

**O/0740/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3714046**

**BY THE BLUEBIRD PROJECT**

**TO REGISTER:**



**AS A TRADE MARK IN CLASSES 12 & 25**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO**

**UNDER NO. 431238 BY**

**DONALD WALES**

## BACKGROUND AND PLEADINGS

1. On 4 January 1967, Donald Campbell set off to make an attempt to break the water speed record on Coniston Water in Cumbria in a boat named Bluebird K7 (“the boat”). He and his father, Sir Malcolm Campbell, shared a long history of speed record breaking on land and on water. Since 1912, the vehicles that they used went under the name of “Bluebird”. Sadly, Donald Campbell lost his life that day when the boat suffered an accident. The Campbell Family Heritage Trust (“The Trust”) was created in 2001 to keep their legacy alive. One of the trustees, and the nephew of Donald Campbell, is the opponent in these proceedings.

2. The wreckage of the boat, and Donald Campbell’s body, were recovered in 2001. This allowed the family to give Mr Campbell a belated funeral. The recovery was led by William Smith, then of Kiltech Underwater Limited, and since 2012 the Managing Director of Bluebird Project Ltd, which is the applicant in these proceedings under the name “The Bluebird Project”. Both parties agree that a decision was taken in 2002 to rebuild the boat. The Trust gave it to The Ruskin Museum in Coniston (“The Museum”) in 2006 and the parties are in dispute about the nature of their relationship. I shall return to this later in my decision.

3. On 25 October 2021 (“the relevant date”), the applicant applied to register the mark shown on the front cover of this decision as a trade mark in the United Kingdom in respect of the following goods:

Class 12

*Vehicles; parts and fittings for vehicles.*

Class 25

*Clothing; footwear; headgear.*

The application was published for opposition purposes on 19 November 2021.

4. On 21 February 2022, the application was opposed by Donald Wales (“the opponent”). He states that he is responsible for maintaining the heritage of the Bluebird name on behalf of the Campbell family. 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”) and concerns all the goods in respect of which registration is sought.

5. Under section 5(2)(b), the opponent is relying on the following UK trade marks (UKTMs):

UKTM No. 2315925

**BLUEBIRD**

Filing date: 6 November 2002

Registration date: 9 October 2009

Goods and services relied on:

Class 12

*High speed, trials and racing vehicles for use on land and water; electrically powered vehicles.*

Class 25

*T-shirts, sweatshirts, fleeces, wind/rain tops, hats and caps.*

Class 41

*Organising, holding and presenting exhibitions relating to land and water speed records and record attempts; information, advisory and consultancy services relating thereto.*

UKTM No. 906742985

**BLUEBIRD**

Filing date: 11 March 2008

Registration date: 9 June 2009

Goods and services relied on:

Class 12

*High speed, trials and racing vehicles for use on land and water; electrically powered vehicles.*

Class 16

*Printed publications; books, magazines, periodicals, guides, stationery; posters, postcards, photographs; writing instruments, pens, pencils; notebooks, notepads.*

Class 41

*Organising, holding and presenting exhibitions relating to land and water speed records and record attempts; information, advisory and consultancy services relating thereto.*

6. Both marks qualify as earlier marks under section 6(1)(a) of the Act. As they completed their registration procedures more than five years before the application date of the contested mark, the opponent has made a statement that he has used the earlier marks for all the goods and services relied on.

7. The opponent claims that the dominant and distinctive element of the contested mark is the word "BLUEBIRD", which comprises the entirety of the earlier marks. Consequently, he argues, the marks are visually, aurally and conceptually similar. He also claims that the contested goods are identical with, or similar to, goods and services of the earlier marks, and that there is a likelihood of confusion on the part of the public.

8. Under section 5(3), the opponent claims that UKTM No. 2315925 has a reputation for the goods in Class 12 and services in Class 41 listed above. He claims that use of the contested marks would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier mark. In particular, he claims that the contested mark would benefit from the commercial attraction of the earlier mark and its use would suggest that the applicant is connected with the Campbell family or has been authorised to use the Bluebird mark. He also claims that the reputation of the earlier mark would be damaged "*due to the negative*

*connotations associated with the Applicant and its ongoing dispute with The Ruskin Museum regarding ownership of the Bluebird K7 water speed vehicle in which Donald Campbell lost his life.*” Finally, the opponent claims that use of the contested mark would dilute the ability of the earlier mark to identify the opponent and his family.

9. Under section 5(4)(a), the opponent claims to own goodwill generated through direct use and licensing of the sign **BLUEBIRD** throughout the UK since 1927 for the following goods and services: *High speed land and water vehicles; electric vehicles; printed publications, books, guides, posters, postcards, photographs, cards, mugs, caps, badges, pens, notepads, models, caps, clothing; exhibition and museum services.* Use of the contested mark would constitute a misrepresentation calculated to deceive the public into believing that there is a commercial relationship between the parties. The opponent would suffer damage through loss of direct sales, damage to reputation and loss of distinctiveness of the sign. Consequently, use of the contested mark would be contrary to the law of passing off.

10. Under section 3(6), the opponent claims that:

“The Applicant’s attempt to secure rights in the trade mark BLUEBIRD through the trade mark application in question involves questionable behaviour and sharp practice. The Applicant claims partial ownership of the Bluebird K7 water speed vehicle that had been gifted to The Ruskin Museum by the family of the [sic] Donald Campbell. The Applicant’s claim to entitlement of the trade mark applied for rests on such claim to ownership, which is disputed by both The Ruskin Museum and the Opponent.”

11. The applicant filed a defence and counterstatement denying the claims made. In particular:

- a. Under section 5(2)(b), it denies that the marks and the goods and services are similar, and that there is a likelihood of confusion between the marks. It did not request that the opponent file proof of use of the earlier marks;
- b. Under section 5(3), it denies that use of the contested mark would lead the relevant public to believe that the marks are used by the same undertaking, take unfair advantage of the opponent’s mark or cause reputational damage

to the opponent. It adds that *“The bald fact of the matter is that it is the opponent who is riding the coat tails of BBP [The Bluebird Project] and exploiting the fruits of our hard work and not the other way around”* and that the reputation of the opponent comes from the achievements of Donald Campbell and his father;

- c. Under section 5(4)(a), it denies that there is misrepresentation;
- d. Under section 3(6), it claims that it has used the contested mark for some time and that the opponent has been aware of this. It describes the application for registration as *“a ‘loose end’ we have meant to tidy up for some time”*.

12. Both parties filed evidence and this is listed below. I confirm that I have read all the evidence and submissions filed and will refer to them as necessary during the course of my decision.

13. Neither side requested a hearing and so I have taken this decision after a careful consideration of the papers. In these proceedings, both parties have represented themselves.

## **EVIDENCE AND SUBMISSIONS**

14. The opponent’s evidence in chief comes in the form of a witness statement from the opponent himself, Mr Wales, and is dated 10 February 2023. His evidence goes to the history and achievements of Donald Campbell and Sir Malcolm Campbell, the use of the earlier marks by the Campbell family and the relationship between the parties. Mr Wales’s witness statement is accompanied by 19 exhibits. He also filed written submissions on the same date.

15. The applicant had already filed a witness statement as its counterstatement. This came from William Hammerton Smith, the leader of the Bluebird Project since 1996 and Managing Director of Bluebird Project Ltd since 2012. He made a further witness statement dated 10 February 2023, covering the history of the Bluebird Project. It is accompanied by 16 exhibits.

16. On 9 May 2023, Mr Smith made a request to file further evidence. He explained that he now had a document that was not available at the time of filing his second witness statement. Permission was given and a third witness statement was filed. This is dated 22 May 2023 and has as an exhibit a letter from the opponent's cousin and daughter of Donald Campbell, Ms Gina Campbell.

17. The opponent informed the Registry that it wished to file evidence in reply and permission was granted. The evidence is in the form of a witness statement from Mr Wales dated 17 July 2023 in which he responds to the evidence of Mr Smith. He also provides a witness statement from Ms Gina Campbell dated 12 July 2023.

18. The applicant filed very brief written submissions in lieu of a hearing on 26 November 2023.

## **RELEVANCE OF EU LAW**

19. 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.

## **PRELIMINARY ISSUES**

20. The applicant submits that the application should be permitted to proceed to registration as the contested mark has been in use from the start of the project up to the present day. In his second witness statement, Mr Smith argues that "*The Opponent has had more than sufficient time and information to raise any issues ahead of the present and yet has not done so.*"<sup>1</sup> However, the fact that a party has not objected to use before the filing date does not preclude it from opposing the registration of a trade mark. There may be a number of reasons why it has not raised any issues before: for example, the use might have been on a small scale or it might have been purely local.<sup>2</sup>

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<sup>1</sup> Paragraph 23.

<sup>2</sup> For the avoidance of doubt, I am not saying that these reasons apply here. They are merely examples to illustrate a general point.

A trade mark, however, gives the proprietor the right to stop other parties from using or registering similar marks for similar goods and services, if such use would be likely to cause confusion. A party's calculation about whether it is worth making an objection is likely to be based not just on how a mark is being used now but on how it could fairly be used in the future. I therefore dismiss this argument.

21. The applicant also submits that the word "BLUEBIRD" is used by other businesses. In its counterstatement, it argues that the contested mark "... *is no more confusingly similar than Nissan's Bluebird car, Bluebird care homes or Bluebird confectionary.*"<sup>3</sup> Two of these examples relate to goods and services that are totally dissimilar to the goods and services in either party's specifications. I have no evidence pertaining to the Nissan car to indicate when the sign might have been in use or the extent of any use. Exhibit BBP15 to Mr Smith's second witness statement shows six signs containing the word "Bluebird" which he states relate to clothing or to garage services and which have been taken from the internet. These are undated so I am unable to assess the extent to which they have been used on the market by the relevant date. Exhibit BBP16 to the second witness statement contains a screenshot of a search on the Companies House website for companies with the word "BLUEBIRD" in their name. This gives no indication of the presence of the sign in the market. Finally, Exhibit BBP18 to Mr Smith's third witness statement shows the entry on the register for UKTM No. 3499456, which is a figurative mark containing the word "Bluebird" and which is registered for goods in Classes 9, 16, 25 and 28. Mr Smith states that this mark pertains to a vintage car nicknamed "AC Bluebird". He continues:

"7. ... The car in [sic] an AC Aceca once driven by Donald Campbell and lovingly restored to immaculate condition by its owner with the involvement and assistance of the Bluebird Project some years ago. The car, it's [sic] history and the involvement of Bluebird Project is well known in the public domain and goes to the very heart of the Donald Campbell/Bluebird story."

Mr Smith has, however, provided no evidence to corroborate his claim as to the knowledge of the public. Neither is there any evidence of use in the market for the goods for which UKTM No. 3499456 is registered.

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<sup>3</sup> Paragraph 4.

22. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, the General Court (“GC”) said that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS (Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”

23. As the applicant has not provided any evidence to show that the signs were in use on the market, I dismiss this argument.

## **DECISION**

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

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

“A trade mark shall not be registered if because—

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

25. I have already noted that the marks relied on by the opponent qualify as earlier marks and that the opponent made a statement of use in relation to them. Because the applicant did not request proof of use, the opponent may rely on all the goods and services shown in the table in paragraph 5 above.

26. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“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 and services***

27. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. 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: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296].

28. The goods and services to be compared are shown in the table below. Because the applicant did not require the opponent to prove that it had used the earlier marks for the goods and services relied upon, I must base my comparison on the terms that

appear in both parties' specifications and how they might be fairly used. As both the earlier marks are identical, I have combined the lists of goods and services relied upon.

Contested goods	Earlier goods and services
<p><u>Class 12</u> <i>Vehicles; parts and fittings for vehicles.</i></p> <p><u>Class 25</u> <i>Clothing; footwear; headgear</i></p>	<p><u>Class 12</u> <i>High speed, trials and racing vehicles for use on land and water; electrically powered vehicles.</i></p> <p><u>Class 16</u> <i>Printed publications; books, magazines, periodicals, guides, stationery; posters, postcards, photographs; writing instruments, pens, pencils; notebooks, notepads.</i></p> <p><u>Class 25</u> <i>T-shirts, sweatshirts, fleeces, wind/rain tops, hats and caps.</i></p> <p><u>Class 41</u> <i>Organising, holding and presenting exhibitions relating to land and water speed records and record attempts; information, advisory and consultancy services relating thereto.</i></p>

*Class 12*

29. Where goods in the specification of one party are included in a broader term from the other party's specification, those goods are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05 at [29]. The contested *Vehicles* includes the earlier *High speed, trials and racing vehicles for use on land and water* and *Electrically powered vehicles*. They are identical per *Meric*.

30. The opponent submits that the contested *Parts and fittings for vehicles* are complementary to its *High speed, trials and racing vehicles for use on land and water* and *Electrically powered vehicles*. In *Boston Scientific Ltd v OHIM*, the GC said that goods and services are complementary when

“82. ... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

31. I agree that they are complementary. The contested term would cover parts and fittings for the types of vehicle in the opponent’s specifications; the respective goods are indispensable or important for the use of each other; and the applicant’s parts would include parts, such as brake discs and pads, motors and wheels, that customers would expect to be produced by the manufacturer of the vehicle. The end-consumer of the goods is the same and I consider that it is likely that there will be at least some overlap in the trade channels, as vehicle traders often sell parts and fittings for those vehicles. I find that there is a medium degree of similarity between the parties’ goods.

#### *Class 25*

32. The contested *Clothing* includes the opponent’s *T-shirts, sweatshirts, fleeces, wind/rain tops*. They are identical per *Meric*.

33. The contested *Headgear* includes the opponent’s *Hats and caps*. They are identical per *Meric*.

34. Finally, I come to the contested *Footwear*. Like the opponent’s Class 25 goods, they are used to cover parts of the body, provide protection from the elements and may be chosen for their appearance. They are likely to be made from different materials, with footwear generally being more robust. However, the goods are likely to be sold through some of the same trade channels to the same consumers. I find that they are similar to a medium degree.

### ***Average consumer and the purchasing process***

35. 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.


36. The goods in Class 12 are likely to be purchased either by members of the general public or businesses and professionals. In my view, they will be occasional purchases and, in the case of vehicles, the cost of these will be high. Consequently, I find that the purchasing process for vehicles will be highly considered. The level of attention paid will, in my view, be high. *Parts and fittings for vehicles* are likely to be less costly but even so I consider that the attention paid will be above medium, particularly given the importance of some of the parts for the performance and safety of the vehicle. The goods are likely to be purchased from retailers, dealers and specialist suppliers, either online or in physical premises. They would typically be bought after a visual inspection of the goods, or after viewing information on websites or in brochures or catalogues. I therefore find that the purchasing process will be largely visual. However, I do not discount that there may be a role for word-of-mouth recommendations or discussions with sales staff, and so the average consumer may also hear the marks spoken.

37. The average consumer of the Class 25 goods is a member of the general public. They will buy the goods either from a specialist retailer (for instance, in the case of the sports clothing) or a general clothing or 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 of the mark will be the most significant: see *New Look limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, at [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 of the goods varies, but in many cases they will be relatively frequent purchases. The consumer will pay attention to the size, the materials, the style and colours to ensure that they buy a garment or footwear 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**

38. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. 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*, paragraph 34.

39. The respective marks are shown in the table below. As the earlier marks are identical, I shall now refer to them in the singular.

<b>Contested mark</b>	<b>Earlier mark</b>
	BLUEBIRD

40. The contested mark is a composite mark, made up of verbal and figurative elements. The verbal element consists of the words “THE BLUEBIRD PROJECT” presented with no spaces in lower case in a stylised typeface. It is my view that the average consumer will easily identify the three separate words despite their juxtaposition. Of these words, the most distinctive is “BLUEBIRD”. The first word is simply the definite article, while the last word “PROJECT” suggests a time-limited task with a specific goal. The word “BLUEBIRD” identifies the particular project. The opponent submits that the figurative element placed above the words is “*a stylised depiction of the famous Bluebird racing boat, and hence will be perceived as a mere illustration of the racing boat*”.<sup>4</sup> The applicant makes no specific submissions on the average consumer’s perception of the device. On the basis of the images of the racing boat provided in evidence, I can accept that this is a stylised version of that boat. I can also accept that there will be some consumers who will perceive the illustration in the

<sup>4</sup> Opponent’s submissions, paragraph 19.

way argued by the opponent. However, the applicant's goods are targeted towards the general public and there is no evidence of the level of knowledge of the Bluebird racing boat among the public at large. In my view, there will be some consumers who see the device as a stylised boat or another type of vehicle, and there will be others who see it as an abstract drawing. However the consumer views the device, though, I consider that the verbal element plays the greater role in the overall impression of the mark. The GC held in *Migros-Genossenschafts-Bund v European Union Intellectual Property Office (EUIPO)*, Case T-68/17 at [52] that verbal elements must generally be regarded as more distinctive than figurative elements, as the public will identify the mark concerned by means of the words. I consider that to be the case with the contested mark. Consequently, I find that the dominant and distinctive element of the mark is "BLUEBIRD".

41. The earlier mark consists of the single word "BLUEBIRD". The overall impression of the mark resides in this single word, that being the mark as a whole.

42. The opponent submits that the marks are visually highly similar because they share the dominant and distinctive element "BLUEBIRD". However, the fact that some words in the contested mark are non-distinctive does not mean they can automatically be disregarded: see *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd (PURITY HEMP COMPANY IMPROVING LIFE AS NATURE INTENDED)*, BL O-115-22 at [31]. The applicant's device also acts as a point of difference between the marks. Taking account of the differences, and the identity of the dominant and distinctive element, I find that the marks are visually similar to a medium degree.

43. Turning now to the aural comparison, I find that the words are common English words that would be given their usual pronunciation. This means that the earlier mark has two syllables, while the contested mark has five. The second and third syllables of the contested mark are identical to the earlier mark. Taking account of the differences, and the identity of the dominant and distinctive element, I find that the marks are aurally similar to a high degree.

44. The opponent submits that the marks are conceptually identical, as the average consumer will see the device as either reinforcing the concept of the Bluebird boat or as mere decoration. In my view, it is more likely that the word "BLUEBIRD" will make

the average consumer think of a medium-sized bird known for the colour of its plumage. However, I accept that there is likely to be a significant proportion of consumers of the high-speed, trials and racing vehicles who would be aware of the boat and so would think of the it when encountering the marks used on these goods. For them, I can accept that the marks are conceptually identical.

45. As the evidence shows that the efforts to recover the wreckage of the Bluebird boat have received coverage in national media and on BBC television, it is possible that a significant proportion of consumers of the more general vehicles in Class 12 would also be aware of the boat, particularly if those vehicles are for use on the water. I note here that “significant” does not necessarily mean a majority of consumers. For these consumers, the marks would be highly similar conceptually, with the idea of a project being the sole point of conceptual difference from the earlier mark.

46. However, I do not believe that a significant proportion of consumers of Class 25 goods would know about the Bluebird boat, even given the media coverage I have mentioned above. In my view, the word “BLUEBIRD” would bring to mind the bird. In the context of clothing, I consider that they will see the device as decorative and abstract, and so I find that for these consumers the marks are highly similar conceptually.

### ***Distinctive character of the earlier mark***

47. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*.

“23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and

statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

49. The word “BLUEBIRD” does not describe or allude to any characteristics of the goods which I found to be identical or similar to the contested goods. It is a word in standard English usage and so I find that it has a medium degree of inherent distinctive character. The opponent claims that this inherent distinctive character has been enhanced through the use made of the mark.

50. I am in no doubt that the name “BLUEBIRD” was used since 1912 by members of the Campbell family for their vehicles. However, what is relevant here is use as a trade mark, that is use that indicates to the public that the goods offered in trade come from a particular undertaking. I shall bear this point in mind when assessing the evidence that I summarise below.

51. Mr Wales’s evidence contains two examples of the mark being used in connection with vehicles. The first is a collaboration with Atalanta Motors on the design and production of a sports car called the “Bluebird Atalanta”. According to an article from Atalanta’s website, the car was launched in July 2017 at the Shelsley Walsh hill climb and its price started from £150,000. Each car was to be produced to order. There is also a print out from the website of Bonham’s, advertising the auction of a 2019 Atalanta “Bluebird” Roadster. The car appears to have a UK registration. The advertisement states that it is “*One of only three Atalanta ‘Revival’ continuations built*”, but it is not clear from this whether there only three Atalanta Bluebirds built, or whether the Bluebird was one of three different models produced by the company.<sup>5</sup> There is no other evidence showing numbers sold or the extent of any advertising. The second example is the “Sapheria Project” which began in 2020 or 2021 and produced a vehicle called the Bluebird Sapheria. There is no evidence of this ever having been offered for

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<sup>5</sup> Exhibit DW16.

sale, but even so the design of the vehicle was only completed in 2022, which is after the relevant date.<sup>6</sup> The evidence does not show that there is sufficient use for the opponent's goods in Class 12 for the inherent distinctiveness of the mark to have been enhanced.

52. There are a few more examples of some of the Class 25 goods. Mr Wales states that the BLUEBIRD name is used on a range of clothing produced by a company called Retro Clothing. Exhibit DW11 shows a selection of T-shirts, but the exhibit is undated and there is nothing in the witness statement to indicate whether these goods were available on or before the relevant date. The goods are also shown on print-outs from the etsy website. One item is shown as being listed on 3 February 2023, but this is the only date on the exhibit or in the witness statement.<sup>7</sup> T-shirts can also be seen on undated photographs showing stalls promoting the activities of the Campbell Family Heritage Trust.<sup>8</sup> However, it is not clear how many were sold on or before the relevant date.

53. Exhibit DW14 contains an invoice dated 5 July 2017 from a company that brands merchandise. It shows that the opponent ordered 50 baseball caps. According to the design sheet, the word "BLUEBIRD" was to have been embroidered on the back of the caps. I have no information to say how the caps might have been made available to the public or how many were actually sold.

54. The final piece of evidence that I need to discuss here is a licensing agreement between a company called Malcolm Campbell (London) Limited and Haythornthwaite & Sons Limited, permitting the latter to use BLUEBIRD trade marks and specified images on a range of branded clothing. The contract period lasted from 11 August 2014 to 11 July 2019. Mr Wales states that, as a result of this agreement, BLUEBIRD-branded clothing was on sale in Harrods. There are no images to show how the mark might have been used and no information on sales or advertising.

55. Taken as a whole, the evidence falls short of what would be required to show that the distinctive character of the mark had been enhanced through the use made of it.

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<sup>6</sup> Exhibit DW17.

<sup>7</sup> Exhibit DW12.

<sup>8</sup> Exhibit DW15.

### ***Conclusions on likelihood of confusion***

56. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. There is no law setting out precisely what weight should be attached to each of the factors or providing a formula that can be applied to any set of circumstances. However, I am required to 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.

57. 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 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.

58. Earlier in my decision, I found that:

- The goods are either identical or similar to a medium degree;
- The average consumer of the Class 12 goods is a member of the general public or a business/professional who will be paying a high, or higher than medium, degree of attention;
- The average consumer of the Class 25 goods is a member of the general public who will be paying a medium degree of attention;
- The purchasing process would be largely visual;

- The dominant and distinctive element of the contested mark is “BLUEBIRD” and this is the single element of the earlier mark;
- The marks are visually similar to a medium degree and aurally similar to a high degree;
- One group of consumers will find the marks conceptually identical; another will find them conceptually highly similar; and
- The earlier mark has a medium degree of inherent distinctive character which has not been enhanced through use.

59. The dominant and distinctive element of the contested mark is identical to the earlier mark. However, the additional material, even though it makes a lesser contribution to the overall impression of the mark, led me to find that the marks were visually similar to only a medium degree. However, the higher degree of attention paid by the average consumer of the Class 12 goods makes imperfect recollection less of a factor. Even where the goods are identical, I find that the differences between the marks are such that the average consumer of the Class 12 goods is unlikely to mistake one mark for the other.

60. Turning to the Class 25 goods, I recall that I found the degree of attention paid by the average consumer would be only medium. It is my view that imperfect recollection will come into play here. I consider that the average consumer on encountering the contested mark will recall that the earlier mark contains the word “BLUEBIRD” but is unlikely to remember whether it also contains a figurative element or non-distinctive, or less, distinctive words. I find that there is a likelihood of direct confusion with regard to the Class 25 goods.

61. I now turn to indirect confusion. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, gave at [17] 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)."

62. 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."

63. As I found that "BLUEBIRD" is the dominant and distinctive element of the contested mark, and that the other words are non-distinctive, it is my view that the average consumer who is not directly confused would assume that the contested mark is a figurative mark that includes a longer version of the word mark owned by the same undertaking.

64. The opposition succeeds in full under section 5(2)(b). For completeness, I shall proceed to consider the remaining grounds.

## **Section 5(3)**

65. 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.”

66. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

67. I have already found the marks to be similar under section 5(2)(b).

### ***Reputation***

68. In *General Motors Corp v Yplon SA*, Case C-375/97, 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.

69. The opponent claimed a reputation for the goods in Class 12 and services in Class 41. The law is clear that any reputation must be in goods and/or services covered by the trade mark registration: see *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16. In paragraph 51 above, I considered whether the evidence showed that the distinctive character of the earlier mark had been enhanced by use in relation to the Class 12 goods in the registration. I shall not repeat my summary of this evidence here, but note that the evidence of use is patchy and largely undated and so I am unable to find reputation for the Class 12 goods.

70. The Class 41 services are as follows: *Organising, holding and presenting exhibitions relating to land and water speed records and record attempts; information, advisory and consultancy services relating thereto*. While Mr Wales's witness statement covers work done with the Museum to preserve the Bluebird K7 boat, there is no evidence of any use of the earlier mark in relation to these services and I am therefore unable to find that the earlier mark has a reputation.

71. The section 5(3) ground fails.

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

72. 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

...”

73. 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.”

74. 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.”

## **Goodwill**

75. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

76. The opponent must show that it had goodwill in a business and that the sign relied upon is associated with, or distinctive of, that business. The first point to address in section 5(4)(a) claims is usually the relevant date on which a protectable goodwill must be shown. In *Advanced Perimeter Systems v Keycorp Limited (MULTISYS)*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”<sup>9</sup>

77. The applicant claims that it has used the contested mark on embroidered clothing, signed prints and DVDs since 2002.<sup>10</sup> Mr Smith states that sales have raised around £5,000 per year for the project, with approximately 80% of those sales coming from

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<sup>9</sup> Quoted in paragraph 43 of BL O-410-11.

<sup>10</sup> Counterstatement and first witness statement of William Smith, paragraph 2.

clothing. However, in my view, 2002 cannot be said to be the start of the behaviour complained about, as it is the opponent's position that at this point there was a three-way working group responsible for the project. I shall say more about this when I come to the section 3(6) ground. For the present purposes, however, nothing turns on the identification of the relevant date for reasons that I shall now explain.

78. In *Starbucks (HK) Limited & Anor v British Sky Broadcasting Group PLC & Ors* [2015] UKSC 31, Lord Neuberger (with whom the rest of the Supreme Court agreed) stated that:

"47. I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.

...

52. As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. 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 the 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."

79. The opponent has provided me with no evidence of actual sales to UK customers before the filing date of the contested mark for the goods and services claimed. The name “BLUEBIRD” has clearly been used for the vehicles of both Sir Malcolm and Donald Campbell since 1927, but there is no evidence that these vehicles were sold to the public. In my view, the “Bluebird Atalanta” discussed above would not be described as a high-speed land vehicle, but as a sports car. However, even if it could be, I have very limited evidence on how many of these vehicles were sold. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks* at [52], *Reckitt & Colman and Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After doing so, he concluded that:

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

80. The evidence is insufficient to show that there was goodwill in the business. As the Supreme Court said, reputation in the name “BLUEBIRD” is not enough for a claim under section 5(4)(a) to succeed. Neither do I consider £4,000 of clothing sales sufficient to be able to conclude that there would be misrepresentation and damage, even if I were to assume the best possible case for the opponent (namely, that the sales from 2002 claimed by the applicant created goodwill acquired by the opponent). Even if I had found there to be protectable goodwill in the business, I am not convinced that it would be owned by the opponent. Mr Wales says in his first witness statement that he owns the trade marks relied on under sections 5(2)(b) and 5(3) with the agreement of, and for the benefit of, the Campbell Family Heritage Trust; he says nothing about the ownership of any goodwill. There is also nothing in the exhibits that deals with this point. As the opposition has already succeeded and I found that the evidence did not show goodwill, I considered that it would impose unnecessary costs upon the opponent to ask him to clarify the ownership.

81. The section 5(4)(a) ground fails.

## Section 3(6)

82. 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.”

83. 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 Mağazacılık 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 Mağazacılık* 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 Mağazacılık* 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]".

84. I also bear in mind the following relevant points taken from other cases:

- 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) at [133];
- b) It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull* at [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) at [167].<sup>11</sup>

85. According to Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Alexander Trade Mark*, BL O/036/18, 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?

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<sup>11</sup> Approved by the Court of Appeal in *Hotel Cipriani Srl & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2010] EWCA Civ 110.

- 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?

86. The opponent's claim is that the applicant had been working with the Trust and the Museum on a project to restore the Bluebird K7 boat and that this relationship had deteriorated into a dispute over the ownership of the restored boat. The applicant claimed partial ownership, based on the new parts that had had to be fitted. The opponent claims that the applicant did not enjoy partial ownership of the boat and therefore had no right to apply for a trade mark using a name it knew belonged to the Trust. I am satisfied that this was an objective for the purposes of which the contested application could not properly be filed, and so I must now decide whether the opponent has established a case that the applicant must rebut.

87. Mr Wales states that a three-way working group was set up in 2002 between the Trust, Mr Smith's company Kiltech Underwater Limited, and the Museum, to which the Trust later gifted the wreckage of the Bluebird K7.<sup>12</sup> Around 2008, the Museum put together a plea for urgent funding for "*The Bluebird Project at The Ruskin Museum*", describing it as "*an imaginative community-owned-and-managed sustainable-museum/tourism-based rural regeneration scheme*".<sup>13</sup> Prior to this, Mr Smith had signed a Gift Aid declaration form on 6 January 2006 and the form referred to "*The Bluebird Project*" and "*The Ruskin Museum's Bluebird Project*".<sup>14</sup> The opponent submits that this shows that Mr Smith was aware of the identity of the three-way working group. The opponent also refers to a letter from Mr Smith to a company that had offered to rebuild the boat's fuel pumps.<sup>15</sup> The letter states that the rebuilt pumps "*will belong to the project ... in accordance with proper museum practice*". Again, the opponent submits that this is evidence that Mr Smith understood the aims and structure of the project.

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<sup>12</sup> First witness statement of Mr Wales, paragraph 11.

<sup>13</sup> Exhibit DW3.

<sup>14</sup> Exhibit DW4.

<sup>15</sup> Exhibit BBP09.

88. According to Mr Wales, the logo that is used in the contested mark was presented to the working group and was agreed. He does not say when this took place, although I can see that it has been used on business cards that Mr Smith states date from 2002.<sup>16</sup> Mr Wales also accepts that there were sales of merchandising to fund the project.<sup>17</sup> These are the sales that I discussed under the section 5(4)(a) ground.

89. Mr Wales states that on 28 June 2012, Mr Smith registered The Bluebird Project Limited with Companies House. In March 2013, Mr Smith and Mr Wales were in email correspondence. Mr Wales accused Mr Smith of making a claim to ownership of the boat, and Mr Smith responded that the Museum owned the wreckage that had been salvaged and that “*the Bluebird Project team*” owned all the components that had been created or added to complete the boat.<sup>18</sup> The email exchange suggests that Mr Smith was using this term to refer to the people who had volunteered their time to restore the boat and had been engaged in the hands-on activity that was required. Mr Wales states that litigation over the ownership of the boat is ongoing.

90. On 12 April 2019, Mr Smith wrote to the Museum:

“... We are not interested in working with you any longer so as of tomorrow’s workshop session we shall begin removing that which is ours from K7 to separate it from the wreckage you were given in 2006. Once this process is complete you can come and remove your property and we will build new to replace it in order that we can carry on the Bluebird Project without you.”<sup>19</sup>

91. The only explanation given for the breakdown in relations between the parties is an article from the September 2019 issue of *Vanity Fair*. It suggests there was a difference of opinion between the Museum and Mr Smith, with the Museum wanting the boat to be kept on its premises and Mr Smith arguing that the boat should be used. The Campbell family is presented in this article as trying to keep the peace between the two sides.<sup>20</sup> None of the witness statements directly covers this point. I also note

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<sup>16</sup> Exhibit BBP01.

<sup>17</sup> Paragraph 31.

<sup>18</sup> Exhibit DW6.

<sup>19</sup> Exhibit DW7.

<sup>20</sup> Exhibit BBP11 to the first witness statement of William Smith.

that it is not clear whether this is the full article, given that the exhibit ends somewhat abruptly.

92. It is not wholly clear what caused the relationship between the family and Mr Smith to deteriorate to this point, but Mr Wales claims that “The Bluebird Project” has posted insulting tweets about him, the Campbell family and the Museum. Exhibit DW9 contains some examples. Not all of these are dated, but I can see that there was a reply to a tweet on 18 July 2021.

93. Mr Smith denies the existence of a three-way working group. He submits that, if such a group had existed, the opponent should have been able to provide extensive documentation and challenged the opponent to file such proof. He states that “The Bluebird Project” worked autonomously with regard to the Museum and has never had any ties with the Trust.<sup>21</sup> He continues:

“10. The original contract for restoration works to be carried out was between the RM [Ruskin Museum] and Kiltech Underwater Ltd. The CFHT [the Trust] having donated the recovered wreckage as part of that same contract. No mention of, or provision for, this group is made in the donation agreement.”

94. Mr Smith then refers to Exhibit BBP02 to his second witness statement, which he described as the Deed of Gift between the Trust and the Museum. However, all that he has filed is the front cover so there is no documentary evidence to support his account of the contents of the agreement.

95. In a third witness statement, Mr Smith provides evidence that he submits shows that there was no three-way working group and that he was working with complete autonomy right from the start of the project. This is a handwritten letter from Ms Gina Campbell on behalf of the Trust dated 28 November 2001, in which she says:

“Dear Bill,

Thank you for your fax of today’s date, outlining very accurately and precisely all the efforts, energys and activities that you and your company

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<sup>21</sup> Second witness statement of William Smith, paragraph 8.

have put in to the Bluebird Project. I use this term, as it will cover conception to finalised restoration of Bluebird Hydroplane K7, which we shall refer to from now on in as 'Bluebird Project' for ease.

I write on behalf of the above mentioned Trust, that we are totally satisfied with all your proposals, and for ease of continuity and time saving would like to give you the title of Team Leader – Project Leader, such as you prefer so that you may pursue all the avenues and leads you have made so far in concluding the final restoration of the above mentioned vessel.

We hasten to add that at this time, and until the project has secured funding, that the Trust nor its Trustees can guarantee to make good any expense you may so incur. In fact we know that you will make application to whatsoever body as is available for funding the project. You will have the right in your position to make any representations as you see fit on behalf of the Bluebird Project. All we ask is that you keep us informed of any progress made in this area. We shall naturally proceed in the same direction – trying to secure the finance that will be necessary.

If you see fit – at the appropriate time to use the services of Lynx Motors, then this or any other arrangement will be at your own discretion.

This preliminary letter is to give you the authority to act on our behalf. Please also be aware that we cannot be held responsible for any accidents or injury to anyone whilst working on the aforementioned craft. This will need to fall under your own insurance/risk. Likewise we would not make any claim against any accident or injury whatsoever befalling anyone using this vessel at a later date.

This letter is a very brief outline, on what must at a later stage – if deemed necessary form the basis of any contract between the parties.

In reference to your last paragraph (of fax), naturally we wish you to continue with the proposed work, in the knowledge that the project will not be pulled

out from under you. We are all operating under a 'trust' and bond of word and I know each party will honour this trust."<sup>22</sup>

96. In her witness statement, Ms Campbell says that:

6. ... Advising that he [Mr Smith] could refer to himself as Project Leader was recognition that at that time, The Campbell Family Heritage Trust was satisfied that Mr Smith was working with us as part of the Bluebird Project. I emphasise in the letter that his right to make representations is on behalf of the Bluebird Project, that is with the aim of assisting the Trust in achieving the aim of restoring Bluebird K7. My letter does not give any rights to Mr Smith relating to the Bluebird Project, Bluebird K& [sic], or the BLUEBIRD name."

97. The most plausible interpretation of Ms Campbell's letter is that the Bluebird Project was not in the sole control of Mr Smith. There is no evidence from either party that any formal contract was entered into. The letter does, in my view, provide an explanation as to why there is none of the extensive documentation that the applicant submits would prove the existence of a three-way working group. Ms Campbell states that "*We are all operating under a 'trust' and bond of word and I know each party will honour this trust.*" In my view, the evidence shows that there were several parties involved in the project: Mr Smith and his company, the Trust and the Museum. The opponent has, in my view, shown that there was a duty of trust between the project parties and Mr Smith was empowered to seek funding and contributions towards the restoration of the boat. He was not empowered to apply to register a trade mark using the name "BLUEBIRD". I find that there is a *prima facie* case of bad faith that the applicant is now required to rebut.

98. Mr Smith states that:

"2. I am project leader of the Bluebird Project, (The Applicant) and have been so without interruption since October 2000, firstly as an agent of Kiltech Underwater Ltd., with whom the original agreement to recover and restore the wreck of Bluebird was made, then later as the agent of Bluebird

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<sup>22</sup> Exhibit BBP17.

Project Ltd., which took over all works in 2012 and continues to the present.”<sup>23</sup>

99. Mr Smith states that there have never been any formal agreements between the applicant and the Trust. I accept that the evidence shows this to be the case. However, I consider that Ms Campbell’s letter, which forms part of Mr Smith’s evidence, shows that there was an informal agreement between them.

100. Mr Smith also alleges that the opponent has altered the narrative to support its case. He refers to the parts of Mr Wales’s first witness statement that deal with the concerns expressed in 2013.<sup>24</sup> He adds that Mr Wales was photographed in the Bluebird Project workshop in 2014.<sup>25</sup> The logo can be seen in these. The problem for the applicant is that exactly the same photographs were exhibits to Mr Smith’s first witness statement, in which he states that they were taken on 12 December 2009. This discrepancy leads me to treat these parts of the witness statements with some caution.

101. Later in his second witness statement, Mr Smith states that the applicant has been “*very publicly*” using the contested mark for 22 years in full knowledge of the opponent. He refers to the *Vanity Fair* article that I have already mentioned, which represents the Trust as trying to keep the peace between the Museum and Mr Smith. There is also an article from the website of the *Daily Mail*, dated 7 November 2016.<sup>26</sup> However, the full text of this article has not been adduced in evidence. There is only the title (“Engine of Donald Campbell’s Bluebird is to roar again following a painstaking restoration bid 50 years after the legendary speedboat racer died in the craft while going for the world record”) and some photographs. I cannot see what the author wrote about the restoration of the boat, or how he referred to the parties involved in this dispute, the Trust or the Museum. The probative value of this exhibit is therefore limited. Finally, there is a still from an edition of the BBC’s *One Show* broadcast on 20 March 2018 in which Ms Campbell sits beside Mr Smith, who is wearing a polo shirt on which the contested mark is emblazoned. This predates the *Vanity Fair* article.

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<sup>23</sup> Second witness statement of Mr Smith.

<sup>24</sup> See paragraph 89 above.

<sup>25</sup> Second witness statement of Mr Smith, paragraph 11.

<sup>26</sup> Exhibit BBP07 to the second witness statement of Mr Smith.

There is nothing in the evidence to indicate what was discussed on the television programme.

102. Mr Smith claims that the applicant has “*forged its own reputation for engineering excellence and problem solving extending far beyond our work on the Bluebird boat and it is this we wish to build upon*”.<sup>27</sup> He lists the following projects in connection with which he states that the applicant has used its mark and reputation:

- The construction of a replica of the Crusader jet boat for a project run by 4<sup>th</sup> year engineering students at Leeds University (October 2021);
- Restoration of an engine and repainting an Avro Vulcan bomber that had not run in 36 years (July 2019);
- Preparation of jet dragster “STAY GOLD” to compete for a British Land Speed Record (January 2017);
- Support of the Baton of Hope suicide prevention charity (undated); and
- Modification and preparation of the Guinness World Record holding head-controlled wheelchair driven to a world record in 2022. Mr Smith states that the BBC news article<sup>28</sup> credits the Bluebird Project for its involvement. What the article actually says is that “*The 48-year-old, from Hull, completed the feat in a wheelchair designed by the team who helped restore Donald Campbell’s Bluebird boat*” and so does not mention the applicant by name. It is also dated after the relevant date of 25 October 2021.

The projects listed in the first three bullet points are evidenced by photographs, which do not show use of the contested mark or even the name “Bluebird”. On the basis of the evidence before me, I am unable to find that the applicant had established its own reputation separate from that of Donald Campbell’s boat.

103. The applicant has failed to rebut the *prima facie* case of bad faith, and so I find that the section 3(6) ground is successful.

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<sup>27</sup> Second witness statement of Mr Smith, paragraph 17.

<sup>28</sup> Exhibit BBP14 to the second witness statement of Mr Smith.

## **OUTCOME**

104. The opposition is successful under sections 5(2)(b) and 3(6). Application No. 3714046 is refused registration.

## **COSTS**

105. The opponent has been successful and is therefore entitled to a contribution towards his costs. It is the long-established practice in this tribunal that costs are not intended to compensate parties for all the expense to which they have been put, but to provide a contribution. This is because the tribunal is intended to be relatively low-cost. As he has represented himself, he was invited to complete a proforma indicating the time spent on particular activities associated with the opposition. These are as follows:

### Forms

5 hours on completing the notice of opposition;

2.5 hours on considering the defence and counterstatement filed by the applicant;

### Preparing evidence/written submissions and considering and commenting on the other side's evidence/written submissions

10 hours on reading the applicant's evidence and preparing responses;

20 hours on looking for substantial evidence and preparing for filing;

1 hour on reading the applicant's extra submissions;

4 hours on preparing extra responses and filing evidence.

### Preparing for a hearing

3.5 hours for preparing spreadsheets for costs and filing forms and re-reading documents.

106. In my view, the amount of time spent on the activities listed under "Forms" and "Preparing evidence/written submissions and considering and commenting on the other side's evidence/written submissions" are reasonable. There was no hearing in these proceedings and so it is not clear to me why the opponent might have needed to re-read any documents. I am prepared to allow 1 hour for gathering and filing the costs proforma. This gives a total of 43.5 hours. The sum to be awarded per hour is

analogous to that set out in the Civil Procedure rules, Part 46, which is currently £19 per hour. I therefore award the opponent costs of £826.50 in relation to the time he spent.

107. The opponent is also entitled to £200 for the official costs incurred. He has also requested £20 for other expenses, namely phone calls, letters and photocopying. The tribunal does not usually reimburse such expenses and I see no reason to do so in this case.

108. The opponent expressed his wish to submit a number of invoices from the firm of Marks & Clerk for what he describes as “*extra legal advice*”. These invoices amount to £6550.20. The opponent has chosen to represent himself before the tribunal. It would not therefore be appropriate to give an award of costs for the legal advice sought. Even if he had chosen to be represented, it is extremely rare for a costs award to cover the full amount of costs incurred. I award the opponent £1026.50 as a contribution towards his costs.

109. I therefore order The Bluebird Project to pay Donald Wales the sum of £1026.50. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 8<sup>th</sup> day of August 2024**

**Clare Boucher  
For the Registrar,  
Comptroller-General**