O/0178/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3759523

BY NAVWAY LIMITED

TO REGISTER:

AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 434749 BY

CARYN MANDABACH PRODUCTIONS LIMITED

BACKGROUND AND PLEADINGS

1. On 26 February 2022, Navway Limited ("the applicant") applied to register the trade mark shown on the front cover of this decision in the United Kingdom in respect of the following goods:

> <u>*Class 25*</u>
> *Clothing; Clothes; Tops [clothing]; Knitted clothing; Children's clothing; Leather clothing; Gloves [clothing]; Jackets [clothing]; Ladies' clothing; Knitwear [clothing]; Denims [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Suits; Men's suits; Women's suits; Three piece suits [clothing]; Coats; Sheepskin coats; Fur coats; Overcoats; Jackets; Leather jackets; Hats; Shirts; Underwear; Socks.*

2. On 1 July 2022, the application was opposed by Caryn Mandabach Productions Limited ("the opponent"). The opponent is the co-producer of, and owner of the rights in and to, the television programme *Peaky Blinders*. The opposition is based on sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act")[1] and concerns all the goods in respect of which registration is sought.

3. Under section 5(2)(b), the opponent is relying on UKTM No. 3700495, **PEAKY BLINDERS**, which has a filing date of 24 September 2021 and a registration date of 17 June 2022. The goods relied on are as follows:

> <u>*Class 25*</u>
> *Clothing, footwear, headgear; shirts, t-shirts, pants, jackets; caps; hats; flat caps; suits; suit coats; dress suits; ties; bow ties; coats; shoes; boots.*

4. The opponent claims that the distinctive and dominant element of the contested mark is the word "PEAKY", as "CLOTHING" is descriptive of the goods in the application and the figurative element would not create a different overall impression. It argues that the contested mark is visually and aurally similar to the earlier mark relied

[1] 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.

on under this ground. The goods are, it claims, identical or at least highly similar and as a result there exists a likelihood of confusion with the earlier mark.

5. Under section 5(3), the opponent is relying on UKTM No. 917869277, **PEAKY BLINDERS**, which has a filing date of 7 March 2018 and a registration date of 11 October 2018. This mark is a comparable mark and so retains the filing date of the EU Trade Mark from which it was created. The opponent claims that this mark has a significant reputation for the following goods and services:

> _Class 9_
> *Pre-recorded DVDs featuring crime dramas; Downloadable digital audio and video recordings containing crime dramas; Downloadable television programmes and video recordings featuring crime dramas; data carriers, including DVDs and CDs with recordings of sound, images, music recordings, movies, television programs; downloadable video and sound recordings.*
>
> _Class 41_
> *Entertainment in the form of a television series containing crime drama; Providing online information in the field of television and video entertainment containing crime dramas via the internet; Entertainment in the form of non-downloadable videos and images containing television programmes about crime dramas transmitted via the internet and wireless communication networks; Production, presentation and distribution of audio and video works and materials, including television programs, television shows and films containing crime dramas; entertainment; educational and entertainment services including the production and presentation of audio and video works and materials including television programs, radio programs and films; theatrical, musical, television and film entertainment services; providing digital video and or audio recordings (not downloadable) via a computer network such as the Internet; Interactive television entertainment in relation to crime dramas; production of live television programs.*

6. The opponent claims that the dominant and distinctive element of the contested mark (“PEAKY”) is highly similar to the earlier mark relied on under this ground. It adds that characters in the drama series that uses the earlier mark are known for wearing flat caps, like the one shown in the figurative element of the contested mark. It argues

that it is common for films and television shows to license official merchandise such as clothing. Consequently, the relevant public will believe that the contested mark is being used by the opponent or that there is an economic connection between the parties. The public would make a link between the two marks and this would cause the consumer to bestow on the applicant's goods the qualities associated with the goods and services for which the earlier mark has a reputation. Such use would take unfair advantage of this reputation. Damage may also occur to the opponent's reputation if the goods sold by the applicant are of lower quality and attract poor publicity or adverse customer feedback. The link would also be likely to weaken the ability of the earlier trade mark to identify the goods and services as being connected to the opponent and so dilute the attractive power of the earlier mark.

7. Under section 5(4)(a), the opponent claims to have used the following signs throughout the UK since September 2013 in connection with *Television series, pre-recorded goods including DVDs, entertainment services, and licensing accompanying merchandise*:

PEAKY BLINDERS

8. The opponent claims to have built up goodwill under these signs and that use of the contested mark for the applied-for goods would give rise to a misrepresentation that the goods were from, or were connected to, the opponent and that this would damage the opponent's goodwill. Consequently, use of the contested marks would be contrary to the law of passing off.

9. Under section 3(6), the opponent claims that the applicant must have known about the reputation and success of the television programme *Peaky Blinders* and made the

application with the purpose of securing a monopoly for itself and appropriating the goodwill and reputation in the programme, not to engage fairly in competition but in a manner inconsistent with honest practices and undermining the interests of the opponent. The opponent claims that the application amounts to bad faith and in particular cites the decision of the Court of Justice of the European Union ("CJEU") in *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ v European Union Intellectual Property Office ("EUIPO")*, Case C-104/18 P and the decision of the Cancellation Division of the EUIPO in *Caryn Mandabach Productions Limited v Chaos Brothers UK Limited (PEAKY BLINDERS)*, No. 000032441, dated 19 May 2020.

10. The applicant filed a defence and counterstatement denying the claims made. In particular, it argues that the figurative element is the dominant and distinctive element of the contested mark, that the phrase "peaky clothing" alludes to a style of British headgear and clothing from the 1920s, and that the dominant and distinctive element of the earlier marks is the word "BLINDERS". It continues:

> "9. The name 'peaky blinders' carries a very clear and precise meaning. It refers to the characters in the eponymous gang featured in the television series Peaky Blinders which is produced by the Opponent and Banijay Group SAS and their proclaimed capacity to blind their enemies by using a razor blade stitched into the peak of their caps."

11. It also argues that:

> "16. … the Opponent is effectively seeking to assert trade mark rights over sales of an entire style of vintage clothing namely 'peaky' (also known as 'peaked cap') headwear and related clothing with the effect of suppressing entirely legitimate commercial activities. Peaky hats and related clothing have formed part of popular culture for many years. The popularity of this style of hatwear and clothing long predates the recent television show 'Peaky Blinders'. The Opponent does not own intellectual property rights in this style of hat wear and related clothing which is part of popular culture and not *owned* by anyone."

12. Only the opponent filed evidence. It comes in the form of a witness statement from Susan Waddell dated 31 January 2023. Until January 2023, she was the Commercial

Director of Caryn Mandabach Productions Limited and at the time of the witness statement she was a consultant to the opponent. Her evidence goes to the reputation of the earlier mark relied on under section 5(3) and the claimed goodwill. She also gives evidence relating to the applicant's use of the contested mark and the phrase "Peaky Blinders". The opponent filed written submissions on 31 January 2023.

13. Neither party requested a hearing or filed final written submissions.

14. In these proceedings, the opponent is represented by Wiggin LLP and the applicant by Panoramix Limited (having previously been represented by Lawbriefs Ltd).

DECISION

15. I find it convenient to deal with the section 5(3) ground first.

Section 5(3)

16. Section 5(3) of the Act is as follows:

> "A trade mark which–
>
> (a) is identical with or similar to an earlier trade mark,
>
> […]
>
> shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

17. The earlier mark relied upon by the opponent under this ground is a comparable trade mark and so Paragraph 10 of Part 1 of Schedule 2A of the Act applies. It says:

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

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

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

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

18. The relevant case law can be found in the following judgments of the Court of Justice of the European Union ("CJEU"): *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-383/12 P). The law appears to be as follows:

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

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

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

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that

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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) 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.

i) 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 on the earlier mark; *L'Oréal*, paragraph 40.

j) 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal.*

Reputation

19. In *General Motors*, the CJEU held that:

"24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

20. The relevant date on which the opponent must show a reputation is the date of application for the contested mark, i.e. 26 February 2022. For the period up to 31 December 2020, the relevant territory is the EU (which then included the UK); for the period after that date, it is the UK alone.

21. *Peaky Blinders* is the name of a crime drama series co-produced by the opponent and broadcast in the UK on BBC television. The BBC commissioned the opponent and Tiger Aspect Productions Limited to develop the programme under its General Terms which confirmed that the rights to the programme trade marks remained with the co-producers and that the BBC was granted an exclusive, royalty-free, irrevocable licence to use the programme trade marks.[2]

22. The show begins in 1919 and features the fictitious Shelby family that runs the Peaky Blinders gang in Birmingham, then London and the United States. The final series is set in 1933. Ms Waddell explains that:

> "28. Throughout all series of the Programme, the Peaky Blinders gang are known for their distinctive dress, comprising sharp suits and a distinctive hat. The name of the gang alludes to the hat worn by its members: a peaked flat cap into *[sic]* with a razorblade sewn into the peak, which could then be used as a weapon. Within the universe of the Programme, it is the clothing of the Peaky Blinders that causes them to be recognised and feared."

23. Exhibit SW-3 contains stills from the programme illustrating the characters' dress. See, for example, the image below:[3]

[2] Exhibit SW-1.
[3] Exhibit SW-3, page 6.

24. The following table shows the dates on which episodes were first broadcast:[4]

Series	Dates first broadcast
1	12 September 2013, 19 September 2013, 26 September 2013, 3 October 2013, 10 October 2013, 17 October 2013.
2	2 October 2014, 9 October 2014, 16 October 2014, 23 October 2014, 30 October 2014, 6 November 2014.
3	5 May 2016, 12 May 2016, 19 May 2016, 26 May 2016, 2 June 2016, 9 June 2016.
4	15 November 2017, 22 November 2017, 29 November 2017, 6 December 2017, 13 December 2017, 20 December 2017.
5	25 August 2019, 26 August 2019, 1 September 2019, 8 September 2019, 15 September 2019, 22 September 2019.
6	27 February 2022, 6 March 2022, 13 March 2022, 20 March 2022, 27 March 2022, 3 April 2022.

25. The earlier mark is shown in the opening credits for each episode, with the image below taken from Episode 1 of Series 5:[5]

26. The average audience figures for each series are shown in the table below. These figures take into account viewers from replays of the programme:[6]

Series	Average Audience
1	2,700,000
2	2,400,000
3	2,800,000
4	4,900,000
5	7,400,000
6	7,100,000

[4] Witness statement of Susan Waddell, paragraph 22.
[5] Paragraph 32.
[6] Paragraph 41.

27. The programme was also available via the Netflix streaming service from September 2014.[7]

28. By the fifth and sixth series, each episode enjoyed around a 25% share of the UK television audience when first broadcast.[8] Although the sixth series was broadcast shortly after the relevant date, it is my view that this evidence sheds light backwards on the level of knowledge of the mark on the relevant date among the audience for TV crime dramas, which I consider to be the relevant public. The programme is unlikely to have attracted such high viewing figures without such knowledge.

29. Exhibit SW-7 contains information on audience demand for the programme. This is measured in "Average demand expressions per 100 capita". The methodology used to produce these figures is not entirely clear but is described by the responsible TV analytics company, Parrot Analytics, as

> "The global TV measurement standard developed by Parrot Analytics, which represents the total audience demand being expressed for a title, within a market. Audience demand reflects the desire, engagement and viewership, weighted by importance; so a stream/download is a higher expression of demand than a 'like'/comment."[9]

However, the exhibit provides some information on demand in other EU Member States:

	Average Demand Expressions® per 100 capita			
Market	**2018**	**2017**	**2016**	**2015**
United Kingdom	6.592	4.583	2.914	1.867
Ireland	6.008	6.704	5.056	2.400
France	6.549	3.770	2.744	1.042
Germany	2.220	1.269	0.930	0.461
Spain	3.452	1.852	2.039	1.161
Italy	2.702	1.154	0.609	0.278
The Netherlands	3.051	1.260	1.024	0.468
Poland	3.161	2.254	1.509	0.856
Sweden	1.632	0.879	0.858	0.342

[7] Paragraph 23.
[8] Paragraph 38.
[9] Page 1.

What I take from this evidence is that there was a degree of knowledge of the earlier mark in connection with a television programme in Member States other than the UK.

30. Ms Waddell states that Exhibit SW-8 contains data relating to downloads of the programme and DVD sales. She says that over £5,300,000 worth of DVDs and downloads have been sold in the UK. However, I find that this exhibit is not easy to understand. The first page contains a table showing sales against individual episodes and whole series. They are divided into "DTO/EST" (an abbreviation that is not explained but I am assuming refers to downloads) and "DVDs" for the UK and for Ireland. This table is undated so it is impossible to tell when these sales were made. The second page is undated and shows sales for the fifth series, as follows:

BBC WW as at March 2021

DTO / EST Unit Sales:	270
DVD / BLU Ray Unit Sales:	2,212

Arte as at 8th Feb 2021

BLU Ray Season 5 Unit Sales:	1,459
DVD Season 5 Unit Sales:	4,387
BLU Ray Season 1-5 Unit Sales:	2,709
DVD Season 1-5 Unit Sales:	8,044

The exhibit does not say where these sales were made. The rest of the exhibit contains a spreadsheet which states that £5,321,912 worth of DVDs and downloads were sold by BBC Studios Distribution Limited, £513,339 by ARTE France Développement, £48,980 by Entertainment One Benelux BV. There may have been sales made in other EU Member States, although this is not obvious from the names of the distribution companies (for example, it is possible that Plaion Pictures GmbH is a German or Austrian distributor, but it could equally be Swiss). Furthermore, this information is undated.

31. I now come to what the evidence shows about the activities undertaken to promote the mark. Before each series, the BBC broadcast trailers, with the trailer for the sixth

series first shown on 1 January 2022.[10] Four days before the launch of Episode 1 and three days before the relevant date, i.e. on 23 February 2022, the BBC broadcast a video recapping the events of the previous five series.[11] Further promotional activities have included posters, an exhibition at Birmingham Library in 2014, and “red carpet” premiere events to launch the first episode of each series from the second series onwards.

32. The programme has received press coverage coinciding with the broadcast of each of the series and Ms Waddell provides some examples in Exhibits SW-18 to SW-23. Publications include *The Daily Telegraph, The Times, Birmingham Post, Daily Mail, Daily Mirror, The Guardian* and date from 2 September 2013 to 25 February 2022. Many of these articles refer to the stylishness of the programme and its high production values.

33. Awareness has also been spread through various social media channels. The following table shows the number of UK followers (and their share of the total) in 2018 and 2021:[12]

	2018		**2021**	
	UK Followers	**UK Share of Followers**	**UK Followers**	**UK Share of Followers**
Twitter/X	179,050	48%	278,460	35%
Facebook	367,832	n/a	566,999	19%
Instagram			480,200	9.8%

Ms Waddell also states that at some point the Instagram account had 24% of its followers in the UK (equating to 227,769). No date is given.

34. Exhibit SW-27 contains data on visits to the programme’s BBC website pages. Between 2 October 2017 and 30 September 2018, there were 4,303,586 page views from the UK, 119,710 from Ireland, 53,947 from France, 50,591 from The Netherlands, 43,170 from Spain and 33,764 from Germany. There were over 10,000 views from each of Greece, Italy, Belgium, Poland and Sweden. The exhibit also includes data

[10] Paragraph 68.
[11] Paragraph 69.
[12] Paragraphs 78-82 and the exhibits cited.

showing visits to the programme's fan website, www.peakyblinders.tv, but the period covered here is 18 January 2019 to 24 January 2023.

35. The programme has received numerous awards since the first series and these are shown in the table below.[13] I have not included awards for the sixth series, which was broadcast after the relevant date.

Series	Award	Category
1	2014 BAFTA Television Craft Awards	Best Director: Fiction
		Best Photography and Lighting: Fiction
	2014 RTS Programme Awards	Best Drama Series
	2014 RTS Craft & Design Awards	Best Costume Design: Drama
		Judges' Award
	2014 C21 Drama Awards	Editors Choice Award
2	2015 IFTA Film and Television Awards	Best Costume Design
3	2017 Irish Film and Television Awards	Best Leading Actor in a Drama Series (Cillian Murphy)
4	2018 BAFTA Television Awards	Best Drama Series
	2018 TBI Content Innovation Awards	Best Returning Drama Series
		Series Launch of the Year
5	BAFTA TV Craft	Make Up & Hair Design
	2020 National Television Awards UK	Best Drama Performance (Cillian Murphy)
	2020 TV Choice Awards UK	Best Drama Series

36. The majority of the evidence relates to the UK. I have already noted that the fact that the earlier mark relied on under this ground is a comparable mark based on an EUTM means that I must consider use in the EU for the period up to 31 December 2020. However, I remind myself that the CJEU held in paragraphs 20-30 of its judgment in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07 that an EUTM may be considered to have a reputation if it is known by a significant part of the relevant public in a substantial part of the territory of the European

[13] Paragraph 73. Nominations are also shown in paragraph 74.

Community and that the territory of a single Member State may be considered as satisfying that requirement. Additionally, in *Whirlpool Corporation & Ors v Kenwood Limited* [2009] ETMR 5 (HC), Mr Geoffrey Hobbs QC, sitting as a Deputy Judge of the High Court, held that the UK could be regarded as a substantial part of the Community.[14]

37. On the basis of the evidence summarised above, I am satisfied that the opponent has shown that the earlier mark has a reputation for the TV drama, but I do not consider that it extends beyond this to the more general television or wider entertainment services, such as *Production of live television programs*. Neither do I see any evidence of the provision of interactive television entertainment. The evidence on DVDs and downloads is sparse and, in my view, insufficient to support a finding of a reputation for the Class 9 goods. I find that the opponent has shown that the earlier comparable mark had a strong reputation at the relevant date for the following services:

> <u>*Class 41*</u>
> *Entertainment in the form of a television series containing crime drama; Entertainment in the form of non-downloadable videos and images containing television programmes about crime dramas transmitted via the internet and wireless communication networks; Production, presentation and distribution of … video works and materials, namely television programs, television shows … containing crime dramas.*

Link

38. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

39. The similarity between the marks must be assessed here in the same way as it would be under section 5(2): see *Adidas Salomon*, paragraphs 28-29.

[14] Paragraph 76.

40. It is established case law that the average consumer, through whose eyes similarity of the marks is assessed, normally perceives a mark as a whole and does not proceed to analyse its various details: see *SABEL BV v PUMA AG*, Case C-251/95, particularly paragraph 23. The CJEU also explained in this case 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. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo SA v OHIM*, Case C-519/12 P, paragraph 34.

41. The respective marks are shown below:

Contested mark	**Earlier mark**
PEAKY CLOTHING	PEAKY BLINDERS

42. The earlier mark is a plain word mark. Registration of such marks protects the word or words contained in the mark irrespective of case, colour or typeface: see *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39. In my view, the average consumer will see the word "PEAKY" as an adjective that qualifies the word "BLINDERS". For a significant proportion of the average consumers of the opponent's services and the applicant's goods, the mark will bring to mind the opponent's television programme and the gang featured in it.

43. The contested mark is a composite mark containing verbal and figurative elements. The latter appears on the left of the mark and consists of a skull-like face, sporting a moustache and bushy black beard. On top of the head is a baggy, peaked cap with a button in the centre. The device is shown in black and white. The verbal element consists of two words – "PEAKY" and "CLOTHING" – in a standard, upper-case typeface, presented over two lines. The second of these words is descriptive of the

contested goods. I note the claim made by the applicant in its counterstatement that "PEAKY CLOTHING" would be understood to refer to a style of clothing from the 1920s. I am unaware of such use and the applicant has filed no evidence to substantiate this claim. However, I consider that the device is likely to reinforce the perception that "PEAKY" refers to a style of headgear. The courts have held that word elements tend to be more distinctive than figurative elements, as these are more readily used to refer to the origin of the goods and services in question: see *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37. I consider this to be the case here and, as "CLOTHING" is descriptive, it is "PEAKY" that makes the greatest contribution to the overall impression of the mark. The role of the device is lesser, but its position and striking appearance lead me to find that its contribution is far from negligible.

44. Turning now to the visual comparison, I remind myself that I should not simply ignore descriptive elements: see *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd (PURITY HEMP COMPANY IMPROVING LIFE AS NATURE INTENDED)*, BL O-115-22, paragraph 31. The earlier mark and the verbal element of the contested mark both have two words, the first of which is the same. The second words, and the presence of the device in the contested marks, are points of difference. I bear in mind the tendency of the average consumer to pay more attention to the beginning of marks than to the end, while acknowledging that this is not a hard and fast rule: see *El Corte Inglés SA v OHIM*, Joined Cases T-183/02 and T-184/02, paragraphs 81-83. Considering each mark as a whole, I find that there is a low degree of visual similarity between them.

45. The verbal element is the only part of the contested mark that will be articulated. Both marks therefore have four syllables, of which the first two are identical. The words are common English words and will be pronounced in the usual way. I find that there is a medium degree of aural similarity between the marks.

46. I have already touched on the conceptual messages conveyed by the marks. The earlier mark will bring to the mind of a significant proportion of the public the television series of that name, the gang and its distinctive headgear. Turning now to the contested mark, I note that the word "PEAKY" has a number of meanings, but in the context of the goods for which registration is sought it will, in my view, be perceived as

referring to a style of headgear. This message would be reinforced by the hat shown in the device. The skull-like face and black expanses where the eyes would lend an edgy appearance to this device. The beard and moustache evoke a different time period from that of the TV programme. I consider that the marks are conceptually similar to no more than a medium degree.

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

47. The parties' goods and services would be dissimilar for the purposes of a section 5(2)(b) claim. The relevant factors were set out in paragraph 23 of the CJEU's judgment in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, and by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary. The only similarity is in user, as both the goods and services are aimed at the general public, but this is not sufficient for me to find similarity overall.

48. The opponent submits that the relevant public is accustomed to seeing rights associated with television programmes and films used on items of merchandise, such as clothing. It has provided some examples in Exhibit SW-29 of clothing merchandise associated with the television shows *Masterchef*, *Game of Thrones, Doctor Who, Stranger Things* and *Breaking Bad* and the film series *Batman* and *Harry Potter*. I consider that the evidence supports the opponent's submission, which also accords with my experience as a consumer.

49. The earlier mark has itself been licensed on a range of merchandise, including clothing.[15] The table below shows the number of units sold, but it does not break the figures down into types of goods sold. There are no screenshots dated before the relevant date, but the narrative evidence is unchallenged, and so I accept that the opponent licensed the earlier mark for use on a variety of goods including clothing.

[15] Witness statement of Susan Waddell, paragraphs 92-93.

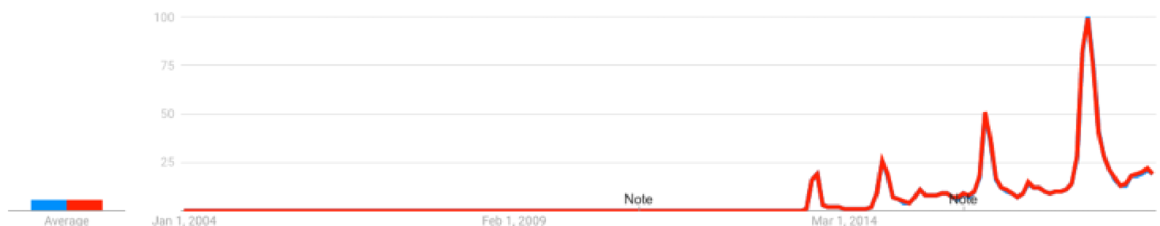
Year	Number of units sold exceeding
2019	130,000
2020	102,000
2021	164,000
2022 (Q1)	32,000

The strength of the earlier mark's reputation

50. I have already discussed the evidence adduced to show the reputation of the earlier trade mark. I found it to be strong.

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

51. The two words that comprise the earlier mark are words in ordinary English usage. The evidence indicates that there was a real-life gang in Birmingham that went by the name "Peaky Blinders".[16] However, the opponent has adduced evidence from Google Analytics to show that before the first series was broadcast in September 2013 the number of searches for "Peaky Blinders" was negligible. In the graph below, the blue line is for "Peaky Blinders", while the red line is for "Peaky Blinders (Television series)".[17]



52. I find that the inherent distinctive character of the earlier mark for the services for which I found a reputation is slightly higher than medium, because of the striking combination of two ordinary words. When assessing whether this inherent distinctive character has been enhanced through use, the same factors are relevant as those that

[16] See, for example, the report on the BBC website about the exhibition arranged to coincide with the second series of the programme. This can be found in Exhibit SW-11.
[17] Exhibit SW-04.

I discussed under “Reputation”. This time, the relevant territory is the UK as it is through the eyes of the relevant public in the UK that I must consider whether there is a link. In my view, the press coverage, promotional activity, viewing figures and awards are such as to enhance the distinctive character of the earlier mark to a high degree.

Whether there is a likelihood of confusion

53. The dissimilarity between the goods and services would have precluded a finding of likelihood of confusion under section 5(2)(b). However, there are some instances where some marks are so highly distinctive and well known that there is likely to be some confusion almost irrespective of the goods or services in relation to which they are used, as my colleague, Mr Allan James, explained in *Lazard & Co., Holdings Ltd v Lazard Consulting Ltd*, BL O-359-15, paragraph 55. It is not clear to me from the submissions of the opponent whether it is arguing that this would be such a case. However, in my view, the marks are not sufficiently similar to overcome the dissimilarity between the goods and services. I find there to be no likelihood of confusion.

Conclusions on link

54. There does not need to be a likelihood of confusion for a link to be established in the mind of the relevant public: see *Adidas-Salomon*, paragraph 27. The strong reputation and the enhanced distinctive character of the earlier mark point towards a finding that there is a link. I have found that the marks are visually similar to a low degree, aurally similar to a medium degree, and conceptually similar to no more than a medium degree. There are noticeable differences between them. However, I consider that the device will increase the likelihood of a link being created in the mind of the relevant public, given the reputation of the earlier mark. This is because it features a peaked cap that appears highly similar to those worn by some of the main characters. This can be clearly seen by comparing the mark with stills from the programme and artwork used for the DVDs and advertising, see for example the DVD for series 3, shown below:[18]

[18] Exhibit SW-09, page 1.

55. Taking all the factors into account, I consider that a link would be created in the mind of the relevant public.

Damage

56. The opponent claims that damage would occur through the applicant taking unfair advantage of the earlier mark's reputation, or through the dilution or tarnishment of the earlier mark. I shall deal with the claim on unfair advantage first.

57. Unfair advantage means that consumers are more likely to buy the goods and services of the contested mark than they would otherwise have been if they had not been reminded of the earlier marks. In *L'Oréal*, the CJEU said:

> "50. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third

party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation 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."

58. Earlier in the same case, the CJEU also said:

> "41. As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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."

59. In *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods and/or services offered under the later trade mark was required to establish unfair advantage. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited & Anor* [2019] EWHC 2003 (IPEC).

60. I have already referred to the reputation of the earlier mark for stylishness and high production values. This is an image that would be attractive in the goods for which registration is sought. The consumer is likely to have the style of clothing worn in the series in their mind when they see the contested mark. In my view, the image would be transferred and this would make it more likely that the consumer would buy the goods of the applicant rather than those of another trader. I find that damage through unfair advantage is made out.

61. The applicant has not pleaded that it has due cause to use the mark and so the opposition succeeds fully under section 5(3).

62. As I have found there to be unfair advantage, I shall not consider the other heads of damage pleaded by the opponent.

63. For completeness, I shall consider the other grounds.

Section 5(2)(b)

64. Section 5(2) of the Act is as follows:

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

65. The earlier mark relied on under this section, UKTM No. 3700495, was registered on 17 June 2022 and so is not subject to the proof of use provisions in section 6A of the Act. The opponent may rely on all the goods for which that mark stands registered.

66. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

> 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater degree of similarity between the marks and vice versa;

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

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

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

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

Comparison of goods

67. Where goods (or services) in the specification of one party are included in a broader term from the other party's specification, those goods (or services) are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. All the contested goods are included in the opponent's *Clothing* or *Headgear* and so I find that they are identical.

Average consumer and the purchasing process

68. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: see *Lloyd Schuhfabrik*, paragraph 26.

69. The average consumer *of Clothing* and *Headgear* is a member of the general public. The consumer will buy the goods from a clothing retailer or a department store, either visiting a physical shop or ordering from the internet or a printed catalogue. This means that the mark will be seen and so the visual element will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. However, I do not discount the aural element, as the consumer may in some cases be assisted by a member of staff. The price varies, but in many cases these goods will be frequent purchases. The consumer will pay attention to the size, the materials, the style and colours to ensure they buy a garment that fits them and achieves the effect they desire. In my view, the average consumer of these goods will be paying a medium degree of attention.

Comparison of marks

70. I have already compared the marks and I adopt the findings I made in paragraphs 39-46 above.

Distinctive character of the earlier mark

71. Under section 5(3), the opponent was able to rely on services in Class 41. However, my findings on inherent distinctive character apply equally in respect of the Class 25 goods relied on under section 5(2)(b). The earlier mark is not allusive or descriptive. I have insufficient information to assess the extent of its use in relation to the goods at issue and so I am unable to find that the distinctive character of the mark has been enhanced. It remains at its inherent level of slightly higher than medium.

Conclusions on the likelihood of confusion

72. The likelihood of confusion must be assessed globally, taking into account all relevant factors. I am required to consider the question from the perspective of the average consumer and should also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

73. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

74. In my view, there are sufficient differences between the marks for them not to be mistaken for each other, even though the goods are identical. I have already found that the average consumer would perceive "PEAKY" in the earlier mark to be qualifying the noun "BLINDERS". The term as a whole has a meaning different from its separate

parts. In addition, the device in the contested mark will not be overlooked. Even bearing in mind the imperfect recollection of the average consumer, I do not consider that there is a likelihood of direct confusion.

75. I come now to indirect confusion. In paragraph 17 of his decision in *LA Sugar*, Mr Iain Purvis QC, sitting as the Appointed Person, gave the following examples of when indirect confusion could occur:

> "(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI', etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

76. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

> "12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.
>
> 13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a

likelihood of indirect confusion given that there is no likelihood of direct confusion."

77. I also bear in mind the comments of Mr James Mellor QC (as he then was), sitting as the Appointed Person, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, that

> "81.4 … I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: 'Taking account of the common element <u>in the context of the later mark as a whole.'</u> (my emphasis)."

78. The opponent submits that, because of the reputation the earlier mark has in relation to the television programme and the argument that I have accepted that the average consumer is accustomed to seeing licensed and authorised merchandise associated with successful television programmes and films, there is a risk that the average consumer might believe that the applicant's goods come from the opponent or an undertaking related to the opponent.

79. I have accepted that a proportion of consumers will understand the earlier mark to mean the television programme *Peaky Blinders*. If they were to see clothing sold under the mark "Peaky Blinders", I am of the mind that they would assume that the goods were authorised by the holder(s) of the rights in that trade mark. However, I do not consider that they would make the same assumption on encountering the contested mark, given the differences between the marks. The shared element "PEAKY" would, in my view, call the earlier mark to mind, but, as Mr Mellor said in paragraph 81.3.3 of *Duebros*, this is *"mere association"*, not confusion. I find there is no likelihood of indirect confusion.

80. The opposition fails under section 5(2)(b).

Section 5(4)(a)

81. Section 5(4)(a) of the Act states that:

> "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 or 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 4(A) is met
>
> …"

82. Subsection 4(A) is as follows:

> "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."

83. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off at [406]:

> "First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the

defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

Relevant date

84. In *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220, Kitchin LJ (as he then was) said:

> "165. … Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the [contested] trade mark would have amounted to passing off. But if the [contested] trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began."

85. Ms Waddell states that the applicant operates a website, http://peakyclothing.com, that was registered on 7 January 2022, six days after the BBC first broadcast the trailer for the sixth series of the TV programme.[19] Screenshots from the Wayback Machine Internet Archive show that clothing and headgear were being offered for sale on this website by at least 18 May 2022. Evidence is also provided of the applicant's social media accounts. There is, however, no evidence of any trading or promotional activity before the date on which the contested application was made. Therefore, the relevant date for the purposes of section 5(4)(a) is 26 February 2022.

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[19] Paragraph 102 and Exhibit SW-35.

Goodwill

86. The opponent must show that it had goodwill in a business at the relevant date and that the signs relied upon were associated with, or distinctive of, that business. I remind myself that the opponent claims goodwill in connection with *Television series, pre-recorded goods including DVDs, entertainment services, and licensing accompanying merchandise*.

87. For present purposes, I shall proceed on the basis that the opponent has shown that it has a qualifying goodwill deriving from its trading activities in all these areas.

Misrepresentation

88. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

> "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] RPC 341 at page 407 the question on the issue of deception or confusion is:
>
> > 'is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."

89. The opponent submits that the public would believe that the applicant's goods are those of the opponent, or are authorised by it. It has referred me to a number of cases where the questions to be decided centred on whether the public would believe that goods or services are licensed, endorsed or approved by another party, through the use of likenesses, characters or names associated with that other party. These include

the well-known *Irvine v Talksport* [2001] 1 WLR 2355 and *Fenty v Topshop* [2015] EWCA Civ 3. In both these cases, likenesses of the individuals in question (racing driver Eddie Irvine and singer Rihanna) were used. As the contested mark and the signs are similar, not identical, I do not consider that the earlier cases are on all fours with the instant case. The third case referred to by the opponent is *Mirage Studios & Ors v Counter-Feat Clothing Company Limited & Anor* [1991] FSR 145, where the plaintiffs were granted an interim injunction. Here the signs were similar, rather than identical, but the judge was able to consider evidence of mistakes made by members of the public. As I have noted above, there is nothing before me to indicate that the applicant was trading under the contested mark on or before the relevant date.

90. Finally, the opponent referred me to the decision of the General Court ("GC") in *Blackmore v EUIPO (DEEP PURPLE)*, where it said at paragraph 66 that the question to be addressed was *"whether there is a genuine likelihood that the relevant public will be led to attribute the commercial origin of the goods and services to the opponent"*. It draws my attention to social media posts from the applicant which it submits show that the applicant was deliberately linking goods sold under the contested mark to the opponent's television programme by using hashtags #peakyblindersoutfit and #peakyblinders and that such use would deceive the public. However, all of these posts are dated after the relevant date.

91. The opponent also submits that the contested mark is reminiscent of the stylised sign. I accept that there are similarities between the typefaces used in both the signs, but there is nothing remarkable about either of them.

92. The use of the distinctive headgear in the contested mark would, in my view, bring the television programme to the mind of a significant group of the public, but this is not the same as misrepresentation. As I said in my assessment of the section 5(2)(b) ground, I find it unlikely that the public would assume that use of the word "PEAKY"

even with the device would designate goods that had been approved by the opponent. I find there is no misrepresentation and so the section 5(4)(a) claim fails.

Section 3(6)

93. Section 3(6) of the Act is as follows:

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

94. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121, the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ,* Case C-104/18 P, *Hasbro, Inc. v EUIPO,* Case T-663/19, *pelicantravel.com s.r.o. v OHIM,* Case T-136/11, and *Psytech International Ltd v OHIM,* Case T-507/08. Floyd LJ summarised the law as follows:

> "67. The following points of relevance to this case can be gleaned from these CJEU authorities:
>
> 1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
>
> 2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].
>
> 3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to

distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacilik* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacilik* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]".

95. In addition, the following points are relevant:

a. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies. However, Arnold J (as he then was) said that *"cogent evidence is required due to the seriousness of the allegation*". This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 133;

b. It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull*, paragraph 137; and

c. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2008] EWHC 3032 (Ch), paragraph 167, and approved by the Court of Appeal, [2010] EWCA Civ 110.

96. According to Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Alexander Trade Mark*, BL O/036/18, at paragraph 8, the key questions for determination in a claim of bad faith are as follows:

a. What, in concrete terms, was the objective that the party alleged to have acted in bad faith has been accused of pursuing?

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

c. Has it been established that the contested application was filed in pursuit of that objective?

97. The opponent alleges that the applicant knew of the reputation and success of its television programme and that it sought to secure a monopoly for itself, appropriating the goodwill and reputation in the programme. I consider that such an objective would be one for the purposes of which an application could not properly be filed.

98. I infer that it is likely that the applicant knew about the television programme and its success. I have already referred to the social media posts which use hashtags that specifically refer to the programme. Although these were posted after the relevant date, the coverage in national newspapers, viewing figures and the trailers lead me to find that it is likely the applicant was aware of the programme when it filed the application. The social media posts also, in my view, cast light backwards on the intention of the applicant. The use of the hashtags suggests a targeting of fans of the programme. I found that the contested mark would create a link in the mind of the relevant public (i.e. viewers of TV crime dramas) and that the applicant would gain an unfair advantage from this link. There is, in my view, a *prima facie* case that the verbal and figurative elements of the contested mark were chosen for this purpose and that the application was made in bad faith.

99. In *Holzer y Cia de CV v EUIPO*, Joined cases T-3/18 and T-4/18, the GC held (at paragraph 36 of that judgment) that although there is a presumption of good faith, the objective circumstances of a particular case may lead to the rebuttal of that presumption. In that event, it is for the applicant to provide plausible explanations for the objectives and commercial logic pursued by the application for registration of the trade mark.

100. The applicant has made no specific defence of the allegations. In its counterstatement, it focuses on each of the relative grounds raised. It then says:

> "24. The Applicant further asserts that its Application may co-exist without causing any confusion with the Registered Mark and further asserts that the various grounds on which the Opponent relies to oppose the Application are all entirely without merit."

101. Elsewhere in the counterstatement, it argues that the word "peaky" is used descriptively by *"numerous online retailers"* and that it will provide evidence of this in due course. No such evidence has been filed. I consider that the applicant has not provided plausible explanations for the objectives and commercial logic it has been pursuing. It has not rebutted the *prima facie* case of bad faith, and so the section 3(6) ground is successful.

OUTCOME

102. The opposition is successful and Application No. 3759523 is refused registration.

COSTS

103. The opponent has been successful and is entitled to a contribution towards its costs, based on the scale published in Tribunal Practice Notice No. 2/2016. In the circumstances, I award the opponent the sum of £2450 which has been calculated as follows:

Preparing a statement and considering the other side's statement:	*£350*
Preparing evidence:	*£1500*
Preparing written submissions in lieu of a hearing:	*£400*
Official fees:	*£200*
TOTAL:	***£2450***

104. I therefore order Navway Limited to pay Caryn Mandabach Productions Limited the sum of £2450. 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 4th day of March 2024

Clare Boucher
For the Registrar,
Comptroller-General