

O/0230/26

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. UK00003809878
IN THE NAME OF ERROLL LIM ISIP FOR THE MARK:**

London Barrio Fiesta

IN CLASSES 35, 36, 37, 38, 41 & 44

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 506741 BY
THE PHILIPPINE CENTRE (TAGPUANG PILIPINO)**

BACKGROUND AND PLEADINGS

1. Erroll Lim Isip (“the proprietor”) is the registered proprietor of the UK trade mark shown on the cover of this decision (“the contested mark”). The contested mark was filed on 15 July 2022 and was granted registration on 11 November 2022. It stands registered for the following services:

Class 35: Event marketing; Promotion of special events; Marketing services relating to esports events; Advertising services relating to esports events; Promotion of sports competitions and events; Arranging promotion of charitable fundraising events; Organisation of events for commercial and advertising purposes.

Class 36: Financial sponsorship of sports events; Financial sponsorship of dance events; Charitable fundraising by means of entertainment events.

Class 37: Cleaning of venues before and after events.

Class 38: Broadcasting of esports events; Streaming of esports events.

Class 41: Dance events; Special event planning; Organisation of musical events; Conducting of educational events; Organising of recreational events; Conducting of cultural events; Organising community sporting events; Organization of entertainment events; Organisation of entertainment events; Arranging of musical events; Organising community cultural events; Ticketing and event booking services; Ticket procurement services for entertainment events; Ticket reservation and booking services for cultural events.

Class 44: Providing portable toilets for events.

2. On 29 November 2023, the contested mark was subject to an invalidation application by The Philippine Centre (Tagpuang Pilipino) (“the applicant”). The application is based on section 47 and sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).
3. Under its 5(4)(a) ground, the applicant relies on the unregistered sign ‘Barrio Fiesta Sa London’. The applicant claims that it has been using this sign throughout the UK since 1985 in respect of the following services:

Class 41: Organisation of cultural events; Organizing cultural and arts events; Conducting of cultural events; Cultural activities; Entertainment, sporting and cultural activities; Festivals (Organisation of-) for cultural purposes; Organization of entertainment events; Presentation of live entertainment events; Organisation of entertainment events; Organising community cultural events; Organisation of entertainment and cultural events; Organising events for cultural purposes; Conducting of entertainment events; Arranging of cultural events; Organization of events for cultural purposes; Organisation of events for cultural, entertainment and sporting purposes; Production of live entertainment events; Ticket reservation and booking services for cultural events; Arranging of musical events; Booking of performing artists for events (services of a promoter); Arranging and conducting of live entertainment events; Arranging and conducting of entertainment events; Arranging and conducting of entertainment events for charitable fundraising purposes.

4. By virtue of relying on section 5(4)(a) of the Act, the applicant’s claim is that through its use of the above sign, it has acquired goodwill in its business and that use of the contested mark amounts to a misrepresentation to the public which would, in turn, cause damage to the applicant.

5. Under the 3(6) ground, the applicant claims that the proprietor was aware of the applicant's business and its use of the sign. It is claimed that the proprietor subsequently applied for the contested mark in bad faith with the intention to ride on the back of the goodwill and reputation of the applicant and to use it to impede the applicant's ability to secure its own registration in the UK. Further, it is claimed that the contested mark was sought with the sole intention of monopolising and exploiting the applicant's established goodwill. Lastly, the applicant claims that the proprietor has made substantial claims to an association with the applicant for the purpose of creating confusion.
6. The proprietor filed a counterstatement wherein he admitted to some of the paragraphs in the applicant's statement of grounds. On this point, I note that while the proprietor has conceded to the existence of goodwill in the applicant's business, he has denied the overall claims against him.
7. The applicant has been represented throughout these proceedings by Agile IP LLP. The proprietor is unrepresented. Both parties filed evidence in chief with the applicant also filing written submissions alongside its evidence. No hearing was requested and only the proprietor filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.
8. 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

9. The applicant's evidence came in the form of the witness statements of Joseph Parinas and Malcolm Conlan, both of which are dated 24 June 2024. Mr Parinas is the Chairman of the applicant and Mr Conlan is a board member of the applicant,

a position he has held since 2015. Both statements were adduced in support of the grounds of the invalidation application. However, neither statement was accompanied by any exhibits. On this point, I note that the submissions filed during the evidence rounds do include 17 annexes. While these are labelled 1 to 18, I note Annex 16 is missing. I will discuss these annexes further below.

10. The proprietor filed evidence in the form of a witness statement in his own name, dated 24 August 2024. The proprietor's evidence is accompanied by 8 exhibits, being Exhibit A to G, and was adduced in order for the proprietor to defend the claims against it, such as claiming that the sign relied upon by the applicant is generic.

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

PRELIMINARY ISSUES

The applicant's written submissions and accompanying annexes

12. As set out above, the applicant's annexes were filed alongside its submissions as opposed to evidence. This is not the correct format for the filing of evidence of fact because the submissions are not accompanied by a statement of truth. Therefore, I have no way to verify the veracity of the documents included as annexes. While I note that the applicant is legally represented and should have been aware of this requirement, I am of the view that this issue should have been picked up by the Tribunal upon the filing of the submissions. At that point, the Tribunal should have afforded the applicant the opportunity to re-file these annexes in the correct format, i.e. accompanied by a witness statement with a signed statement of truth.

13. While I accept that the appropriate steps were not taken in these proceedings, I do not consider that this presents any complications for the decision I must make. This is because, having considered these annexes, I am of the view that even if they were filed in the correct format, they carry very little evidential weight. Of the 17 annexes, 10 of them are either undated, from after the relevant date for these

proceedings or originate from the Philippines (be that by way of letters from the British Embassy in Manila, the Malacañan Palace in Manila or the Filipino press). Such evidence is incapable of pointing to the position amongst the relevant UK public as at the relevant date.

14. Of the seven annexes that are from prior to the relevant date and relate to the relevant territory, they are of no material assistance either. I say this because they simply cover three posters from events (with no additional evidence provided), letters from the MP for Brentford and Isleworth and the Mayor of the Borough of Elmbridge, and two letters from the Filipino Embassy in the UK. While these letters refer to the success of the applicant's event, any comments to this effect are without context. I say this because there is nothing before me to suggest the size of the Filipino community in the UK (or any regions within it, for that matter) so it is not possible for me to determine precisely what is meant by the authors' comments regarding the success of the events. In any event, as alluded to above, the proprietor has conceded that there exists goodwill in the applicant's business so given that these annexes are vague, and include no information as to the number of attendees or any turnover/revenue figures generated, they do not take the applicant's case any further.

15. As a result of the above, I do not consider that these annexes, even if they were filed in the correct evidential format, are capable of pointing towards the existence of goodwill in the UK or that the contested mark was applied for in bad faith.

Settlement discussions/negotiations

16. In various documents filed in these proceedings, the parties have made reference to their alleged willingness to engage in mediation in order to reach settlement in this matter, all whilst pointing out the opposing parties' unwillingness to do so. I also note that the proprietor has filed evidence of correspondence from the applicant's representative wherein it confirmed that the applicant was not willing to

engage in further discussions.¹ While no material has been provided that is expressly referred to as without prejudice, the submissions and evidence before me have no bearing on the outcome of this decision. The parties' willingness (or lack thereof) to engage in settlement discussions is beyond the remit of the Tribunal and, instead, my decision will focus solely on the various assessments required under the grounds at issue. I will, therefore, say no more about any of these comments, submissions or the evidence referred to above.

DECISION

17. Section 5(4)(a) and 3(6) of the Act have application in invalidation proceedings by virtue of section 47 of the Act, which states as follows:

“47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

¹ Exhibit G

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(4)(a)

18. 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.”

19. 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.”

20. 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).”

21. 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 source 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

22. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.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.’ ”

23. The contested mark does not have a priority date. Further, there is no evidence to suggest any use of the contested mark prior to it being filed, meaning that the relevant date for the section 5(4)(a) assessment falls on the filing date of the contested mark, being 15 July 2022.

Goodwill

24. 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.”

25. 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.”

26. 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.”

27. 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.”

28. Ordinarily, the first hurdle for the applicant under this ground is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the sign relied upon was distinctive and/or associated with that goodwill.

However, I note that in considering the issue of goodwill, the proprietor's counterstatement set out that:²

"28. [...] The Defendant recognises the Applicant's assertion of goodwill in the UK and internationally."

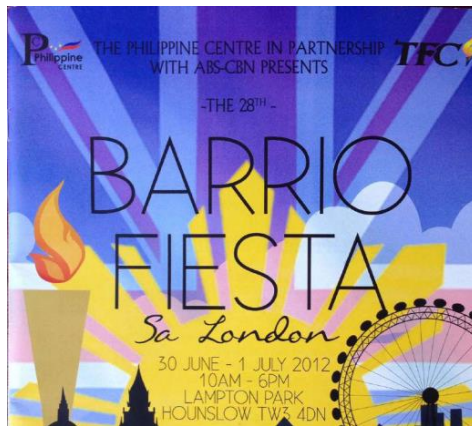
29. The above pleading is a clear concession that the proprietor accepts that the applicant's business enjoys a protectable level of goodwill in the UK. While that may be the case, the question now falls to whether the sign relied upon is distinctive of, or associated with, the goodwill of the applicant's business. This is where the proprietor appears to focus his defence. For example, I note that the proprietor's position is that the sign relied upon is generic and emblematic of traditional Filipino community celebrations and is utilised globally to denote similar cultural gatherings. This argument is repeated in several different ways throughout the proprietor's documents, most notably at paragraph 8 of his counterstatement, which states:

"This widespread use of "Barrio Fiesta" across different cities and countries, organised by various groups, underscores the term's generic status and cultural significance, precluding exclusivity and affirming its broad applicability beyond any single entity's claim."

30. Such an argument can, in the present case, potentially point to a claim that the sign relied upon is descriptive of a Filipino themed festival meaning that any conceded goodwill in the applicant's business may not necessarily be associated with the sign. On this point, I note that the proprietor has sought to argue that the generic nature of the sign relied upon is such that the applicant's own events can be distinguished by the inclusion of the name 'The Philippine Centre' on its posters. Examples of this are given in the proprietor's evidence which shows a number of the applicant's event posters, one of which relates to the applicant's 2012 event which, for illustrative purposes, appears as follows:³

² While this concession was made when the proprietor was discussing the section 3(6) claim against him, I am unable to ignore what is clearly a concession as to the existence of goodwill.

³ Exhibit D



31. For the avoidance of doubt, the other posters provided are consistent with the one shown above. In considering this argument, I am required to assess to whether the sign 'BARRIO FIESTA SA LONDON' would be viewed as descriptive by a significant portion of the relevant public. I accept that 'LONDON' will be descriptive of the location of the event and, further, that 'FIESTA', whilst being a Spanish word, will be understood by a significant proportion of the relevant public as referring to a type of 'party'. Such words clearly carry less weight within the sign relied upon but that doesn't render the sign as a whole generic. This is because the word 'BARRIO' carries a prominent role in the sign and in order for me to be satisfied that it is also descriptive or generic, I need to turn to the evidence.

32. The proprietor, in his evidence, claims that 'Barrio Fiesta' is used across different cities and countries, which underscores the term's generic status. In respect of the generic nature of the applicant's sign, paragraph 15 of the proprietor's witness statement sets out that:

"For goodwill to attach, it must relate to a distinctive mark or brand, not a commonly used phrase that refers to Filipino communal celebrations. As previously demonstrated (see Exhibit A), "Barrio Fiesta" is a widely used term across the global Filipino diaspora and is not exclusive to the Applicant."

33. If proven, this would be a strong argument in favour of the proprietor. However, I do not consider that the evidence sufficiently demonstrates the proprietor's point. I say this because, having considered the evidence filed, I note the following:

- a. Of the various posters filed allegedly showing the 'widespread use' of 'BARRIO FIESTA',⁴ only two are from prior to the relevant date. These show an event called 'BARRIO FIESTA' in Birmingham 2017 and one in Manchester in 2019.
- b. Where the proprietor has sponsored events,⁵ those events are either not adequately dated (for example, there is a reference to days and months but not to the year of the event) or are clearly from after the relevant date.
- c. Where promotional events or social media posts are provided to demonstrate the difference between the applicant and the proprietor,⁶ these are undated or from after the relevant date.

34. Unfortunately for the proprietor, the evidence from prior to the relevant date is very limited and clearly fails to demonstrate the 'BARRIO FIESTA' is the subject of widespread use.⁷ Further, the proprietor has not adduced any evidence as to the attendance levels of these different events, so I have no way to determine their popularity. If he had filed such evidence, then it could have been used to demonstrate that 'BARRIO FIESTA SA LONDON' was readily understood by a significant proportion of the relevant public in the UK as a reference to a London based Filipino cultural event/festival. Such a conclusion would have offered considerable support to the proprietor's position that the sign relied upon was a generic term and, as such, the applicant would be faced with a far higher burden in order to prove that such a sign was distinctive of or associated with its business.

⁴ Exhibit A and C

⁵ Exhibit B

⁶ Exhibit E and F

⁷ On this point, I accept that there may be an argument that the name of a cultural festival, even without evidence, should not be protectable due to it being non-distinct because it is so widely known (such as DIWALI, for example). However, I do not consider this applies to 'Barrio Fiesta Sa London' as it is not a fact that is too notorious to be the subject of any serious dispute (see the guidance on taking judicial notice in *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08). Again, the evidence provided is not at such a level that it could be argued that it should not be owned by a private promoter.

However, none of this has been proven in the present case so I only have the inherent position upon which to base my finding.

35. While I accept that the reference to 'Fiesta' and 'London' will be understood as a reference to a London based party, I simply have nothing to support the claim that as at the relevant date, 'Barrio Fiesta Sa London', as a whole, was a generic term. This is on the basis that 'BARRIO' carries no obvious meaning to the UK consumer. Further, having considered the posters filed by the proprietor, the sign is displayed prominently with the references to the Philippine Centre being very small. As such, I see no reason why the sign relied upon would not be distinctive of or associated with the applicant's goodwill.

36. While the concession of the proprietor allows the present ground to proceed, the proprietor has not set out what level he considers the goodwill to sit. It is, therefore, left for me to determine the level of protectable goodwill that vests in the applicant's business. On this point, I note that the proprietor's counterstatement recognises, at paragraph 5, that the applicant has used the 'Barrio Fiesta Sa London' as a brand name for thirty years. As the proprietor has accepted that the applicant's use of the sign is long-standing, I am of the view that it is reasonable to infer that applicant's festivals would have been relatively successful. While I do not consider that the evidence of use filed by the applicant demonstrates any wider degree of success beyond this, I am willing to find that the proprietor's concession is such to warrant a finding that the goodwill sits at at least a moderate degree.

37. Lastly, I must consider in what services the goodwill vests. I can deal with this briefly on the basis that the evidence before me appears to only make reference to a festival relating to the culture of the Filipino community. On this point, I refer to paragraph 2 of Mr Parinas's witness statement which states that:

"The first fiesta was a modest event and over the course of thirty-nine years, we have built in size because of our reputation for throwing a safe, inclusive, family friendly festival. Our event draws influences from the Philippines, but the 'Barrio Fiesta' is not a Filipino cultural feature in its own right."

38. I appreciate that the above statement confirms that the festival is not solely related to the Filipino culture. However, the mention of Filipino culture is clearly an indication that the applicant organises a cultural event (be that solely Filipino or not). On this point, I note that there is nothing before me to suggest that the event has expanded beyond being a cultural event, such as one that relates to the provision of general entertainment or sporting events, for example. As such, I find that the present ground may only proceed in reliance upon the term “festivals (organisation of-) for cultural purposes”.

39. I will now turn to the issue of misrepresentation.

Misrepresentation

40. 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.”

41. 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.”

42. In considering the issue of misrepresentation, I remind myself that where a sign is descriptive, it may be the case that smaller differences between the sign/mark at issue may be sufficient to avoid confusion.⁸ I raise this here because, as above, the proprietor’s main focus appears to be on the generic nature of the applicant’s sign. However, as above, I have found that the sign relied upon by the applicant has not been proven to be descriptive or generic meaning that this principle does not apply to the present case.

43. Before proceeding, I consider it necessary to set out that it is not necessary for the applicant to show that there has been actual misrepresentation to the relevant public.⁹ Therefore, a notional assessment in respect of the existence of misrepresentation may apply. In determining whether misrepresentation exists, I will first consider the similarity of the sign relied upon and the contested mark before proceeding to consider the closeness (or otherwise) of the fields of business associated with the parties’ services.

44. I have found that the applicant enjoys a protectable level of goodwill for the sign ‘Barrio Fiesta Sa London’. The contested mark is ‘Barrio Fiesta London’. I note that, in his counterstatement, at paragraph 6, the proprietor accepts that the sign and the mark are linguistically equivalent. Even without such a concession, the sign and the mark at issue are clearly highly similar. While they differ in the order of

⁸ *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39

⁹ See page 495 of *Neutrogena* (cited above), namely the reference by Morritt LJ to the judgment of Lord Diplock in *GE Trade Mark* [1973] RPC 297

their words and the presence of the letters 'Sa' towards the end of the sign relied upon, they both identically produce the element 'Barrio Fiesta'. Further, the shared reference to London in the mark/sign will also be noticed, though I do appreciate that it carries much less weight in the sign and the mark due to its purposes as an indicator that the services are offered in or originate from London.

45. Turning to the services at issue, I remind myself that, as per the excerpt from Halsbury's that I have reproduced above, I must consider the closeness (or otherwise) of the respective fields of activity in which the applicant and the proprietor carry on their businesses. The applicant's goodwill vests in "festivals (organisation of-) for cultural purposes". Clearly, the applicant operates in the field of organising cultural events. The proprietor's services cover various classes, namely class 35, 36, 27, 41 and 44. I will deal with the services in each of these classes in turn, beginning with class 35.

Class 35

Marketing services relating to esports events; Advertising services relating to esports events; Promotion of sports competitions and events.

46. The above services are in the field of advertising, promotion and marketing. Whilst they relate to events, the events relate to esports (being competitive computer games) and sports, generally. I do not consider that these are commonly cultural in nature. As such, I am of the view that the proprietor's field of activity for the above services is different to that of the applicant. On this point, I remind myself that the burden of proving the existence of misrepresentation where there is no common field of activity is a heavy one.¹⁰ In the present case, the evidence does not make any attempt to satisfy this burden. Regardless of the (at least) moderate degree of goodwill vested in the applicant's sign, I find that these factors are such that there exists no misrepresentation between these services, even in light of the higher degree of similarity between the sign and the mark at issue.

¹⁰ See *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) and *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501

Event marketing; Promotion of special events; Arranging promotion of charitable fundraising events.

47. The above services relate to the promotion or marketing of events that can be cultural in nature. I consider that the fields of activity for the above services and the service of the applicant are relatively close despite the above covering marketing and promotion of the events as opposed to their organisation. I say this because those seeking the applicant's organisational service will likely seek the services of the proprietor and, in my view, the organiser of a cultural event is likely to also market and promote the event being organised as part of its overall service. As such, bearing in mind the degree of similarity between the contested mark and the applicant's sign together with the (at least) moderate degree of the applicant's goodwill, I find that consumers will be deceived into believing that the above services are from, or associated with, the applicant. As such, there exists a risk of misrepresentation in respect of these services.

Organisation of events for commercial and advertising purposes.

48. The above term, whilst being for commercial and advertising purposes, does cover the organisation of an event. While the aim of the event may be to advertise something, there is nothing preventing the event from being cultural in nature. On this point, I note that the event may be to advertise various businesses run by people of certain cultures. As such, I consider that there is sufficient degree of closeness between the above service and the service of the applicant. This, together with the degree of similarity between the contested mark and the sign relied upon leads me to conclude that a significant proportion of the relevant public will be deceived into believing that the above service, when offered under the contested mark, originates from or is associated with the applicant. Therefore, I find that there exists a risk of misrepresentation in respect of these services.

Class 36

Financial sponsorship of sports events; Financial sponsorship of dance events;

49. While the above services may relate to events, they are financial services covering the sponsorship of said events. While the reference to events is noted, the above are not services in the same or similar field to that of the applicant's service. Those looking to organise an event via the applicant's service may potentially seek sponsorship for the same. However, I do not consider that the provider of these services would coincide and I am of the view that the relevant public would be aware of this. On this point, I have no evidence to demonstrate any such overlap. Relying on the same considerations that I discussed at paragraph 46 above, I find that there exists no misrepresentation between these services and that of the applicant.

Charitable fundraising by means of entertainment events.

50. I am of the view that the service for charitable fundraising is not the same as services for financial sponsorship so consider it appropriate to deal with the above term separately. The above service will be sought by those organising a cultural event (which could include entertainment elements) as, in organising said event, they may begin with fundraising efforts in order to finance it. Additionally, such a service may also be provided by the undertaking responsible for the organisation of the event. Therefore, I find that there exists a degree of closeness between the fields of activity for the above service and that of the applicant. Taking this into account together with the degree of similarity between the contested mark and the applicant's sign and the moderate degree of the applicant's goodwill, I find that consumers will be deceived into believing that the above services are from, or associated with, the applicant. As such, there exists a risk of misrepresentation in respect of these services.

Class 37

Cleaning of venues before and after events.

51. While the above term is a cleaning service, it relates specifically to the cleaning of venues before and after events. Those events can be cultural and, in my view, the cleaning of a venue before and after an event is an important consideration for someone looking to organise an event. Further, those seeking the organisation of events would expect the undertaking responsible for organising it would also clean up the venue, or at least be associated with the undertaking that does. This leads me to conclude that there is a degree of closeness between the fields of activity covered by the applicant's service and the above. This, together with the similarity of the contested mark and sign relied upon are such that I am satisfied that a significant proportion of the relevant public will believe that the services originate from the same undertaking or ones that are associated with one another. As a result, I find that there exists a misrepresentation between these services.

Class 38

Broadcasting of esports events; Streaming of esports events.

52. The above services of the proprietor relate expressly to the broadcasting and streaming of esports. Firstly, these terms are telecommunication services and, therefore, operate in a different field to that of the applicant's service. Further, I have nothing to suggest that esports are cultural in nature, which distances the services further. As a result, I find that the difference in the parties' fields of activity is too great a hurdle to overcome. This means that, regardless of the similarity between the sign and contested mark and the level of goodwill vested in the applicant, I find that there exists no misrepresentation with the applicant's sign when the relevant public views the contested mark on the above services.

Class 41

Dance events; Special event planning; Organisation of musical events; Conducting of educational events; Organising of recreational events; Conducting of cultural events; Organization of entertainment events; Organisation of entertainment events; Arranging of musical events; Organising community cultural events.

53. All of the above services can cover the organisation of events that are cultural. I say this because the dance events, for example, can cover dances from different cultures. Further, the educational events can offer education in relation to different cultures. As a result, these services can be said to operate in the same field of activity with the applicant's services. As such, I find that the closeness of these services together with the similarity between the sign and the contested mark will result in the relevant public believing that the above services, when offered under the contested mark, originate from or are associated with the applicant. Therefore, I find that there exists a misrepresentation between these services.

Ticketing and event booking services; Ticket procurement services for entertainment events; Ticket reservation and booking services for cultural events.

54. The ticketing of an event is, in my view, sufficiently close to the organisation of the event itself that there exists a misrepresentation between the contested mark and the sign in respect of these services. I find that the relevant public will believe that the organiser of a cultural event will be responsible for the ticketing of the same, especially given the similarity between the contested mark and the sign at issue. Therefore, I find that there exists a misrepresentation between these services.

Organising community sporting events.

55. As far as I am aware, community sporting events are not commonly cultural in nature and I have nothing before me to suggest otherwise. Regardless of the degree of similarity between the contested mark and the applicant's sign and the (at least) moderate level of goodwill, I do not consider that the relevant public would

believe that the above service, even when offered under the similar contested mark, originates from or is associated with the applicant. Therefore, there exists no misrepresentation between these services.

Class 44

Providing portable toilets for events.

56. When the relevant public for the parties' service is looking to organise an event (such as an outdoor event at a location with no built-in infrastructure), I am of the view that they will assume that the organiser will arrange the provision of portable toilets for that event. As such, I am of the view that there exists a degree of closeness between the above service and that of the applicant. I find that this, together with the degree of similarity between the contested mark and the applicant's sign, will result in the relevant public (when viewing the above service under the contested mark) being deceived into believing that the above service is offered by, or associated with, the applicant. As such, there exists a misrepresentation between these services.

Conclusion in respect of misrepresentation

57. Given the findings reached above, I consider that there exists a misrepresentation between the contested mark and the sign relied upon but only in respect of the following services:

Class 35: Event marketing; Promotion of special events; Arranging promotion of charitable fundraising events; Organisation of events for commercial and advertising purposes.

Class 36: Charitable fundraising by means of entertainment events.

Class 37: Cleaning of venues before and after events.

Class 41: Dance events; Special event planning; Organisation of musical events; Conducting of educational events; Organising of recreational events; Conducting of cultural events; Organization of entertainment events; Organisation of entertainment events; Arranging of musical events; Organising community cultural events; Ticketing and event booking services; Ticket procurement services for entertainment events; Ticket reservation and booking services for cultural events.

Class 44: Providing portable toilets for events.

58. It is against these services that the present ground may proceed.

Damage

59. Having found the existence of goodwill and misrepresentation in respect of the services listed at paragraph 57 above, I consider that damage through diversion of sales is easily foreseeable. The opposition based upon section 5(4)(a) is, therefore, successful in respect of these services only.

60. I will now proceed to consider the 3(6) ground of the application.

Section 3(6)

61. Section 3(6) of the Act states:

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

62. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]”

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”), para 29; *Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive

right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

63. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which

are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

64. It is necessary to ascertain what the proprietor knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

65. The applicant's pleaded case under the present ground covers four separate claims. These are that:

- a. the contested mark was applied for with the intention to ride on the back of the goodwill and reputation of the applicant;
- b. the proprietor intended to use the contested mark to impede the applicant's ability to secure its own registration in the UK;
- c. the contested mark was sought with the sole intention of monopolising and exploiting the applicant's established goodwill; and
- d. the proprietor has made substantial claims to an association with the applicant for the purpose of creating confusion.

66. In addition, I note that the applicant's pleaded claim relies on the fact that the proprietor knew of the applicant's business operation. While the proprietor did accept that he was aware of the applicant's events and presence (and even conceded to the existence of goodwill), this is not enough by itself to warrant a finding of bad faith. On this point, I refer to paragraph 40 of *Lindt*¹¹ which sets out that:

“the fact that an applicant knows or must know that a third party has long been using [...] an identical or similar sign for an identical or similar product capable

¹¹ *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07

of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith.”

67. As a result of the above, it is not enough to simply suggest that the proprietor was aware of the applicant’s event and that by filing for his mark he was acting in bad faith. Therefore, I must be satisfied that the evidence presents something more to show that the proprietor was acting in line with the intentions put forward by the applicant. In order to do this, I will deal with each of the pleaded claims of the applicant separately.

The contested mark was applied for with the intention (1) to ride on the back of the goodwill and reputation of the applicant and (2) to monopolise and exploit the applicant’s established goodwill.

68. I am of the view that I can deal with these claims (being those referred to at points a. and c. above) together. I appreciate that there was a degree of success under the section 5(4)(a) ground above. However, my assessment under the section 5(4)(a) ground was a notional one that does not require evidence of an actual intention to exploit the applicant’s goodwill. Therefore, the fact that I found misrepresentation above does not mean that I am bound to find that the proprietor acted with such intentions in filing for his mark. In respect of the present ground, I note that there is nothing before me by way of evidence that proves that the proprietor actually applied for his mark with this intention. Without such, I am not willing to find that the applicant has satisfied the burden to prove such an allegation.

69. In respect of the present argument, I consider it necessary to discuss Mr Parinas’s witness statement, namely paragraphs 12 and 13. I do so because these include reference to unknown third parties being confused and misled by the proprietor’s events. This evidence states as follows:

“12. I was contacted by Robinson Land Corporation (RLC) when they arrived in the UK to attend Mr. Isip’s fiesta. They were shocked and confused to find out that we were not in affiliation with Mr. Isip’s event, as this is what they assumed

was the case. Robinson Land Corporation had paid to have a stall [...] in belief that it was our event. They had also sponsored the event assuming that it was our fiesta. We called an emergency meeting with RLC to explain the situation and make it clear that we were in no way affiliated and that it was not our event. This added to our growing concerns.

13. Our second largely concerning complaint came from the nurses and medics that volunteer at our Barrio Fiesta. They had mistakenly gone to Mr. Isip's fiesta and came across the same alarming, dangerous experience. We had the nurses, reaching out distressed over what they had experienced. The nurses, like the vendors, had become confused and assumed they were volunteering for our event. The nurses are happy to volunteer as they are aware that we are a charitable event, we are a non-for-profit organisation."

70. This evidence is noted but it pertains to hyperbolic conversations with unnamed third parties that took place, seemingly, at unknown dates. Such evidence clearly amounts to hearsay evidence and is unverifiable. In any event, even if such evidence was verified, these unknown persons being confused or misled does not, by itself, support a claim that the proprietor actively sought to mislead them (or anyone else, for that matter) by riding on the back of the applicant's goodwill. Without anything further in support of the proprietor actually displaying these intentions, I find that this aspect of the applicant's claim fails.

The contested mark was applied for with the intention to be used to impede the applicant's ability to secure its own registration in the UK.

71. The evidence of the applicant sets out, at paragraph 11 of Mr Parinas's witness statement, that it applied to register the trade mark 'Barrio Fiesta Sa London' in the UK on 16 June 2023. It is confirmed that an opposition to this application was raised by the proprietor leading to the applicant subsequently withdrawing its application for said mark. This is noted but, at that point, the proprietor had a validly registered trade mark and he was entitled to use it as the basis of an opposition against the applicant's trade mark. This is a fundamental right afforded to owners of registered

trade marks and the simple raising of an opposition is not an act of bad faith in itself. In order for the present argument to succeed, the applicant would need to prove that it was for this reason that the proprietor filed for his mark. In short, there is nothing before me in evidence to demonstrate that this was the case. As a result, I find that this aspect of the applicant's claim fails.

The contested mark was applied for so that the proprietor could present himself as being associated with the applicant for the purpose of creating confusion.

72. I note that the only evidence of the proprietor seemingly claiming an association with the applicant comes from the narrative evidence of Mr Parinas which sets out at paragraph 8 that:

“We were alerted and subsequently incredibly concerned when we were made aware of Mr. Isip's marketing of his fiesta. Mr. Isip had made every attempt to align his fiesta with ours. Considering we were refraining from holding a fiesta that year, it was difficult for consumers to distinguish between the two- as only one event was going ahead.”

73. This is a very vague claim and, having considered the evidence as a whole, it is entirely unsupported. There is no documentary evidence pointing to the proprietor actually seeking to make such an association. For example, there are no advertising materials showing the proprietor seeking to actively put forward an association with the applicant's events. I appreciate that the proprietor applied for a similar mark to that of the sign that he knew was being used by the applicant. However, as set out above, mere knowledge of another party using a similar mark is not enough. Further, his evidence rebuts the applicant's claim by confirming that he applied for the contested mark with the intention to continue the Filipino community cultural celebrations, which had been halted due to the COVID-19 pandemic.¹² He also confirms that he wanted to ensure continuity of a community

¹² See paragraph 8 of the proprietor's witness statement

tradition and that he did not intend to exploit the applicant's goodwill.¹³ I have no documentary evidence from the applicant to disprove these statements.

74. Further, I also appreciate that the evidence sets out that some persons were confused (being those discussed in the evidence I reproduced at paragraph 69). However, as above, this evidence is hearsay evidence and, again, does not point to any actual intention of the proprietor to associate his event with the applicant.

75. While I accept that the assertion set out at paragraph 72 above was made in the body of a witness statement, it is not actually borne out by any supporting evidence confirming such an intention and, on this point, I remind myself that claims of bad faith are serious allegations that must be distinctly proven. They cannot be found to be successful on the basis of mere assumptions, suppositions or inferences. In my view, failing to provide any documentary evidence in support of this claim is a considerable issue for the applicant. As such, without anything further, I find that the applicant has fallen far short of crossing this threshold for the present claim. It, therefore, fails.

Conclusion in respect of the section 3(6) ground

76. As above, all pleaded claims of the applicant have failed. It is noted that in its submissions, the applicant raised a claim that the proprietor sought to block the applicant's status as a charitable event. The applicant submits that he succeeded in doing so because the applicant decided to call off its 2023 event as a result of the legal ambiguity created by the presence of the contested mark as well as the proprietor's refusal to engage in negotiations. Firstly, this argument was not raised at the outset and it is not appropriate for the applicant to raise it via submissions later on in the course of these proceedings. Secondly, this claim is discussed solely in the submissions and is not supported by any evidence whatsoever. It is simply not appropriate for me to deem these submissions as substantiating any claim as

¹³ See paragraph 9 of the proprietor's witness statement

they are not accompanied by a sworn statement of truth so I am unable to place any evidential weight on this claim whatsoever.

77. Even if it were the case that the argument was (1) brought at the appropriate time and (2) mentioned in the witness statements as opposed to the submissions, it would fail. I say this because the argument sets out that this was a decision reached by the applicant itself as a result of a vague reference to 'legal ambiguity' and the applicant's failure to engage in discussions. Firstly, there is no obligation on a party to engage in negotiations and the failure to do so does not indicate bad faith. Secondly, the argument does not refer to any instances where the proprietor actually sought to place pressure on the applicant. Lastly, the argument does not prove anything about the proprietor's intention as at the relevant date. Therefore, this argument is a mere supposition and there is nothing that actually demonstrates with any certainty that this is what the proprietor's intentions were in applying for his mark.

78. As a result of the above, I find that the applicant's section 3(6) ground fails in its entirety.

Final remarks under the section 3(6) ground

79. I remind myself that I found misrepresentation and damage under the section 5(4)(a) ground of the application in respect of some services, being those that can be said to be more closely associated with the applicant's field of business. For the avoidance of doubt, I consider it necessary to set out that even if I was satisfied that the proprietor had acted in bad faith in applying for his mark, I see no reason why such a finding would extend beyond those services for which there was a misrepresentation and damage (being those listed at paragraph 57 above). This is because the distance between the remaining services is such that even if it could be said that the proprietor was actively intending to misrepresent himself as the applicant and cause confusion, this would relate to the provision of the 'London Barrio Fiesta' cultural event and any associated services only. In short, I see no reason why any finding of bad faith would extend to services relating to sports,

esports or financial sponsorship (being those for which the section 5(4)(a) ground failed).

CONCLUSION

80. The application has succeeded in part under the section 5(4)(a) ground. As a result, the contested mark is, subject to any successful appeal of my decision, hereby declared invalid, and treated as if it had never been registered, for the following services:

Class 35: Organisation of events for commercial and advertising purposes; Event marketing; Promotion of special events; Arranging promotion of charitable fundraising events.

Class 36: Charitable fundraising by means of entertainment events.

Class 37: Cleaning of venues before and after events.

Class 41: Dance events; Special event planning; Organisation of musical events; Conducting of educational events; Organising of recreational events; Conducting of cultural events; Organization of entertainment events; Organisation of entertainment events; Arranging of musical events; Organising community cultural events; Ticketing and event booking services; Ticket procurement services for entertainment events; Ticket reservation and booking services for cultural events.

Class 44: Providing portable toilets for events.

81. However, the contested mark has survived the application to some degree meaning that it may, again subject to any successful appeal of my decision, remain registered for the following services:

Class 35: Marketing services relating to esports events; Advertising services relating to esports events; Promotion of sports competitions and events.

Class 36: Financial sponsorship of sports events; Financial sponsorship of dance events

Class 38: Broadcasting of esports events; Streaming of esports events.

Class 41: Organising community sporting events.

COSTS

82. On balance, I find that the applicant has enjoyed the greater degree of success in these proceedings and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. That being said, I consider it appropriate to reduce the costs award in order to reflect the fact that the proprietor has successfully defended his mark for some terms.

83. In the circumstances, I award the applicant the sum of **£750** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of invalidity and considering the counterstatement	£350
Preparing evidence and considering the evidence of the proprietor:	£600
<u>Sub-total:</u>	<u>£950</u>
<i>Reduction:</i>	<i>-£400</i>
Official fees (not subject to a reduction):	£200

Total:

£750

84. I hereby order Erroll Lim Isip to pay The Philippine Centre (Tagpuang Pilipino) the sum of £750. 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 19th day of March 2026

A COOPER

For the Registrar