O/0644/23

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3554542
IN THE NAME OF PIZZA TEXAS BULLS INC
FOR THE TRADE MARK:


IN CLASSES 30, 39 & 43

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 504125
BY NBA PROPERTIES, INC.

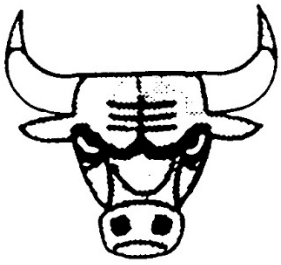
## Background and pleadings

1. PIZZA TEXAS BULLS INC ("the proprietor") is the registered proprietor of the trade mark shown on the cover page of this decision, under registration number 3554542 ("the contested mark"). The contested mark was filed on 11 November 2020 and became registered on 2 April 2021. It stands registered in respect of the following goods and services:

> Class 30: Pizzas and pizza products namely, pizza crusts, pizza pies, pizza mixes, pizza flour, pizza dough, pizza sauces, prepared pizza meals, preparations for making pizza bases and pasta for incorporating into pizzas; sauces and spicy sauces.
>
> Class 39: Pizza delivery services; delivery of food and drinks by restaurants.
>
> Class 43: Restaurant services; restaurant services featuring in-restaurant dining and carryout services; catering services; cafes; services of preparation of takeaway.

2. On 10 September 2021, NBA Properties, Inc. ("the applicant") made an application for a declaration of invalidity in respect of the contested mark pursuant to section 47 of the Trade Marks Act 1994 ("the Act"). The application is based upon sections 5(2)(b), 5(3), 5(4)(a) and 5(4)(b) of the Act.

3. For the purposes of its claim under section 5(2)(b), the applicant relies upon the following trade marks:

| UK registration no. 914103824 | UK registration no. 900189878 |
|---|---|
|  |  |
| Filing date: 20 May 2015<br>Registration date: 26 October 2015<br>("the first earlier mark") | Filing date: 1 April 1996<br>Registration date: 11 May 1999<br>("the second earlier mark") |
| **UK registration no. 2031560** | **UK registration no. 2118930** |
|  |  |
| Filing date: 25 August 1995<br>Registration date: 9 August 1996<br>("the third earlier mark") | Filing date: 18 December 1996<br>Registration date: 11 December 1998<br>("the fourth earlier mark") |

4. These earlier marks stand registered in respect of a wide range of goods and services, as set out in the annex to this decision. However, for the purposes of its claim under this ground, the applicant relies upon a limited list of class 41 services. These are outlined at paragraph 33 below. The applicant contends that the contested mark is similar to each of its earlier marks and that the parties' goods and services are similar. On this basis, the applicant submits that there is a likelihood of confusion.

5. As for its claim under section 5(3), the applicant relies upon all four registrations listed above, as well as the following trade marks:

| UK registration no. 912739751 | UK registration no. 917256728 |
|---|---|
|  |  |
| Filing date: 28 March 2014<br>Registration date: 22 August 2014<br>("the fifth earlier mark") | Filing date: 28 September 2017<br>Registration date: 24 January 2018<br>("the sixth earlier mark") |

6. The goods for which these marks are registered are also included in the annex to this decision. The applicant claims that each of its earlier marks have a reputation for all the goods and services for which they are registered. It argues that the similarity between the parties' marks and goods and services would cause the relevant public to mistakenly believe there is an economic connection between them. Moreover, it contends that use of the contested mark would take unfair advantage of the reputation of the earlier marks, since the proprietor would benefit from the applicant's advertising and investment without making the same level of investment. The applicant also submits that if the proprietor's goods and services do not match the quality provided by the applicant and are of lower quality, the reputation and distinctive character of the earlier marks will be damaged.

7. The applicant also claims that the earlier marks relied upon under sections 5(2)(b) and 5(3) are well-known marks within the meaning of Article 6*bis* of the Paris Convention.

8. The applicant's marks qualify as "earlier trade marks" in accordance with section 6 of the Act, as their filing dates are earlier than the filing date of the contested mark.[1]

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM or IREU. As a result of the applicant's EUTM numbers 14103824, 189878, 12739751 and 17256728 being registered as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

All bar the sixth earlier mark had completed their registration processes more than five years before the date of the application for invalidity. As such, they are subject to the use provisions specified within section 47(2B) of the Act. In its application, the applicant made a statement of use in respect of all the goods and services it relies upon. The sixth earlier mark had not completed its registration process more than five years before the date of the application for invalidity. Consequently, the applicant may rely upon all the goods for which it is registered, without having to demonstrate genuine use.

9. Under section 5(4)(a), the applicant claims that it has a protectable goodwill in relation to which it has used the following signs throughout the UK since 1966:


10. All four signs are said to have been used in relation to the following goods and services:

> Restaurant services; provision of food and drink; toys; clothing, footwear, headgear; advertising, marketing and promotional services for sport teams and sporting events; organising and conducting of sporting activities and events; educational services; providing of training; entertainment services; sporting and cultural activities; information services relating to sports events.

11. The applicant argues that the similarity between the signs and the contested mark, as well as the similarity between the parties' goods and services, would give rise to misrepresentation and damage.

12. Turning to its claim under section 5(4)(b), the applicant asserts that it is the owner of the copyright works i) and ii) displayed above at paragraph 9. It claims that it commissioned the creation of the works by Dean Wessel in 1966. Further, that it was

first marketer of the works, being authorised to do so in the USA and UK. The applicant submits that use of the proprietor's mark – which incorporates a close imitation of the works – is liable to cause confusion and is, therefore, objectionable under section 5(4)(b) of the Act.

13. The proprietor filed a counterstatement denying the grounds of invalidation. The proprietor argues that it has legitimate interest in using its company name as a trade mark. Moreover, it asserts that there are many restaurants across the world using imagery of a bull's head to give a commercial impression of meat. The proprietor submits that this was the brief given to its agent when creating the contested mark "from scratch". Furthermore, the proprietor contends that the contested mark is not similar to the earlier marks when compared as wholes. On this basis, as well as the competing marks being "registered for different classes", the proprietor denies that there is a likelihood of confusion. The proprietor also highlights a decision of the EUIPO which rejected an opposition instigated by the applicant on the basis of its 'Chicago Bulls' mark. Within its counterstatement, I note that the proprietor indicated that it did not require the applicant to provide proof of use of its earlier marks.

14. Both parties are professionally represented; the applicant by Stratagem Intellectual Property Management Limited and the proprietor by Beta IP Consulting Limited. Only the applicant filed evidence. Neither party requested a hearing. Neither party filed written submissions in lieu of attendance, though I note that the applicant filed written submissions during the evidence rounds. This decision is taken following careful consideration of all the papers before me.

15. 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 upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

**Preliminary remarks**

16. Within its counterstatement, the proprietor submitted that there are many restaurants across the world using registered trade marks which incorporate a bull's head. However, I must, at this early stage, clarify that the existence of other registered marks will not have any bearing on the outcome of these proceedings; their mere existence is not material to, for instance, whether there exists a likelihood of confusion between the contested mark and the applicant's earlier marks, or the distinctive character of bull's head devices. This is because there is no evidence that the marks are in use and that consumers have become accustomed to differentiating between them.[2]

17. Furthermore, the proprietor highlighted that its name is PIZZA TEXAS BULLS INC. On this basis, it has argued that it has legitimate interest to use this company name as a trade mark. I disagree. The UK register operates on the principle of first-to-file. If grounds exist which could prevent the registration of a later mark, the mere fact that the mark is an entity's company name would not allow it to circumvent those grounds. For example, every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Whether a mark reflects its owner's company name is not relevant to that assessment.

18. In addition, the applicant notified the Registry on 2 May 2023 that the proprietor was no longer actively trading. Even if proved, this development would have no bearing on the grounds of invalidation to be determined; whether the proprietor is trading is not a relevant factor under any of the grounds brought by the applicant. Moreover, this development post-dates the filing date of the contested mark, i.e. after the point in time at which the applicant's claims must be adjudged.

19. Finally, both parties have referred to prior decisions of the EUIPO. Whilst these are noted, it suffices to say that they are not relevant to the present proceedings. It is

[2] *Zero Industry Srl v OHIM*, Case T-400/06, paragraph 73

well-established that previous decisions of the EUIPO are not binding on the Registrar, and I place no weight on them in my assessment of the applicant's claims.

**Evidence and submissions**

20. The applicant's evidence is given in the affidavit of Anil George, and twenty-one accompanying exhibits (AVG1 to AVG21).[3] Mr George is the Vice President & Assistant General Counsel (Intellectual Property) of the applicant. He states that he has been employed by the applicant for over 20 years. The purpose of his statement is to provide details as to the background of the applicant, as well as its use of the marks/signs relied upon in these proceedings.

21. As noted above, the applicant also filed written submissions during the evidence rounds.

22. I have read all the evidence and submissions and will return to them to the extent I consider necessary in the course of this decision.

**Statutory provisions**

23. Sections 5(2)(b), 5(3), 5(4)(a) and 5(4)(b) have application in invalidation proceedings because of the provisions of section 47 of the Act, the relevant parts of which read as follows:

> 47. – (1) […]
>
> (2) The registration of a trade mark may be declared invalid on the ground –

[3] I note that the affidavit has not been dated. Moreover, it does not commence with the necessary statement of oath. These irregularities ought to have been corrected during the course of the proceedings so that the affidavit was compliant with part 32 of the Civil Procedure Rules and supplementary Practice Direction 32. However, for reasons that will become apparent, I do not consider it necessary for the applicant to be required to do so at this stage.

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

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

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."

24. Sections 5(2)(b) and 5A of the Act read as follows:

"5(2) A trade mark shall not be registered if because -

[…]

(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."

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

25. Sections 5(3) and 5(3A) of the Act state:

> "(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 the repute of the earlier trade mark.
>
> (3A) 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."

26. Sections 5(4) and 5(4A) stipulate 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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) (aa) above, in particular by virtue of the law of copyright or the law relating to industrial property rights.
>
> 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."
>
> "(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."

**Section 5(2)(b)**

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

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

**Comparison of goods and services**

28. In *Canon,* the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment that:

> "In assessing the similarity of the goods or services concerned, […] 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".

29. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 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.

30. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the General Court stated that "complementary" means:

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

31. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J (as he then was) stated that:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

32. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold set out the following summary of the correct approach to interpreting broad and/or vague terms:

> “[…] the applicable principles of interpretation are as follows:
>
> (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
>
> (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
>
> (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
>
> (4) A term which cannot be interpreted is to be disregarded.”

33. The goods and services to be compared are as follows:

| Applicant's services | Proprietor's goods and services |
|---|---|
| *The first earlier mark*<br><br>Class 41: Entertainment; sporting and cultural activities.<br><br>*The second earlier mark*<br><br>Class 41: Entertainment services; sporting and cultural activities.<br><br>*The third and fourth earlier marks*<br><br>Class 41: Entertainment services relating to sporting and cultural activities | Class 30: Pizzas and pizza products namely, pizza crusts, pizza pies, pizza mixes, pizza flour, pizza dough, pizza sauces, prepared pizza meals, preparations for making pizza bases and pasta for incorporating into pizzas; sauces and spicy sauces.<br><br>Class 39: Pizza delivery services; delivery of food and drinks by restaurants.<br><br>Class 43: Restaurant services; restaurant services featuring in-restaurant dining and carryout services; catering services; cafes; services of preparation of takeaway. |

34. I note that the proprietor has argued that the goods and services are not similar because they appear in different classes. However, whether goods or services are in the same or different classes is not decisive in determining whether they are similar or dissimilar, as per section 60A of the Act:

> "(1) For the purpose of this Act goods and services-
>
> (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

35. Furthermore, the applicant has provided evidence alongside its written submissions which, it argues, demonstrates that there is a "very strong relationship" between sporting and cultural activities and food and drinks.[4] The applicant contends that it is extremely common for food and beverages, such as pizza, to be sold at sporting events. As this "evidence" was not provided in the proper format (i.e. exhibited to a witness statement or affidavit), I place no weight on it. Even if it was, the documents provided suggest that food and drinks are offered at sporting events and that they may be consumed by viewers whilst in attendance. However, that is not sufficient to conclude that there is any similarity in a trade mark sense; for instance, that they overlap in trade channels or are produced by the same undertakings. They broadly show that the food and drinks are offered by different undertakings than the provider/organiser of the sporting events under different trade marks. Neither do I consider the limited examples provided to be compelling evidence of what is typical in trade in the UK, not least because some relate to the USA or Spain.

Class 30

36. The proprietor's goods in this class broadly comprise foodstuffs, being pizzas and ingredients therefor. The applicant's services comprise entertainment services and sporting/cultural activities. The nature, method of use and intended purpose of the respective goods and services is clearly very different. Given their entirely distinct uses and purposes, there is no competition between them. Although foodstuffs such as pizzas may be sold at entertainment or sporting events, the goods and services are

[4] Annexes 4-7 to the applicant's written submissions

not complementary in the sense outlined in case law; they are not important to one another in such a way that consumers will believe that responsibility for them lies with the same undertaking. Moreover, I do not consider that sufficient to find that the respective goods and services share trade channels; whilst foodstuffs may be served at entertainment events, given the differences in nature, it is unlikely that they would be the responsibility of the same undertakings. I acknowledge that they will share users insofar as they are both purchased by the general public; however, this is at too broad a level to engage similarity overall. In light of all this, I find that the respective goods and services are dissimilar.

Class 39

37. In my view, there is no overlap in nature, method of use or intended purpose between the proprietor's services in this class and those of the earlier marks. The former comprise transportation services which are used to deliver food and drinks to consumers, whereas the latter consist of entertainment, sporting and cultural services which will be sought for enjoyment purposes or to develop, for example, the artistic, intellectual or social development of the public. To my mind, the respective services do not typically reach the market through shared channels of trade; the proprietor's services will be engaged when ordering food from a restaurant or take-away establishment, whereas the applicant's will be obtained directly from entertainment providers or third-party ticket agencies. As the respective services have different uses and purposes, there is no competition between them; a consumer seeking the delivery of food is unlikely to purchase entertainment services instead, or vice versa. The respective services are not important or indispensable to one another in such a way that consumer will believe that the responsibility for them lies with the same undertaking. As such, they are not complementary. Users may overlap to the extent that they may both be purchased by the general public. However, that is not sufficient to engage any meaningful similarity. Overall, I find that the respective services are dissimilar.

Class 43

38. The proprietor's services in this class consist of services for the provision of food, either within a hospitality setting or on a take-away basis. When compared with the applicant's entertainment, sporting and cultural services, it is clear that the respective services have very different natures, methods of use and intended purposes. There is no competition between the respective services. Moreover, they are not complementary in the sense outlined in case law. I acknowledge that it is not uncommon for some venues to provide food and drinks to attendees of sports and entertainment events; to this extent, there may be an overlap in trade channels. I also accept that, on a broad level, the respective services share users, since they may both be purchased by the general public. However, in the context of the aforementioned differences, I do not consider these overlaps to be sufficient to engage any similarity between the respective services overall. Taking all of this into account, I find that they are dissimilar.

39. Some degree of similarity between goods or services is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered.[5] As I have found all the proprietor's goods and services to be dissimilar to the applicant's services, the application for invalidity under this ground must fail.

**Conclusion**

40. The applicant's claim under section 5(2)(b) is dismissed.

**Section 5(3)**

41. 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'Oréal v Bellure,* Case C-323/09, *Marks and Spencer v Interflora* and

[5] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, paragraph 49

Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oréal v Bellure).*

42. The conditions of section 5(3) are cumulative. Firstly, the applicant must show that its earlier marks are similar to the contested mark.[6] Secondly, the applicant must show that the marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the applicant must establish that the public will make a link between the marks, in the sense of the earlier marks being brought to mind by the contested mark. Fourthly, assuming the foregoing conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the applicant will occur. It is not necessary for the purposes of section 5(3) that the goods or services are similar, although the relative distance between them is one of the

[6] For reasons that will become apparent, the applicant has satisfied this first requirement.

factors which must be assessed in deciding whether the public will make a link between the marks.

43. The relevant date for the assessment under this ground is the filing date of the contested registration, that being 11 November 2020.

**Reputation**

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

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

45. As the first, second, fifth and sixth earlier marks are comparable marks, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

> "10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union".

46. Mr George says that the National Basketball Association ("NBA") is the world's premier professional men's basketball league; beginning in 1946, it now consists of 30 member teams located in the USA and Canada.[7] According to Mr George, the NBA and its member teams are well-known to consumers across the world; the league is said to have developed a strong global business through television broadcasting, merchandising and licensing programs, basketball development and community outreach programs, international exhibitions, events, promotions and contests.[8] According to Statista, NBA league revenue rose from $2.66billion in 2001/02 to $4.56billion in 2013/14.[9]

47. Mr George explains that the Chicago Bulls are a professional basketball team based in Chicago, USA.[10] The team joined the NBA in 1966; it has won six NBA titles (between 1991-1993 and 1996-1998) and plays its home matches at the United Centre, which has a capacity of between 20,000-23,000.[11] The team also featured Michael Jordan and other "Hall of Famers".[12] According to Forbes, as of 2019 the Chicago Bulls were one of the top five most valuable NBA teams with an estimated value of $2.9billion.[13] In February 2020, Forbes calculated the Chicago Bulls' team value to be $3.2billion.[14] A graph from Statista shows that the team's value rose from

[7] Affidavit of Anil George, §4
[8] George, §7
[9] Exhibit AVG19
[10] George, §11
[11] George, §11
[12] George, §11
[13] George, §12
[14] Exhibit AVG21

$325million in 2003 to $3.2billion in 2020.[15] Another graph from Statista shows that global revenue rose from $115million in 2001 to $301million in 2019.[16] The bull's head logo is said to have been designed by Dean Wessel and adopted by the team in 1966; since then, it has been in continuous use for over 50 years.[17]

48. The NBA broadcasts its basketball games, including those of the Chicago Bulls, in the UK via major networks, such as BT Sports, ESPN and Sky Sports.[18] Broadcasting schedules from 2009 to 2017 have been provided for each Chicago Bulls game televised in the UK.[19] From these, I note that, for example, in the 2012/13 season, each game had an average reach of 35,000, whereas, in the 2015/16 season, each game had an average audience of 5,000. I also note that the NBA announced a four-year deal with Sky Sports to broadcast its games from the 2018/19 season. The television audiences in 2018/19 and 2019/20 are said to have been over 5million and 6.5million, respectively.[20] Viewers are exposed to the bull's head logo throughout the games on the floor of the court, the television scoreboard, and the big screen:[21]



[15] George, §25
[16] George, §26
[17] George, §12
[18] George, §72; Exhibit AVG15
[19] Exhibit AVG15
[20] George, §73
[21] Geoirge, §§74-75

49. The NBA is said to have generated over $450million from overseas broadcasting rights in 2019.[22] Games were also promoted on the Virgin media website, the Sky Sports NBA Twitter account, and the Sky Sports website on 15 and 16 September 2020; around 1,700 articles mentioned the Chicago Bulls on the latter between 2012 and 2020.[23]

50. Mr George explains that the applicant provides an on-demand digital entertainment platform, 'NBA TV', which is available in the UK.[24] Customers are able to purchase access to all games for an entire season through a 'League Pass' subscription; the UK, the number one market in Europe, is said to have had the fifth-highest number of subscribers worldwide in 2019.[25] Mr George gives the following UK subscriber figures:[26]

| Year | Subscribers |
|---|---|
| 2012 | 6,500 |
| 2013 | 9,500 |
| 2014 | 10,500 |
| 2015 | 11,500 |
| 2016 | 12,500 |
| 2017 | 13,500 |
| 2018 | 14,000 |
| 2019 | 18,000 |
| 2020 | 25,000 |
| Total | 121,000 |

51. According to Mr George, 15 basketball games have been held in the UK.[27] One such game was held at the O2 Arena, London, on 6 October 2009.[28] Over 18,000

[22] George, §77
[23] George, §83-86
[24] George, §88
[25] George, §88
[26] George, §88
[27] George, §92
[28] George, §92

people are said to have been in attendance.[29] Extracts from contemporaneous articles in BBC Sport, ESPN and The Guardian have been provided as examples of press coverage of the event.[30] The bull's head logo can be seen outside the venue in a photograph:[31]


52. Mr George says that, since 1996, the Chicago Bulls and the NBA have used the earlier marks for an extensive list of goods and services in the EU and UK.[32] He adds that the NBA's global merchandising program is extensive; league- and team-branded products are said to be available through its licensees in brick-and-mortar retail outlets as well as online.[33] He says there are thousands of stores across six continents; a photograph of one example, on Carnaby Street, London, is provided:[34]


[29] George, §92
[30] George, §91; Exhibit AVG18
[31] George, §92
[32] George, §23
[33] George, §10
[34] George, §10

53. Mr George says that online retail sales and league royalties for Chicago Bulls team- and player-branded merchandise in Europe were as follows:[35]

| Year | Turnover ($) |
|---|---|
| 2011 | 8,758,393 |
| 2012 | 7,359,714 |
| 2013 | 10,729,225 |
| 2014 | 19,055,774 |
| 2015 | 17,665,657 |
| 2016 | 13,886,866 |
| 2017 | 17,079,881 |
| Total | 94,535,510 |

54. The figure relating to the UK between 2009 and 2014 was $3,317,243.[36] Mr George also provides the following figures, which he says relate to royalty figures for all NBA teams received from authorised licensees:[37]

| Year | EU ($) | UK ($) |
|---|---|---|
| 2011 | 7,605,000 | 310,500 |
| 2012 | 5,543,000 | 588,500 |
| 2013 | 7,375,500 | 1,304,000 |
| 2014 | 15,440,000 | 3,526,500 |
| 2015 | 9,940,500 | 2,159,000 |
| 2016 | 11,659,000 | 3,166,500 |
| 2017 | 12,519,000 | 3,365,000 |
| 2018 | 20,973,500 | 6,352,500 |
| 2019 | 17,372,000 | 4,165,500 |
| 2020 | 24,175,000 | 5,856,500 |
| Total | 132,602,500 | 30,794,500 |

[35] George, §28
[36] George, §28; Exhibit AVG3
[37] George, §29

55. The UK figures are included within those for the EU. Mr George says that the above figures include the Chicago Bulls, but the applicant does not keep sales figures by individual team outside of the USA and Canada.[38] He does state, however, that annual retail sales of Chicago Bulls-branded goods in the EU and UK were as follows:[39]

| Year | Units | Turnover ($) |
|---|---|---|
| 2017 | 32,619 | 204,000 |
| 2018 | 247,669 | 10,986,364 |
| 2019 | 350,642 | 11,444,370 |
| 2020 | 702,574 | 8,774,573 |
| Total | 1,333,504 | 31,409,307 |

56. Furthermore, between October 2009 and December 2016, sales of wholesale merchandise in Europe (including the UK) bearing the earlier marks totalled over $77.5million; this figure relates to brick-and-mortar outlets, the NBA's online EU store, online licensees, the NBA.com store and league royalties.[40]

57. Mr George says that products bearing Chicago Bulls branding have been available through mail order catalogues since the 1980s and via the NBA's online store since 1995; a printout from the same included in the affidavit shows that the store delivers to the EU.[41] Since 2012, the store has been accessible to European (and UK) customers at nbastore.eu/stores/nba/en; as of 19 January 2018, nearly 1,500 different types of official licensed products bearing the Chicago Bulls team name and earlier marks were available to purchase from the same.[42] Printouts from the NBA's global and EU stores, dated 12 June 2015, 14 September 2018 and 14 August 2020, are in evidence.[43] They show a range of different goods bearing the earlier marks offered for sale. The goods include, *inter alia*, various types of clothing, hats, sunglasses,

[38] George, §29
[39] George, §31
[40] George, §30
[41] George, §35
[42] George, §36
[43] Exhibit AVG4

jewellery, swimwear, scarves, bags, watches, shoes, lanyards, keychains, mobile phone and tablet cases, wallets and purses, umbrellas, toys, basketballs, lunch boxes, teddy bears, belts, pillows, towels, computer keyboards and mice, ties, banners, nail art, patches and pins, ornaments, balloons, gloves, gift wrap and tags, spatulas, nightlights, bottle openers and medals.

58. Mr George explains that the NBA's merchandising partners include Nike, Adidas, Fox Sports, New Era, Footlocker, Electronic Arts and Champion; Chicago Bulls merchandise is sold in physical stores, such as Foot Locker, Sports Direct and JD Sports, across the UK through licensing arrangements.[44] Photographs of Foot Locker and Footasylum stores in Havering, London, have been provided as examples.[45] They are dated 25 February 2018 and show hats bearing the earlier marks. Moreover, printouts from a selection of UK webpages (such as Footlocker, ASOS and Sports Direct) from 2018 and 2020 are in evidence.[46] These show hats, joggers, hoodies, shorts, bags and t-shirts bearing the earlier marks for sale in pound sterling. Printouts from a selection of other UK websites (New Era, Mitchell and Ness, Panini and Amazon), dated 16 September 2020, have also been provided.[47] These also show Chicago Bulls-branded clothing and headgear, as well as basketball jerseys, stickers and other memorabilia, for sale. Mr George states that Electronic Arts, the licensee of the videogame NBA Live, has over 450million registered players across the world; since its first release in 1994, there have been 23 games to date, with the most recent being in 2018.[48] NBA games featuring the Chicago Bulls were also created by From the Bench, Saber Interactive and 2k prior to the relevant date.[49]

59. According to Mr George, the applicant has a large, international social media following on platforms such as Instagram, Facebook, Twitter, YouTube, Google+ and Pinterest.[50] Printouts of the Chicago Bulls' accounts on these platforms have been exhibited.[51] From these, I note that, as of 8 December 2020, its Instagram account

[44] George, §§39-40
[45] Exhibit AVG5
[46] Exhibit AVG6
[47] Exhibits AVG7-AVG10
[48] George, §48-49
[49] George, §50-60
[50] George, §61
[51] Exhibit AVG12

had 5.6million followers; its Facebook account has around 18million likes and followers; its Twitter account, which was created in 2008, has 4million followers; on 22 January 2018, its YouTube account, which was created in 2008, had 78,000 subscribers and around 34million views; its Google+ account has 127,000 followers; and, as of 19 January 2018, its Pinterest account had 10,000 followers. According to Statista, as of November 2019, the Chicago Bulls had 26million followers on social media.[52]

60. According to Smart Insights, the NBA was the 8th most followed brand on Instagram in March 2017.[53] Mr George says that fans post Chicago Bulls material on the NBA's pages.[54] Further, as of 10 September 2020, 413,000 people from the UK followed NBA on Facebook; 286,000 people from the UK followed NBA on YouTube; and 738,000 people from the UK follow the NBA Twitter account.[55] The NBA UK Facebook account had 1.6million followers on 15 September 2020 and, on the same date, its UK Twitter account had 91,400 followers.[56] Sample posts from the NBA UK Facebook account, dated between 2012 and 2017, are included in his affidavit. Details as to the number of visits to NBA.com between 2012 and 2017 from Europe have been provided.[57] From the same, I note the number of visits from the UK were as follows:

| Year | Website visits |
|---|---|
| 2012 | 1,842,880 |
| 2013 | 3,850,444 |
| 2014 | 3,935,684 |
| 2015 | 4,834,350 |
| 2016 | 6,059,632 |
| 2017 | 5,322,104 |
| Total | 25,845,094 |

[52] Exhibit AVG13
[53] Exhibit AVG13
[54] George, §63
[55] George, §63
[56] George, §64
[57] Exhibit AVG15

61. For the Chicago Bulls-specific website, Mr George says that there were approximately 213,000 visits from the UK between 2016 and 2020.[58]

62. Mr George states that $3.1million was spent between 2011 and 2021 to promote the NBA's teams' branded goods and services; this was done through the applicant's websites, social media, television, cinema, radio, and online and printed publications.[59] Although they are not broken down by team outside of the USA, the following annual breakdown of expenditure relating to the UK has been provided:[60]

| Year | Expenditure ($) |
|---|---|
| 2011 | 218,525 |
| 2012 | 106,799 |
| 2013 | 769,176 |
| 2014 | 426,213 |
| 2015 | 633,535 |
| 2016 | 166,163 |
| 2017 | 306,069 |
| 2018 | 295,305 |
| 2019 | 221,962 |
| 2020 | 50 |
| Total | 3,143,797 |

63. Mr George says that The Metro – the UK's highest circulation print newspaper as of March 2020, with a circulation of 1.3million – has published articles about the Chicago Bulls over the years; he also provides extracts from several online articles from 2009 to 2020.[61] I note that 225 articles mentioned the team between 2006 and 2021. The team was also mentioned in several other UK publications, such as ESPN, BBC Sport and The Telegraph (2009), The Times (2012) The Daily Star (2013) and The Mail Online (2017).[62]

[58] George, §71
[59] George, §69
[60] George, §70; Exhibit AVG14
[61] George, §96
[62] George, §97

64. According to Mr George, four ‘Live, Learn or Play Spaces’ were created in the UK prior to November 2020; these consist of new or refurbished basketball courts, libraries, playgrounds, homes, fitness facilities and technology rooms.[63] He says that attendees have been exposed to NBA teams’ logos – including those of the Chicago Bulls – on the walls of the facilities.[64] He adds that one youth-orientated program available internationally is ‘Jr. NBA’; this was first introduced in England in 2014 and Scotland in 2017.[65] In the UK, there are 28 under-12/14 leagues, each with 30 teams representing each of the NBA teams.[66] He says that there were over 30,000 participants between 2014 and 2020, all of whom would have been exposed to the Chicago Bulls team name and logos.[67] Extracts from a number of articles about the program are provided, including one from Sky Sports regarding the expansion of English leagues from 13 to 16 in 2019, as well as one from BBC News regarding the launch of the program in Scotland.[68] Moreover, Mr George says that ‘NBA Crossover’ is an interactive fan event which showcases the convergence of NBA and pop culture; there were events in London in October 2016, August 2018 and September 2019.[69] The first is said to have had over 3,000 attendees in its first three days.[70] Chicago Bulls jerseys are visible in photographs and articles about the exhibitions in London.

65. Mr George says that Chicago Bulls has become a famous household name throughout the world, in part, due to the accomplishments of Michael Jordan; Mr Jordan won many accolades and, between 1980 and 1998, generated more than $10billion in revenue.[71] A documentary series called ‘The Last Dance’ was created by ESPN Films and Netflix, which follows Mr Jordan’s career in the Chicago Bulls team; it was released on Netflix’s UK platform on 20 March 2020.[72] The bull’s head logo is visible in printouts of the series’ synopsis and still images from the first episode. Extracts of articles from The Guardian, BBC Sport and The Mirror (May 2020)

[63] George, §98
[64] George, §98
[65] George, §99
[66] George, §99
[67] George, §99
[68] George, §99
[69] George, §108
[70] George, §108
[71] George, §§101-106
[72] George, §§101-106

regarding the launch of the series are included in Mr George's affidavit; one says the series had 23.8million viewers outside the USA in the first four weeks, whilst others refer to it as "widely acclaimed" and the "world's most popular documentary".

66. An online international research study was undertaken in July 2014.[73] It covered 18 different markets and had around 20,000 participants; of those, 1,000 were from the UK (aged 12-64). The NBA was the fourth most popular sports property worldwide, with 1.7million 'fans', and its events were two of the top seven sporting events. The Chicago Bulls was the participants' second favourite team. I note that basketball was second (to football) in the world's most popular sports. I also note extracts from a book entitled 'The $100 Billion Allowance' by Elissa Moses (2000).[74] It was based upon studies which covered the UK, amongst other territories. It states that the Chicago Bulls was the tenth most recognised brand by teens.

67. The NBA has operated a highly successful basketball competition in the USA and Canada for several decades. That is clear from the significant league revenue which was generated for around 20 years prior to the relevant date, as well as the value of the broadcasting rights for its games. The earlier marks have been used in connection with one of its teams for several decades. The Chicago Bulls had a period of sustained success in the 1990s and are one of the NBA's most valuable teams; the team was valued by third parties at over $3billion in the year of the relevant date and it generated a global revenue of over $300million the previous year. Although the team is based in the USA, the evidence shows that its games are broadcast in the UK via major networks. Average audience/reach figures between 2009 and 2017 were in the thousands to tens-of-thousands, whereas its overall television audiences in 2018/19 and 2019/20 were in the millions. Viewers of the games would have undoubtedly been exposed to the earlier marks. The games were also available to view in the UK through the applicant's on-demand platform, which had 121,000 'League Pass' subscribers between 2012 and 2020. Basketball games involving the team have been held in the UK, with one in London in 2009 being attended by 18,000 people. Again, the evidence shows that attendees would have been exposed to the earlier marks. The applicant

[73] Exhibit AVG19
[74] Exhibit AVG20

had a significant social media presence prior to the relevant date; its UK-facing accounts on a variety of platforms had substantial numbers of followers/views/likes prior to the relevant date. I also note that the Chicago Bulls-specific website had over 200,000 visits from the UK between 2016 and 2020. The team featured regularly and consistently in major UK news outlets for many years prior to the relevant date. The applicant spent around $3million between 2011 and the relevant date to promote the NBA's teams in the UK. I note that no breakdown has been provided, so it is not possible to ascertain the specific figures which relate to the earlier marks. Although I accept that an equal proportion of the overall figures would likely be a fairly small amount of expenditure (particularly considering the figures are said to relate to the NBA's teams' branded goods, as well as their services), they are at least consistent with there being some marketing efforts in this territory. Individuals in the UK may have also been exposed to the earlier marks prior to the relevant date through the applicant's 'Live, Learn or Play Spaces', 'Jr. NBA' youth program or 'NBA Crossover' exhibitions. Moreover, a documentary regarding one of the team's most successful and well-known players was released in the UK prior to the relevant date and received positively. Viewers of the documentary (albeit I have no viewership figures for the UK) would have been exposed to the earlier marks throughout the series. On the balance of the evidence as a whole, I am satisfied that the applicant has demonstrated that the first, second, third and fourth earlier marks had a moderate reputation in the UK in relation to *'entertainment in the nature of basketball games; sporting activities in the nature of running a basketball team'* at the relevant date.

68. I do not consider the evidence sufficient to establish a qualifying reputation in respect of any of the other goods and services of those earlier marks, nor any of the goods of the fifth and sixth earlier marks. Firstly, there is insufficient evidence of the applicant providing any sporting, entertainment or cultural services under the first, second, third or fourth earlier marks other than basketball events. Although the applicant's 'Live, learn or Play Spaces' and 'NBA Crossover' activities in the UK could fall into these categories, I do not consider creating four facilities or hosting three exhibitions sufficient *per se* to support a finding that the earlier marks were well-known by the relevant public for those services, not least because these activities related to all the NBA teams (not just the Chicago Bulls) and no further evidence relevant to the activities has been provided (such as, for example, turnover information). The 'Jr. NBA'

youth program might, admittedly, qualify as a sporting activity. However, the numbers of participants prior to the relevant date were relatively small and, again, no further information has been provided which would enable me to conclude that the earlier marks were well-known for these services. Secondly, I accept that a wide variety of goods branded with the earlier marks are offered for sale in the UK. Moreover, the turnover the applicant generated in connection with royalties and the retail sale/wholesale of these goods in the UK and Europe prior to the relevant date was not insignificant. In addition, the applicant's merchandising partners include some major UK retailers. However, Mr George has included an extremely broad range of goods within his affidavit and also says that, as of 19 January 2018, nearly 1,500 different types of branded products were available to purchase. Further, the printouts from the applicant's (and third-party) websites are consistent with this; many different types of goods are visible. No breakdown as to the revenue generated from the applicant's merchandising operations has been provided, nor what proportion of the same can be attributed to particular goods. The evidence does not include, for example, invoices, order confirmations or commercial agreements, for example, that establish which specific goods the turnover has been generated in connection with. Without further information to contextualise the figures, I consider the evidence to be far too vague, i.e. the evidence lacks the requisite specificity to support a finding that the earlier marks had a qualifying reputation at the relevant date in respect of the goods relied upon.

**Link**

69. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take into account all relevant factors. The factors are identified in *Intel* at paragraph 42. I will take these in turn.

The degree of similarity between the conflicting marks

70. The first earlier mark is figurative and comprises a bull's head device, presented in red, black and white. The overall impression is dominated by the device, with the use of colour playing a lesser role. The fourth earlier mark is identical to the first,

absent the use of colour. As it is the only element of the mark, its overall impression is dominated by the device itself.

71. The second and third earlier marks are figurative and comprise the words 'CHICAGO BULLS' and a bull's head device. It is my view that the words and the device dominate the overall impression of the marks in roughly equal measure.

72. The contested mark is figurative and consists of the words 'PIZZA TEXAS BULLS' and a bull's head device. The words are presented in white and the device in red. These elements sit atop a black background. In my view, the words 'TEXAS BULLS' and the bull's head device dominate the overall impression of the mark in roughly equal measure. The use of colour, whilst still contributing, plays a lesser role. Given the word 'PIZZA' will be seen as a descriptive reference to the goods and services, it plays a much lesser role in the overall impression.

*The first earlier mark and the contested mark*

73. Visually, the competing marks are similar to the extent that they both include a bull's head device. Both devices are also presented in red. The competing marks are different in that the contested mark contains the additional words 'PIZZA TEXAS BULLS'. Whilst the common presence of a bull's head device is, as noted above, a point of visual similarity, the respective devices are presented in different styles with different detailing. The contested mark also has a black background which is not replicated in the first earlier mark, though I accept that this plays a lesser role in the overall impression of the former. Overall, I find that there is a low degree of visual similarity between the competing marks.

74. The first earlier mark solely consists of a device, which consumers will make no attempt to articulate.[75] Conversely, the words in the contested mark will be pronounced (in the ordinary way). These words have no counterparts in the first earlier mark, rendering the competing marks aurally dissimilar.

[75] *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T- 424/10

75. Unsurprisingly, the first earlier mark conveys the concept of a red bull. The contested mark also provides this concept due to its device. However, the contested mark also contains the words 'PIZZA TEXAS BULLS'. The word 'PIZZA' will be understood in accordance with its ordinary meaning. Although the word 'PIZZA' plays a reduced role in the overall impression of the mark, it is still a meaning not replicated by the first earlier mark. The words 'TEXAS BULLS' combine, in my view, to convey the concept of bulls from, or in, Texas, USA. The first earlier mark does not share this meaning. Overall, I find that the competing marks are conceptually similar to a medium degree.

*The second and third earlier marks and the contested mark*

76. Visually, the marks coincide in the shared use of a bull's head device. Moreover, the competing marks all contain the word 'BULLS'. They differ in the inclusion of the words 'PIZZA TEXAS' in the contested mark and the word 'CHICAGO' in the earlier marks. In addition, the style of the bull's head devices is different. The contested mark also makes use of colour, though I accept that this element plays a lesser role in its overall impression. Overall, I find that there is a low degree of visual similarity between the competing marks.

77. The words 'CHICAGO BULLS' in the earlier marks will be pronounced in the ordinary way. The same is true of the words 'TEXAS BULLS' in the contested mark. Although the word 'PIZZA' in the contested mark is descriptive, that does not necessarily render it aurally invisible.[76] Due to the size and positioning of the word in the mark, it is my view that consumers will still articulate it. As such, the competing marks are aurally similar in that they share the word 'BULLS' but differ in the remaining verbal elements. In light of this, I find that the competing marks are aurally similar to a medium degree.

78. The competing marks all convey the concepts of a bull's head, as well as bulls from a location in the USA. However, they are clearly different locations. The contested

[76] *The Stockroom (Kent) Ltd V Purity Wellness Group Ltd*, Case BL O/115/22

mark also provides the meaning, albeit descriptive, of the word 'PIZZA'. Overall, I find that the competing marks are conceptually similar to a medium degree.

*The fourth earlier mark and the contested mark*

79. The fourth earlier mark and the contested mark share the same similarities and differences as the first earlier mark. There is an additional difference in that the fourth earlier mark is not presented in red. However, I do not consider that this will have any material impact on the levels of similarity between the competing marks. This is particularly the case given that, as a mark registered in black and white, the fourth earlier mark can be used in any colour (including red). As such, my findings at paragraphs 73 to 75 are equally applicable here.

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

80. I have already found that the applicant's *'entertainment; sporting and cultural activities'* and *'entertainment services relating to sporting and cultural activities'* are dissimilar to the goods and services of the contested mark. I acknowledge that the services for which I have found that the earlier marks enjoy a reputation are different to those considered under that ground (in that they are narrower). However, I still consider the reputed services to be dissimilar to the goods and services of the contested mark for the same reasons as given at paragraphs 36 to 38. I accept that dissimilarity is a relative concept. Nevertheless, the parties' goods and services are provided in entirely distinct industries. The only clear overlap is that food and drinks may be available to purchase at sporting events (such as basketball games).

81. The parties' goods and services are available to the general public; the section of the public interested in attending/viewing basketball games may also be, for example, consumers of pizza. The applicant's services are likely to be purchased at varying degrees of frequency; some may only attend/view basketball games occasionally, whilst others may be regular attendees/viewers. The purchasing process is unlikely to be merely casual, with consumers considering factors such as cost, location, view,

and the teams involved. The proprietor's goods and services may be purchased relatively frequently. Consumers will consider factors such as ingredients and nutritional content (class 30), the range and speed of the delivery service (class 39) and cost, the range of dishes offered, service levels and location (class 43). In my view, the general public is likely to demonstrate a medium level of attention during the purchasing of the parties' goods and services. I accept that this may be slightly higher for the applicant's services, which are likely to attract a greater outlay.

The strength of the earlier mark's reputation

82. I have found that the earlier marks have a moderate reputation in the UK.

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

83. In *Lloyd Schuhfabrik Meyer*, 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *WindsurfingChiemsee*, paragraph 51)."

84. The first and fourth earlier marks are figurative and comprise a bull's head device, the former in colour and the latter in black and white. The image of a bull's head does not have any obvious meaning when considering the reputed services. However, bulls and associated imagery are not particularly unusual. Overall, I find that the first and fourth earlier marks possess a medium level of inherent distinctive character. I should add that I do not consider the use of colour or black and white to have any material impact on the level of distinctiveness.

85. The second and third earlier marks are figurative and comprise the words 'CHICAGO BULLS' and a bull's head device. These elements are (roughly) equally distinctive. As noted above, the image of a bull's head has no obvious meaning in relation to the reputed services. The words 'CHICAGO BULLS' will be understood as meaning bulls from, or in, Chicago. This meaning is not descriptive or allusive of the reputed services. Overall, I find that the second and third earlier marks enjoy a medium level of inherent distinctiveness.

86. I have already assessed the evidence filed by the applicant. For the same reasons as given at paragraph 67, it is my view that the evidence supports a finding that the inherent distinctiveness of the earlier marks has been enhanced through use to between a medium and high level in respect of the reputed services.

Whether there is a likelihood of confusion

87. As outlined above, some degree of similarity between goods or services is necessary to engage the test for likelihood of confusion. Given that I have found the parties' respective goods and services to be dissimilar, I conclude that there would be no confusion. I acknowledge that the provisions of section 5(3) offer additional protection which takes into account the repute and distinctiveness of earlier trade marks. However, in the circumstances, I do not believe that the relevant public would be caused to believe that the user of the contested mark for dissimilar goods is economically connected to the user of the earlier marks.

Conclusions on link

88. I accept that the applicant has demonstrated that the earlier marks enjoy a moderate reputation. I also acknowledge that the earlier marks are factually distinctive to between a medium and high level. Nevertheless, I have found that the parties' goods and services are dissimilar. Although all the competing marks make use of bull's head devices, and the second and third earlier marks also include the word 'BULLS', they are only visually similar to a low degree and conceptually similar to a medium degree. The first and fourth earlier marks share no aural similarity with the contested mark and, although the second and third earlier marks do share some aural similarity with the contested mark, they are only aurally similar to a medium degree. In short, there are relatively low levels of similarity between the competing marks, overall. In this context, I do not consider the reputation of the earlier marks or the level of distinctive character they possess, or a combination of the two, to be sufficient to counteract the differences between the parties' goods and services. This is particularly the case, given that the relevant public will demonstrate at least a medium level of attention during the purchasing process. In light of all the above factors, it is my view that the common occurrence of bull's head devices and the shared word 'BULL' are insufficient to cause the relevant public to make a link between the competing marks. I consider it highly unlikely that the earlier marks would be brought to mind by the contested mark in the context of the proprietor's goods and services. If any link is made, it will be too fleeting to result in any damage arising; given that the parties' goods and services are dissimilar, there is unlikely to be any change in economic behaviour.

**Conclusion**

89. The applicant's claim under section 5(3) is dismissed.

**Article 6*bis* of the Paris Convention**

90. The applicant seeks to rely upon the earlier marks as well-known within the meaning of Article 6*bis* of the Paris Convention and section 56 of the Act. Section 56 of the Act states as follows:

> "56. Protection of well-known trade marks: Article 6bis.
>
> (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well-known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who—
>
> (a) is a national of the United Kingdom or a Convention country, or
>
> (b) is domiciled in, or has a real and effective industrial or commercial establishment in, the United Kingdom or a Convention country,
>
> whether or not that person carries on business, or has any goodwill, in the United Kingdom.
>
> References to the proprietor of such a mark shall be construed accordingly.
>
> (2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well-known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to the well-known trade mark—
>
> (a) in relation to identical or similar goods or services, where the use is likely to cause confusion, or
>
> (b) where the well-known trade mark has a reputation in the United Kingdom and the use of the other trade mark—

(i) is without due cause, and

(ii) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the well-known trade mark.

[…]

(2A) Subsection (2)(b) applies irrespective of whether the goods or services in relation to which the other trade mark is used are identical with, similar to or not similar to those for which the well-known trade mark is entitled to protection."

91. Such well-known marks qualify as earlier marks in proceedings such as these by virtue of section 6(1)(c) of the Act, which reads:

"6. - (1) In this Act an "earlier trade mark" means—

[…]

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well-known trade mark."

92. Having already failed on the basis of its earlier marks as defined in section 6(1)(a) of the Act, the applicant's claim to those marks being well-known within the meaning of Article 6*bis* of the Paris Convention (and, therefore, potentially earlier marks in accordance with section 6(1)(c) of the Act) would not, in my view, impact on my findings under section 5(2)(b) or 5(3). Firstly, under section 56(2)(a) of the Act, the owner of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain the use of a trade mark which is identical or similar to that well-known mark, where the use is likely to cause confusion, only in relation to identical or similar goods or services. As I have found the parties' goods and services to be dissimilar, this line of argument cannot succeed. Secondly, although section 56(2)(b) of the Act does not require that the goods and services are

identical or similar, even if I was to accept that the earlier marks were well-known within the meaning of Article 6*bis*, on the basis of the evidence before me, this could only extend to the services for which I found the marks to have a reputation under 5(3). Given that I have already found that the earlier marks would not be brought to mind by the contested mark when considering those services and the goods and services of the proprietor, it is difficult to envisage how any damage would occur under section 56(2)(b) in the absence of any under section 5(3). For instance, I am not satisfied that any advantage gained (if any) would be unfair, or that there would be any change in economic behaviour.

**Conclusion**

93. The applicant's reliance on Article 6*bis* is dismissed.

**Section 5(4)(a)**

94. 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)."

95. 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 reputation 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**

96. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, Case BL O/410/11, Mr Daniel Alexander QC, 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.'"

97. There has been no claim by the proprietor that the contested mark had been used prior to the earliest claimed use of the applicant's alleged earlier signs or the filing date of the registration at issue. Moreover, no such evidence has been adduced. Therefore, the relevant date for assessing the applicant's claim under section 5(4)(a) is the filing date of the contested mark, that being 11 November 2020.

**Goodwill**

98. The first hurdle for the applicant is to show that it had the necessary goodwill resulting from the trading activity relied on under the signs at the relevant date.

99. I have already found the applicant's evidence sufficient to establish a reputation for marks identical to the four signs listed above. For the same reasons provided at paragraph 67, I am satisfied that the applicant would have accrued a moderate level of goodwill in relation to its business in *'entertainment in the nature of basketball games; sporting activities in the nature of running a basketball team'* prior to the relevant date. I am also satisfied that the signs relied upon were distinctive of that goodwill.

**Misrepresentation and damage**

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

> "There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

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

101. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet LJ made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

> "There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd*. (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego case Falconer J*. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

> '…whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant':

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

> 'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to

> show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

> '…in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

102. I acknowledge that there is no requirement for the parties to be operating in a common field of activity. However, it is still a highly relevant consideration and, as the case law above makes clear, proving a likelihood of confusion and any resulting damage where there is no common field of activity is a heavy burden. The services in which the evidence demonstrates that the applicant's signs have been used are entirely dissimilar to the proprietor's goods and services and there is only a tenuous overlap between the parties' respective fields of activity, at best. Moreover, on the balance of the evidence filed in these proceedings, I do not consider the applicant to be a household name in the UK. It is my view that the level of goodwill in the applicant's business at the relevant date is not sufficient to overcome the distance between the parties' fields of activity. This is particularly the case, given that there are relatively low levels of similarity between the competing marks, overall. It is considered unlikely that members of the public will be deceived into believing the proprietor's goods and services are offered by the undertaking responsible for the applicant's signs, or an economically linked undertaking. There will be no misrepresentation and, therefore, there is no risk of damage. Even if some members of the public are misled due to the similarities between the marks, it is my view that they would be less than substantial in number.

**Conclusion**

103. The applicant's claim under section 5(4)(a) is dismissed.

**Section 5(4)(b)**

104. The applicant's pleaded case is as follows:

> "The well-known mark in question is the CHICAGO BULL and bull head logo mark of the famous CHICAGO BULLS National Basketball Association Team […], used, inter alia, in relation to basketball games, competitions and exhibitions in the US, Canada and Europe. The Applicant claims unregistered common law rights, including copyright, in relation to the mark through use in the US, Canada and Europe since at least 1966 in connection with the Team's games.
>
> The Applicant has sponsorship, advertising and licensing relationships for the NBA Teams' marks for a very wide range of goods and services, including the sale of food and beverages. Such goods and services also include but are not limited to a variety of CHICAGO BULLS branded merchandise including toys, clothing, footwear, headgear; advertising, marketing and promotional services for sport teams and sporting events; organising and conducting of sporting activities and events; educational services; providing of training; entertainment services; sporting and cultural activities; information services relating sports events.
>
> Use of the Proprietor's mark incorporating a close imitation of the Applicant's mark, for such similar goods and services would therefore be liable to cause confusion and is therefore objectionable on such grounds.
>
> Please refer to the attached letter […], specifically paragraphs 3 - 10, for further information provided specifically in relation to the Applicant's claim under section 5(4)(b) […].

The Applicant objects to all of the Proprietor's goods services under these grounds."

105. The relevant parts of the letter referred to above are as follows:

"7. The author of the works […] was Dean P. Wessel, who created the works in 1966.

8. The author was a United States citizen at the time the works were created, and the United States at the time, was and is a party to the Berne Convention. The works therefore qualify for copyright protection under sections 154 and 159 of the Copyright, Designs and Patents Act 1988.

9. The Applicant was the commissioner of the works and the Applicant was incorporated in the United States.

10. The Applicant was the first marketer of the works and the works were first marketed in the United States in 1966. The Applicant was authorised to market the works in the United States and the United Kingdom."

106. The works in question are the logos shown below.


(collectively, "the works")

**Works under the Copyright, Designs and Patents Act 1988**

107. Section 1 of the Copyright, Designs and Patents Act 1988 ("CDPA") provides for copyright to subsist in original artistic works. Section 4 CDPA further provides:

> "4 – Artistic works.
>
> (1) In this Part "artistic work" means –
>
> (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
>
> […]
>
> (2) In this Part –
>
> […]
>
> "graphic work" includes –
>
> (a) any painting, drawing, diagram, map, chart or plan […]"

108. I accept that the works identified by the applicant constitute graphic works and qualify as artistic works under the CDPA.

**Ownership of the works and their creation**

109. The applicant's pleaded case is that Dean Wessel, an American citizen, was commissioned to create the works in 1966. In his narrative evidence, Mr George also says that the works were designed by Dean Wessel and adopted by the Chicago Bulls in 1966. However, there is no evidence to show that Mr Wessel created the works, or that rights in them were transferred to the applicant. For example, no communications between Mr Wessel and the applicant have been provided, nor any documents relevant to the works' creation. There is no correspondence in which Mr Wessel

releases copyright in the works to the applicant. There is no evidence of any agreement entered into by Mr Wessel and the applicant, or any evidence of sums paid in exchange for the creation of the works. Based on the evidence before me, I am not satisfied that the applicant has sufficiently demonstrated that it is the owner of the works. That said, considering the applicant's unchallenged assertion that it commissioned Mr Wessel to create the works, I will proceed on the assumption that this requirement has been satisfied.

**Whether the works meet the criteria for copyright protection**

110. Section 153 of the CDPA states that copyright does not subsist in a work unless certain conditions are met. These are set out in the following sections of the Act and relate to the citizenship or residence of the author at the time the work was created or published, or the place where it was first published.

111. Section 159 of the CDPA states that:

> "(1) Where a country is a party to the Berne Convention or a member of the World Trade Organisation, this Part, so far as it relates to literary, dramatic, musical and artistic works, films and typographical arrangements of published editions –
>
> > (a) applies in relation to a citizen or subject of that country or a person domiciled or resident there as it applies in relation to a person who is a British citizen or is domiciled or resident in the United Kingdom."

112. The applicant's pleaded case states that Mr Wessel was an American citizen at the time of the creation of the works. No evidence has been provided in support of this, such as, for example, personal identification or biographical information. However, I note that Mr Wessel's nationality is not in dispute and, therefore, I will proceed on that basis. The USA is both a party to the Berne Convention and a member of the World Trade Organisation. Whilst the evidence is not without its limitations, I find that the qualification criteria are met.

**Whether use of the contested mark would constitute copyright infringement**

113. Section 17 of the CDPA states that:

> "(1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies shall be construed as follows.
>
> (2) Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form."

114. In *Designers Guild v Russell Williams (Textiles) Ltd (t/a Washington DC)*,[77] Lord Millett set out the approach to assessing whether artistic copyright has been infringed:

> "The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges have been from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are commonplace, unoriginal, or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying.
>
> […]
>
> Once the judge has found that the defendants' design incorporates features taken from the copyright work, the question is whether what has been taken

[77] [2000] 1 WLR 2416, paragraphs 2425 to 2426

constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the copyright work. It does not depend upon its importance to the defendants' work, as I have already pointed out. The pirated part is considered on its own (see *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.* [1964] 1 W.L.R. 273, 293 per Lord Pearce) and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose."

115. Given that the bull's head device is present in both works, and the first work contains additional words (one of which does not appear in the contested mark), I will focus my visual comparison on the second work and the contested mark. If the applicant's claim based upon the second work fails, it follows that it will also fail in respect of the first work.

116. The second work and the contested mark both contain images of a bull's head. They are both presented in red and white, with the black background of the contested mark creating an overlap with the black detailing in the second work. The horns in the second work and the contested mark have a similar shape. However, there are significant stylistic and artistic differences between the two bull's heads. Firstly, the bull's head in the contested mark is all red, with white eyes, and black detailing arising from the use of negative space. It has minimal detailing. The second work, on the other hand, is presented in red and has white horns with red tips. Moreover, it has significantly more facial detail and is presented as one complete image (in contrast to the contested mark's use of negative space); it could reasonably be described as a more conventional representation of a bull's head. The eyes, nose, forehead, brow, and mouth are also very different in style when compared to those of the contested mark. Finally, the contested mark contains the words 'PIZZA TEXAS BULLS', which have no counterparts in the second work. In light of all this, it is my view that the similarities relied upon are not sufficiently close, numerous or extensive to be more likely to be the result of copying than mere coincidence. I find that the applicant has failed to raise a *prima facie* case of copying for the proprietor to answer.

**Conclusion**

117. The applicant's claim under section 5(4)(b) is dismissed.

**Overall outcome**

118. The application for invalidation under sections 5(2)(b), 5(3), 5(4)(a) and 5(4)(b) of the Act, as well as Article 6*bis* of the Paris Convention, has failed. Subject to any appeal against my decision, the contested mark will remain registered in the UK.

**Costs**

119. As the proprietor has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I note that the proprietor filed a counterstatement but did not file any evidence or written submissions during the proceedings. As such, I award the proprietor the sum of **£400** as a contribution towards the cost of considering the applicant's statement and preparing a counterstatement.

120. I order NBA Properties, Inc. to pay PIZZA TEXAS BULLS INC the sum of **£400**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

**Dated this 7th day of July 2023**

**James Hopkins**
**For the Registrar**

**Annex**

**Goods and services of the first earlier mark (914103824)**

Class 9: Audio recordings and video recordings featuring entertainment and information in the field of basketball; audio discs, video discs, computer laser discs, pre-recorded audio and video cassettes, pre-recorded audio and video tapes, pre-recorded compact discs, pre-recorded computer laser discs, all featuring entertainment and information related to basketball; computer accessories, namely flash drives, computer stands, mouse pads, mice, disc cases, computer carry-on cases, computer sleeves, keyboard wrist pads, all related to basketball; computer programs for viewing information, statistics or trivia about basketball; computer software, namely screen savers featuring basketball themes; computer software to access and view computer wallpaper; computer browser software for use in viewing and displaying data on the Internet; computer skins, namely, fitted plastic film for covering and providing a scratch proof barrier for computer devices; computer game software; video game software, video game cartridges; radios, electronic audio speakers, headphones and ear buds, wireless telephones, telephones; cell phone accessories, namely headsets, skins, face plates and cell phone covers; electronics accessories, namely skins, covers and stands for MP3 players, electronic tablets and portable personal digital assistant devices; decorative switch plate covers, video monitors, computer monitors, binoculars; sunglasses; eyeglass frames; eyewear straps and chains; eyeglass and sunglass cases; magnets; disposable cameras; credit cards and pre-paid telephone calling cards magnetically encoded; downloadable video recordings, video stream recordings, and downloadable audio recordings in the field of basketball provided over the Internet; downloadable computer software for viewing databases of information, statistical information, trivia, polling information, and interactive polling in the field of basketball provided over the Internet; downloadable computer game software; downloadable interactive video games and downloadable trivia game software provided over the internet; downloadable computer software for use as screensavers and wallpaper, to access and display computer browsers, for use in viewing data on the Internet, for use in designing plastic film computer skins to protect computer monitors, for use in creating avatars for playing games and for use in remotely manipulating computer cursors over the Internet; downloadable electronic

publications in the nature of magazines, newsletters, coloring books, game schedules all in the field of basketball provided over the Internet; downloadable catalogs provided over the Internet featuring an array of basketball-themed products; downloadable greeting cards provided over the Internet; decorative cloth wind socks.

Class 16: Publications and printed matter; basketball trading cards, trading cards, stickers, decals, commemorative basketball stamps, collectible cardboard trading discs, postcards; memo boards, clipboards; paper coasters, place mats of paper, facial tissues; note cards, memo pads, note pads, scrap books; ball point pens, crayons, felt tip markers, rubber bands, pencils, pen and paper holders, desktop document stands, rubber stamps, drafting rulers; paper banners and flags, 3-ring binders, stationery folders, wirebound notebooks, portfolio notebooks, unmounted and mounted photographs, posters, calendars, bumper stickers, book covers, bookmarks, wrapping paper, children's activity books, children's coloring books; statistical books, guide books, and reference books, all in the field of basketball; magazines in the field of basketball, catalogs in the field of basketball, commemorative game and souvenir programs related to basketball; paper pennants, stationery, stationery-type portfolios, invitation cards, printed certificates, greeting cards, Christmas cards, holiday cards; informational statistical sheets for basketball topics; newsletters, brochures, pamphlets, and game schedules in the field of basketball; bank checks, check book covers, check book holders, comic books; non-magnetic credit cards and telephone calling cards not magnetically encoded; money clips.

Class 18: Athletic bags, shoe bags for travel, overnight bags, backpacks, baby backpacks, knapsacks, duffel bags, tote bags, beach bags, beach tote bags, drawstring pouches, luggage, luggage tags; canes, umbrellas, patio umbrellas, beach umbrellas, golf umbrellas; valises, attaché cases, billfolds, wallets, briefcases, business card cases, book bags, all-purpose sports bags, gym bags, purses, coin purses, fanny packs, waist packs; cosmetic cases sold empty, garment bags for travel, handbags, key cases, leather key chains, suitcases, toiletry cases sold empty, trunks for traveling and rucksacks; foot lockers; pet clothing, pet leashes, and pet collars.

Class 25: Clothing, footwear, headgear; basketball shoes, basketball sneakers, slippers; T-shirts, shirts, polo shirts, sweatshirts, sweatpants, pants, hosiery, tank tops,

jerseys, shorts, pajamas, sport shirts, rugby shirts, sweaters, belts, ties, nightshirts, warm-up suits, warm-up pants, warm-up tops/shooting shirts, jackets, wind resistant jackets, parkas, coats; baby bibs not of paper, wrist bands (clothing), aprons, undergarments, boxer shorts, slacks; ear muffs, gloves, mittens, scarves, woven and knit shirts, jersey dresses, dresses, cheerleading dresses and uniforms; swim wear, bathing suits, swimsuits, bikinis, tankinis, swim trunks, bathing trunks, board shorts, wet suits, beach cover-ups, bathing suit cover-ups, bathing suit wraps; sandals, beach sandals; hats, caps, visors, head bands, beach hats, sun visors, swim caps, bathing caps, novelty headwear with attached wigs.

Class 28: Toys, games and sporting goods; basketballs, golf balls, playground balls, sports balls, rubber action balls and foam action balls, plush balls for games, plastic balls for games; basketball nets, basketball backboards, miniature basketball backboards, pumps for inflating basketballs and needles therefor; golf clubs, golf bags, golf putters, golf accessories, divot repair tools, tees, ball markers, golf bag covers, club head covers, golf gloves, golf ball sleeves, golf putting greens; billiard cue racks, billiard balls, billiard ball racks; dart board cabinets; electronic basketball table top games, basketball table top games, basketball board games, action skill games, adult's and children's party games, trivia information games and electronic video arcade game machines; basketball kit comprised of a net and whistle; dolls, decorative dolls, collectible dolls, toy action figures, bobblehead action figures, stuffed toys, plush toys; jigsaw puzzles, toy building blocks; Christmas tree ornaments and Christmas stockings; toy vehicles in the nature of cars, trucks, trains and vans, all containing basketball themes; novelty foam toys in the shapes of fingers and trophies, toy trophies; playing cards, card games; toy noisemakers, pet toys; beach toys, beach balls, inflatable balls, toy pails, toy shovels, sand toys, sand box toys, water-squirting toys; pool accessories, swim floats, pool floats, toy water rafts, foam floats, swim rings, pool rings, foam rings, body boards, surf boards, swim fins, surf fins, arm floats and water wing swim aids, all for recreational use; volleyball game kits comprised of ball, net, sidelines and whistle, and water polo game kits comprised of ball, net and whistle; miniature stadium reproductions, small toy plastic models of a stadium; snow globes; video game machines for use with television and video game hand held controllers for use with console video gaming systems.

Class 35: Retail store services, computerized on-line retail store services, online ordering services, electronic retail store services via computer, and electronic mail order catalog services, all featuring an array of basketball-themed merchandise; promoting the goods and services of others by arranging for sponsors to affiliate these goods and services with a basketball program; promoting the sale of goods and services of others through the distribution of promotional contests provided over the internet; conducting public opinion poll surveys and public opinion poll surveys in the field of basketball for non-business, non-marketing purposes over the internet.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; entertainment and educational services in the nature of ongoing television and radio programs in the field of basketball and rendering live basketball games and basketball exhibitions; the production and distribution of radio and television shows featuring basketball games, basketball events and programs in the field of basketball; conducting and arranging basketball clinics and camps, coaches clinics and camps, dance team clinics and camps and basketball games; entertainment services in the nature of personal appearances by a costumed mascot or dance team at basketball games and exhibitions, clinics, camps, promotions, and other basketball-related events, special events and parties; fan club services; entertainment services, namely providing a website featuring multimedia material in the nature of television highlights, interactive television highlights, video recordings, video stream recordings, interactive video highlight selections, radio programs, radio highlights, and audio recordings in the field of basketball; providing news and information in the nature of statistics and trivia in the field of basketball; on-line non-downloadable games, computer games, video games, interactive video games, action skill games, arcade games, adults' and children's party games, board games, puzzles, and trivia games; electronic publishing services, publication of magazines, guides, newsletters, coloring books, and game schedules of others on-line through the Internet, all in the field of basketball; providing an online computer database in the field of basketball.

**Goods and services of the second earlier mark (900189878)**

Class 9: Pre-recorded audio and video tapes, cassettes and compact discs; magnetic and optical carriers provided with prerecorded sound, images, graphics, text, data,

programs and information; computer software and programs; video game software; parts and fittings for all the aforesaid goods; all relating to or for use in connection with or for the promotion of the sport of basketball.

Class 25: Clothing, footwear, headgear; articles of clothing for sports and leisure wear; parts and fittings for all the aforesaid goods.

Class 41: Educational services; providing of training; entertainment services; sporting and cultural activities; information services relating to the aforesaid.

**Services of the third earlier mark (2031560)**

Class 41: Education, training and entertainment services, all relating to sporting and cultural activities.

**Goods and services of the fourth earlier mark (2118930)**

Class 25: Clothing, footwear, headgear; articles of clothing for sports and leisure wear; parts and fittings for all the aforesaid goods.

Class 41: Education, training and entertainment services; all relating to sporting and cultural activities.

**Goods of the fifth earlier mark (912739751)**

Class 9: Audio recordings and video recordings featuring entertainment and information in the field of basketball; audio discs, video discs, computer laser discs, pre-recorded audio and video cassettes, pre-recorded audio and video tapes, pre-recorded compact discs, pre-recorded computer laser discs, all featuring entertainment and information related to basketball; computer accessories, namely flash drives, computer stands, mouse pads, mice, disc cases, computer carry-on cases, computer sleeves, keyboard wrist pads, all related to basketball; computer programs for viewing information, statistics or trivia about basketball; computer software, namely screen savers featuring basketball themes; computer software to

access and view computer wallpaper; computer browser software for use in viewing and displaying data on the Internet; computer skins, namely, fitted plastic film for covering and providing a scratch proof barrier for computer devices; computer game software; video game software, video game cartridges; radios, electronic audio speakers, headphones and ear buds, wireless telephones, telephones; cell phone accessories, namely headsets, skins, face plates and cell phone covers; electronics accessories, namely skins, covers and stands for MP3 players, electronic tablets and portable personal digital assistant devices; decorative switch plate covers, video monitors, computer monitors, binoculars; sunglasses; eyeglass frames; eyewear straps and chains; eyeglass and sunglass cases; magnets; disposable cameras; credit cards and pre-paid telephone calling cards magnetically encoded; downloadable video recordings, video stream recordings, and downloadable audio recordings in the field of basketball provided over the Internet; downloadable computer software for viewing databases of information, statistical information, trivia, polling information, and interactive polling in the field of basketball provided over the Internet; downloadable computer game software; downloadable interactive video games and downloadable trivia game software provided over the internet; downloadable computer software for use as screensavers and wallpaper, to access and display computer browsers, for use in viewing data on the Internet, for use in designing plastic film computer skins to protect computer monitors, for use in creating avatars for playing games and for use in remotely manipulating computer cursors over the Internet; downloadable electronic publications in the nature of magazines, newsletters, coloring books, game schedules all in the field of basketball provided over the Internet; downloadable catalogs provided over the Internet featuring an array of basketball-themed products; downloadable greeting cards provided over the Internet.

Class 25: Clothing; footwear, basketball shoes, basketball sneakers, sandals, beach sandals; hosiery, T-shirts, shirts, polo shirts, sweatshirts, sweatpants, pants, tank tops, jerseys, shorts, pajamas, sport shirts, rugby shirts, sweaters, belts, ties, nightshirts, warm-up suits, warm-up pants, warm-up tops/shooting shirts, jackets, wind resistant jackets, parkas, coats, baby bibs not of paper, head bands, wrist bands, aprons, undergarments, boxer shorts, slacks, ear muffs, gloves, mittens, scarves, woven and knit shirts, jersey dresses, dresses, cheerleading dresses and uniforms; swim wear, bathing suits, swimsuits, bikinis, tankinis, swim trunks, bathing trunks, board shorts,

wet suits, beach cover-ups, bathing suit cover-ups, bathing suit wraps, beach hats, sun visors, swim caps, bathing caps; hats, caps, visors, novelty headwear with attached wigs.

Class 28: Toys, games and sporting goods; basketballs, golf balls, playground balls, sports balls, rubber action balls and foam action balls, plush balls for games, plastic balls for games; basketball nets, basketball backboards, miniature basketball backboards, pumps for inflating basketballs and needles therefore; golf clubs, golf bags, golf putters, golf accessories, namely, divot repair tools, tees, ball markers, golf bag covers, club head covers, golf gloves, golf ball sleeves, golf putting greens; billiard cue racks, billiard balls, billiard ball racks, dart board cabinets, electronic basketball table top games, basketball table top games, basketball board games, action skill games, adult's and children's party games, trivia information games and electronic video arcade game machines, basketball kit comprised of a net and whistle; dolls, decorative dolls, collectible dolls, toy action figures, bobblehead action figures, stuffed toys, plush toys; jigsaw puzzles, toy building blocks; Christmas tree ornaments and Christmas stockings; toy vehicles in the nature of cars, trucks, trains and vans, all containing basketball themes, novelty foam toys in the shapes of fingers and trophies, toy trophies, playing cards, card games, toy noisemakers, pet toys; beach toys, namely, beach balls, inflatable balls, toy pails, toy shovels, sand toys, sand box toys, water-squirting toys; pool accessories, namely swim floats, pool floats, toy water rafts, foam floats, swim rings, pool rings, foam rings, body boards, surf boards, swim fins, surf fins, arm floats and water wing swim aids, all for recreational use; volleyball game kits comprised of ball, net, sidelines and whistle, and water polo game kits comprised of ball, net and whistle; decorative cloth wind socks; miniature stadium reproductions, namely, small toy plastic models of a stadium; snow globes; video game machines for use with television and video game hand held controllers for use with console video gaming systems.

**Goods of the sixth earlier mark (917256728)**

Class 9: Audio recordings and video recordings featuring entertainment and information in the field of basketball; audio discs, video discs, computer laser discs, pre-recorded audio and video cassettes, pre-recorded audio and video tapes, pre-

recorded compact discs, pre-recorded computer laser discs, all featuring entertainment and information related to basketball; computer accessories, blank USB flash drives, pre-recorded flash drives featuring information in the field of basketball; stands adapted for computers, laptops and tablet computers; mouse pads, computer mice, compact disc cases, computer carrying cases, protective sleeves for laptop and tablet computers, wrist rests for use with computers, all related to basketball; battery chargers for mobile phones; computer programs for viewing information, statistics or trivia about basketball; computer software; screen savers featuring basketball themes; computer software to access and view computer wallpaper; computer browser software for use in viewing and displaying data on the Internet; computer skins, fitted plastic film for covering and providing a scratch proof barrier for computer devices; computer game software; video game software; video game cartridges; radios, electronic audio speakers, headphones and ear buds; wireless telephones, telephones; cell phone accessories, headsets, fitted plastic films known as skins for covering and protecting cell phones, face plates and cell phone covers; electronics accessories, fitted plastic films known as skins for covering and protecting electronic apparatus such as MP3 players, electronic tablets and portable digital assistant devices; covers and stands for MP3 players, electronic tablets and portable personal digital assistant devices; decorative switch plate covers; video monitors, computer monitors; binoculars; sunglasses; eyeglass frames; eyewear straps and chains; eyeglass and sunglass cases; magnets; disposable cameras; credit cards and pre-paid telephone calling cards magnetically encoded; downloadable video recordings, video stream recordings, and downloadable audio recordings in the field of basketball provided over the Internet; downloadable computer software for viewing databases of information, statistical information, trivia, polling information, and interactive polling in the field of basketball provided over the Internet; downloadable computer game software; downloadable interactive video games and downloadable trivia game software provided over the internet; downloadable computer software for use as screensavers and wallpaper, to access and display computer browsers, for use in viewing data on the Internet, for use in designing plastic film computer skins to protect computer monitors, for use in creating avatars for playing games and for use in remotely manipulating computer cursors over the Internet; downloadable electronic publications in the nature of magazines, newsletters, coloring books, game schedules all in the field of basketball provided over the Internet; downloadable catalogs provided

over the Internet featuring an array of basketball-themed products; downloadable greeting cards provided over the Internet; mouth guards for sports; decorative cloth wind socks.

Class 14: Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments; jewelry; costume jewelry; beaded jewelry; rubber or silicon wristbands in the nature of a bracelet, beaded necklaces; beads for use in the manufacture of jewelry; earrings, necklaces, rings, bracelets, cuff links, pendants, charms for collar jewelry and bracelets; clocks; watches; watch bands and watch straps, watch cases, watch fobs; jewelry boxes, tie clips; medallions; non-monetary coins of precious metal; precious metals; key chains of precious metal; key chains as jewelry [trinkets or fobs]; figures and figurines of precious metal; trophies of precious metals.

Class 28: Toys, games, playthings and sporting goods; gymnastic and sporting articles; basketballs, golf balls, playground balls, sports balls, rubber action balls and foam action balls, plush balls for games, plastic balls for games; basketball nets, basketball backboards, miniature basketball backboards, pumps for inflating basketballs and needles therefor; golf clubs, golf bags, golf putters, golf accessories, divot repair tools, tees, ball markers, golf bag covers, club head covers, golf gloves, golf ball sleeves, golf putting greens; billiard cue racks, billiard balls, billiard ball racks; dart board cabinets; electronic basketball table top games, basketball table top games, basketball board games, action skill games, adults' and children's party games, trivia information games and electronic video arcade game machines; basketball kit comprised of a net and whistle; dolls, decorative dolls, collectible dolls, toy action figures, bobblehead action figures, stuffed toys, plush toys; jigsaw puzzles, toy building blocks; Christmas tree ornaments, decorations and Christmas stockings; toy vehicles in the nature of cars, trucks, trains and vans, all containing basketball themes; novelty foam toys in the shapes of fingers and trophies, toy trophies; playing cards, card games; toy noisemakers, pet toys; beach toys, beach balls, inflatable balls, toy pails, toy shovels, sand toys, sand box toys, water-squirting toys; pool accessories, swim floats, pool floats, toy water rafts, foam floats, swim rings, pool rings, foam rings, body boards, surf boards, swim fins, surf fins, arm floats and water wing swim aids, all for recreational use; volleyball game kits comprised of ball, net, sidelines and whistle, and

water polo game kits comprised of ball, net and whistle; miniature stadium reproductions, small toy plastic models of a stadium; snow globes; video game apparatus; video game machines for use with television and video game hand held controllers for use with console video gaming systems; exercise treadmills; toy banks.