O/0413/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003945811

BY MARTYN TREVOR KEEBLE

TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASSES 9, 25 AND 45

AND OPPOSITION THERETO UNDER NO. 445644

BY NATHAN NICHOLAS LOWRY

BACKGROUND AND PLEADINGS

1. On 15 August 2023, Martyn Trevor Keeble ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 3 November 2023 and protection is sought for the goods and services set out in Annex 1 to this decision.[1]

2. On 1 February 2024, the application was opposed by Nathan Nicholas Lowry ("the opponent") based upon sections 5(1), 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act").[2] Under sections 5(1), 5(2) and 5(3) of the Act, the opponent relies upon the following trade mark:

MARQUEE

(series of 2)
UKTM no. 3298814
Filing date: 22 March 2018
Registration date: 1 April 2022

3. Under sections 5(1), 5(2)(a) and 5(2)(b), the opponent relies upon the goods and services underlined in Annex 2 to this decision. The opponent claims that the marks are identical or similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion. The opposition under these grounds is directed only at those goods underlined in Annex 1 to this decision.

[1] Although the application originally related to a broad range of goods and services, including those in class 41, following a different opposition in relation to which the applicant failed to file a TM8 within the prescribed time period, the application in relation to those broader goods and services was deemed abandoned.
[2] The opposition was originally brought in the name of Caviar Holdings Inc. However, the opponent requested substitution of the opponent following a transfer of ownership of the earlier mark.

4. Under section 5(3) of the Act, the opponent relies upon the same earlier mark. The opponent claims to have a reputation for all of the goods and services shown in Annex 2 to this decision and the application is opposed in its entirety. The opponent claims that use of the applicant's mark, without due cause, would take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the earlier mark.

5. Under section 5(4)(a) of the Act, the opponent relies upon signs identical to those shown in paragraph 2 of this decision. The opponent claims to have used the signs throughout the UK since at least January 2006 in relation to the goods and services shown in Annex 3 to this decision. The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

6. Under section 3(6) of the Act, the opponent claims that the applicant has full knowledge of the opponent's activities and long-standing use of the MARQUEE brand. The opponent claims that the applicant's previous behaviour towards the opponent leads to the conclusion that the filing of the application is part of a pattern of behaviour intended to undermine, frustrate and damage the opponent's rights and to block and challenge the opponent's commercial activities.

7. The applicant filed a counterstatement denying the grounds of opposition. It does not appear to be in dispute that there has been goodwill associated with the MARQUEE brand, but rather the scope and ownership of any such goodwill is disputed by the applicant.

8. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful consideration of the papers on file.

REPRESENTATION

9. The applicant is represented by Julian Wilkins of Wordley Partnership.

10. The opponent is represented by JMW Solicitors LLP.

EVIDENCE AND SUBMISSIONS

11. The opponent's evidence in chief took the form of his own witness statement dated 1 July 2024, which is accompanied by 12 exhibits (NLL1 to NLL12).

12. The applicant's evidence took the form of:

a. His own witness statement dated 8 January 2025, which is accompanied by 6 exhibits (MK1 to MK6).

b. The witness statement of Michael Smith dated 8 January 2025. Mr Smith is a music producer and founder of RYP Recordings, who gives his opinion that he associates the MARQUEE brand with the applicant. Whilst I have noted this, I bear in mind that opinion evidence is of limited value in this context.

13. The opponent filed evidence in reply in the form of his second witness statement dated 6 March 2025, which is accompanied by 2 exhibits (NLL13 and NLL14).

14. The opponent filed written submissions in lieu dated 29 April 2025.

15. The applicant filed written submissions in lieu dated 7 May 2025.[3]

RELEVANCE OF EU LAW

16. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

[3] A short extension of time was granted for the filing of written submissions in lieu.

DECISION

Preliminary issues

Statutory Acquiescence

17. In his written submissions in lieu, the applicant sought to rely upon the defence of statutory acquiescence (section 48 of the Act) for the first time. This was not pleaded and that, in itself, is sufficient reason to dismiss the defence. However, for the avoidance of doubt, statutory acquiescence is concerned with use of a registered trade mark in the UK for a continuous period of five years. As the application in issue is not yet registered, that defence cannot apply. Consequently, it would not have assisted the applicant even if it had been properly pleaded.

The opponent's ability to rely upon the earlier mark

18. The applicant has also made reference to section 46 of the Act and points to the fact that the opponent has not put his mark to genuine use. The opponent's mark was not registered until 2022 and so it is not yet subject to revocation on the grounds of non-use (there is a 5-year grace period following registration), nor is it subject to the use provisions in section 6A of the Act as explained below. For the sake of completeness, I note that the applicant has not filed any challenge to the validity of the earlier mark and so it can be relied upon by the opponent in full in these proceedings.

Honest concurrent use

19. Finally, the applicant raised a defence of honest concurrent use in his written submissions in lieu. In order to rely upon such a defence, the applicant should have pleaded it in his Form TM8. Consequently, this cannot be taken into consideration for the purposes of this decision. In any event, there would need to be clear and specific evidence that the two marks were known to the same relevant public without any confusion occurring in order for this defence to succeed. In my view, the evidence filed in this case falls well short of establishing such a defence.

Section 5(1)

20. Section 5(1) of the Act states:

> "A trade mark shall not be registered if it is identical with an earlier trade mark and the goods and services for which the trade mark is applied for are identical with the goods and services for which the earlier trade mark is protected."

21. Given its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years prior to the filing date of the application in issue, it is not subject to the use provisions in section 6A of the Act. Consequently, although the applicant requested that proof of use be filed, the opponent is not required to do so and can rely upon all of the goods and services identified.

Comparison of goods

22. The competing goods are as follows:[4]

Opponent's goods	**Applicant's goods**
Class 9 Apparatus for recording, transmission or reproduction of sound and/or images; compact discs, DVDs and other digital recording media; magnetic data carriers; magnetic and/or smart cards; scanners; readers for magnetic data carriers, cameras; records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other	Class 9 Musical recordings; Musical sound recordings; Recorded media; Digital recording media; Digital data recording media; Electronic publications recorded on computer media; Optical recording media; Magnetic data recording media; Optical data recording media; Blank digital recording media; Recorded video tapes; Electronic databases recorded on

[4] Although the opponent also relies upon goods and services in class 41, as that class no longer forms part of the application (and for reasons that will become clear I do not need to rely upon those services under section 5(2)) I have not used it for the purposes of my comparison.

carriers bearing or for use in bearing sound, video, data or digital recordings; computer hardware and software; computer software supplied over the Internet; music, images, recordings and publications (downloadable) provided on-line from databases or the Internet; sound recordings in the form of phonograph records, discs and tapes; video recordings in the form of discs and tapes; discs and tapes, all for recording sound and/or vision; cassettes and cartridges all for use with or containing video and sound recordings; cinematographic films; sunglasses; eyewear; eyeglass cases, chains and cords; audio and video recordings; eBooks; binoculars; computer accessories; radios; portable music players; headphones; telephones; batteries. <u>Class 25</u> Clothing, footwear, headgear.	computer media; Recorded tapes; Electronic magnetic recording media; Recorded content; Data recorded electronically from the internet; Recorded film; Data recorded electronically; Downloadable media; Recorded films; Photographic media [films, exposed]; Recorded tape cassettes; Media streaming software; Covers for digital media players; Digital media streaming devices; Digital storage media; Multi-media recordings; Books recorded on tape; Tape recordings of music; Pre-recorded video tapes featuring music; Digital video recorders; Musical video recordings; Prerecorded digital audio tapes; Audiovisual recordings; Computer software for the display of digital media; Computer games programs recorded on tapes [software]; Computer software platforms, recorded or downloadable; Downloadable educational media; Digital audio tape recorders; Pre-recorded video tapes;Pre recorded computer software. <u>Class 25</u> Clothing; Ready-to-wear clothing; Headbands for clothing; Clothes; Hoods [clothing]; Wristbands [clothing]; Belts [clothing]; Waterproof clothing; Leisure

	clothing; Ties [clothing]; Tops [clothing]; Dance clothing.

23. 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 of its judgment that:

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

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. Another factor in assessing similarity is to consider the extent to which the goods at issue may be regarded as "complementary", which case law describes as meaning that "… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."[5] For the purposes of assessing similarity, it is permissible, to group specified terms together where they are sufficiently comparable in essentially the same way for essentially the same reasons.[6]

26. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysterne v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

Class 9

Musical recordings; Musical sound recordings; Recorded film; Recorded films; Multi-media recordings; Musical video recordings; Audiovisual recordings; Recorded media; Recorded tapes; Recorded content; Data recorded electronically from the internet; Data recorded electronically; Downloadable media; Downloadable educational media; Electronic databases recorded on computer media; Electronic publications recorded on computer media; Books recorded on tape; Tape recordings of music; Pre-recorded video tapes featuring music; Prerecorded digital audio tapes; Pre-recorded video tapes.

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

6 See *Separode* Trade Mark (BL O/399/10)

27. These goods are identical on the principle outlined in *Meric* to the terms “music, images, recordings and publications (downloadable) provided on-line from databases or the Internet” and/or “audio and video recordings” in the opponent’s specification.

Digital recording media; Digital data recording media; Optical recording media; Magnetic data recording media; Optical data recording media; Blank digital recording media; Recorded video tapes; Electronic magnetic recording media; Photographic media [films, exposed]; Recorded tape cassettes; Digital storage media.

28. These are terms which cover either blank recording media or recording media which is pre-recorded with content. In either case, I find these terms to be identical on the principle outlined in *Meric* to “records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound, video, data or digital recordings” in the specification of the earlier mark.

Media streaming software; Computer software for the display of digital media; Computer games programs recorded on tapes [software]; Computer software platforms, recorded or downloadable; Pre recorded computer software.

29. These terms are identical on the principle outlined in *Meric* to “computer hardware and software” in the specification of the earlier mark.

Digital media streaming devices; Digital video recorders; Digital audio tape recorders.

30. These terms are identical on the principle outlined in *Meric* to “apparatus for recording, transmission or reproduction of sound and/or images” in the specification of the earlier mark.

Covers for digital media players.

31. These goods are likely to be sold through the same trade channels as the digital media players themselves, which would fall within the term “apparatus for recording, transmission or reproduction of sound and/or images” in the specification of the earlier mark. The goods will be sold to the same users. They are complementary, because

one is important or indispensable for the other and the average consumer would expect the same undertaking to be responsible for both. Plainly, the purpose, method of use and nature of the goods differ, with one being the player itself and the other being a cover for it. Given the differing purposes, there is no competition. Taking all of this into account, I find the goods to be similar to a medium degree. There are no other terms relied upon by the opponent which put it in a stronger position.

Class 25

Clothing; Ready-to-wear clothing; Headbands for clothing; Clothes; Hoods [clothing]; Wristbands [clothing]; Belts [clothing]; Waterproof clothing; Leisure clothing; Ties [clothing]; Tops [clothing]; Dance clothing.

32. These terms are identical on the principle outlined in *Meric* to "clothing, footwear, headgear" in the specification of the earlier mark.

Comparison of trade marks

33. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
MARQUEE  (series of 2)	

34. The first mark in the opponent's series of marks is a word-only mark. Consequently, it provides the opponent protection for the word itself, presented in any typeface. Consequently, I find the marks to be identical. Further, the second mark in

the series differs to the applicant's mark in ways that are so insignificant that they would go unnoticed by the average consumer. Consequently, they are also identical.[7]

Conclusions on section 5(1)

35. The result of these findings is that the opposition based upon section 5(1) of the Act succeeds for all of those goods that I have found to be identical. The only term that survives the section 5(1) ground (of those that were subject to this ground of opposition) is *covers for digital media players,* which I found to share a medium degree of similarity with the opponent's goods. I will, therefore, proceed to consider the section 5(2)(a) ground in respect of that term only. I do not need to address the section 5(2)(b) ground in any further detail, because that ground is only concerned with similar marks (and I have found the marks in this case to be identical).

Section 5(2)(a)

36. Section 5(2) of the Act states:

> "A trade mark shall not be registered if because-
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

[7] *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA,* Case C-291/00

37. The following standard summary of the principles applicable to the assessment of the likelihood of confusion under section 5(2) was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

> (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
>
> (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
>
> (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
>
> (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
>
> (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
>
> (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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

38. For the reasons given above, I find the relevant goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

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

40. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

41. The average consumer for the goods will be a member of the general public or, in some circumstances, business users. The goods are likely to vary in price with digital media players being reasonably costly but covers less so. The goods will not be frequent purchases. The average consumer is likely to take factors such as compatibility, effectiveness and quality into account when purchasing the goods. In my view, a medium degree of attention will be paid, although it may be slightly higher

for business users or where the items involved are at the more expensive end of the scale.

42. The goods are likely to be selected from the shelves of a retail outlet or online equivalents. Consequently, I find that visual considerations will dominate the purchasing process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

Comparison of marks

43. For the reasons given above, I find the marks to be identical.

Distinctive character of the earlier trade mark

44. 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 1-2779, 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)."

45. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

46. The earlier mark consists of the word MARQUEE. The first mark in the series is word-only, and the second mark is presented in a stylised font. However, nothing will turn on this as I do not consider that the stylisation increases the distinctiveness of the word itself to any material degree. The word MARQUEE refers to a large tent which is often used to host events. It is neither descriptive nor allusive for the goods in issue. In my view, the mark is inherently distinctive to a medium (or average) degree.

47. Although the opponent has filed evidence of use, it focuses upon the opponent's business as an entertainment venue. There is nothing in the evidence which suggests to me that there is any enhanced distinctiveness for the goods in issue.

Likelihood of confusion

48. 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 goods may be offset by a greater degree of similarity between the marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process.

49. I have found as follows:

a. The goods are similar to a medium degree.

b. The average consumer for the goods is a member of the general public or a business user who will pay a medium degree (or slightly higher than medium degree) of attention during the purchasing process.

c. The purchasing process is predominantly visual, although I do not discount an aural component.

d. The marks are identical.

e. The earlier mark is inherently distinctive to a medium (or average) degree for the relevant goods.

50. Bearing all of the above factors in mind, I find that there is a likelihood of confusion. This is because the marks are identical, meaning there is nothing to assist the average consumer in distinguishing between them, and in the context of goods which are similar to a medium degree, I find it likely that the average consumer will confuse them. I find this to be the case notwithstanding the only medium (or average) level of distinctiveness, and even in circumstances where the average consumer is paying a higher than medium degree of attention during the purchasing process.

51. The opposition based upon section 5(2)(a) succeeds.

Section 5(4)(a)

52. Section 5(4)(a) of the Act states as follows:

> "5(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."

53. Subsection (4A) of section 5 of the Act 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."

54. 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)."

The Evidence

55. The parties are in agreement that the Marquee Club was originally founded by Mr H. Pendleton in 1958.[8] I do not understand it to be in dispute that the club was originally located on Oxford Street, London, before moving to Wardour Street in around 1964. I also do not understand it to be in dispute that the Marquee Club was known as a music venue, attracting famous acts such as The Rolling Stones, Led Zepplin and Iron Maiden. The parties are also in agreement that in around 1987/1988, Mr Pendleton sold at least some of his rights in the Marquee Club to an individual called Mr Gaff.[9]

56. The real crux of this dispute goes to the ownership of the goodwill. I understand Mr Keeble's position to be that the sale to Mr Gaff concerned only the rights relating to the physical music venue. Mr Keeble asserts that Mr Pendleton retained all other rights in the name, which he then licensed to a company owned by Mr Keeble.[10] This is supported by a witness statement of Mr Nick Pendleton (the son of Mr Pendleton), who states that his father retained the rights for using the MARQUEE name and logo in all respects, with the exception of a permanent bricks and mortar music venue.[11] Mr Lowry does not comment upon the particular extent of the rights that were transferred to Mr Gaff, but states that these rights were subsequently transferred to Mr Lowry's company (Leisure Trading and Development Limited).

57. The difficulty facing both parties is that neither of them have provided copies of these assignments; I have, therefore, no way of knowing the scope of the assignment(s) that were made. Whilst the applicant and Mr Nick Pendleton have given their understanding of the intentions of Mr Pendleton when he sold his venue to Mr Gaff, in the absence of a copy of the assignment (if, indeed, it was made in writing), it is impossible to know what was actually transferred. Mr Lowry has provided details from the Register which record the assignments made dating back to 2002 (when Mr Gaff assigned the mark in question to one of his own companies).[12] Whilst this

[8] See paragraph 16(a) of Mr Keeble's witness statement and paragraph 5 of Mr Lowry's first witness statement.
[9] See paragraph 6 of Mr Lowry's first witness statement and paragraph 16(b) and 21 to Mr Keeble's witness statement.
[10] See paragraphs 21 and 22 of Mr Keeble's witness statement.
[11] Exhibit MK2
[12] Exhibit NNL1

evidences transfer of ownership of a previous trade mark, it does not provide details of the assignments of goodwill to enable me to determine what rights were transferred/retained.

58. I have no details to suggest that Mr Pendleton was doing more than operating a bricks and mortar club. Consequently, it seems to me that any subsequent assignment can only have transferred goodwill insofar as it related to those activities; this appears to be the extent of the goodwill that had been generated, based upon the evidence before me. I am, therefore, inclined to prefer Mr Lowry's version of events, that all rights were transferred to him (by virtue of his company). That is not to say that Mr Keeble did not believe that he was legitimately being given a license to use the MARQUEE sign/mark, but if those rights had already been assigned to Mr Gaff (and subsequently Mr Lowry) it does not appear to me that there were any rights to licence by that time (unless the scope of the goodwill was broader than the evidence before me would suggest).

59. In any event, Mr Lowry has filed evidence that since 2004, he has been operating the Marquee Club through his various companies (of which he has been the sole director). Mr Lowry states that these companies have been using the name with his consent under an implied licence.[13] He operated a physical premises between 2004 and 2008, first in Leicester Square and subsequently in Upper St Martin's Lane, London. This is supported by evidence of promotional materials for the club dated during this time, which display the following sign:

[13] See paragraph 9 to Mr Lowry's first witness statement.

60. There is also a wage form provided, which Mr Lowry states is from approximately 2005 (for the sum of just over £1,000), a photograph of the club from around 2005, an invoice dated 2007 for over £6,000 addressed to the opponent at the Marquee Club which he states related to alcoholic beverages for the venue and till sheets recording over £1,000 and £300 in cash respectively from around 2007. There is further evidence of costs incurred in the running of the physical premises during this period (including, *inter alia,* a service charge of over £15,000, management fees of almost £10,000 and a rental payment of almost £140,000).[14] I have no evidence regarding attendee numbers for this period. However, the club was valued at £1.4million in December 2004 and in the same year, the club was described by *The Guardian* as "legendary" and by *The Independent* as "the musical A-bomb".[15] It was also listed as number 1 by *Q Magazine* in a list of "Great Venues Without Which Rock 'N' Roll Would Have Been Very Different".[16]

61. Mr Lowry states that whilst the physical premises closed in 2008, he has continued to operate events under the sign. The evidence that he has filed to support this are:[17]

a. A flyer for an event running between 2 July 2012 and 31 July 2012 called *The Marquee Club and Exhibition*, consisting of live bands and a photograph exhibition relating to the famous acts that played at the original venue.

b. A document which Mr Lowry describes as an invoice for a Marquee Club event in 2012, which is on Lloyds TSB headed paper (so appears more as a bank statement). This document is illegible due to the print quality, even when zooming in.

c. A document which is described as a Statement of Sales from 2012 (although the date is illegible due to print quality), which shows the amount submitted as in excess of £5,700.

[14] Exhibit NNL5
[15] Exhibits NNL6 and NNL7
[16] Paragraph 32 of Mr Keeble's witness statement.
[17] Exhibit NNL3

d. Undated photographs of a club (no sign is visible) which Mr Lowry states are from a Marquee Club event in around 2012.

e. An invoice issued by a security company for security services at a Marquee event which took place on 24 June 2016 for the total sum of £636.

f. An invoice dated September 2016 which Mr Lowry states relates to alcohol provided for a Marquee Club event which took place in July 2016. The document itself is largely illegible, although I can make out the total which appears to be £162.

g. An invoice dated July 2016 for an event which Mr Lowry states took place that month. The invoice relates to goods used in the provision of that event, although I note that no reference is made to the MARQUEE sign. The invoice is for just under £1,500.

62. There are photographs of t-shirts provided which bear the insignia of various bands.[18] Mr Lowry states that these were sold at the Marquee Club, but I have no details regarding the number of sales. Similarly, evidence of goods such as records and DVDs available for sale on Amazon and HMV, bearing the sign, have been provided, which Mr Lowry states were sold in 2015, but no information is supplied regarding the number of sales made of these goods.[19] There is evidence that some preparatory activities were commenced in 2007 for a film about the Marquee club, and a list of interviews to take place relating to a documentary in 2013 is provided.[20] There is also evidence of investment in this regard.[21] There is evidence that the BBC produced a radio documentary about the Marquee Club in 2019, although it is not clear if this is related to the preparatory works undertaken in 2013.[22] I note that there is evidence of financial projections for the period 2012 to 2017, but it is not clear to me whether these 'projections' were achieved or not.[23]

[18] Exhibit NNL3
[19] Exhibit NNL4
[20] Exhibit NNL4
[21] Exhibit NNL7
[22] Exhibit MK2
[23] Exhibit NNL7

63. A document dated July 2017 states that the physical venue was due to be re-launched at the London Pavillion.[24] The forecasts suggested that this was due to be a multi-million pound operation. The document sought investment of around £5million, with the re-launch intended to take place in October 2017. This document is in the name of one of the companies to which Mr Lowry states he had given a licence to use the mark in issue. There is evidence of apparent interest in investing in the project.[25] However, there is no evidence that the re-launch actually took place.

Relevant date

64. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC (now KC), 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.' "

65. There is some suggestion in the applicant's evidence that he has been carrying out activities prior to the filing date under the MARQUEE brand. For example, Mr Keeble states that he has "built up [his] own goodwill using the Marquee name through my music business Marquee Records Limited…". However, I will begin by assessing

[24] Exhibit NNL5
[25] Exhibit NNL7

the position as at the prima facie relevant date (being the filing date of the contested application). If there is no goodwill at the prima facie relevant date, then the passing off claim cannot succeed.

Goodwill

66. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described 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."

67. 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 that 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."

68. 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."

69. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (now KC), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

"... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

70. In *Ad Lib Club Limited v Granville* [1971] FSR 1 (HC), Vice Chancellor Pennycuick stated that:

> “It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.
>
> In the present case, it is quite true that the plaintiff company has no longer carried on the business of a club, so far as I know, for five years. On the other hand, it is said that the plaintiff company on the evidence continues to be regarded as still possessing goodwill to which this name AD-LIB CLUB is attached. It does, indeed, appear firstly that the defendant must have chosen the name AD-LIB CLUB by reason of the reputation which the plaintiff company’s AD-LIB acquired. He has not filed any evidence giving any other reason for the selection of that name and the inference is overwhelming that he has only selected that name because it has a reputation. In the second place, it appears from the newspaper cuttings which have been exhibited that members of the public are likely to regard the new club as a continuation of the plaintiff company’s club. The two things are linked up. That is no doubt the reason why the defendant has selected this name.”

71. I have no doubt that during its heyday, from the 1950s to the 1980s, the Marquee Club had a protectable goodwill within the entertainment industry. I do not understand it to be in dispute between the parties that there has been goodwill of which the name MARQUEE was distinctive. Indeed, the parties are in agreement that that goodwill was (at least in part) transferred from Mr Pendleton to Mr Gaff (and associated companies). The position as to whether, and to what extent, that goodwill was transferred to either of the parties to this dispute is unclear. However, what is clear is that the opponent was trading himself (through various companies) by virtue of a physical entertainment

venue which appears to have been reasonably successful and no doubt benefitted from the continued association with the earlier famous club (whether or not it was permitted to do so). Certainly, as of 2008, when the physical premises closed, I find that there was a protectable goodwill of which the MARQUEE brand was distinctive. In light of Mr Lowry's uncontested evidence that his companies were operating under a licence, it seems that he was the owner of that goodwill.

72. However, the relevant date is 15 August 2023, which is some 15 years after the opponent's venue closed. There appears to have been a limited number of events run in 2012 and 2016 under the MARQUEE name, although the evidence in this regard is limited. For example, I have no evidence regarding the number of people who attended these events or exactly how many such events took place. Whilst there was some suggestion that documentaries and films were in production, only one (produced by the BBC) appears to have been aired.

73. As noted above, where a business benefits from goodwill, that goodwill can (and often does) continue after the cessation of the business. The length of time for which that residual goodwill continues is a question of fact and degree. It may be that in 2017, there continued to be some (albeit diminished) goodwill in the MARQUEE sign. Clearly, there was something that prompted investors to show interest in a project which was billed as a re-launch of the Marquee Club. However, that was 6 years prior to the relevant date, and I have absolutely no evidence of any activities whatsoever on the part of the opponent taking place during that 6-year period. There is certainly no evidence that a re-launch actually took place. Whilst there is evidence that a 2019 BBC radio documentary regarding the Marquee Club was produced, there is nothing to suggest that this was by reference to either party to these proceedings. Bearing that period of inactivity in mind, combined with the fact that this was only ever a single club (with a spattering of subsequent events post-2008 to keep the brand in the mind of the public), I find that the opponent did not benefit from any goodwill as of the relevant date. The opposition based upon this ground, therefore, falls at the first hurdle.

74. For the avoidance of doubt, even if I am wrong in that finding and the opponent continued to benefit from a modest amount of residual goodwill at the relevant date, the distance between the parties fields of activity in relation to those services which

have survived the 5(1) and 5(2) grounds of opposition (being legal services in the applied-for specification vs entertainment services for which the opponent had goodwill), I would not have found misrepresentation or damage.

75. The opposition based upon section 5(4)(a) of the Act is dismissed.

Section 5(3)

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

> "5(3) A trade mark which -
>
> > (a) is identical with or similar to an earlier trade mark, […] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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."

77. Section 5(3A) of the Act states:

> "Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

78. 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 and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM*.

79. I can deal with this ground relatively swiftly. I have summarised the opponent's evidence of use above. In my view, the evidence falls well short of establishing the requisite reputation. In assessing whether there is a reputation, factors such as the intensity, geographical spread, length of use, market share and advertising investment are relevant. There is no evidence of use in the years leading up to the relevant date,

and even for the period prior to that the evidence is very limited. There appears to have only ever been one club (which then became a spattering of subsequent events within a small geographical area) and I have no evidence regarding market share. In my view, whilst the Marquee Club was no doubt famous in the past, the evidence falls well short of establishing the requisite reputation at the relevant date. Consequently, this ground of opposition falls at the first hurdle.

80. The opposition based upon section 5(3) of the Act is dismissed.

Section 3(6)

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

> "A trade mark shall not be registered if or to the extent that the application is made in bad faith."

82. 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 Ankenaevnet 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 Mağazacilik 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)."

83. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

84. It is necessary to ascertain what the applicant 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).

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

85. In its Form TM7, the opponent sets out the bad faith claim as follows:

> "The Applicant is fully aware of the Opponent's activities and long established ownership and use of the MARQUEE brand going back many years. The Applicant's past behaviour and actions towards the Opponent leads to the conclusion that the filing of the Application is part of an ongoing agenda of the Applicant to undermine, frustrate and damage the Opponent's ongoing enjoyment of its established and renowned rights in the MARQUEE brand and to block and challenge the Opponent entering closely related commercial activities to its core business in the future."

Was that an objective for the purposes of which the contested application could not be properly filed?

86. I accept that mere knowledge of another party's business activities in the UK does not establish bad faith; *Lindt, Koton* (paragraph 55). However, if the application was part of a pattern of behaviour intended to frustrate, damage or challenge the opponent's legitimate business activities, then I am satisfied that that is an objective for the purposes of which the contested application could not be properly filed.

Was it established that the contested application was filed in pursuit of that objective?

87. The parties first appear to have come into contact with each other in around 2012, when the opponent states that they entered into a licence agreement for the production of a documentary regarding the Marquee Club and merchandise products bearing that name.[26] Mr Lowry has provided part of an agreement to support this contention, although interestingly any pages which would ordinarily state the party names have

[26] See paragraph 33 of the Mr Lowry's first witness statement.

been omitted.[27] Mr Keeble has also supplied a copy of an agreement from 2012, between The Marquee Club (it is not clear whether this is the opponent or not) and the applicant's company, Robana Picture Limited.[28] This discusses the production of a documentary and so is consistent with the parties' positions on this point. However, even proceeding on the basis that there was an agreement between the parties, it does nothing more than confirm that in 2012, the applicant and the opponent entered into a licence agreement regarding the production of a documentary about a famous club. Even if this could be taken as evidence that the opponent had goodwill in the name at that time, and in respect of which it was granting a licence to the applicant, it does not reflect the position at the relevant date (which was some 10 years later). As I have already found, the opponent did not, in fact, benefit from goodwill at the relevant date, even if it did so in 2012.

88. At some point since 2012, the applicant has commenced his own business under the MARQUEE sign. This is a fact that does not appear to be disputed by the opponent.[29] The result of my findings in this decision is that, by the relevant date, the opponent no longer benefitted from residual goodwill that it had previously enjoyed due to inactivity and the applicant either continued to trade himself at that time under the sign or had previously traded under the sign, even if he had himself ceased to do so by then. Against this backdrop, I am not satisfied that the opponent has established a prima facie case of bad faith. An allegation of bad faith is one that must be distinctly proved; it is not sufficient to establish facts which are as consistent with good faith as bad faith. In any event, the only services which have survived the 5(1) and 5(2) opposition are legal services which are entirely unrelated to the services of an entertainment venue. I can see no reason to find bad faith in applying for services which are unrelated to those for which the opponent may have previously benefitted from goodwill.

89. The opposition based upon section 3(6) of the Act is dismissed.

[27] Exhibit NNL9
[28] Exhibit MK1
[29] See paragraph 11 of Mr Lowry's second witness statement.

CONCLUSION

90. The opposition is successful in relation to the following goods for which, subject to appeal, the application is refused:

Class 9 Musical recordings; Musical sound recordings; Recorded media; Digital recording media; Digital data recording media; Electronic publications recorded on computer media; Optical recording media; Magnetic data recording media; Optical data recording media; Blank digital recording media; Recorded video tapes; Electronic databases recorded on computer media; Recorded tapes; Electronic magnetic recording media; Recorded content; Data recorded electronically from the internet; Recorded film; Data recorded electronically; Downloadable media; Recorded films; Photographic media [films, exposed]; Recorded tape cassettes; Media streaming software; Covers for digital media players; Digital media streaming devices; Digital storage media; Multi-media recordings; Books recorded on tape; Tape recordings of music; Pre-recorded video tapes featuring music; Digital video recorders; Musical video recordings; Prerecorded digital audio tapes; Audiovisual recordings; Computer software for the display of digital media; Computer games programs recorded on tapes [software]; Computer software platforms, recorded or downloadable; Downloadable educational media; Digital audio tape recorders; Pre-recorded video tapes;Pre recorded computer software.

Class 25 Clothing; Ready-to-wear clothing; Headbands for clothing; Clothes; Hoods [clothing]; Wristbands [clothing]; Belts [clothing]; Waterproof clothing; Leisure clothing; Ties [clothing]; Tops [clothing]; Dance clothing.

91. The opposition is unsuccessful in relation to the following services for which, subject to appeal, the application may proceed to registration:

Class 45 Legal advice; Legal services; Legal research; Legal advice and representation; Legal advocacy services; Patent licensing [legal services]; Provision of legal research; Certification of legal documents; Mediation in legal procedures; Legal mediation services; Mediation [legal services]; Legal research services; Legal consultation services; Licensing of intellectual property [legal services]; Personal legal affairs consultancy; Legal services relating to copyright licensing; Provision of expert legal opinions; Legal consultancy services; Legal support services; Legal services relating to wills; Provision of legal information; Professional legal consultations relating to franchising; Legal advice relating to franchising; Monitoring intellectual property rights for legal advisory purposes; Legal and judicial research services in the field of intellectual property; Legal services relating to business; Licensing of trademarks [legal services]; Legal consultancy relating to intellectual property rights; Licensing of software [legal services]; Software licensing [legal services]; Expert consultancy relating to legal issues; Legal services relating to the exploitation of intellectual property rights; Alternative dispute resolution services [legal services]; Legal services relating to the exploitation of copyright and industrial property rights; Legal services relating to the management and exploitation of copyright and ancillary copyright; Legal services relating to the acquisition of intellectual property; Granting of software licenses [legal services]; Legal services relating to the registration of trademarks; Information services relating to legal matters; Legal services relating to the exploitation of transmission rights; Computer software (Licensing of -) [legal services]; Computer software licensing [legal services]; Licensing of computer software [legal services]; Legal services relating to the negotiation and drafting of contracts relating to intellectual property rights; Information, advisory and consultancy services relating to legal matters; Legal services relating to the exploitation of film copyright; Granting of software licences [legal services]; Domain names (Registration of -) [legal services]; Registration of domain names [legal services]; Legal services relating to the management, control and granting of licence rights; Legal services in relation to the negotiation of contracts for others; Providing

information relating to legal affairs; Provision of information relating to legal services; Copyright (Professional advisory services relating to infringement of -); Litigation advice; Copyright (Professional advisory services relating to licensing of -); Professional advisory services relating to intellectual property rights; Copyright (Professional advisory services relating to -); Advisory services relating to intellectual property licensing; Enforcement of intellectual property rights; Licensing of intellectual property rights.

COSTS

92. As the parties have both enjoyed a degree of success, I direct that each party bears their own costs.

Dated this 13th day of May 2026

S WILSON
For the Registrar

ANNEX 1

Class 9

Musical recordings; Musical sound recordings; Recorded media; Digital recording media; Digital data recording media; Electronic publications recorded on computer media; Optical recording media; Magnetic data recording media; Optical data recording media; Blank digital recording media; Recorded video tapes; Electronic databases recorded on computer media; Recorded tapes; Electronic magnetic recording media; Recorded content; Data recorded electronically from the internet; Recorded film; Data recorded electronically; Downloadable media; Recorded films; Photographic media [films, exposed]; Recorded tape cassettes; Media streaming software; Covers for digital media players; Digital media streaming devices; Digital storage media; Multi-media recordings; Books recorded on tape; Tape recordings of music; Pre-recorded video tapes featuring music; Digital video recorders; Musical video recordings; Prerecorded digital audio tapes; Audiovisual recordings; Computer software for the display of digital media; Computer games programs recorded on tapes [software]; Computer software platforms, recorded or downloadable; Downloadable educational media; Digital audio tape recorders; Pre-recorded video tapes;Pre recorded computer software.

Class 25

Clothing; Ready-to-wear clothing; Headbands for clothing; Clothes; Hoods [clothing]; Wristbands [clothing]; Belts [clothing]; Waterproof clothing; Leisure clothing; Ties [clothing]; Tops [clothing]; Dance clothing.

Class 45

Legal advice; Legal services; Legal research; Legal advice and representation; Legal advocacy services; Patent licensing [legal services]; Provision of legal research; Certification of legal documents; Mediation in legal procedures; Legal mediation services; Mediation [legal services]; Legal research services; Legal consultation services; Licensing of intellectual property [legal services]; Personal legal affairs consultancy; Legal services relating to copyright licensing; Provision of expert legal opinions; Legal consultancy services; Legal support services; Legal services relating to wills; Provision of legal information; Professional legal consultations relating to

franchising; Legal advice relating to franchising; Monitoring intellectual property rights for legal advisory purposes; Legal and judicial research services in the field of intellectual property; Legal services relating to business; Licensing of trademarks [legal services]; Legal consultancy relating to intellectual property rights; Licensing of software [legal services]; Software licensing [legal services]; Expert consultancy relating to legal issues; Legal services relating to the exploitation of intellectual property rights; Alternative dispute resolution services [legal services]; Legal services relating to the exploitation of copyright and industrial property rights; Legal services relating to the management and exploitation of copyright and ancillary copyright; Legal services relating to the acquisition of intellectual property; Granting of software licenses [legal services]; Legal services relating to the registration of trademarks; Information services relating to legal matters; Legal services relating to the exploitation of transmission rights; Computer software (Licensing of -) [legal services]; Computer software licensing [legal services]; Licensing of computer software [legal services]; Legal services relating to the negotiation and drafting of contracts relating to intellectual property rights; Information, advisory and consultancy services relating to legal matters; Legal services relating to the exploitation of film copyright; Granting of software licences [legal services]; Domain names (Registration of -) [legal services]; Registration of domain names [legal services]; Legal services relating to the management, control and granting of licence rights; Legal services in relation to the negotiation of contracts for others; Providing information relating to legal affairs; Provision of information relating to legal services; Copyright (Professional advisory services relating to infringement of -); Litigation advice; Copyright (Professional advisory services relating to licensing of -); Professional advisory services relating to intellectual property rights; Copyright (Professional advisory services relating to -); Advisory services relating to intellectual property licensing; Enforcement of intellectual property rights; Licensing of intellectual property rights.

ANNEX 2

Class 9

Apparatus for recording, transmission or reproduction of sound and/or images; compact discs, DVDs and other digital recording media; magnetic data carriers; magnetic and/or smart cards; scanners; readers for magnetic data carriers, cameras; records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound, video, data or digital recordings; computer hardware and software; computer software supplied over the Internet; music, images, recordings and publications (downloadable) provided on-line from databases or the Internet; sound recordings in the form of phonograph records, discs and tapes; video recordings in the form of discs and tapes; discs and tapes, all for recording sound and/or vision; cassettes and cartridges all for use with or containing video and sound recordings; cinematographic films; sunglasses; eyewear; eyeglass cases, chains and cords; audio and video recordings; eBooks; binoculars; computer accessories; radios; portable music players; headphones; telephones; batteries.

Class 14

Jewellery, imitation jewellery; chronometric and horological instruments; watches; cases for watches; clocks; key rings and key chains; cufflinks; tie pins; medallions; ornaments [jewellery]; badges of precious metals; key fobs; parts and fittings for the aforesaid goods.

Class 16

Paper and cardboard; printed matter; printed publications; books, novels, booklets, magazines, pamphlets; souvenir event programs; tickets; laminated tickets and VIP tickets; photographs; instructional and teaching material (except apparatus); artists' materials; stationery, writing materials, writing paper, envelopes, notebooks, postcards, diaries, note cards; greeting cards, trading cards; posters; pictures; book covers; book marks, book ends, calendars, diaries, gift wrapping paper, paperweights; paper party decorations, including paper napkins, paper doilies, paper place mats, crepe paper, invitations, paper table cloths; printed patterns; paper patterns; photographic or art mounts; prints; engravings.

Class 18

Articles made of leather or of imitation leather, namely attaché cases and brief cases; rucksacks; backpacks; bags, cases; wallets; purses; coin purse; business card cases; card wallets; carryalls; key holders; luggage; umbrellas and parasols; sports bags and holdalls; parts, fittings and accessories for all the aforesaid goods.

Class 25

Clothing, footwear, headgear.

Class 35

Advertising; business management; business administration; business analysis, research and information services; retail services, on-line retail services and electronic shopping services all in connection with apparatus for recording, transmission or reproduction of sound and/or images, compact discs, DVDs and other digital recording media, magnetic data carriers, magnetic and/or smart cards, scanners, readers for magnetic data carriers, cameras, records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound, video, data or digital recordings, computer hardware and software, sunglasses, eyewear, eyeglass cases, chains and cords, audio and video recordings, eBooks, binoculars, computer accessories, radios, portable music players, headphones, telephones, batteries, printed publications, books, novels, booklets, magazines, pamphlets, souvenir event programs, tickets, laminated tickets and VIP tickets, photographs, stationery, writing materials, writing paper, envelopes, notebooks, postcards, diaries, note cards, greeting cards, trading cards, posters, pictures, book covers, book marks, book ends, calendars, diaries, gift wrapping paper, paperweights, paper party decorations, photographic or art mounts, prints, engravings, jewellery, imitation jewellery, watches, cases for watches, clocks, key rings and key chains, cufflinks, tie pins, medallions, ornament badges of precious metals, rucksacks, backpacks, bags, cases, wallets, purses, business card cases, card wallets, carryalls, key holders, key fobs, luggage, umbrellas and parasols, badges, sport bags and holdalls, clothing, footwear, headgear; information, consultancy and advisory services in relation to all the aforesaid services.

Class 38

Telecommunication services; electronic messaging services; provision of wireless internet access services; video, audio and television streaming services; telecommunication services, namely, electronic transmission of streamed and downloadable audio, video, photograph and game files via computer and electronic communications networks; providing on-line facilities, via a global computer network and other computer and electronic communication networks, to enable users to access multimedia content; instant messaging services; providing on-line chat rooms and bulletin boards for the transmission of messages among computer users; provision of information, consultancy and advisory services in relation to all the aforesaid services.

Class 41

Production, presentation, distribution, and/or syndication of television and radio programmes and/or films and sound video recordings; publishing and providing printed publications and electronic publications; providing online electronic publications; information, consultancy and advisory services in relation to all of the aforesaid services.

ANNEX 3

Goods

Apparatus for recording, transmission or reproduction of sound and/or images; compact discs, DVDs and other digital recording media; magnetic data carriers; magnetic and/or smart cards; scanners; readers for magnetic data carriers, cameras; records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound, video, data or digital recordings; computer hardware and software; computer software supplied over the Internet; music, images, recordings and publications (downloadable) provided on-line from databases or the Internet; sound recordings in the form of phonograph records, discs and tapes; video recordings in the form of discs and tapes; discs and tapes, all for recording sound and/or vision; cassettes and cartridges all for use with or containing video and sound recordings; cinematographic films; sunglasses; eyewear; eyeglass cases, chains and cords; audio and video recordings; eBooks; binoculars; computer accessories; radios; portable music players; headphones; telephones; batteries; musical recordings; musical sound recordings; recorded media; digital recording media; electronic publications recorded on computer media; recorded video tapes.

Jewellery, imitation jewellery; chronometric and horological instruments; watches; cases for watches; clocks; key rings and key chains; cufflinks; tie pins; medallions; ornaments [jewellery]; badges of precious metals; key fobs.

Printed matter; printed publications; books, novels, booklets, magazines, pamphlets; souvenir event programs; tickets; laminated tickets and VIP tickets; photographs; instructional and teaching material (except apparatus); artists' materials; stationery, writing materials, writing paper, envelopes, notebooks, postcards, diaries, note cards; greeting cards, trading cars; posters; pictures; book covers; book marks, book ends, calendars, diaries, gift wrapping paper, paperweights; photographic or art mounts; prints.

Rucksacks; backpacks; bags, cases; wallets; purses; coin purses; business card cases; card wallets; carryalls; key holders; luggage; umbrellas and parasols; sports bags and holdalls.

Clothing, footwear, headgear; headband wristbands; tops.

Services

Advertising; business management; retail services, on-line retail services and electronic shopping services all in connection with apparatus for recording, transmission or reproduction of sound and/or images, compact discs, DVDs and other digital recording media, magnetic data carriers, magnetic and/or smart cards, scanners, readers for magnetic data carriers, cameras, records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound, video, data or digital recordings, computer hardware and software, sunglasses, eyewear, eyeglass cases, chains and cords, audio and video recordings, eBooks, binoculars, computer accessories, radios, portable music players, headphones, telephones, batteries, printed publications, books, novels, booklets, magazines, pamphlets, souvenir event programs, tickets, laminated tickets and VIP tickets, photographs, stationery, writing materials, writing paper, envelopes, notebooks, postcards, diaries, note cards, greeting cards, trading cards, posters, pictures, book covers, book marks, book ends, calendars, diaries, gift wrapping paper, paperweights, paper party decorations, photographic or art mounts, prints, engravings, jewellery, imitation jewellery, watches, cases for watches, clocks, key rings and key chains, cufflinks, tie pins, medallions, ornament badges of precious metals, rucksacks, backpacks, bags, cases, wallets, purses, business card cases, card wallets, carryalls, key holders, key fobs, luggage, umbrellas and parasols, badges, sport bags, holdalls, clothing, footwear, headgear.

Production, presentation, distribution and/or syndication of television and radio programs and/or films and sound video recordings; publishing and providing printed publications and electronic publications; providing online electronic publications; musical performances; production of musical recordings; music recording; audio, film, video and television recording services; provision of entertainment services through the media of audio tapes; provision of online information relating to audio and visual

media; publication of texts in the form of electronic media; entertainment services for sharing audio and video recordings; services for the showing of video recordings; business management of entertainment events and presentations.

Promoting live entertainment events for others; promoting ticket sales for live entertainments events for others; advertising and marketing services namely, placement and dissemination of advertising, and developing marketing campaigns for others; entertainment ticket agency services; entertainment in the nature of live music concerts, disc jockey concerts, music festivals, dance parties and night clubs; organizing and producing live entertainment events in the nature of live music concerts, disc jockey concerts, music festivals, dance parties and nightclubs; music promoter services; booking of performing artists for events (services of a promoter); event management of entertainment events and presentations; provision of entertainment facilities; production of live entertainment events; providing a website featuring music and entertainment.

Management of Intellectual Property; Licensing of intellectual property; copyright licensing; licensing of trademarks; legal services relating to the management and exploitation of copyright and ancillary copyright; negotiation and drafting of contracts relating to intellectual property rights; legal services relating to the exploitation of film copyright; legal services relating to the management, control and granting of licence rights; advisory services relating to intellectual property licensing.