, I note that the opponent confirms that it advertises on a range of platforms including paid advertisements on digital platforms such as Facebook and also via physical advertising such as shop windows, in shopping centres and outdoor advertising. Examples of these adverts have been provided¹⁸ and I note that the Facebook pages show adverts for the 2022 copy of the opponent's book, as well as the 2021 copy. As for the examples of physical adverts, I note that these show stands in ASDA for the 2018 copy of the book, a stand for the 2020 copy of the book in an unknown book store and advertising screens that show adverts in unknown shopping centres for the 2020 copy of the book that show it as being available in WHSmith and Sainsbury's.

85. I note that the advertising expenditure in the UK for between 2018 and October 2021 has been provided. These show an expenditure of £80,500 in 2018, £256,000 in 2019, £379,000 in 2020 and £402,000 for up to October 2021 for a total of £1,117,500. Having said that, I note that the figure for 2021 inevitably includes some expenditure from after the relevant date, a fact I will bear in mind going forward.

86. As the opponent has filed additional evidence from Mr Bitel, being the Chief Executive of the London Marathon, I consider it necessary to also address this briefly. This evidence sets out that the London Marathon has partnered with the opponent since 2007. On an annual basis, the marathon is broadcast on the BBC into millions of homes across the UK. Specific breakdowns of these figures are not provided; however, this does not take away from the fact that the marathon draws a significant viewership on a yearly basis. Aside from a photo from the 2017 marathon showing the opponent's branding together with a participant in an ostrich outfit with what appears to be a record certificate,¹⁹ I have no evidence as to the overall presence of the opponent's branding on these broadcasts or at the events, themselves.

¹⁸ Exhibit RM26

¹⁹ Exhibit NB2

87. This evidence goes on to claim that the opponent has a long standing reputation and enjoyed a recognised integrity. Further, it submits that the opponent is well-known and respected by the British public as the authoritative name in world record verification. While this statement is noted, it is merely an opinion of the witness and does not assist me in my determination of the existence of enhanced distinctiveness (or reputation or goodwill, for that matter).

88. Taking all of the above into account, it is clear that the opponent has been selling its 'GUINNESS WORLD RECORDS' book since 2000, indicating a prolonged period of activity. The total global book sales are extremely significant and while they are international figures and, prior to 2000 the books were sold under a different branding, I am satisfied that the opponent's ongoing presence in the marketplace points to a significant level of sales in the UK. This is on the basis that, as repeatedly mentioned in the evidence, the UK is a significant market for the opponent and that, for the five years prior to the relevant date, the UK market equated for around 25% of the total turnover of the opponent. From this, I consider it reasonable to infer that the opponent has, since 2000, been active on a large scale throughout the UK. A further supporting factor I take into account in making this inference is the opponent's presence in well-known UK-wide retailers such as Tesco, ASDA and WHSmiths.

89. Even without such an inference, the sales and turnover figures demonstrated for the UK are high for the period of 2016 to 2020. Further, the YouTube and Facebook Live viewership figures are also significant and assist in pointing to an overall awareness of the opponents' brand in the UK. On this point, I wish to point out that it is somewhat unfortunate that the opponent has not provided turnover or sales figures for a longer time period on the basis that, unlike assessments for proof of use, enhanced distinctiveness assessments are not limited to the five year period covered by the figures provided. Therefore, further and more historic turnover figures specific to the UK would have been of great assistance. Having said that, the inference I have made at paragraph 88 above is sufficient to result in a finding that the UK use has been significant for a longer period of time than just the five years provided for in the evidence.

90. Turning to consider the opponent's marketing effort, I note that they have clearly undertaken efforts to promote its business between 2018 and the relevant date. While the advertising spend may not be high, it is still significant, being in excess of one million pounds for a period of almost four years (albeit with some costs inevitably occurring after the relevant date). In my view, this indicates a genuine attempt by the opponent to maintain a continued presence across the UK both via physical and digital advertising. As above, I have some criticism of the opponent in that the advertising expenditure evidence only spans just over three years and I would expect additional figures to be readily available to the opponent. However, as was the case with the same issue regarding the turnover and sales figures above, this does not cause any particular problems for the opponent on the basis that the inference from the global use provided is still indicative of a strong presence in the UK marketplace.

91. Lastly, I wish to discuss the survey evidence. While I am conscious not to attribute too much weight to it on the basis that it only surveyed 2,088 people, it is evidence that can be used to support the evidence discussed above in that it points to the fact that 'GUINNESS WORLD RECORDS' is well-known across the UK population. However, I will treat this evidence with some caution on the basis that some of the responses refer to the pre-2000 name of the opponent's books.

92. On the balance of the evidence as a whole, I am satisfied that it points towards an enhanced distinctiveness of the opponent's mark. However, I do not consider that this applies to all goods and services and, therefore, find that a significant proportion of average consumers in the UK will, because of the mark, identify only some of the goods and services at issue as originating from the opponent. I consider that, for those goods and services to which this finding applies, the evidence is sufficient to find that the distinctiveness of the opponent's mark has been enhanced through use to a high degree. In this scenario, I consider that the enhanced level of distinctiveness applies to the mark as a whole, not just the word 'GUINNESS' (being the dominant inherent element). This is on the basis that the evidence points to use of the mark as a whole and I am satisfied that the relevant

public associate some of the goods and services of the opponent with 'GUINNESS WORLD RECORDS'.

93. Having reached my findings above, it is necessary to discuss the fact that the evidence points towards the sales of the opponent's 'GUINNESS WORLD RECORDS' book and the provision of entertainment via videos online or on TV only. I note the reliance upon goods such as electronic publications (which can cover an e-version of the opponent's book) and services such as organisation of events for world breaking purposes. However, while I accept that it may be the case that the opponent provides these goods and services, I have no evidence of sales of electronic versions of its book and neither is there anything that points towards a level of use of its organising services. On the point of the organisation services, I note that the evidence discusses the London Marathon wherein runners attempt world records, however, I note that this event is organised by a different entity. Another particular service I wish to discuss is the data verification and verification of records. While I do not doubt that the opponent does verify its records, I do not see any evidence that points towards the opponent's business enjoying an enhanced level of distinctiveness in respect of such a service. I do not consider it unreasonable to suggest that information in respect of the provision of such services would have been readily available to the opponent and might have been provided in the course of these proceedings. For example, it might have provided evidence pointing to how many verifications are provided on an annual basis.

94. Without anything further regarding goods and services outside of books and entertainment services, I am unwilling to accept that the distinctiveness of the opponent's mark has been enhanced in respect of anything other than the following:

Class 16: Books; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or

occurrences, but excluding any of the above which fall exclusively within alcoholic or non-alcoholic beverages of any kind.

Class 41: Entertainment by means of television and Internet; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, and excludes any of such services which relate to alcoholic or non-alcoholic beverages of any kind.

95. To confirm, I consider that the opponent's mark, for the above goods and services, enjoys a high degree of distinctive character. For the remaining goods and services, the inherent position applies in that the opponent's mark enjoys a higher than medium (but not high) degree of distinctive character with 'GUINNESS' being the dominant and distinctive element.

Comparison of the marks

96. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

97. 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.”

98. It would be wrong, therefore, to artificially dissect the trade marks, although 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.

99. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
GUINNESS WORLD RECORDS	WORLD BOOK OF RECORDS LIMITED

Overall Impression

100. The applicant's mark is a word only mark that consists of the words 'WORLD BOOK OF RECORDS LIMITED'. It is my view that the word 'LIMITED' will be readily understood by consumers as a reference to the company and is, therefore, likely to be afforded very little trade mark significance. As a result, I consider that the overall impression of the mark is dominated by the words 'WORLD BOOK OF RECORDS' with 'LIMITED' playing a much lesser role.

101. The opponent's mark is also a word only mark that consists of the words 'GUINNESS WORLD RECORDS'. I am of the view that 'WORLD RECORDS' play a lesser role in the overall impression of the opponent's mark with 'GUINNESS' playing the greater role.

Visual Comparison

102. Visually, the marks share the words 'WORLD' and 'RECORDS'. While that may be the case, these words are placed at different points within their respective

marks. Most notably, 'WORLD' is the first word of the applicant's mark whereas it is the second word of the opponent's mark. 'GUINNESS' is the first element of the opponent's mark and, given that it plays the greater role in the overall impression of that mark, I am of the view that it will be seen as a prominent point of difference across the marks, particularly given that average consumers tend to focus on the beginnings of marks.²⁰ The marks also differ in the presence of the words 'BOOK', 'OF' and 'LIMITED' in the applicant's mark, all of which have no counterpart in the opponent's mark. Taking all of the above into account, I am of the view that the marks are visually similar to a low degree.

Aural Comparison

103. While playing a lesser role, I consider that the words 'WORLD RECORDS' in the opponent's mark will still be pronounced. The opponent's mark will, therefore, consist of five syllables that will be pronounced 'GIN-ISS-WURLD-REK-ORDS'. As for the applicant's mark, I do not consider that 'LIMITED' will be pronounced meaning that, aurally, it consists of five syllables that will be pronounced 'WURLD-BOOK-OV-REK-ORDS'. While the marks have identical endings and share one other syllable (albeit at different points in the marks), their beginnings differ, so too do the elements 'BOOK' and 'OF' in the applicant's mark. Taking all of this into account, I am of the view that the marks are aurally similar to between a low and medium degree.

104. If I am wrong to find that 'LIMITED' in the applicant's mark will not be pronounced, then I consider the addition of three syllables at the end of the applicant's mark, none of which are present in the opponent's mark, results in a finding that the marks are aurally similar to a low degree.

Conceptual Comparison

105. I find 'GUINNESS' will either be viewed as a made-up word with no meaning or a relatively uncommon surname. Either way, it has no shared concept in the

²⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

applicant's mark. As for the words 'WORLD RECORDS', these words will be understood as referring to the widely understood notion of world records, being feats of human achievement or accomplishments or natural occurrences that are unmatched across the world. Turning to the applicant's mark, a similar concept to 'WORLD RECORDS' will apply to the mark as a whole with the differences coming in the reference to a 'BOOK', being the publications where such records would be recorded and 'LIMITED', being a reference to the company. Overall, the conceptual hook of world records apply to both parties' marks and, bearing in mind the points of difference (in 'GUINNESS' and references to a 'BOOK' and the company being 'LIMITED'), I am of the view that the marks are conceptually similar to a medium degree.

Likelihood of confusion

106. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

107. I have found the applicant's goods and services to be either identical or to range in similarity from a high to a low degree with the opponent's goods and services. I have found the average consumer for the goods and services to be either members

of the general public or business users. The goods and some of the services will be selected through primarily visual means, although I do not discount an aural component. Some services (being those selected by a business user) will be selected through both visual and aural means. I have concluded that where the average consumer is a member of the general public, they will pay a medium degree of attention when selecting the goods and services and, for those services selected by a business user, a higher than medium (but not high) degree of attention will apply. I have found that the opponent's mark is inherently distinctive to a higher than medium (but not high) degree but that this has been enhanced through use to a high degree for some goods and services, a factor that weighs in the opponent's favour. I have found the parties' marks to be visually similar to a low degree, aurally similar to between a low and medium degree (or low if 'LIMITED' is pronounced) and conceptually similar to a medium degree.

108. I note that the opponent submits that "there can be no doubt that there is" a likelihood of direct confusion. Such an argument is based on the distinctiveness of the opponent's mark and the level of identity or similarity of the goods and services at issue. However, I do not agree that it is simple as that. Firstly, the high degree of distinctiveness of the opponent's mark only applies in respect of some of the goods and services and, secondly, while I note that there is some identity and high level of similarity of the goods and services at issue, there is also a low degree of similarity in respect of some services.

109. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that regardless of the distinctive character of the opponent's mark (be that high or higher than medium), I do not consider that the marks will be directly confused for one another. I make this finding primarily on the basis that the visual and aural similarity of the marks is such that the differences between the marks would clearly be noticed. Even taking into account the shared concept that runs through both marks, this is not sufficient to overcome the marks' differences. The 'GUINNESS' element in the opponent's mark will not be overlooked and I am of the view that it will actually be a point of reference that the average consumer focuses on to assist them in accurately recalling or

remembering which party's mark was which. Consequently, I do not find that there is any likelihood of direct confusion, even for those goods and services that I have found to be identical.

110. Turning now to consider a likelihood of indirect confusion, I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis K.C., as the Appointed Person, explained that:

“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’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand

extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

111. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

112. I note the opponent's submissions refer to the case of *L.A. Sugar* (cited above) and set out that there is a risk of indirect confusion on the basis that the average consumer would see the applicant's mark and assume that the opponent was "engaged in a new line (often referred to as a sub or diffusion brand) or initiative." While noted, I do not consider that this is the case. I see no reason as to why the differences between the marks would give rise to an understanding like that put forward by the opponent. The common element across the parties' marks lies in their references to world records and while I accept that the opponent's mark has, in certain circumstances, a high degree of distinctive character in its mark, it does not follow that this results in a likelihood of indirect confusion. On this point I am reminded of the case of *Kurt Geiger v A-List Corporate Limited*²¹ wherein Mr Iain Purvis K.C., sitting as the Appointed Person, set out that it is important to bear in mind what it is about the earlier mark which gives it distinctive character which, in the present case, is 'GUINNESS'. No shared or similar element exists in the applicant's mark. It is my view that the common elements will be seen as purely coincidental in that the marks at issue belong to two separate undertakings that

²¹ BL O/075/13

happen to be involved in world records. Further, when confronted with both marks, I do not consider that the average consumer would consider it logical for the opponent to have removed its distinctive and dominant element, being 'GUINNESS', from its mark and simply to have added in the words 'BOOK OF' and 'LIMITED' (insofar as the latter is noticed). Even if the reference to world records in the applicant's mark brings the opponent's mark to mind, this is mere association, not indirect confusion.²²

113. As a result of my findings above, the opposition under section 5(2)(b) fails in its entirety. I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

114. Section 5(3) of the Act states:

“5(3) A trade mark which –

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 European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

115. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors*, *Case 252/07, Intel*, *Case C-408/01, Adidas-Salomon*, *Case C-487/07, L'Oreal v Bellure*, *Case C-323/09, Marks and Spencer v Interflora*, *Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

²² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

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 Salomon, 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* and *Environmental Manufacturing, paragraph 34*.

(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 of 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 holder 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*).

116. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the opponent must also show that its mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods 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.

117. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 16 March 2021.

Reputation

118. In *General Motors*, Case C-375/97, the CJEU held that:

“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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

119. Under its 5(3) ground, the opponent relies on the same mark as it did under its 5(2)(b) ground, being the word only mark “GUINNESS WORLD RECORDS”. In addition, it claims to have obtained a reputation in the same set of goods and services in Classes 9, 16, 35, 38, 41 and 42 as relied upon in the above ground. These are reproduced in full in **Annex 1** of this decision.

120. When assessing the enhanced distinctive character of the opponent's mark, I undertook a detailed assessment of the evidence filed. This same evidence is relied upon for the basis of the opponent's 5(3) claim. I do not intend repeat the evidence in full here, however, a summary of the evidence can be found at paragraphs 70 to 91 above.
121. The evidence shows that use of the 'GUINNESS WORLD RECORD' mark began in 2000, with that year's edition of the book selling over 2 million copies worldwide and, the same year saw the launch of the Guinness World Records TV show. While the global sales figures aren't broken down into UK sales, I am satisfied that this is when use began in the UK on the basis that it is reasonable to infer that some of the figures can be attributed to the UK given that the UK is a major market for the opponent. I note that no turnover or sales figures specific to be UK are provided until 2016. However, between 2016 and 2020 the opponent's turnover in the UK was £28,091,000 and, during that time, it sold a total of 2,337,630 books. In my view, these figures represent a significant turnover and a substantial level of book sales in the UK during this time.
122. Turning to the viewership figures provided, I note that the opponent broadcast a TV show for three seasons from 2012 onwards on ITV, being a major UK-wide broadcasting network. While no viewership figures for this television show are provided, I consider it reasonable to infer from the fact that the show broadcast on ITV and ran for three seasons that the opponent's attracted a reasonable amount of views. Further, the viewership figures for the opponent's online broadcasts and videos via YouTube and Facebook Live are significant and total 82,635,244 and 27,428,436, respectively. As for advertising, the figures provided are fairly substantial when compared to the turnover (totalling £1,117,500 for 2018 to October 2021, being some seven months after the relevant date) and, in my view, demonstrate significant marketing efforts in the UK, particularly when accompanied with evidence of the types of advertising undertaken. Lastly, the opponent has provided a number of press articles from UK-wide publications from over a substantial time period that, in my view, assist in pointing toward a widespread knowledge of the brand across the UK.

123. Taking all of the evidence into account, I am content to conclude that it demonstrates that the opponent had, at the relevant date, obtained a strong reputation in its marks for the following goods and services:

Class 16: Books; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, but excluding any of the above which fall exclusively within alcoholic or non-alcoholic beverages of any kind.

Class 41: Entertainment by means of television and Internet; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, and excludes any of such services which relate to alcoholic or non-alcoholic beverages of any kind.

124. While I note that the opponent relies on a wider range of goods and services, I have set out in my enhanced distinctiveness assessment above that it has not filed any evidence to support its claim to have obtained a reputation in those goods or services. I reach the same conclusion here and, therefore, the opponent's reliance for its claimed reputation on any other goods and services other than those listed above hereby fails.

Link

125. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

126. I have found the applicant's mark to be visually similar to a low degree, aurally similar to between a low and medium degree and conceptually similar to a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

127. I have undertaken a full goods and services comparison above. However, that comparison was made in respect of the entirety of the opponents' specification. Under the current ground, the opponent has only demonstrated a reputation in respect of some goods and services. Inevitably, this results in different outcomes than those which were reached during the 5(2)(b) goods and services comparison. I do not intend to undertake another full goods and service comparison, however, I will address the issue in as much detail as I consider necessary below.

128. The nature of some of the applicant's goods and services mean that there is a degree of closeness between them and the reputed goods and services of the opponent. This is on the basis that the relevant public concerned with the goods and services may consider there to be an association between them insofar as they may all relate to world records (being the specific purpose of the opponent's reputed goods and services). Further, for these goods and services, I am of the view that the relevant section of the public will be the same. These goods and services are as follows:

Class 9: Mobile app's; Mobile software; Software; Computer hardware; Mobile phones; Tablet computers; Electronic paper (display devices)

Class 16: Books; Magazines; Stationery; Covers [stationery]; Files [stationery]; Pens; Writing implements [writing instruments]; Cards; Greeting cards; Printed awards; Printed award certificates; Directories; Classified directories; City directories.

Class 41: Online electronic publishing of books and periodicals; Providing online electronic publications; Providing online videos, not downloadable; Entertainment services; Television entertainment; Live entertainment; Entertainment information; Arranging of award ceremonies; Organisation of competitions and awards; Arranging and conducting award ceremonies; Arranging of award ceremonies to recognise achievement; Online entertainment services; Publication of printed directories.

129. The remaining services of the applicant have no degree of closeness to the opponent's reputed goods and services and neither do I consider that the relevant section of the public concerned with them overlap with the section of the public concerned with the opponents' reputed goods and services.

The strength of the earlier mark's reputation

130. The opponent's mark has a strong reputation in the UK.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

131. I have found above that the inherent distinctive character of the opponent's mark is higher than medium. I have found that this has been enhanced through

use to a high degree in respect of the same goods and services that have accrued a reputation.

Whether there is a likelihood of confusion

132. I have found there to be no likelihood of confusion.

Conclusion on link

133. I find that the differences between the marks are such that a significant proportion of the relevant public would not make a link between the marks, regardless of what goods or services the applicant's mark is displayed on. I make this finding also based on the fact that the distinctiveness of the opponent's mark is dominated by the word 'GUINNESS' and the absence of this element (or a similar one) in the applicant's mark means that there will be no link in the minds of the average consumer. Lastly, I do not consider that the use of the common elements of 'WORLD' and 'RECORDS' are sufficient to give rise to the existence of a link on the basis that they are descriptive of the reputed goods and services of the opponent on the basis that they relate solely to world records. As was the case under the 5(2)(b) assessment above, such a connection to world records would, in my view, be coincidental.

134. If I am wrong to conclude as I have above, I make an alternative finding that the strength of the opponent's reputation and distinctiveness of its mark would cause another (also) significant proportion of the relevant public to call 'GUINNESS WORLD RECORDS' to mind upon being confronted with the applicant's mark. This would be on the basis that the mere sight of a mark that includes a reference to a 'WORLD BOOK OF RECORDS' would trigger a mental association with 'GUINNESS WORLD RECORDS' in the thought process of those consumers.²³ That being said, I consider that this only applies to those goods and services listed

²³ The degree of similarity required to create a link between the marks may be less than that required to create a likelihood of confusion: *Intra-Press SAS v OHIM*, CJEU, Joined Cases C-581/13P & C582/13

at paragraph 128 above. I will, therefore, proceed to consider damage for those goods and services, premised on my alternative finding of a mental link arising.

Damage

135. The opponent has pleaded that use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the opponent's mark and/or be detrimental to the distinctive character or reputation of the opponent's mark I will deal with each head of damage in turn below.

Unfair Advantage

136. Unfair advantage can be taken of an earlier mark where there is no likelihood of confusion between it and the later mark. In these circumstances, the unfair advantage is usually the result of the transfer of the image of the earlier mark, or of the characteristics it projects, to the goods/services identified by the later mark. This is often argued to apply in look-alike trade mark cases where there is clear blue water between the word elements of the marks,²⁴ or cases where the respective goods/services are dissimilar, but use of the later mark is still capable of unfairly exploiting the reputation of the earlier mark.²⁵

137. I note that at paragraph 3.1.2 of its statement of grounds, the opponent sets out that the applicant's mark will:

“free-ride on the coat-tails of the reputation and/or prestige associated with the Earlier Trade Mark and thereby derive an illegitimate benefit from them and/or illegitimately exploit the marketing efforts expended by the Opponent in order to create and maintain the Earlier Trade Mark's reputation and image.”

138. In support of its claim of unfair advantage, I note that the opponent provided detailed submissions. I have given these full consideration and while I do not intend

²⁴ Lonsdale Sports Limited v Erol, [2013] EWHC 2956 (Ch)

²⁵ Claridges Hotel Limited v Claridge Candles Limited and Anor, [2019] EWHC 2003 (IPEC)

to discuss them in full, there are some points that I consider it necessary to address before moving to consider unfair advantage. I will do so briefly below.

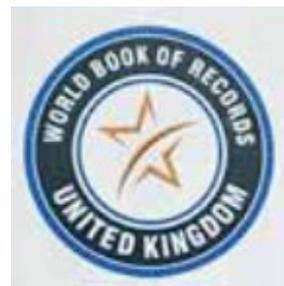
139. I note that a number of the submissions are based on goods or services that are not relevant to the present issue, namely “promoting the goods and services of other by arranging for sponsors to affiliate their goods and services with awards programs”,²⁶ being a service that the opponent claims to have provided for a number of years. I also note reference to the provision of adjudicating services.²⁷ Neither of these services are relied upon in the present proceedings and, further, neither enjoy a reputation and are not, therefore, relevant to the current issue.

140. The opponent also made reference to a recent case of the UK IPO, being decision BL O/685/22. The reference to this decision is not relevant to these proceedings on the basis that (1) the facts of that case are not on all fours with the present case and (2) that case is currently subject to an ongoing appeal.

141. I also note that the opponent’s submissions make reference to the applicant adopting a golden star device in a blue roundel, being an important element of the opponent’s branding. Examples taken from the evidence were provided in the submissions and I reproduce these below:



(being the opponent’s use)



(being the applicant’s use)

142. I note the case of *Lonsdale* (cited above) wherein Norris J found that, under 5(3), look-a-like marks may take unfair advantage. However, the issue I have with these submissions is two-fold. Firstly, the marks shown in the examples provided

²⁶ Paragraph 4.16.11 of the opponent’s submissions

²⁷ Paragraph 4.16.12 of the opponent’s submissions

above are not the marks at issue in the present proceedings. Secondly, the submissions of the opponent are somewhat selective as I note that the applicant's evidence, for the most part, shows a different logo on its certificates and on its websites and social media, being the following:



28



29



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The above uses, which dominate the applicant's evidence, do not, in my view, constitute look-a-like marks with the example shown of the opponent's use.

143. Even if I were to consider this point in respect of the applicant's intent to take unfair advantage of the opponent's reputation, I do not consider that it furthers the opponent's position. I note that the aforementioned case of *Lonsdale* relies on the fact that, on first glance, a consumer may think that someone was wearing 'Lonsdale' clothing and the creation of such an illusion may result in an unfair advantage. While I note the similarity of the examples shown, I do not consider that use of a roundel or star device is particularly distinct from a trade mark perspective. If anything, a roundel device is very common so its shared use cannot be considered surprising. Further, I am of the view that, on first glance, the average consumer would still notice the 'GUINNESS' element in the opponent's use and the absence of the same in the applicant's use. Therefore, no such association would be made. This submission is, therefore, dismissed.

144. I do not doubt that the opponent enjoys a strong reputation in its reputed goods and services, however, I am not convinced that use of the applicant's mark would free-ride on the coat-tails of the reputation and/or prestige associated with the

²⁸ Page 45 of Exhibit SS7

²⁹ Page 1 of Exhibit SS9

³⁰ Page 1 of Exhibit SS10

opponent's mark. Neither do I consider that the applicant would illegitimately benefit from the opponent's mark simply by making a reference to a book of world records.

145. While the opponent's mark will not be artificially dissected by the relevant public, the descriptive nature of 'WORLD RECORDS' means that the dominant and distinctive element of the opponent's mark is the word 'GUINNESS'. It is this element that will, in my view, be considered the attractive force of the opponent's business operations. I am of the view that in order to free-ride on the opponent's mark, there must be something in the applicant's mark that the relevant public would consider as something that takes an unfair advantage of a perceived connection with 'GUINNESS', such as the use of an identical or similar element. That is simply not the case on the basis that there is no such counterpart in the applicant's mark. Even if the average consumer picks up on the common use of 'WORLD RECORDS' across the parties' marks, I do not consider it sufficient that use of the same gives rise to an unfair advantage via a commercial advantage in favour of the applicant or exploitation of the marketing efforts of the opponent. I find that this is particularly the case given the descriptive nature of these elements within the opponent's mark. I do not consider that the reputation enjoyed by the opponent's mark will transfer onto the applicant's mark simply due to the shared use of those descriptive elements.

146. While I appreciate that the evidence of the opponent points to it being a leader in the field of world records (particularly in its book), it cannot be the case that any reference to a 'book of world records' gives rise to an unfair advantage. I make this finding whilst acknowledging the opponent's claim to be the only entity in the UK that uses a mark with 'WORLD RECORDS' to credit and award achievement.³¹ On this point, I am not convinced that the relevant public would assume that the opponent was the only undertaking that dealt in world records by using the words 'WORLD RECORDS'. Further, as a leader in the field of world records who enjoys a strong reputation in its books, it is likely that the opponent will face competition from other entities that seek to enter the market by selling identical or similar goods

³¹ Paragraph 8.7 of the witness statement of Raymond Marshall

that relate to world records. The common reference to world records is not, in my view, sufficient to give rise to there being an unfair advantage. Further, the opponent's use of 'WORLD RECORDS' cannot be the sole connection that gives rise to the opponent enjoying a monopoly over the field of producing books that compile world records. The claim of unfair advantage, therefore, fails.

Detriment to distinctive character

147. Turning to the opponent's pleaded case, I note that, under this arm of the 5(3) ground, the opponent pleads that use of the applicant's mark would:

“dilute the distinctive character and/or the reputation of the Earlier Trade Mark because the presence on the market of a highly similar mark will reduce the capacity of the Earlier Trade Mark to arouse an immediate association with the Opponent's services for which they are registered. Taking account of the normal practice in relation to the goods and services covered by the Trade Mark, said association will create a change in the economic behaviour of the average consumer of the goods and services for which the Earlier Trade Mark is registered, or a serious likelihood that said change will happen in future, thereby diluting the Earlier Trade Mark's value and reputation. This change in economic behaviour would be reflected, for example, in a shift of consumers from the services distinguished by the Earlier Trade Mark to those distinguished by the Trade Mark and a respective decrease in sales of the former.”

148. Firstly, I note that the pleaded ground relies on the fact that the marks are highly similar. As set out above, the marks are not highly similar. In any event, I fail to see how the similarity of the marks at issue (being of low visual similarity, low to medium aural similarity and medium conceptual similarity) give rise to a detriment to distinctive character, particularly given that the dominant and distinctive element in the opponent's mark has no similar counterpart in the applicant's mark.

149. I note that the opponent submissions make reference to the survey results that were adduced in the evidence, being those that I have discussed at paragraph 82

above. While the survey results are noted, I have already commented on the fact that the majority of responses given in reference to the opponent's world records were simply the word 'GUINNESS' (or a misspelling of the same). On this point, I remind myself that I have found throughout this decision that it is 'GUINNESS' that is the dominant and distinctive element of the opponent's mark. This is not an element which is present in the applicant's mark and I fail to see how detriment to the opponent's distinctive character would exist. I am of the view that when confronted with the parties' marks, the relevant public would attribute any mental link between them to their shared reference to world records, not to an immediate association between the goods or services at issue, as pleaded by the opponent. The opponent also submits that the shared reference to world records would cause the relevant public to wonder about a link between the parties. I do not consider that this will be the case. This is because the applicant's mark makes no association with 'GUINNESS', being where the distinctiveness of the opponent's mark lies. Why, in that scenario, would the consumer believe there to be any association between the undertakings responsible? I do not consider that they would and, from this, it follows that the economic behaviour of the relevant public would remain unchanged regardless of the existence of a mental link being made between the marks. Lastly, I consider that even if they are aware of the opponent's brand, the relevant public's ability to identify the goods and services of the opponent will not be weakened as a result of the presence of the applicant's marks due to the complete lack of reference to the dominant 'GUINNESS' element. The claim of detriment to distinctive character, therefore, fails.

Detriment to repute

150. In its notice of opposition, the opponent pleaded detriment to repute (or tarnishing). In its submissions, the opponent set out that, for the sake of procedural economy, it would focus on detriment to distinctive character only. It did not, therefore, make any further submissions in respect of this pleading. For the avoidance of doubt, I do not consider that there would be any detriment to repute. For example, if the scenario exists where an average consumer, upon selecting the applicant's goods/services, considers that they have negative characteristics

or qualities, this will have no impact on the earlier mark and will not, therefore, reduce the power of attraction of the opponent's goods or services. This is on the basis that the average consumer will be aware that the applicant's goods/services do not originate from or are not associated with the opponent. This is due to the fact that the element that dominates the opponent's mark shares no identical or similar element in the applicant's mark. The shared reference to world records is not, in my view, sufficient to lead the consumer to reach such a conclusion. As a result, I find that there is also no detriment to the repute (or tarnishing) of the opponent's mark.

151. Given my findings above, the opposition under the 5(3) ground fails in its entirety. I will now move to consider the 5(4)(a) ground.

Section 5(4)(a)

152. Section 5(4)(a) of the Act reads as follows:

“(4) 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, where the condition in subsection (4A) is met,

(aa)

(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.”

153. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

154. 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).”

155. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and

- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

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

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

Relevant Date

156. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander K.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

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

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

157. The applicant's mark does not have a priority date. The applicant's evidence sets out that it was registered as a company on 15 March 2017.³² It also sets out that the company, as at the date of the witness statement given (being 4 May 2022) is at the development stage but has sponsored third party companies and has conducted some certification programs. On this point, I note that the applicant's evidence consists of articles surrounding the presentation of the applicant's awards to various individuals. I note that the majority of the awards refer to London and the UK. However, they appear to have been given mostly to individuals in different countries such as India, USA and Mauritius. Of the 45 pages of awards, I note that twelve awards were given in London³³ and one was given in Birmingham.³⁴ While noted, none of the articles are dated so I am unable to determine when this use occurred. Further evidence of awards is provided but this is taken from the

³² Exhibit SS2

³³ Pages 2 to 6 and 9 to 14 of Exhibit SS6

³⁴ Page 15 of Exhibit SS6

applicant's 'Asia Edition' and while there are some references to the UK, none of the evidence is dated. I note that some of the articles consist of images of the awards being presented to individuals, but I am unable to make out the exact dates shown on the awards. There is also evidence provided of the applicant's website which launched in the year 2017 which has "42 Lakh" views.³⁵ I have no indication of what 'Lakh' means so am unable to determine the level of views the website has had. In any event, given that the bulk of the evidence relates to use in India, it is not clear whether these views came from users in the UK. Social media print outs have been provided and I note that these are all dated 4 May 2022 and there is no indication as to how many followers of these accounts are from the UK or whether they were present as at the relevant date.

158. I have given consideration as to whether any of the evidence filed by the applicant is capable of being considered as being the start of the behaviour complained about. It is not. This means that the relevant date for assessment of the opponent's claim under section 5(4)(a) of the Act is the date of the application for registration, being 16 March 2021.

Goodwill

159. The first hurdle for the opponent is that it needs to show that it had the necessary goodwill in its business at the relevant date and that its unregistered sign, being 'GUINNESS WORLD RECORDS', was distinctive or associated with that goodwill. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

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

³⁵ Paragraph 3.1.9(a) of the Witness Statement of Santosh Shukla

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

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

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

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

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie,

that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

162. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

163. Goodwill arises as a result of trading activities. In undertaking my assessment of the opponent's 5(2)(b) claim, I provided a detailed summary of the opponent's evidence in respect of its goods, and services. While the assessment under the opponent's 5(4)(a) claim relies on a different list of goods and services (being those listed in **Annex 2** of this decision), the same detailed summary is applicable here. I do not intend to repeat the summary of the evidence again here save as to say that the opponent appears to have been selling its book under the sign relied upon since 2000 and the opponent's turnover and book sales since 2016 in the UK have been significant. Further, the opponent has been providing entertainment services via television and internet broadcasts on ITV and on YouTube and Facebook Live,

respectively. I note that the viewership figures in the UK for the internet videos are significant.

164. I do not intend to re-assess the evidence in light of the different specification of goods and services on the basis that (1) the evidence relied upon is the same and (2) the list under the 5(4)(a) ground contains similar goods and services to those in respect of which I have found there to be enhanced distinctiveness and a reputation. Further, the same issue I have discussed throughout this decision regarding the opponent's evidence remains, namely that a majority of the goods and services relied upon are not covered by the evidence.

165. Of those goods for which I have already found there to be enhanced distinctiveness and a reputation under 5(2)(b) and 5(3) grounds, respectively, I note that the opponent's list of goods under this ground consists of the following:

“Books; all of the aforementioned goods are limited to these-relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, but excluding any of the above which fall exclusively within alcoholic or non-alcoholic beverages of any kind.”

166. These are identical goods to those relied on under the previously assessment grounds. I am of the view that for those same reasons discussed throughout this decision, the opponent enjoys a very strong level of goodwill in the above goods and I consider that the sign relied upon is distinctive of and/or associated with that goodwill.

167. Further, I note that the opponent's list of services for which it claims goodwill includes the broad term “entertainment, education and cultural services”. Unlike the services relied upon under 5(2)(b) and 5(3), these services are not limited in any way. Given the nature of the opponent's services as set out in its evidence, I do not consider it appropriate to accept the existence of goodwill in these services

as a whole. Therefore, I consider it appropriate to make a similar finding to those I have made above in that the opponent's evidence points towards the existence of goodwill in the following sub-category of services only:

“Entertainment by means of television and Internet; all of the aforementioned services are limited to these-relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, but excluding any of the above which fall exclusively within alcoholic or non-alcoholic beverages of any kind.”

168. For the same reasons as discussed throughout this decision, I consider that the opponent's business enjoys a strong level of goodwill in respect of the above services and the sign relied upon is distinctive of and/or associated with that goodwill.

169. The only other goods relied upon under this ground that I consider it appropriate to discuss in further detail are “printed awards” and “printed award certificates”. It is my understanding from the evidence that the opponent provides record breakers with printed award certificates to commemorate their record. Such evidence includes the award presented at Cath Kitson's record breaking afternoon tea party³⁶ and Land Rover's record breaking Lego Tower Bridge replica.³⁷ While this is noted, I do not consider it sufficient to demonstrate that these events are considered trading activities that are capable of giving rise to the existence of goodwill in the opponent's business. In any event, these are only two examples of use and not sufficient to give rise to the existence of a protectable level of goodwill in respect of the goods relied upon.

³⁶ Exhibit RM16

³⁷ Exhibit RM19

Misrepresentation and damage

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

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

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

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

And later in the same judgment:

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

171. I am reminded of the case of *Marks and Spencer PLC v Interflora*³⁸ wherein Lewison L.J. found that although the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely that the difference between the legal tests will produce different outcomes. I find that to be the case here. While the level of goodwill is strong, I do not consider that members of the relevant public would be deceived into thinking the applicant’s goods and services were that of the applicant, due to the lack of any association with ‘GUINNESS’.

172. As a result, I do not consider that there is misrepresentation and the opponent’s reliance upon the 5(4)(a) ground fails.

CONCLUSION

173. The opposition fails in its entirety and the applicant’s mark may, therefore, proceed to registration for all of the goods and services applied for.

COSTS

174. The applicant has been successful and is, therefore, entitled to its costs. As the applicant was unrepresented during these proceedings, it was required to file a costs proforma and did so on 29 August 2022. The applicant claims to have spent the following amount of time on the various stages of these proceedings:

Notice of Defence:	14 hours
Considering forms filed by the other party:	8 hours
Research and collection of evidence	24 hours
Preparing evidence:	14 hours
Considering opponent’s evidence:	44 hours
Preparing written submissions:	8 hours
Total:	112 hours

³⁸ [2012] EWCA (Civ) 1501

175. I appreciate that the tasks outlined above would have required more of a time commitment by the applicant on the basis that it is unrepresented. However, I am of the view that the time spent on the above tasks are on the excessive side. For example, I note that the defence filed was relatively straight forward with the counter statement being three pages in length. Further, while the evidence filed by the applicant during these proceedings was of some significant length, it was ultimately of no real assistance to the applicant and, in any event, I consider the total time spent of 58 hours (including the assessment of the opponent's evidence) to be excessive. I consider a costs award for the following number of hours to be reasonable:

Notice of Defence:	3 hours
Considering forms filed by the other party:	2 hours
Preparing evidence:	8 hours
Considering opponent's evidence:	5 hours
Preparing written submissions:	2 hours
Total:	20 hours

176. In relation to the hours expended, I note that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore award the applicant the sum of £380.00 (20 hours at £19 per hour) in respect of its costs proforma.

177. I hereby order Guinness World Records Limited to pay WORLD BOOK OF RECORDS LIMITED the sum of £380.00. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 18th day of November 2022

A COOPER
For the Registrar

ANNEX 1

The opponent's first mark

Class 9

Magnetic data media including video tapes, audio tapes, floppy disks and magnetic media for recording, storage and retrieval of audio or visual data; optical data media including compact discs, CD-ROMs, Digital Video Discs, holograms and optical media for recording, storage and retrieval of audio or visual data; computer programs including computer programs for games, searching directories, managing databases, electronic publishing, verifying data and presenting information; books, magazines and other publications provided in electronic format; electronic databases; equipment for measuring world record times; apparatus for electronic publishing; apparatus for the verification of information; scientific, photographic, cinematographic, optical, weighing, measuring, checking, and teaching apparatus and instruments relating to world records or outstanding achievements; protective clothing and footwear; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, but excluding any of the above which fall exclusively within alcoholic or non-alcoholic beverages of any kind.

Class 16

Books, magazines, journals, almanacs; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, but excluding any of the above which fall exclusively within alcoholic or non-alcoholic beverages of any kind.

Class 35

Organisation of exhibitions for commercial or advertising purposes; advisory services; data verification and verification of records, publicity and publication of publicity texts

exhibitions; advertising on a data communications network; data searching in computer files; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, and excludes any of such services which relate to alcoholic or non-alcoholic beverages of any kind.

Class 38

Dissemination of television and radio signals whether analogue or digital, by means of terrestrial, satellite, cable, or other media including point to point, point to multi-point and interactive broadcasting; electric mail services; provision of telecommunications access and links to computer databases and the Internet; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, and excludes any of such services which relate to alcoholic or non-alcoholic beverages of any kind.

Class 41

Entertainment, education, instruction, tutoring and training by means of radio, television and Internet; interactive entertainment services; services provided online from computer databases or web-sites, all relating to education, entertainment, recreation or publishing; production, editing, presentation and distribution of television and film programmes, films, sound and video recordings, CD-ROMs, computer games and interactive broadcast programmes; organisation, production and presentation of events for educational, cultural, or entertainment purposes; organisation, production and presentation of competitions, games, quizzes, shows, audience participation events relating to world records or outstanding achievements; museum services; organisation of exhibitions relating to world records or outstanding achievements for cultural or educational purposes; providing museum facilities; publishing services; publication of books, magazines, almanacs and journals; publication of electronic books and journals; production and presentation of educational and instructional information; photographic library services; provision of information relating to world

records or outstanding achievements; education information, entertainment information and recreation information; library services; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, and excludes any of such services which relate to alcoholic or non-alcoholic beverages of any kind.

Class 42

Design of databases and web-sites; leasing of access time to computer databases; compilation of information relating to world records, outstanding achievements or record breaking attempts; printing of books; consultancy services relating to world records, outstanding achievements or world record breaking events; preparation of regulations and measurement criteria relating to world records or outstanding achievements; advisory services relating to regulations covering world records or outstanding achievements; literature searching services; issuing certificates relating to world records or outstanding achievement; authentication of world records or outstanding achievements; designating classes or categories for world records or outstanding achievements; production, editing, presentation and distribution of interactive computer programs; all of the aforementioned goods are limited to those relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, and excludes any of such services which relate to alcoholic or non-alcoholic beverages of any kind.

ANNEX 2

Goods and services relied upon under 5(4)(a)

Magnetic data media including video tapes, audio tapes, floppy disks and magnetic media for recording, storage and retrieval of audio or visual data; optical data media including compact discs, CD-ROMs, Digital Video Discs, holograms and optical media for recording, storage and retrieval of audio or visual data; computer software computer programs including computer programs for games, searching directories, managing databases, electronic publishing, verifying data and presenting information; books, magazines and other publications provided in electronic format; publications (downloadable); electronic databases; equipment for measuring world record times; apparatus for electronic publishing; apparatus for the verification of information; scientific, photographic, cinematographic, optical, weighing, measuring, checking, and teaching apparatus and instruments relating to world records or outstanding achievements; protective clothing and footwear; medallions.

Books, magazines, journals, almanacs; all of the aforementioned goods are limited to these-relating to record achievements, record breaking events or occurrences (whether relating to human beings, natural phenomena or otherwise occurring), record breaking attempts and outstanding and unusual achievements, failures or occurrences, but excluding any of the above which fall exclusively within alcoholic or non-alcoholic beverages of any kind; printed awards; printed award certificates; directories; writing implements; stationery; clothing, caps; lanyards for wear.

Organisation of exhibitions for commercial or advertising purposes; advertising services; advisory services; data verification and verification of records, publicity and publication of publicity texts exhibitions; advertising on a data communications network; data searching in computer files.

Dissemination of television and radio signals whether analogue or digital, by means of terrestrial, satellite, cable, or other media including point to point, point to multi-point

and interactive broadcasting; electric mail services; provision of telecommunications access and links to computer databases and the Internet.

Entertainment, education and cultural services; instruction, tutoring and training by means of radio, television and Internet; interactive entertainment services; services provided online from computer databases or web-sites, all relating to education, entertainment, recreation or publishing; production, editing, presentation and distribution of television and film programmes, films, sound and video recordings, CD-ROMs, computer games and interactive broadcast programmes; organisation, production and presentation of events for educational, cultural, or entertainment purposes; organisation, production and presentation of competitions, games, quizzes, shows, audience participation events relating to world records or outstanding achievements; museum services; organisation of exhibitions relating to world records or outstanding achievements for cultural or educational purposes; providing museum facilities; publishing services; publication of books, magazines, almanacs and journals; publication of electronic books and journals; electronic publications (non-downloadable); production and presentation of educational and instructional information; photographic library services; provision of information relating to world records or outstanding achievements; education information, entertainment information and recreation information; library services.

Design of databases and web-sites; leasing of access time to computer databases; compilation of information relating to world records, outstanding achievements or record breaking attempts; printing of books; consultancy services relating to world records, outstanding achievements or world record breaking events; preparation of regulations and measurement criteria relating to world records or outstanding achievements; advisory services relating to regulations covering world records or outstanding achievements; literature searching services; issuing certificates relating to world records or outstanding achievement; authentication of world records or outstanding achievements; designating classes or categories for world records or outstanding achievements; production, editing, presentation and distribution of interactive computer programs.

