

O-540-14

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 2652922
BY TOURISM WORLD LIMITED TO REGISTER THE TRADE MARK**



IN CLASS 41


**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 400459
BY MISS WORLD LIMITED**

Background and pleadings

1) On 14 February 2013, Tourism World Limited (“the applicant”) applied to register the mark shown on the front page of this decision. It was accepted and published in the Trade Marks Journal on 22 March 2013 for the following list of services:

Class 41: Organisation of Beauty Pageants and Competitions

2) Miss World Limited (“the opponent”) opposes all of the services listed on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on four earlier marks. Earlier mark 1278551 MISS WORLD puts the opponent in no better position than when it relies upon its Community Trade Mark (CTM) 151282 and therefore, I will make no further mention of it. The remaining three earlier marks are detailed below:

Mark & other relevant details	Services relied upon
CTM 4984928 MISS BIKINI WORLD Filing date: 29 March 2006 Date of entry in register: 01 October 2010	Class 41: Organisation and running of contests; beauty contests;
CTM 0151282 MISS WORLD Filing date: 01 April 1996 Date of entry in register: 21 January 1999	Class 41: ...; organisation, sponsorship, running of contests; beauty contests; ...
1278549  Filing date: 01 October 1986 Date of entry in register: 22 March 1991	Class 41: Organisation of contests; ...

3) The opponent argues that the marks are highly similar and that the respective services share a high level of similarity. All of the marks relied upon by the opponent are earlier marks within the meaning of Section 6 of the Trade Marks Act 1994 ("the Act"). Further, earlier marks CTM 0151282 and 1278549 are subject to the proof of use requirements set out in Section 6A of the Act because they completed their registration procedures more than five years before the opposed marks were published.

4) The same three earlier marks are also relied upon when relying upon grounds based upon Section 5(3) of the Act. The opponent claims that it is the operator of the world-famous MISS WORLD beauty pageants, which it has run since the early-1950s. As the result of this long and extensive use it claims a unique and distinctive reputation in the UK in respect of all three marks. It claims that its marks' ability to attract business will be seriously tarnished by the presence of competing pageants bearing the opposed mark and that their ability to attract business will be diluted by the applicant's use of its mark.

5) The opponent also relies on grounds based upon Section 5(4)(a) and Section 3(6) of the Act because use of the applicant's mark would amount to passing off of the opponent's marks and because the applicant's mark was filed as part of "a purposeful campaign to hedge around and where possible intrude into the exclusive brand MISS WORLD..." and that these "marks are then used in practice as a composite as MISS TOURISM WORLD, since the applicant knows that it is not entitled to variations on anything too similar to MISS WORLD".

6) The applicant filed a counterstatement denying the claims. The applicant further states that it relies upon its own concurrent use of its mark. It claims concurrent use of its MISS BIKINI WORLD mark since 1998. It also states that it is currently pursuing invalidation proceedings against the opponent's CTM 4984928 (although this was not actually filed until 18 November 2013, some five months after the date of the applicant's counterstatement).

7) Whilst two of the opponent's earlier marks are subject to proof of use, it was confirmed at the hearing that the applicant does not put the opponent to such proof (see paragraph 15(ii), below). The consequence of this is that the opponent can rely upon the full list of services as listed in the table at paragraph 2.

8) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate or necessary. The opponent has also filed written submissions which will not be summarised but will be kept in mind where appropriate. A Hearing took place on 17 September 2014, at which the opponent was represented by Mr Mark Heritage for Bear & Wolf IP LLP and the applicant by its own Mr Steven Baugh. The submissions made during the Hearing have been fully considered in reaching this decision and will be referred to as and when appropriate during this decision.

Opponent's Evidence

9) This takes the form of a witness statement by Mr Michael Anthony Macario, Finance Director of the opponent. His evidence can be summarised as follows:

- There has been long use of the mark MISS WORLD dating back to 1951;
- Worldwide turnover has been in the excess of £5 million a year over the last five years¹. At the time Mr Macario joined the opponent in 1984, turnover was in the region of “several hundred thousand pounds” with the UK accounting for about three quarters of this;
- All revenues have been treated by the UK tax authorities as UK income and taxed in the UK with the opponent being a UK registered company;
- Its marks are used to identify a beauty pageant held annually. At page 217 of its exhibit is a list of locations where each contest was held. It was held in London in every year between 1951 and 1988 and also in the years 1990, 1999, 2000, 2002 and 2011. In the other years it was held outside the UK;
- The opponent runs a UK specific licensing network. From 1958, a licence was set up for a MISS UNITED KINGDOM contest but in 1999/2000 it was split into regional competitions i.e. Miss England, Miss Scotland, Miss Wales and Miss Northern Ireland thus there being four licensees in the UK;
- The opponent also operates a worldwide licensing operation where each competing country will hold a national final to select its entry into the competition. Extracts of the opponent's licence terms are provided at pages 218 and 219 and includes the text “The Licensee acknowledges and agrees that Miss World Limited is the exclusive owner of the ...Intellectual Property Rights and that all rights in the Mark and/or Logo ... shall at all times vest in and belong to Miss World Limited”;
- To the best of Mr Macario's knowledge, the opponent's globe logo mark “was developed long before [he] started with the company in 1984). He explains the concept of the mark as representing the worldwide nature of the event, with the initials “MW” representing both MISS WORLD and suggesting a crown. Further examples of the logo mark in use in 1971 and 1975 are provided at pages 718 and 761/762 of his exhibit. It has now become an integral element of the MISS WORLD brand and is used on the opponent's website (see pages 204 to 216 of the exhibit). Use is also shown on some pages of a 1999 press information brochure (for example pages 818, 819 and 837 - 841), on a number of pages of a 2000 brochure from the London Olympia event (see pages 922 to 1005) and on brochures from 2001 (see page 1010), 2002 (for example, pages 1028,

¹ Paragraph 22, Mr Macario's witness statement

1030, 1032, 1034, 1036 and 1038), 2007 (page 1078). The logo mark does not appear in the 2011 brochure (pages 1120 to 1179) contrary to as stated by Mr Macario. All of the above examples (with the exception of pages 761/762 where the logo appears as an integral part of a 25th anniversary logo) appear with the words MISS WORLD positioned directly underneath the logo. The 1999, 2000, 2002 and 2011 events were held in the UK;

- At pages 5 – 203 of the exhibit is information regarding competitors, finalist and winners of the MISS WORLD competition between 1951 and 2013. The opponent's 1278549 device mark (hereafter "the logo mark") appears at the top of the page with the words MISS WORLD underneath ;
- The MISS WORLD event is not merely an attendance event but is broadcast on television. In the UK, the *BBC* broadcast it every year between 1959 and 1979. *Thames Television* took over the UK broadcasting of the event between 1980 and 1988. After this there was a decline in the popularity of mainstream television broadcasts of the event, but broadcasts continued through satellite television channels such as *Sky* (from 1997), *Channel 5* (from 1999) and currently the *E-Channel*;
- Promotion of the MISS WORLD event from the 1950s to the early 2000s was historically done through television advertising or hard copy media. Examples of the latter from the years 1960, 1961, 1986 and 1988 are provided at pages 281 and 558 of the exhibit.
- Examples of typical UK press coverage are provided at pages 559 to 695 of the exhibit. Not all are dated, but those that are appear to cover a date range between 1984 to 1998 and not the 2000s, as stated by Mr Macario. These pages consist mainly of extracts from UK national and regional newspapers reporting on the MISS WORLD event or the holder of the title MISS WORLD;
- Since the 2000s, the opponent has operated a .com website accessible from "just about [anywhere] in the world including the UK";
- On the issue of bad faith, Mr Macario provides a list of various other marks owned by the applicant, that he argues play on the theme of "MISS XYZ" or "MISS XYZ WORLD", with such themes intended to get as close as possible to the mark MISS WORLD. The marks Mr Macario identifies are:
 - UK 2652923: Model of the World The Symbol of Beauty
 - UK2652927: Model of the Universe The Symbol of Beauty
 - UK 2306015: MISS TOURISM
 - UK 2424927: MISS TOURISM LATIN AMERICA
 - UK 2424927: MISS TOURISM EUROPE
 - UK 2424979: MISS TOURISM AFRICA
 - UK 2424980: MISS TOURISM ASIA
 - UK 2425093: MISS TOURISM INTERNATIONAL
 - UK 2426555: TOURISM WORLD

- UK 2426822: BIKINI WORLD

Applicant's Evidence

10) This takes the form of a witness statement by Mr Steven Baugh of the applicant. He states that the applicant's national pageant MISS GREAT BRITAIN was established in 1945 and that its MISS BIKINI WORLD mark is one of a number of its recognised brands in the UK. Pages 1 to 3 of his single exhibit are copies of *Google* search results for "Miss Bikini" and "Miss Bikini World" and Miss Tourism". The first two of these appear to show the applicant's MISS BIKINI WORLD (not MISS BIKINI as applied for) event or website appearing prominently in the results.

11) Mr Baugh states (at paragraph 5 of his witness statement) that "the winners of Miss Great Britain have always gone to the finals of pageants owned and produced by [the applicant] which include ... Miss Bikini World ... and Miss Millionaire."

12) He states further that the opponent has been aware of the applicant's Miss Bikini World, Miss Millionaire and its other pageants. He supports this by stating that Mr John Singh, who is a previous owner of the applicant's business, can recall that the founders of Miss World, Mr & Mrs Morley sent a fax in the year 2000, to all their national directors around the world stating that Miss Tourism World and Miss Bikini World pageants were in no way associated with Miss World. Further, Miss World has previously accepted contestants from Miss Great Britain to compete at Miss World and have also previously also sent contestants to Miss Bikini World. He identifies Imogen Thomas as one such contestant. At page 13 of his exhibit, he provides an undated extract from www.walesonline.co.uk that discusses Ms Thomas' likely success in the TV reality show *Big Brother*. It notes that she has taken part in the Miss Bikini World pageant. Mr Baugh states that the Miss Bikini World pageant has taken place since at least 1998.

13) Similarly to the set up of Miss World, Mr Baugh states that the use of the applicant's pageants, including its associated IP rights are licensed worldwide. At page 16 of the exhibit, Mr Baugh includes a copy of the first page of such an agreement. Under the heading of "Brands", it states "The National Director agrees that the national final competition shall be fully and prominently branded with the logos and names of Tourism World ® Limited at all times. The logos remain the property of Tourism World Organisation at all times."

14) Mr Baugh explains that whilst being beauty pageants, its competitions under MISS BIKINI and MISS MILLIONAIRE and others have always been tourism pageants, used as a tool to promote tourism, the host country and other countries taking part. Mr Baugh identifies that MISS WORLD, on the other hand, has a focus on charity work.

DECISION

Preliminary issues

15) Three preliminary issues were discussed at the hearing:

- (i) This opposition has until this point been consolidated with opposition 400629. The opponent relies on a number of earlier marks that are common to both proceedings, however, one, namely CTM 4984928 MISS BIKINI WORLD is only relied upon in respect of this opposition and is currently the subject of invalidation proceedings before the OHIM. Until such invalidation proceedings have been decided, any impact of this earlier mark upon opposition 400459 can only be provisional and the decision in respect of this opposition must also be provisional. In order not to delay the decision in respect of opposition 400629, I informed the parties that it was my intention to issue separate decisions despite the cases being consolidated up to this stage;
- (ii) There is a discrepancy between the two counterstatements filed in respect of this opposition and that of 400629. Despite the issue of proof of use relating to the same two earlier marks in both proceedings, the applicant put the opponent to proof in only one. Mr Baugh confirmed that the applicant accepted that the opponent had made use of its marks, including in the UK. As a consequence of this, it is not necessary that I consider the opponent's claim to use and it may rely on all the services listed in its statement of case and detailed in the table at paragraph 2;
- (iii) Mr Heritage's skeleton argument raised an issue regarding potential without prejudice evidence filed by the applicant, notably the letters shown at Exhibit 11 and Exhibit 12 of Mr Baugh's witness statement. I identified the lateness of raising this issue, the potential unfairness to the other side and the fact that the relevance to the issues before me were marginal. For these reasons, I declined a request to strike out this evidence at this late stage.

Section 5(2)(b)

16) Sections 5(2)(b) of the Act is 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".

17) 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

18) I did not detect any dispute between the parties that all the respective marks cover essentially identical services. Certainly, when applying the principle that goods can be considered as identical when the goods designated by the other mark are

included in a more general category (*Gérard Meric v OHIM*, T-133/05), then it is self evident that the applicant's services are identical with the relied upon services in all three earlier marks.

Comparison of marks

19) It is necessary for me to undertake three separate comparisons because there are different considerations for each of the opponent's earlier marks. Firstly, I will compare the following:

Earlier mark	Applicant's mark
MISS BIKINI WORLD	

20) Mr Heritage encouraged me to consider the similarity of the opponent's mark with the mark MISS BIKINI WORLD & globe device (i.e. with the addition of the word WORLD) on the basis of this is how the applicant actually uses the applied for mark. I return to this issue later when considering all the aspects of the global appreciation test. It is sufficient here that I record that it is not open for me to undertake the comparison he suggests. Rather, I must consider the mark applied for and its similarity to the opponent's marks.

21) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components and give due weight to any other features which are not negligible.

22) Mr Heritage submitted that the dominant and distinctive element of the applicant's mark is the words MISS BIKINI. I certainly agree that this is a distinctive element of the mark, but because of its position below the large device element and its relative size when compared to the device element, it is my view that the words MISS BIKINI and the device element share equal dominance within the mark. The words "the symbol of beauty" appear in very small script at the bottom of the mark. As they are not quite a negligible element of the mark, I will keep them in mind in the overall comparison of the marks.

23) The opponent's mark consists of three words, with neither one more dominant than the other.

24) Visually, there is some similarity because both marks share the words MISS BIKINI. In all other ways, the respective marks are different. The opponent's mark includes the addition of the word WORLD and the applicant's mark includes the globe/silhouette/crown device, the words "The Symbol of Beauty" and a script used for the words MISS BIKINI that resembles hand writing.

25) Aurally, the applicant's mark will be expressed as MISS-BIK-EEN-EE, with the other elements of the mark unlikely to be referred to. The opponent's mark will be expressed as MISS-BIK-EEN-EE-WORLD. The four syllables of the applicant's mark are incorporated as the first four of five syllables in the opponent's mark, creating obvious similarity between the marks.

26) Conceptually, Mr Heritage submitted that the "globe device" present in the applicant's mark imparts a concept of "world", thereby creating the same concept that is present in the opponent's mark. I do not agree. The presence of the globe is more abstract than the descriptive word "world" and consequently "world" is but one possible concept it may impart. In my view, however, it is more likely that the device will impart a concept of "globe" or "worldwide" and it will not necessarily conjure up, in the mind of the average consumer, the word "world" specifically. The words MISS BIKINI will be understood as describing the title that a woman or girl has won in a beauty contest² that involves a two piece swim suit³. Such a meaning is reinforced by the words "The Symbol of Beauty" that appears under the words MISS BIKINI. The opponent's mark has a concept of a title of a beauty contest that involves competitors from across the world. Conceptually, there is some similarity between the marks insofar that both will be perceived as referring to a beauty contest where bikinis are a feature. Further, there is also some similarity between the concept of a globe or "worldwide" created by the device element present in the applicant's mark and the word WORLD present in the opponent's mark.

27) The second comparison I undertake is in respect of the following marks:

Earlier mark	Applicant's mark
MISS WORLD	

² "miss." Oxford Dictionary of English. Ed. Stevenson, Angus. : Oxford University Press, 2010. Oxford Reference. 2010. Date Accessed 13 Oct. 2014
 <http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m-en_gb-msdict-00002-0525230>.

³ "bikini." Oxford Dictionary of English. Ed. Stevenson, Angus. : Oxford University Press, 2010. Oxford Reference. 2010. Date Accessed 13 Oct. 2014
 <http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m-en_gb-msdict-00002-0076990>.

28) My considerations regarding the dominant and distinctive elements of the respective marks are the same here except that I observe the applicant's mark consists of two words, not three, but once again, neither is more dominant than the other.

29) Visually, the only similarity is the occurrence of the word MISS in both marks. The word BIKINI, the words "The Symbol of Beauty", the device of a globe/crown/female figure are all present in the applicant's mark but absent in the opponent's mark. Further, the word WORLD is present in the opponent's mark and absent in the applicant's mark.

30) Aurally, as with my analysis in the previous comparison, the applicant's mark will be expressed as MISS-BIK-EEN-EE, with the other elements of the mark unlikely to be referred to. The opponent's mark will be expressed as MISS-WORLD. Only the first syllable is common to both marks. In all other respects they are aurally different.

31) Conceptually, as I have said, the applicant's mark will be understood as describing the title that a woman of girl has won in a beauty contest that involves a two piece swim suit and such a meaning is reinforced by the words "The Symbol of Beauty". The opponent's mark has a concept of a title of a beauty contest that involves competitors from around the world. Mr Heritage submitted that there is an identical concept created by the globe device in the applicant's mark and the word WORLD in the opponent's mark. Whilst I would not put it as high as that, there is some conceptual similarity for the reasons I set out in paragraph 26 above.

32) The third comparison is between the following:

Earlier mark	Applicant's mark
	

33) The two prominent elements of the opponents mark are the globe device and the crown device that is designed such as to be reminiscent of the letters "MW". They share equal prominence in the mark. My considerations of the applicant's mark are recorded in paragraph 23 above.

34) Visually, both marks share a globe device and a crown device, but as Mr Baugh submitted, these are quite different in appearance. The globe device in the opponent's mark appears to be un-stylised and a realistic image of the earth. On the other hand, the applicant's globe is less clear, being obscured by curved longitudinal lines and the silhouette of a woman. Similarly with the crown device, one is stylised (but this time the opponent's device) and is designed to appear reminiscent of the letters "MW". The applicant's crown device is reasonably un-stylised and a different shape (being suggestive of a diamond shape similar to a papal mitre). All the word

elements present in the applicant's mark are absent in the opponent's mark so, whilst there are some similarities, there are a greater number of points of dissimilarity.

35) Aurally, once again the applicant's mark will be expressed as MISS-BIK-EEN-EE, with the other elements of the mark unlikely to be referred to. The opponent's mark has no verbal elements that are likely to be expressed, unless the average consumer identifies the letters "MW" in the crown device, but I am far from convinced that this would be spotted and, even if it were so, that it would be referred to. There is no aural similarity.

36) The globe and crown devices create an element of conceptual similarity. However, as I have stated previously, the applicant's mark will be understood as describing the title that a woman or girl has won in a beauty contest that involves a two piece swim suit and that such a meaning is reinforced by the words "The Symbol of Beauty. All these concepts are absent from the opponent's mark.

Average consumer and the purchasing act

37) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

38) The average consumer of the respective services will be the general public. It is not obvious to me that the nature of the purchasing act involves anything other than an average level of care and attention because the services are a form of entertainment that will generally attract a passing interest. The purchasing process will be predominantly visual with the average consumer accessing the services via television or attending a live event. However, I do not ignore aural considerations that may play a role in some circumstances, such as booking tickets for an event over the telephone.

Distinctive character of the earlier trade mark

39) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

40) Mr Macario, in his witness statement, points to contestants in MISS WORLD appearing in bikinis and states that because of this he has "no hesitation in saying that the ... MISS BIKINI WORLD mark ... possess an extremely substantial goodwill and reputation in the UK..." I take this that he also claims enhanced distinctive character through use. However, I reject this. Merely because the contestants in the

MISS WORLD contest appear in bikinis does not indicate that the opponent has used the mark MISS BIKINI WORLD. There is nothing in the opponent's evidence to indicate that it has used this mark and I conclude that its distinctive character has not been enhanced through use. I, therefore, only need to give consideration to its inherent distinctive character. In this respect, none of the elements of the mark strike me as having a great deal of distinctive character, and when combined create a whole that is highly allusive of a beauty competition that is worldwide in nature and involves women or girls in bikinis or alternatively that it is a competition held within the world (sphere) of bikinis. I conclude that the level of distinctive character is only low.

41) Very similar considerations apply to the level of inherent distinctive character of the mark MISS WORLD. However, the majority of the opponent's evidence is directed at illustrating the level of reputation enjoyed by its pageant. Mr Heritage pointed out that MISS WORLD is an annual beauty pageant that has taken place every year since 1951, with the first 37 years being held in London. Annual UK turnover is unclear with only worldwide turnover stated for recent years. Further, whilst the evidence illustrates that there has been consistent use made of the mark, in respect of the UK, such use appears to have significantly reduced. The pageant has only been held once (2011) in the UK since 2002. Coverage on UK television appears to have waned in recent years, with recent coverage apparently being provided on what appears to be a small digital channel. Set against this unimpressive recent use in the UK is the fact that the event had been held in the UK every year (except two) before 2002. Taking all of this into account, I conclude that there is likely to be some residual enhancement to the mark's distinctive character, but I am unable to conclude that this is to any great extent.

42) In respect of the opponent's logo mark, an un-stylised globe device of the type appearing in the mark is inherently low in distinctive character, especially when used in respect of a global event such as the opponent's services. The addition of the "MW crown", however, adds distinctive character to the mark as a whole leading to a moderate level of distinctive character. The evidence illustrates that the opponent currently uses the mark on its website (see pages 5 to 216 and 695 of Exhibit MM1), and the following historical examples are provided:

- on the front cover of the souvenir programme (see page 838) and on the cover of the Press Information pack relating to the 1999 MISS WORLD;
- it appears in the top corner of most pages of the 2000 brochure when the event was held at the London Olympia (page 922 to 1005);
- in the brochure of the 2001 event held in Nigeria (see for example page 1010);
- in the brochure of the 2002 event held in London (see page 1028);
- on the front cover of the 2007 event held in China (page 1078);

43) Mr Macario, in his witness statement, claims that to the best of his knowledge, the mark was developed long before he joined the company in 1984. The evidence is somewhat sporadic and some of the evidence relates to use of the mark when the event was held overseas. In fact, the evidence of use of this mark suffers from the same criticism as the evidence in respect of the opponent's MISS WORLD mark, namely, use in the UK has significantly waned in recent years. I recognise that this

mark has been used historically over many years (and possibly back to 1984 and earlier) and that it currently features on the opponent's website, the evidence is insufficient for me to conclude that at the relevant date of these proceedings this mark benefitted from an enhanced level of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

44) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

45) Firstly, I consider the likelihood of confusion in respect of the opponent's MISS BIKINI WORLD MARK. Mr Heritage submitted that actual use of the applicant's mark is in an amended form with the words MISS BIKINI being amended to MISS BIKINI WORLD. The mark is identical in all other respects to the one applied for. In support of this, he directed me to page 1266 of Mr Macario's witness statement which consists of a copy of a page from what I assume is the applicant's website promoting a forthcoming MISS BIKINI WORLD event. Mr Heritage relied upon High Court decisions in *Grundig Trade Mark* [1968] RPC 89, *Players Trade Mark* [1965] RPC 363 and *WOODIES Trade Mark* [1965] RPC 366 when submitting that such use by the applicant was an example of notional and fair use of its mark. The latter two cases do not appear to be on point. The first case has some parallels, but does not assist the opponent. The case considered whether use of a word and device mark incorporating a shield with a shamrock appearing thereon was in breach of a condition imposed upon a registration for the same mark absent the shamrock that stated the blank space within the shield device shall only be filled with descriptive, non trade mark matter. In a nutshell (see third paragraph, page 99), the appeal judge declined to decide the point that the use described was in breach of the condition imposed upon the application, concluding that "(i)t would be very odd in those circumstances if the breach of the condition had the effects on the application for registration of a quite different mark which the opponents suggest it had". Similarly in the current case, I fail to see how use of a different mark can affect the validity of the mark in the contested application. Therefore, I dismiss this argument.

46) Nevertheless, I have found that:

- the respective marks involve identical services;
- the words MISS BIKINI and the globe/crown device share equal dominance in the applicant's mark;
- no single element dominates the opponent's mark, with its distinctive character resulting from the combination of the three words MISS BIKINI WORLD;
- there is some visual similarity arising from the common occurrence of the words MISS BIKINI in both marks;
- there is obvious and clear aural and conceptual similarity between the marks;
- the purchasing process involves an average level of care and attention;

- the opponent's earlier mark has only a low level of distinctive character.

47) Whilst the final point is in favour of finding that there is no likelihood of confusion, all other considerations point the other way and it is, indeed, my view that when taking imperfect recollection into account there is a likelihood of indirect confusion. This is where the consumer will be aware of some of the differences between the marks but will assume that they identify services that originate from the same or linked undertaking.

48) This finding must be provisional upon the opponent's earlier CTM surviving the cancellation action currently under consideration by the OHIM. Because of this, it is necessary for me to also consider the likelihood of confusion between the applicant's mark and the other two earlier marks relied upon by the opponent.

49) Firstly, in respect of the opponent's MISS WORLD mark, there is a suggestion that the mark is not distinctive. I have not found this, and in fact, it is not open to me to make such a finding because a registered mark must be assumed to have at least some distinctive character (see *Formula One Licensing BV v OHIM*, Case C-196/11P). Further, in the current case, I have found that the mark MISS WORLD benefits from some enhanced distinctive character. However, I find that this is insufficient reason to find a likelihood of confusion.

50) The only similarity between the two marks is the appearance of the word MISS. There are no submissions or evidence before me that suggests that the opponent has a monopoly in respect of all MISS marks. On the contrary, the dictionary reference mentioned in paragraph 27 above demonstrates that the word MISS is used as the title a woman of girl has won in a beauty contest. The respective marks are different in all other respects. Further, use since 2002 appears to have significantly waned in recent years. Taking these points into account, it is my view that they outweigh the fact that the respective services may be identical, that the average consumers will be the same and that the earlier mark's distinctive character is enhanced to some small degree because of its historical use in the UK. I find no likelihood of confusion.

51) Next, I consider the likelihood of confusion between the applicant's mark and the opponent's device mark. The applicant's mark is presented in colour, however, this does not materially affect the outcome of my consideration. Here, the marks share the fact that they both contain a globe and crown device. When considering each mark as a whole, I have found that there are some visual similarities, but there a greater number of points of dissimilarity and there is no aural similarity. Further, the respective services are identical, as are the relevant consumers. I also found that the opponent's mark is endowed with a moderate level of distinctive character, but that the evidence is insufficient for me to conclude that it benefits from any enhanced level of distinctive character.

52) Of relevance in my considerations are the visual differences between the device elements of the respective marks. The opponent's mark contains an unstylised device of a globe whereas the applicant's mark is embellished with longitudinal curved lines and a silhouette of a woman and these obscure the finer detail of the globe. Further, whilst both marks also contain a device of a crown that appears

above the globe they are different in appearance with the opponent's crown being designed so it is reminiscent of the letters "MW". The applicant's crown, on the other hand, suggests a diamond shape (I say "suggests" because the bottom of the crown is obscured by the globe) being reminiscent of a papal mitre. The differences created will be apparent to the consumer when viewing each mark in their entirety. When this is factored into the global appreciation of the circumstances surrounding the marks, I find that the dissimilarities are sufficient for a there to be no likelihood of confusion.

Summary of finding in respect of the Section 5(2)(b) grounds

53) The Section 5(2)(b) ground based upon the opponent's earlier CTM 4984928 MISS BIKINI WORLD is provisionally successful and subject to the CTM surviving the current attack upon it before the OHIM.

54) The Section 5(2)(b) grounds based upon the earlier CTM 0151282 MISS WORLD and UK registration 1278549 device mark both fail.

Section 5(4)(a)

55) The opponent has not used MISS BIKINI WORLD and, consequently, it is unable to demonstrate the necessary goodwill to succeed under a claim for passing off. In respect of its other two earlier marks, the opponent puts forward an argument regarding the similarity of the respective marks, claiming that it will result in misrepresentation. This mirrors its arguments under Section 5(2)(b) where I have already found that its case has failed. Consequently, there is no greater prospect of success under section 5(4)(a) than there is under section 5(2)(b). For the reasons outlined above, there would be no misrepresentation.

Section 5(3)

56) I now consider the ground for opposition under Section 5(3) of the Act. The opponent has provided no evidence of reputation in respect of its MISS BIKINI WORLD mark. Consequently, I conclude that it has no reputation. Consequently, my considerations will be limited to the opponent's case as based upon the mark MISS WORLD and also its device mark.

57) Section 5(3) of the Act reads as follows:

"(3) A trade mark which-

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

58) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009]

ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel*, paragraphs 76 and 77.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any

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

Reputation

59) 'Reputation' for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the CJEU's judgment in *General Motors Corp v Yplon SA (CHEVY)* [1999] ETMR 122 and [2000] RPC 572).

60) I recognise use of the MISS WORLD mark since 1951, but as I have observed earlier, use of the mark in the UK, in recent years has waned with the pageant only being held in the UK once (in 2011) since 2002. A total turnover of £5 million per annum is referred to, but it is not clear what proportion of this was generated into the UK. Recent contests have mainly been held in the Far East and I have no stronger evidence of reputation elsewhere in the EU. I take all of this into account, together with the evidence not providing anything other than a general inference that the mark MISS WORLD benefits from a reputation in the UK as a result of its historical use. This all points to a finding that the mark is not now known by "a significant part of the [UK] public". I have concerns that this finding may sit somewhat uncomfortably with members of the UK public who are old enough to remember the use the pageant associated with the mark in the period up to the late 1970s, but I find that the evidence is not convincing on this point. However, in case I am wrong and the mark has the requisite reputation in the UK at the relevant date (14 February 2013), I will go on to consider the existence of a link.

61) Before I do this, I also need to consider whether the opponent's logo mark benefits from the requisite reputation. Here, the evidence is even less conclusive. Mr Macario states that its use dates back to before his joining of the opponent company in 1984, and his exhibits show use in 1971 and 1975 respectively. The evidence also illustrates use in 1999 and 2000, 2002 in the UK (see paragraph 10, 7th bullet point). There are two criticisms of this evidence. Firstly, it demonstrates only sporadic use in the UK (unlike the opponent's word mark that I accept was used continuously in the UK until the pageant was moved overseas. The only use of the logo mark between 2002 and the relevant date is in the 2011 brochure. Here it always appears with the words MISS WORLD appearing directly below it. I also keep in mind that the relevant public for the opponent's services is the public at large who will engage with the services in a superficial way. Considering all of this, I am unable to conclude that a significant part of the public concerned will know the logo mark and I find that it does not have the necessary reputation in 2013. In light of this finding, it follows that the Section 5(3) grounds fails insofar as the opponent relies upon the logo mark.

62) Mr Heritage submitted that the worldwide use of the opponent's marks is "drawn to the UK" by virtue of opponent being based in UK and by way of its licence agreements. I reject this claim. Reputation must be judged in respect of knowledge

of the relevant public (in the UK) and not by the existence of any licence agreement or for that matter, where a business maybe based.

The Link

63) Having established the existence and scope of a reputation in respect of the opponent's MISS WORLD mark, I need to go on to consider the existence of the necessary link. I am mindful of the comments of the CJEU in *INTEL* that it is sufficient for the later trade mark to bring the earlier trade mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The CJEU also set out the factors to take into account when considering if the necessary link exists:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

64) I have already found that there is no likelihood of confusion and that in terms of similarity between the marks the only common element is the word MISS. Even taking account that identical services are involved, I find that the necessary link is not established. The word MISS is a title bestowed upon the winner of a beauty contest and consequently the existence of the same in both marks will not create a link in the mind of the consumer. Rather, the existence of the word will do no more than indicate the nature of the services provided under both marks, namely beauty pageants.

65) As the necessary link does not exist, it follows that the Section 5(3) grounds based upon the opponent's earlier MISS WORLD mark must fail.

Section 3(6)

66) Finally, I consider the grounds based upon Section 3(6) of the Act. This reads follows:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

67) In terms of the date at which the matter falls to be considered, it is well established that the relevant date for consideration of a bad faith claim is the application filing date (*Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 paragraph 35), namely 14 February 2013.

68) The guidance regarding the general principles of bad faith have been conveniently summarised by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) Arnold J:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999]

RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the

origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

69) On the basis of these authorities it is clear that a finding of bad faith may be made in circumstances which do not involve actual dishonesty. Furthermore, it is not necessary for me to reach a view on the applicant’s state of mind regarding the transaction if I am satisfied that their action in applying for the mark in the light of all the surrounding circumstances would have been considered contrary to normally accepted standards of honest conduct. Thus, in considering the actions of the applicant, the test is a combination of the subjective and objective. Furthermore, it is clear that bad faith in addition to dishonesty, may include business dealings which fall short of the standards of acceptable commercial behaviour i.e. unacceptable or reckless behaviour in a particular business context and on a particular set of facts.

70) The opponent submits that the history between the parties has been such that the actions of the applicant results from its “hedging around the opponent’s rights”. In considering this point I am mindful of the comments of Professor Ruth Annand, sitting as the Appointed Person in *MAGIGROW Trade MARK* (BL O/583/01). When considering a very similar issue, she commented as follows:

68. I am mindful of the comment by Millett L.J. in *The European Limited v. The Economist* [1998] FSR 283 in relation to section 10(2) but in my view, equally applicable in the present context:

A degree of similarity is tolerable; the question is whether there is confusing similarity.

69. The marks in suit have not been found to be confusingly similar to the opponent’s *MIRACLE-GRO* marks either under sections 5(2)(b) or 5(4)(a) of the TMA. The opponent’s remaining grounds of appeal based on deliberate intention to deceive also fail. The opponent has not proved bad faith in Application Nos. 2159942 and 2166950 within the meaning of section 3(6).

71) Similarly, in the current case I have found that the applicant’s mark is not confusingly similar to the opponent’s *MISS WORLD* mark and its device mark. Consequently a claim that the applicant is intentionally “sailing close to the wind” and is acting in bad faith must also fail.

72) I have provisionally found a likelihood of confusion between the opponent’s *MISS BIKINI WORLD* mark and the applicant’s mark. However, the evidence fails to support the submission that the applicant is “hedging around the rights of the opponent”. The opponent has not used its mark and neither is there any evidence that it intends to do so. Therefore, there is nothing to suggest that the applicant is attempting to gain any advantage from the activity of the opponent. Further, there is evidence that the applicant has operated an event called *MISS BIKINI WORLD* since at least 1998 and was referred to in a letter between the parties in 2003 (as evidenced by the existence of the letter shown at Mr Baugh’s Exhibit 11). Having regard for these facts, the application to register the mark without the word *WORLD*

can be characterised as an attempt by the applicant to move away from the rights of the opponent rather than hedging around them. This cannot be characterised as an act of bad faith.

73) In conclusion, the ground based upon Section 3(6) of the Act fails.

FINAL REMARKS AND COSTS

74) The opposition is provisionally successful in respect of the Section 5(2)(b) grounds based upon the opponent's earlier CTM 4984928 MISS BIKINI WORLD. It fails in all other respects.

75) It is normal for costs to follow the event. In this case the final outcome of the proceedings is unknown and will remain pending until such time as the fate of the opponents CTM registration for MISS BIKINI WORLD is known. Consequently, I will reserve my order in respect of costs until such time as this is known and my decision can become final.

76) The parties are directed to inform the Registry of the outcome of the outstanding proceedings at the OHIM in respect of CTM 4984928 MISS BIKINI WORLD as soon as the outcome is known. Once this is known, I will issue a supplementary decision confirming the outcome of the proceedings, making the order as to costs and setting the start of the appeal period.

Dated this 16th day of December 2014

Mark Bryant
For the Registrar,