

O/0010/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003887822

BY AN CONCRETE LTD

TO REGISTER THE TRADE MARK:

**MISFITS BOXING**

IN CLASSES 9, 16, 35, 36, 38, 41 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 441520

BY WASSERMAN BOXING LIMITED

AND

IN THE MATTER OF APPLICATION NO. UK00003930871

BY WASSERMAN BOXING LIMITED

TO REGISTER THE TRADE MARK:

**Misfits Boxing**

IN CLASSES 25 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 445002

BY AN CONCRETE LTD

## BACKGROUND AND PLEADINGS

1. This decision involves two opposition proceedings wherein Wasserman Boxing Limited (“WBL”) and AN CONCRETE LTD (“ANC”) brought oppositions against each other’s trade mark applications. I will summarise the relevant proceedings below, beginning with WBL’s opposition on the basis that it was brought first.

### WBL’S OPPOSITION AGAINST ANC’S APPLICATION NO. UK00003887822

2. On 10 March 2023, ANC applied to register the mark UK00003887822 shown on the cover page of this decision in the UK. The application was published for opposition purposes on 24 March 2023 in respect of the following goods and services:

**Class 9:** *Software applications for mobile devices; Software and applications for mobile devices; Software applications for use with mobile devices; Mobile application software; Application software for mobile devices; Application software for mobile phones; Downloadable software applications for mobile phones; Mobile software; Computer application software for mobile phones; Software applications; Computer application software for mobile telephones; Smartphone software applications, downloadable; Downloadable applications for use with mobile devices; Downloadable applications for mobile devices; Computer software applications; Downloadable mobile applications; Application software for wireless devices; Software for mobile phones; Downloadable mobile applications for use with wearable computer devices; Downloadable software applications; Downloadable software in the nature of a mobile application; Downloadable smart phone applications (software); Downloadable computer software applications; Computer software applications, downloadable; Application software; Software for mobile device management; Mobile device management software; Educational mobile applications; Computer software for mobile phones; Application software for smart phones; Web application software; Downloadable mobile applications for the management of data; Computer software for mobile applications that enable interaction and interface between vehicles and mobile devices; Downloadable application software for smart phones; Application software for televisions;*

*Computer application software; Computer programs and software for image processing used for mobile phones; Computer application software for use with wearable computer devices; Software for smartphones; Electronic game software for mobile phones; Application software for cloud computing services; Downloadable smart phone application software; Business application software; Downloadable mobile applications for the management of information; Application suites [software]; Downloadable application software; Computer game software for use on mobile devices; Smartphone software; Downloadable mobile applications for the transmission of data; Application server software; Application development software; Web application and server software; Application software for robot; Enterprise application software [EAS]; Computer software for application and database integration; Mobile apps; Computer software platforms; Augmented reality software for use in mobile devices; Application simulation software; Downloadable software in the nature of a mobile application for playing games; Computer application software for TV; Computer software to enhance the audio-visual capabilities of multimedia applications; Downloadable mobile applications for the transmission of information; Downloadable game related software applications; Computer telephony software; Computer game software for use on mobile and cellular phones; Application software for smart TV; Middleware for management of software functions on electronic devices; Computer software for use on handheld mobile digital electronic devices and other consumer electronics; Telemetry devices for engine applications; Computer application software featuring games and gaming; Computer software for cellular phones; Collaboration software platforms [software]; Electronic game software for wireless devices; Downloadable software in the nature of a mobile application for food delivery and ordering; Software; Downloadable computer software for use as an application programming interface (API); Downloadable electronic game software for wireless devices; Downloadable computer software for blockchain technology; Digital telephone platforms and software; Mobile computers; Multimedia software; Computer software development tools; Educational computer applications; Computer software to enable the transmission of photographs to mobile telephones; Application software for social networking services via internet; Downloadable mobile applications for*

*booking taxis; Web development software; Software related to handheld digital electronic devices; Computer e-commerce software; Computer software for use as an application programming interface (API); Software for the planning, integration and optimization of Smart City applications; Computer application software for use in implementing the Internet of Things [IoT]; Software for the planning, integration and optimisation of smart city applications; Downloadable applications; Telecommunications software; Educational tablet applications; Computer software platforms for social networking; Personal computer application software for document control systems; Software testing software; Downloadable software in the nature of a mobile application for dark kitchen delivery and ordering; Enterprise software; Software for tablet computers; Software for online messaging; E-commerce software; Networking software; Simulation software for use in digital computers. none of the foregoing is in relation to musical sound recordings and music-related software.*

**Class 16:** *Printed matter; Cartoon strips [printed matter]; Printed matter for instructional purposes; Printed paper signs; Printed promotional material; Printed paper labels; Printed booklets; Printed packaging materials of paper; Printed books; Printed stationery; Printed paper invitations; Photographs [printed]; Printed photographs; Printed material in the nature of color samples; Printed teaching material; Printed pamphlets; Printed lessons; Printed periodicals; Printed advertisements; Printed invitations; Printed visuals; Printed cardboard invitations; Printed patterns; Forms, printed; Printed forms; Printed publications; Publications (Printed -); Printed manuals; Printed brochures; Printed cards; Printed menus; Printed reports; Printed charts; Printed timetables; Timetables (Printed -); Printed leaflets; Printed lectures; Printed information sheets; Printed coupons; Printed diplomas; Printed informational sheets; Printed diagrams; Printed advertising boards of paper; Printed calendars; Printed instructional material on telecommunications; Printed horoscopes; Printed plans; Printed educational materials; Printed informational cards; Printed flyers; Printed teaching materials; Printed tickets; Printed tables; Printed emblems; Printed newsletters; Printed informational folders; Printed publications relating to computers; Printed stories in illustrated form; Printed curricula; Printed guides; Printed art reproductions; Printed certificates; Printed*

*survey answer sheets; Printed vouchers; Printed luggage labels; Dye-sublimation print paper; Paper for printing photographs; Printed consumer reports; Printed paper signs featuring table numbers for use for special events. none of the foregoing is in relation to music-related entertainment services.*

**Class 35:** *Rental of advertising space; Rental of advertising space on the Internet for employment advertising; Advertisement billboards (Rental of -); Rental of billboards; Advertisement hoarding rental; Providing and rental of advertising space; Leasing of advertising hoardings; Leasing of advertising billboards; Rental of digital billboards; Advertising; Advertising and marketing; Hire of advertising hoardings; Advertising, marketing and promotional services; Marketing, advertising, and promotional services; Advertising, promotional and marketing services; Advertising services of a radio and television advertising agency; On-line advertising and marketing services; Advertising services; Rental of publicity equipment; Promotional and advertising services; Promotional advertising services; Advertising and publicity services; Advertising copywriting; Online advertising; Digital advertising services; Rental of sales stands; Promotion, advertising and marketing of on-line websites; Advertising of cinemas. none of the foregoing is in relation to music-related entertainment services.*

**Class 36:** *Sponsorship (Financial -); Financial sponsorship; Fundraising and financial sponsorship; Financial sponsorship and patronage; Financial sponsorship services; Financial sponsorship of esports activities; Financial sponsorship of sporting activities; Financial sponsorship of sports events; Financial sponsorship and funding of television programs; Financial sponsorship of visual arts events; Fundraising and sponsorship; Fund sponsorship; Financial underwriting; Financial investment; Financial assistance; Financial consultancy; Consultancy (Financial -); Financial investments; Financial management of funds; Financial and monetary services. financial sponsorship and funding of visual arts events.*

**Class 38:** *Broadcasting; Radio broadcasting; Television broadcasting; Broadcasting (Television -); Television and radio broadcasting; Radio and*

*television broadcasting; Broadcasting of radio programmes; Radio broadcasting services; Radio and television broadcasting services; Television and radio broadcasting services; Television and radio transmission and broadcasting; Radio programme broadcasting; Satellite broadcasting; Broadcasting of radio and television programmes; Television broadcasting services; Broadcasting of radio programs; Radio and television programme broadcasting; Broadcasting of radio and television programs; Satellite television broadcasting; Broadcasting of television programmes; Television and/or radio broadcasting; Radio program broadcasting; Television programme broadcasting; Radio and television program broadcasting; Subscription television broadcasting; Wireless broadcasting; Interactive television and radio broadcasting; Radio, television and cable broadcasting services; Broadcasting and transmission of radio programs; Broadcasting of television programs; Cable television broadcasting; Broadcasting (Cable television -); Broadcasting and transmission of television programs; Video broadcasting; Broadcasting services; Wireless transmission and broadcasting of television programmes; Broadcasting of programmes by radio; Internet radio broadcasting services; Broadcasting of cable television programmes; Cable television broadcasting services; Broadcasting and transmission of pay-per-view television programs; Broadcasting of teleshopping programmes; Broadcast of radio programmes; Cable television broadcasting information; Operation of radio broadcasting equipment; Subscription television broadcasting services; Television broadcast transmissions; Rental of radio and television broadcasting facilities; Satellite broadcasting services; Broadcasting of programmes by television; Broadcasting of cable television programs; Radio broadcasting of information and other programs; Broadcasting and transmission of cable television programs; Rental of broadcasting apparatus for outside broadcasts; Television programme broadcasting via cable; Satellite and cable broadcasting; Digital audio broadcasting; Rental of radio broadcasting instruments; Broadcast of television programmes; Broadcasting of programmes by satellite; Satellite broadcasting services relating to entertainment; Broadcasting of television and radio programs via cable or wireless networks; Broadcasting of radio and television programs via cable or wireless networks; Cable and satellite broadcasting services; Internet broadcasting services; Broadcasting of*

*television programs via the Internet; Broadcasting of television programs using video-on-demand and pay-per-view television services; Radio and television broadcasting, also via cable networks; Rental of equipment for television broadcasting; Cable television broadcast services; Broadcast of cable television programmes; Broadcasting of financial information by radio; Broadcasting of esports events; Broadcasting of programmes via the internet; Broadcast services; Transmission of radio and television programmes; Broadcasting of financial information by television; Television and radio transmission; Satellite broadcasting services relating to business; Interactive broadcasting and communications services; Operation of broadcasting facilities; Providing information about cable television broadcasting; Television broadcasting services for mobile phones; Broadcasting of video and audio programming over the Internet; Transmission of radio and television programs; Data broadcasting services; Satellite broadcasting services relating to sporting events; Providing information about radio broadcasting; Transmission of radio and television programmes by satellite; Provision of radio broadcasting equipment for outside locations; Broadcasting services relating to Internet protocol TV; Radio telecommunications; Simulcasting broadcast television over global communication networks, the Internet and wireless networks; Rental of satellite broadcasting sets; Provision of television broadcasting equipment for outside locations; Rental of equipment for broadcasting; Rental of broadcasting equipment; Audio, video and multimedia broadcasting via the Internet and other communications networks; Broadcasting of financial information by satellite; Transmission of radio programmes. none of the foregoing is in relation to music-related entertainment services.*

**Class 41:** *Organising of sports and sports events; Sports and fitness; Sports activities; Sports coaching; Organising of sports events and of sports competitions; Organising of sports competitions and sports events; Training in sports; Sports training; Sports refereeing; Sports officiating; Education, entertainment and sports; Sports club services; Sports betting services; Tuition in sports; Sports tuition; Sports entertainment services; Sports and fitness services; Competitions (Organization of sports -); Organization of sports competitions; Training of sports players; Coaching in the field of sports;*

*Organisation of sports events in the field of football; Organisation of sporting competitions and sports events; Hosting of fantasy sports leagues; Instruction in sports; Organisation of sports tournaments; Organisation of sports competitions; Sports coaching services; Providing facilities for sporting events, sports and athletic competitions and awards programmes; Sports camp services; Organising of sports competitions; Sports competitions (Organising of -); Competitions (Organising of sports -); Providing sports news; Arranging of sports competitions; Providing sports facilities for skiing; Organization of electronic sports competitions; Arrangement of sports competitions; Providing online entertainment in the nature of fantasy sports leagues; Providing sports facilities for archery; Tournaments (Staging of sports -); Sport camps; Sports facilities (Leasing of -); Providing facilities for sports tournaments; Conducting of sports competitions; Sports education services; Winter sports instruction; Providing sports facilities for playing polo; Organising of sports events; Online sports betting services; Conducting of sports events; Operation of sports camps; Hire of sports facilities; Sports facilities (Hire of -).*

**Class 45:** *Licensing of radio and television programs; Film, television and video licensing. none of the foregoing is in relation to music-related entertainment services.*

3. On 23 June 2023, the application was opposed in its entirety by WBL based upon Section 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. WBL claims to have used the sign ‘MISFITS BOXING’ throughout the UK since June 2022 in respect of *organisation and promotion of boxing events/matches*.

5. In its pleadings, WBL claims to have acquired goodwill under the sign set out above and submits that use of the contested mark would mislead the public and cause damage, including damage to its goodwill. This misrepresentation, WBL states, is likely to deceive the public into a mistaken belief that the applied-for goods and services, if offered by ANC, are those of WBL or are associated with or endorsed by WBL, and that WBL is likely to suffer damage by way of lost profit and in the form of damage to and/or dilution of its goodwill attached to the sign. Consequently, WBL submits, use of

the contested mark would be contrary to the law of passing off. In particular, within its pleadings, WBL refers to the following facts:

- WBL has since June 2022 extensively promoted its services online under the sign through the following social media pages:
  - i. Twitter: @MisfitsBoxing (which has over 146,000 followers, many of whom are UK residents)
  - ii. Instagram: @misfitsboxing (which has over 410,000 followers, many of whom are UK residents)
  - iii. YouTube: [www.youtube.com/@MisfitsBoxing](http://www.youtube.com/@MisfitsBoxing) (which has over 114,000 subscribers, many of whom are UK residents).
- WBL has established a loyal customer base in the UK under the sign, being those who attend and/or watch boxing events.
- WBL spends approximately £200,000 per year marketing its services under the sign in the UK.
- The well-known YouTuber and rapper known as “KSI” extensively promotes the opponent’s services online under the sign through the following social media pages, which have at all times been accessed and viewed from within the UK:
  - i. Twitter: @ksi (which has over 8.8 million followers, many of whom are UK residents)
  - ii. Instagram: @ksi (which has over 12.8 million followers, many of whom are UK residents)
- By 10 March 2023 (i.e. the filing date), WBL had organised five boxing matches (four of which were in the UK) between well-known celebrities, including famous YouTubers, musicians and professional boxers. Details of those matches (the “Boxing Matches”) are set out below:

1. KSI v. Swarmz and Luis Pineda – London O2 Arena, UK – 27 August 2022
2. Jay Swingler v. Cherdleys – Sheffield, UK – 15 October 2022
3. Deen the Great v. Walid Shark – Austin, Texas – 19 November 2022
4. KSI v. Faze Temperr – London Wembley Arena, UK – 14 January 2023
5. Jay Swingler v. Nichlmao – Telford, UK – 4 March 2023

- The aforementioned boxing matches were promoted under WBL's sign and broadcasted internationally (including in the UK) via DAZN, an international sports streaming service.
- Given the extensive promotion in the UK of the boxing matches by WBL and others, as well as the significant combined social media following in the UK of the participants in the boxing matches, each match attracted a substantial number of attendees, as well as broadcast viewers and pay-per-view viewers via DAZN, many of which (i.e. viewers) are UK residents. Further, each event received significant media attention in the UK, having been reported on by outlets such as talkSPORT, The Mirror, The Daily Express and The Independent.

6. ANC filed a defence and counterstatement denying the claims made. Within its counterstatement, ANC admits that the relevant date from which WBL must establish the existence of a protectable goodwill is the filing date of the opposed application (i.e. 10 March 2023). In this connection, ANC argues that since WBL claims a date of first use in the UK of June 2022, this equates, at best, to around 7-8 months of use in the UK before the relevant date, which combined with the total number of boxing matches on which WBL seeks to rely (only four of which took place in the UK), means that it is unlikely that WBL has generated a protectable goodwill in the UK by the relevant date.

#### **ANC'S OPPOSITION AGAINST WBL'S APPLICATION NO. UK00003930871**

7. On 06 July 2023, WBL applied to register the mark UK00003930871 shown on the cover page of this decision in the UK. The application was published for opposition purposes on 06 October 2023 in respect of the following goods and services:

**Class 25:** *Clothing; headgear; footwear.*

**Class 41:** *Entertainment services, none of the foregoing related to music entertainment services; event planning services, none of the foregoing related to music concerts; sports and fitness services; organising of sports events and sports competitions; organisation, arranging and conducting of boxing matches, contests and competitions; organisation of sports tournaments; providing information about boxing match results; booking of sports personalities and celebrities for events (services of a promoter); sports activities; sports coaching; sports training and tuition; sports refereeing; sports officiating; boxing instruction; sports betting services; providing facilities for sporting events and competitions; providing sports news; ticket reservation and booking services for sporting events; presentation of live show performances, none of the foregoing related to music shows; show production services, none of the foregoing related to music show production services; information, advisory and consultancy services relating to all the aforesaid services and none of said services relating to music entertainment services, music concerts and music shows; all of the aforesaid also provided online from a computer database and/or intranets and/or extranets and/or the Internet and not related to music entertainment services, music concerts and music shows.*

8. On 1 January 2024, ANC partially opposed the application insofar as it seeks registration for the above-listed services in class 41 based upon Section 5(2)(a) of the Act. For the purposes of its opposition, ANC relies upon the class 41 services of its earlier pending application no. UK00003887822 which is objected to by WBL and which I have set out above. ANC states that it operates under the name ‘Misfits boxing’ within the fitness and wellbeing industry and that the services supplied by WBL are very similar to those ANC provides which leads to a likelihood of confusion.

9. By virtue of its earlier filing date, the application relied upon by ANC is an “earlier mark” in accordance with Section 6 of the Act. As ANC’s earlier mark is yet to be registered, it is not subject to the use conditions under Section 6A of the Act. Consequently, ANC may rely upon all of the services it has identified without demonstrating that it has used the mark. However, this is subject to the opposition

filed by WBL being rejected and to ANC's earlier application becoming registered for the services relied upon.

10. WBL filed a counterstatement in which it admits that the marks are identical but denies all of the other claims. Whilst WBL states that it has no knowledge of ANC using the mark the subject of the earlier application and puts ANC to proof of such a claim, to be successful under Section 5(2)(a) ANC does not need to prove earlier use.

11. ANC is unrepresented, whilst WBL is represented by Mills & Reeve LLP.

12. In view of the relationship between each of the above cases, on 30 January 2024 the Registrar directed under Rule 62(1)(g) of the Trade Marks Rules 2008 that they be consolidated.

13. Both parties filed evidence in chief, with WBL also filing evidence in reply. Neither party requested a hearing, but they both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **RELEVANCE OF EU LAW**

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

## **EVIDENCE**

15. WBL's evidence-in-chief consists of four witness statements from the following individuals:

- a) Joshua Morgan – Mr Morgan's witness statement is dated 8 December 2023 and is accompanied by one exhibit, being that labelled JM1 (part 1 and 2). Mr

Morgan is a Senior Legal Counsel for WMG Management Europe Limited, a parent company of WBL.

- b) Krystal Hamilton – Ms Hamilton’s witness statement is dated 8 December 2023. Ms Hamilton is a self-employed model and social media content creator/influencer who goes by the name Elle Brooke.
- c) Mike Goodall – Mr Goodall’s witness statement is dated 11 December 2023. Mr Goodall is a partner in Ringcraft Boxing Facilities.
- d) Nicole Macdermott – Ms Macdermott’s witness statement is dated 8 December 2023. Ms Macdermott is a boxing consultant.

16. ANC’s evidence-in-chief consists of a witness statement from Andrew Odame-Nyadu dated 1 April 2024. Mr Odame-Nyadu’s witness statement is accompanied by six exhibits being those labelled MF1 – MF6.

17. In addition, WBL filed evidence in reply in the form of a witness statement from Jasmine Fearnley dated 24 June 2024. Ms Fearnley is a senior associate employed by WBL’s legal representative and her witness statement is accompanied by one exhibit, being that labelled JF1. Her evidence is only a vehicle for introducing a copy of a letter she sent to ANC requesting further evidence of facts which were referred to in some of the exhibits attached to Mr Odame-Nyadu’s witness statement.

18. I do not intend to summarise the opponent’s evidence (or the submissions of the parties, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

**ACL’S UNDERTAKING TO SUBSTITUTE THE ORIGINAL APPLICANT/OPPONENT AND THE REQUEST FOR SECURITY FOR COSTS.**

19. During the course of the proceedings, it became necessary to resolve two issues which arose on these consolidated cases.

20. The first issue relates to ANC substituting the original party, namely Mr Odame-Nyadu, in both proceedings following Mr Odame-Nyadu's action to assign the application no. UK00003887822 to ANC on 12 August 2024 – this resulted in ANC becoming (a) the applicant for application UK00003887822 and (b) the opponent in the opposition against WBL's application no. UK00003930871. This issue was resolved on 08 January 2025<sup>1</sup> with the Tribunal's receipt of ANC's agreement to the undertakings that (i) any reference to the original opponent in opposition no. 445002 should be read as though it was made in ANC's name and (ii) ANC accepted liability for costs for the whole proceedings in the event of the opposition being unsuccessful.

21. The second issue is related to the first one because WBL requested the Registry to grant security for costs as it believed that Mr Odame-Nyadu had assigned the application UK00003887822 to ANC in an attempt to insulate himself from any adverse cost award and ANC appeared to have no assets or resources with which to satisfy an adverse cost award or against which an adverse cost award could be enforced. Having considered WBL's request, on 5 April 2025 the Registry gave its preliminary view under Rule 68(1) of the Trade Marks Rules 2008 that ANC was to provide security for costs in the amount of £2,000 on or before 7 May 2025. This issue was also resolved on 4 May 2025 with ANC confirming that the ordered security for costs had been paid to WBL's legal representatives.

## **MY APPROACH**

22. As it will be recalled, the ability of ANC to rely on its earlier trade mark application in the opposition against WBL's trade mark application depends on the outcome of WBL's opposition to ANC's trade mark application. Hence, I shall start with WBL's opposition which is based on Section 5(4)(a).

## **DECISION**

---

<sup>1</sup> Undertakings were given on 12.08.24 in respect of ANC's application

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

23. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

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

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

## **General principles of Section 5(4)(a)**

25. 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)."

26. 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.”

## **WBL’S EVIDENCE**

27. Mr Morgan says that WBL is a UK boxing promotional company incorporated in March 2021. He explains that Misfits Boxing is a business which was formally established as a joint venture on 20 July 2022 (i.e. less than 8 months before the relevant date of 10 March 2023) between WBL, Nightmare Entertainment LLP (a limited liability partnership owned by Olajide Olatunji (also known as “KSI”)) and Proper Loud Boxing LLC (a limited liability corporation owned by Mams Taylor). Before that time, WBL had been informally operational since June 2022, having been established for the purposes of arranging and promoting live celebrity crossover boxing events under the mark.

28. By way of background, Mr Morgan says that KSI is a famous musician, internet personality and professional crossover boxer and that his role is to bring attention to the celebrity boxing matches under the contested mark through his audience of social

media followers and also to fight in some of the matches. Mams Taylor is described as a famous music producer, talent manager and boxing promoter.

29. In addition to being involved in the day-to-day operations generally, Mr Morgan says that his role is that of a matchmaker for the boxing matches under the contested mark, in that he selects the celebrity fighters who will generate the most interest. Mr Morgan also explains that WBL's roles and responsibilities have at all times included contracting fighters and suppliers, liaising with governing bodies, procuring sponsorship and organising and promoting the boxing matches under the contested mark.

30. In terms of use of the mark in the UK, Mr Morgan reiterates the information provided by WBL in its pleadings that, by the relevant date, there were four matches which took place in the UK as follows:

- 7 August 2022 at The O2 Arena, London ("Match 1")
- 15 October 2022 at Utilita Arena, Sheffield ("Match 2")
- 14 January 2023 at the OVO Arena, Wembley, London ("Match 4")
- 4 March 2023 at the Telfort International Centre, Telford ("Match 5")

31. Mr Morgan also provides the names of the "celebrity fighters" who participated in the aforementioned matches; it suffices to say that each match included multiple fights and that most of the individuals listed are described as internet personalities, online streamers, social media and gaming influencers, OnlyFans models, and Instagram, YouTube and TikTok content creators. Although Mr Morgan describes some of the fighters as musicians (i.e. Swarmz, DTG, Ashley Rak-Su, Tom Zanetti), comedians (i.e. Sam Hyde), and television personalities (i.e. Idris Virgo, A J Bunker), I have no idea as to how notorious they are in the UK.

32. For each match, Mr Morgan also provides the total number of attendees, tickets sold, and total gross revenue made by WBL, the relevant information being provided in the form of a table which I have reproduced below:

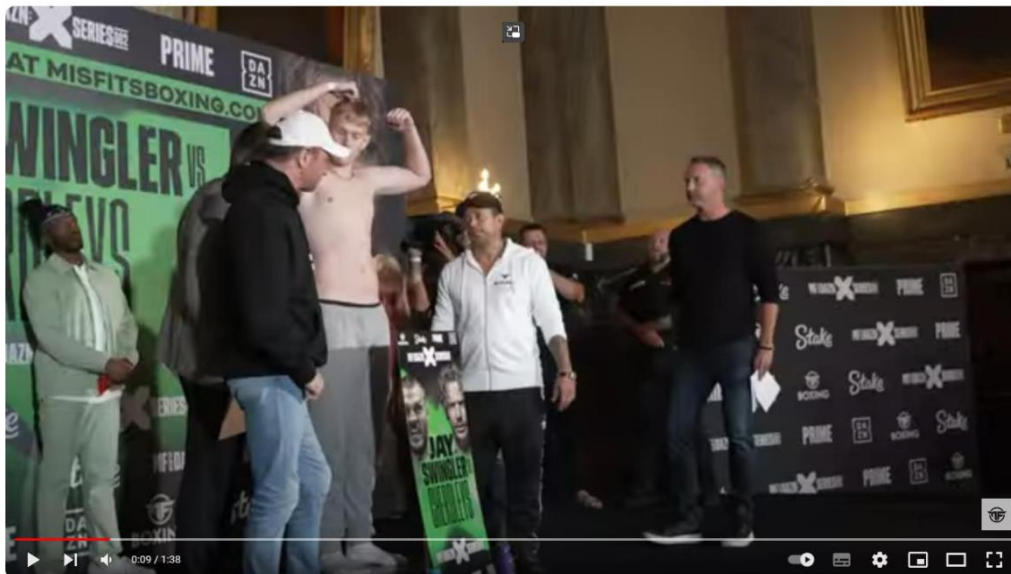
Match	Number of tickets sold	Gross Revenue
Match 1	3,639 (with total attendance, including complimentary tickets, at 15,256)	£790,220
Match 2	1,848 (with total attendance, including complimentary tickets, at 3,380)	£84,410
Match 4	7,223	£544,570
Match 5	1,937	£73,260

33. Mr Morgan states that each match was broadcasted internationally, including in the UK, via DAZN, an international sports streaming service. Mr Morgan also says that during those broadcasts, the commentators made verbal references to the contested mark and that video clips of those broadcasts were uploaded, before the relevant date on DAZN's YouTube channel at <https://www.youtube.com/@XSeriesDAZN>. In this connection, Mr Morgan provide copies of screenshots from two YouTube videos which he says were uploaded on 5 January 2023 and 7 March 2023, the former showing that the word "Misfits" was spoken by the commentator at 10:38 in the context of Match 1 as part of the phrase *"this given right yeah we'd love to see him back to some Misfits"* and the latter showing that the words "Misfits Boxing" were spoken by the commentator at 5:38 in the context of Match 5 as part of the phrase *"Telford England the hometown kid and the unknown at least the Misfits boxing"*. Although the screenshots show the total number of viewers, it is not clear how many viewers were from the UK.

34. Admittedly, there is no evidence of the mark 'Misfits' or 'Misfits Boxing' featuring on the tickets sold. Nevertheless, the exhibits show the mark being visible in relation to the promotion of the matches. In this connection, Mr Morgan explains that in order to promote each match, WBL organised a "Fight Week" which is a week of events to promote the match under the mark. Mr Morgan says that this involves:

- (a) One day of photoshoots for the celebrity fighters – however, there are no images showing whether the mark is visible in this context.

- (b) One day of the celebrity fighters engaging in an open workout. This is described as a media day where the press is invited to watch the fighters showcase their skills for 10-15 minutes each, whilst they shadowbox in a ring. Mr Morgan says that this event is also broadcast live on DAZN and on the official Misfits Boxing social media channels.
- (c) One day press conference whereby all celebrity fighters appear on stage and are asked questions to generate attention for the matches. Mr Morgan says that this event is open to the public and free to attend, whilst also being broadcast live on DAZN and on the official Misfits Boxing social media channels.
- (d) One day for the fighters to weigh in and answer questions in front of a live audience. In this connection, Mr Morgan exhibits screenshots of four videos of the weigh-ins for match 2 which took place on 14 October 2022. As shown below, the mark 'MISFITS' can be seen on the backdrop banner:



'I'LL SMILE WHEN YOU HIT ME' JMX and Ginty FACE OFF at weigh-in | Misfits Boxing

Misfits Boxing  
472K subscribers

Subscribe

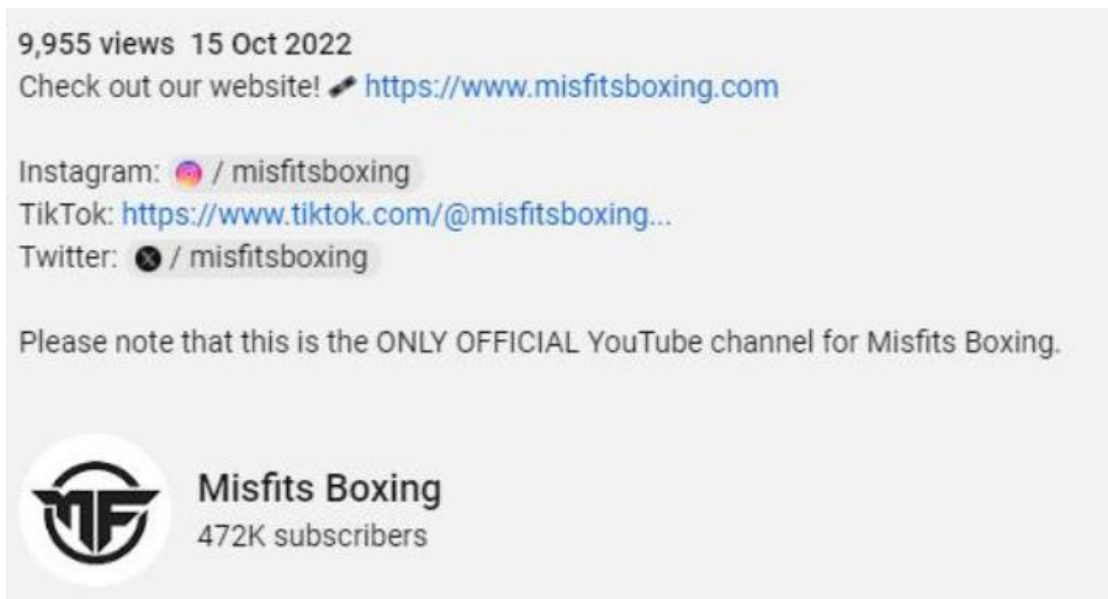
87

Share

Save

Mr Morgan says that those videos were posted before the filing date on the Misfits Boxing's official YouTube channel under the handle @MisfitsBoxing at <https://www.youtube.com/@MisfitsBoxing>. The screenshot also shows that the mark 'Misfits' is used on other social media, including Instagram, TikTok and

Twitter, where Mr Morgan says WBL had promoted each of the matches in the UK:



35. Mr Morgan says that:

- By the filing date, the Twitter account had nearly 120,000 followers, however, it is not clear how many individuals who followed the account were from the UK.
- By the filing date, the Misfits Boxing YouTube Channel had at least 57,700 subscribers, 38.6% of which were based in the UK and WBL had uploaded 208 videos promoting the matches which had been viewed a total of 1.9 million times prior to the relevant date.
- At the date of the witness statement, the Misfits Boxing Instagram account had 1,540 posts and at least 582,000 followers, 32.5% of which were based in the UK. Further, by the filing date, WBL had posted 610 posts promoting the matches on this account. By way of example, Mr Morgan produces screenshots of five such videos which shows they have been 'liked' a combined total of over 3 million times.

- At the date of the witness statement, the Misfits Boxing TikTok account had at least 1.2 million followers and 73 million likes. By the filing date, WBL had posted 214 videos promoting the matches on this account. By way of example, Mr Morgan produces screenshots of five such videos which show that they have been viewed a combined total of nearly 38 million times.

36. Mr Morgan says that WBL spent approximately £122,110 in total promoting matches 3, 4 and 5, broken down as follows: £26,812 (match 3), £57,215 (match 4) and £38,083 (match 5); however, match 3 does not count because it took place in Texas. Nevertheless, this still leaves a total of over £95K for the promotion of matches which took place in the UK prior to the relevant date.

37. Lastly, Mr Morgan says that the fighters in each of the matches were selected on the basis of their celebrity status within the entertainment industry and that of the 49 fighters, 21 are well-known British celebrities, each having a large social media following. Mr Morgan also says that all of those fighters were contractually required by WBL to promote the matches on social media under the sign. Furthermore, Mr Morgan provides the following information/evidence:

- By the filing date, KSI, a British fighter, had at least 8,700,000 followers on Twitter. KSI refers to himself in his bio as “CEO of @misfitsboxing”.
- Copies of printouts from KSI Twitter account all dated prior to the relevant date showing (i) a post which has at least 2.4 million views promoting the Fight Week for match 4 using the sign; (ii) a post which has at least 2.5 million views, announcing a 5-year partnership deal between the Misfits Boxing business and DAZN, and (iii) a post which has at least 5,500,000 views promoting match 4 using the sign by tagging the Twitter account.
- Copies of printouts from the Twitter accounts of two other British fighters named Salt Papi and Swarmz showing that posts promoting match 4 under the sign obtained nearly 200,000 and 1 million views, respectively, prior to the relevant date.

- The matches were attended by a number of well-known British celebrities. By way of example, the documentarian Louis Theroux attended match 4 and provided a ringside interview which was posted to the YouTube Channel on 14 January 2023. In the interview, Mr Theroux gave statements such as *“I love seeing a bit of boxing and there’s something about the way Misfits puts it together it really gets people involved”* and *“I just think what Misfits are doing is exciting and it’s great to be here”*. A printout of the video shows that it had been viewed 18,021 times as of 17 January 2023. Furthermore, the television presenter Holly Willoughby attended match 4 and provided a ringside interview which was posted to the YouTube channel on 14 January 2023. A printout of the video shows that it had been viewed 26,017 times as of 19 January 2023.

38. Lastly, Mr Morgan provides examples of online articles covering the matches which were published prior to the relevant date. One article published on talkSPORT at <https://talksport.com> states: *“This pact is for a new series of events promoted by KSI’s promotional company Misfits Boxing in association with...[WBL]”*. An article from The Mirror at <https://www.mirror.co.uk/> states *“Misfits Boxing returned for its second instalment following the success of KSI’s two fights in one night in August”*. An article from Manchester Evening News states *“Misfits Boxing X Series 002 gets underway on Saturday evening in the sequel to a spectacularly popular first event that had fans gripped from the get-go”*. An article published by The Daily Star talks about a fight between OnlyFans star Astrid Wett and TikTok star Keeley and says that *“the pair will go head-to-head at the Misfits Boxing and DAZN event at Sheffield’s Arena as part of a line up filled with influencers”*. This evidence further refers to other articles from UK newspapers such The Independent, The Sun, Express and The Daily Express all of which refer to the sign Misfits and to the fights organised under it.

39. The rest of the evidence consists of witness statements from the following individuals:

- A self-employed model and social media content creator/influencer who goes by the name Elle Brooke; she states that she fought under WBL’s sign in the

fourth boxing match which took place on 13 May 2023 (this must be a typo as there is evidence confirming that match 4 took place on the date given by Mr Morgan as 14 January 2023)<sup>2</sup> at the OVO Arena in Wembley and was contracted to do so by WBL.

- Mike Goodall, a partner at Ringcraft Boxing Facilities, a company which has been involved in building the boxing rings for all boxing matches under WBL's sign. He states that he has been personally aware of WBL's sign since at least July 2022 when WBL contracted Ringcraft for the design, manufacture and installation of a boxing ring for use at its first boxing match under the sign which took place on 27 August 2022 at the O2 Arena in London.
- Nicole Macdermott, a boxing consultant and founder of a talent management, brand consultancy and PR agency. She states that she managed a number of professional boxers and provided boxing consultancy services for Joe Fournier. She also explains that Mr Fournier fought against KSI in the headline event of the 7<sup>th</sup> boxing match under WBL's sign which took place on 13 May 2023 (after the relevant date) at the OVO Arena in Wembley. Lastly, she states that she attended two further matches that took place on 27 August 2022 and 4 March 2023 (prior to the relevant date).

## **GOODWILL**

40. Mr Odame-Nyadu referred in his witness statement to having established 'Misfits Boxing' in November 2021 and provided copies of flyers promoting three boxercise events under the mark 'Misfits Boxing' which were due to take place on 9 April 2022, 23 September 2022 and 14 January 2023.

41. However, as it will be recalled, in its defence, ANC admitted that the relevant date from which WBL must establish the existence of a protectable goodwill is the filing date of the opposed application (i.e. 10 March 2023).

---

<sup>2</sup> JM1 (part 2) page 34

42. Further, as noted by Ms Fearnley in the letter she sent to Mr Odame-Nyadu (copy of which was attached to her witness statement), the flyers produced in evidence are undated (which means that it is impossible to know when they were created) and Mr Odame-Nyadu failed to provide any further evidence as to the date of creation. Finally, there is no evidence about whether any of these flyers were distributed in the UK, and/or whether, where and to whom any of these events took place.

43. Hence, given (a) ANC's admission about the relevant date being the filing date of the contested mark and (b) the inability of ANC's evidence to establish that the start of the behavior complained about took place before ANC applied for the contested mark, ANC has not established an earlier relevant date for the purpose of assessing goodwill.<sup>3</sup> Accordingly, I will proceed on the basis that the relevant date for my assessment is 10 March 2023.

44. Having clarified the above, I must now turn to facts which I will assess contextually with ANC's criticisms.

45. ANC's main criticism to WBL's evidence is that the duration of WBL's use prior to the filing date of ANC's contested mark is too short to give rise to a protectable goodwill. In this connection, ANC referred to a case which it cited as "*R. v Johnstone [2003] UKHL 28*" and in which, it contended, the judge held that "*mere short-term use of a trademark does not suffice to establish the necessary goodwill to support claims of passing off*". Although the citation is correct, the quotation does not appear in that judgment. There are multiple incorrect citations and quotations contained in ANC's submissions in lieu which makes me think that they might have been produced using AI; whilst I am not going to engage now in a debate about the risks posed by litigants relying on the accuracy of AI without proper checks and verification, I will return to this point later. For now, I will only say that the proposition attributed to the case is incorrect; I say this because the test for whether a claimant may succeed in a passing-off action is whether it has a "more than trivial" or "nominal" goodwill,<sup>4</sup> the duration of the use being only one of the factors which are taken into account in determining the

---

<sup>3</sup> *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

<sup>4</sup> See *Hart v Relentless Records* [2002] EWHC 1984 (Ch) and *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20)

existence of a more than trivial goodwill - other criteria includes, for example, the scale of use. Further, there is nothing which prevents a business which has started using a sign relatively recently, to quickly build a protectable goodwill. Lastly, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill may be small.<sup>5</sup> It follows that even if the evidence did not establish that WBL had built a significant goodwill, I could still find that its trading activity had generated a sufficient goodwill to sustain an action for passing off. It is clear therefore that ANC's argument that "*goodwill requires not only a presence in the market but also continuous and extensive use that demonstrates significant consumer recognition and loyalty*" sets the bar too high. In this connection, ANC referred to another case which it cited as "*Stannard v Reay [1967] FSR 140*"; whilst that case is a real case, it is far from establishing the legal proposition ACL attributes to it, i.e. that continuous and extensive use is required to establish substantial goodwill. If anything, *Stannard v Reay* is often cited for the proposition that a small amount of trading may be sufficient to establish goodwill and that rights can be built up even in a very short period: the facts of the case are, in fact, that the plaintiffs commenced business with a mobile fish and chip van under the trade name "Mr Chippy" in October 1966 and that three weeks later the defendants independently embarked on a business under the same name. Despite the short period of trade, the court found that it was probable that the plaintiff had generated goodwill, granting a pre-trial injunction to prevent the defendant using the same sign under the law of passing off.

46. Another criticism raised by ANC is that it is impossible to know whether the tickets were sold to UK residents as opposed to non-UK residents. In this connection, ANC referred to another case whose citation is not correctly referenced (i.e. *Anheuser-Busch Inc v Budejovicky Budvar NP [1984] FSR 413*) and which does not support the legal proposition attributed to it by ANC, i.e. that it is necessary to provide clear evidence to establish the geographic origin of the customers when claiming goodwill in a particular jurisdiction - the only reference to geographical origin in that case relates to the origin of the product. Further, whilst there is case law about the requirement of territoriality when a foreign business is carried out abroad (such a requirement requires

---

<sup>5</sup> See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others [2013] EWCA Civ 590*.

that the business must have customers within the jurisdiction (i.e. the UK) as opposed to people in the jurisdiction who happen to be customers when they are abroad), I am not aware of any case law which require customers within the UK jurisdiction to be UK nationals or UK residents. In this connection, the Supreme Court in *Starbucks v British Sky Broadcasting*<sup>6</sup> stated as follows:

“Particularly in the light of what has been said in some of the cases discussed above, it appears that there are two connected issues which justify further discussion, namely (i) clarification as to what constitutes sufficient business to give rise to goodwill as a matter of principle, and (ii) resolution of the judicial disagreement as to the jurisdictional division of goodwill described by Lord Diplock in *Star Industrial*.

As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough ... . The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant’s business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant’s service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant. That is why, as explained in *Athlete’s Foot*, the decision in *Panhard et Levassor* and the observations in *Pete Waterman* are compatible with the decision in *Alain Bernardin*.”

47. It seems to me, therefore, that if *customers within the jurisdiction* means people in this jurisdiction who, by booking with, or purchasing from, an entity in this country,

---

<sup>6</sup> [2015] UKSC 31

obtain the right to receive the foreign business's service abroad, it follows that the provision of services within the UK by a UK business which trades in the UK is sufficient to give rise to a protectable goodwill in the UK, regardless of whether the customers who obtain the services in the UK are UK residents or not.

48. ANC also contends, in its submissions in lieu, that in *Taittinger SA v Allbev Ltd* [1993] FSR 641, “the court recognized the importance of demonstrating customer loyalty to establish substantial goodwill”. Whilst that case is a real case, ANC has not pointed to any specific part of that decision supporting the alleged legal proposition; in any event, the case law does not require claimants to provide evidence of customer loyalty in order to establish goodwill, and the fact that the evidence filed does not include specific evidence which ANC contends should have been filed (including repeat ticket purchases, membership subscriptions, or long-term sponsorship deals), is not fatal.

49. Another point raised by ANC is that the evidence about marketing spend is not supported by any data. I reject this criticism as the absence of corroborating evidence is not determinative. Further, Mr Morgan's evidence is unchallenged (but, if the point is a challenge, it was raised too late), and I have no reason to disbelieve it. In this connection, it is important to bear in mind that, as noted by Mr Iain Purvis KC sitting as the Appointed Person in *DAILY RITUAL*, BL-O/005/21, it is not necessary for a witness to provide documentation showing each sale, a point which equally applies to marketing spend:

“23. I see no difficulty with an informed witness summarizing in tabular form the records of his company as to the sales of a particular brand in the UK without exhibiting the actual records. Nor do I see any difficulty with them giving a general account of the lines of products sold under a brand, with some support in the form of archived website extracts, without providing documentation showing each and every item, when it was sold and for what price.”

In this connection, ANC also argues that the total amount of marketing spent in the UK (amounting to £57,215 for match 4, and £38,083 for match 5), is not substantial enough to establish a significant market presence and consumer recognition in the

UK. However, as I have noted above, for WBL to establish an actionable goodwill it has to be more than trivial, significant market presence and consumer recognition not being a requirement under the law of passing off.

50. Lastly, ANC argues that since Misfits Boxing is a joint venture between WBL, Nightmare Entertainment LLP (a limited liability partnership owned by KSI) and Proper Loud Boxing LLC (a limited liability corporation owned by Mams Taylor), any goodwill generated by this collaboration cannot be attributed exclusively to WBL. This point has some merit. It is well-established that in the absence of a contractual arrangement containing provisions governing the use of the mark, the initial vesting of goodwill in one trader or another is always a matter of fact. Wadlow on the Law of Passing-Off 6<sup>th</sup> Ed. provides the following helpful guidance as to the ownership of goodwill as between manufacturers and distributors when there is no agreement covering the ownership of goodwill:

“3-293 The factors which influence the ownership of goodwill were encapsulated by Lord Reid in *Oertli v Bowman* [[1959] R.P.C. 1, 7 HL]:

“Bowmans made and marketed the *Turmix* machines without the appellants [plaintiffs] having controlled or having had any power to control the manufacture, distribution or sale of the machines, and without there having been any notice of any kind to purchasers that the appellants had any connection with the machines.”

3-294 There are two distinct, and not necessarily consistent, standards in this passage. One is to ask who is in fact most responsible for the character or quality of the goods; the other is to ask who is perceived by the public as being responsible. The latter is (perhaps surprisingly) the more important, but it does not provide a complete answer to the problem because in many cases the relevant public is not concerned with identifying or distinguishing between the various parties who may be associated with the goods. If so, actual control provides a less decisive test, but one which does yield a definite answer.

3-295. To expand, the following questions are relevant as to who owns the goodwill in respect of a particular line of goods, or, mutatis mutandis, a business for the provision of services: (1) Are the goods bought on the strength of the reputation of an identifiable trader? (2) Who does the public perceive as responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory? (3) Who is most responsible in fact for the character or quality of the goods? (4) What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? For example, goodwill is more likely to belong to the manufacturer if the goods are distributed through more than one dealer, either at once or in succession. If more than one manufacturer supplies goods to a dealer and they are indistinguishable, the dealer is more likely to own the goodwill.”

51. In the present case, the evidence shows that WBL has acted as a promoter of the Misfits Boxing events (i.e. matches) and is the entity which issued the tickets.<sup>7</sup> Mr Morgan also says that WBL’s roles and responsibilities have at all times included contracting fighters and suppliers, liaising with governing bodies, procuring sponsorship and organising and promoting the boxing matches under the contested mark. In this connection, Mr Goodall says that it was WBL who contracted his company to build the boxing rings; likewise, Ms Hamilton says that it was WBL who contracted her to fight in a match. A number of articles also refer to WBL partnering with KSI to launch the boxing promotional company MISFITS BOXING. Admittedly, in most of the evidence produced by WBL, the name of KSI is more visible than that of WBL. However, I do not think this matters in the present case as the conflict is not between KSI and WBL, and the fact that WBL worked in partnership with KSI and is the company who brought the opposition against ANC is a circumstance which supports the conclusion that WBL is the owner of the goodwill or that they all own goodwill, in which case any of them can bring the action.

52. Turning now to WBL’s evidence, the total revenue generated by the sale of the tickets for the four matches which were held in the UK prior to the relevant date is approximately £1.5million. These matches were attended by over 27K people in the

---

<sup>7</sup> JM1 part 1 pages 7, 8

UK and were watched by many more online, although it is not clear how many viewers were from the UK. Further, a total of £95K was spent in promoting Match 4 and Match 5 in the UK. It is also clear that WBL promoted the matches under the sign 'MISFITS BOXING'. In this connection, there is plenty of evidence showing use of the sign on social media and at the events, and the online articles also refer to the matches being provided under the sign – this corroborates the conclusion that consumers perceived 'MISFITS BOXING' as distinctive of WBL's services, namely those of *organisation and promotion of boxing events/matches*.

53. Bearing in mind all of the above, I consider that notwithstanding the fact that the duration of the use was relatively short, and despite the gaps in the evidence about social media (insofar as it is not clear as to how many followers/viewers were from the UK), the marketing efforts of WBL had generated at the relevant date of 10 March 2023 a moderate goodwill, which is sufficient to sustain WBL's action for passing off. This was undoubtedly assisted by what appears to be the notoriety of KSI (an article from Manchester Evening News refers, for example, to KSI as "*a famous YouTuber turned rapper and boxer*") and of the fighters involved in the matches – on this point, whilst I have no idea about the notoriety of the fighters involved in the matches, in its submissions in lieu, ANC appears to acknowledge and accept their celebrity status.<sup>8</sup>

## **MISREPRESENTATION**

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

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

---

<sup>8</sup> See page 11, where ANC states: ".1.9 CELEBRITY ATTENDANCE DOES NOT AMOUNT TO GOODWILL. In section 24 of Joshua Morgan's witness statement, Party A references the attendance of "well-known British celebrities" at their "MISFITS BOXING" events as purported evidence of substantial goodwill. While the presence of celebrities can undoubtedly enhance the visibility of an event, it does not necessarily translate into genuine consumer recognition and loyalty, which are paramount for establishing goodwill. Goodwill requires that the public consistently associates the brand with Party A's services, rather than merely recognizing the events due to the presence of celebrities."

“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.”

55. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

56. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

57. In *Neutrogena*, Morritt L.J. stated that:

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

58. In its submissions in lieu, ANC argues that in the defence filed by WBL against ANC's opposition to WBL's trade mark application, WBL admitted that it had no knowledge of ANC's activities and that this admission directly impacts the likelihood of misrepresentation because if WBL as a direct party, is unaware of ANC's activities, it is implausible to argue that the public would be misled into believing there is a connection between the two, and the distinct nature of the services provided by ANC ensures that there is no overlap in their consumer bases.

59. For the avoidance of doubt, WBL's admission that it had no knowledge of ANC's activities is not relevant here because there is no real evidence of activity by ANC and, in any event, misrepresentation is not all about what has already occurred, it's also a *quia timet* action. Nonetheless, ANC is right in saying that where there is no common field of activity, the claimant faces an additional burden in establishing misrepresentation and damage. In this connection, ANC states that WBL's promotion of celebrity boxing events and ANC's focus on fitness and wellbeing sporting events cater to completely different consumer needs and interests.

60. In its submissions in lieu, WBL states that it has established goodwill and reputation "*in respect of the organisation and promotion of boxing events (and also in respect of advertising and promotional services generally, as well as the procurement of financial sponsorship)*". That cannot be right: in WBL's pleadings goodwill is claimed only in relation to *organisation and promotion of boxing events/matches* and WBL has not applied to amend those pleadings – hence, even if WBL had actually managed to prove that its goodwill extends to other goods and services, it could not rely on them.

61. In addition, WBL identifies a number of overlaps between the services to which its goodwill is associated and ANC's goods and services in classes 9, 16, 35, 36, 38, 41 and 45. For reasons which will become apparent, I only need to deal with the first group of services as the conclusion I reach in relation to these services is applicable to all of the other goods and services:

- Services which are either identical or highly similar:

**Class 35:** *Advertising; Advertising and marketing; Advertising, marketing and promotional services; Marketing, advertising, and promotional services; Advertising, promotional and marketing services; On-line advertising and marketing services; Advertising services; Promotional and advertising services; Promotional advertising services; Advertising and publicity services; Advertising copywriting; Online advertising; Digital advertising services.*

**Class 41:** *Organising of sports and sports events; Sports and fitness; Sports activities; Organising of sports events and of sports competitions; Organising of sports competitions and sports events; Education, entertainment and sports; Sports entertainment services; Sports and fitness services; Competitions (Organization of sports -); Organization of sports competitions; Organisation of sporting competitions and sports events; Organisation of sports tournaments; Organisation of sports competitions; Providing facilities for sporting events, sports and athletic competitions and awards programmes; Organising of sports competitions; Sports competitions (Organising of -); Competitions (Organising of sports -); Arranging of sports competitions; Arrangement of sports competitions; Tournaments (Staging of sports -); Conducting of sports competitions; Organising of sports events; Conducting of sports events.*

62. I agree with WBL that these services are sufficiently close, being either identical or highly similar to WBL's *organisation and promotion of boxing events/matches*, for misrepresentation to occur. I extend the same conclusion to the remaining services in class 35 and 41 - they are all types of advertising, marketing and sport-related services, which are in the same field as that in which WBL operates and are sufficiently broad to encompass services relate to boxing.

63. Admittedly, some of the terms in classes 35 and 41 relate to advertising and sport-related services which do not relate to boxing (i.e. *Advertising of cinemas* in class 35 and *Organisation of sports events in the field of football; Providing sports facilities for skiing; Providing sports facilities for archery; Winter sports instruction; Providing sports facilities for playing polo* in class 41). Nevertheless, as WBL correctly pointed out in its submissions in lieu, whilst the proximity of the fields of business is a relevant consideration in determining whether or not use of ANC's mark would constitute

misrepresentation, a relative lack of proximity can be offset by other factors. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. 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.' ”

64. The most important factor in this case is, in my view, the identity of ANC's mark to WBL's sign, and crucially, the fact that ANC's mark contains the word 'Boxing' which, when the mark is used in relation to the other classes that have nothing to do with boxing, will most likely result in consumers overlooking the distance between the fields of activities, and being confused into thinking that no-one else but WBL would be using that mark at all. Bearing all of the above into account, I consider that there will be misrepresentation in relation to all of the contested goods and services, because of the identity of the highly distinctive element 'MISFITS' and because the word 'Boxing' in the contested mark is capable of bridging the gap between the goods and services.

## **DAMAGE**

65. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

66. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

67. Where there is a clear overlap between the parties' services in classes 35 and 41, damage will follow misrepresentation and will result in loss of sales for WBL. In addition, where substitution is not possible, given the different nature of the goods and services involved, it is my view that damage is foreseeable in the form of damaging association and/or WBL losing control over his own reputation.

68. The Section 5(4)(a) opposition succeeds in its entirety and ANC's application is refused registration.

69. Since ANC can no longer rely on its application no. UK00003887822, in relation to which WBL's opposition has been successful, ANC's opposition against WBL's application no. UK00003930871 falls away.

## **FINAL REMARKS ON POTENTIAL USE OF AI IN SUBMISSIONS IN LIEU**

70. Whilst there have been recent cases in which the courts and the Appointed Person<sup>9</sup> have warned parties of the risks of using artificial intelligence for legal research, drafting skeleton arguments or written submissions, and I sense that ANC might have used some sort of artificial intelligence tool to draft its submissions in lieu, I accept that it might have misunderstood the references, the lack of experience being a mitigation. Hence, I do not think it would be appropriate to apply any sanction in this case.

---

<sup>9</sup> PROHEALTH, ProHealth (series of 2), PROHEALTH (figurative mark), Pro Health Solutions, case BL-O/0559/25

## **OVERALL OUTCOME**

71. WBL's opposition against ANC's application no. UK00003887822 is successful. ANC's application no. UK00003887822 will be refused in its entirety.

72. ANC's opposition against WBL's application no. UK00003930871 fails. WBL's application no. UK00003930871 can proceed to registration.

## **COSTS**

73. WBL has been successful, and it is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award WBL the sum of £2,400 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement: £400

Filing a counterstatement and considering the notice of opposition: £400

Filing evidence: £1,000

Filing submissions in lieu: £400

Official Fees: £200

Total: £2,400

74. I therefore order AN CONCRETE LTD to pay Wasserman Boxing Limited the sum of £2,400, however, since WBL has already received £2000, ANC will only need to pay a further £400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 8<sup>th</sup> day of January 2026**

**TERESA PINTO**

**For the Registrar**