

O/106/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2510995
BY ASIANA BRIDAL & TRAINING ACADEMY LIMITED
TO REGISTER A TRADE MARK IN CLASSES 3, 41 & 44**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 99335 BY MAGWORLD LIMITED & I AND I MEDIA LIMITED**

BACKGROUND

1. On 12 March 2009, Asiana Bridal & Training Academy Limited (“AB”) applied to register the following trade mark:

ASIANA BRIDAL & TRAINING ACADEMY

Following examination, the application was accepted and published for opposition purposes on 17 April 2009 for the following goods and services:

Class 3: Soaps; perfumes; cosmetics; personal deodorants; essential oils; make-up; toothpaste; hair lotions.

Class 41: Education; training and instruction; cultural activities.

Class 44: Hygienic and beauty care; hair dressing.

2. On 17 July 2009, a notice of opposition was filed which identified Magworld Limited as the opponent. However, in a letter dated 16 December 2010 (i.e. prior to filing its evidence in reply), the opponent’s professional representatives, Boulton Wade Tennant (“BWT”) sought leave to amend the notice of opposition by adding I and I Media Limited as a joint opponent. In a letter from the Trade Marks Registry (“TMR”) dated 25 January 2011, AB’s views were sought on this request. AB’s professional representatives, Marks & Clerk LLP (“MC”), objected to this request in a letter dated 8 February 2011. On 18 March 2011, the TMR wrote to the parties. It said, inter alia:

“The comments in Marks & Clerks LLP’s letter have been noted, however, in line with the decision of Professor Annand in TAO ASIAN BISTRO (BL O-004-11) in particular paragraphs 28 to 35, the Registry proposes to allow I and I Media Limited to be joined as co-opponent to these proceedings.”

3. The parties were allowed until 1 April 2011 to indicate if they wished to be heard on the point. In a letter dated 28 March 2011, I & I Media Ltd indicated that it had had sight of the papers filed in these proceedings, stood by the evidence already submitted and agreed to accept joint liability for costs; no response was received from AB. On 26 April 2011, the TMR wrote to the parties confirming that I and I Media Limited had become a joint opponent in the proceedings; AB did not comment on this letter. As a consequence of the above, it is clear that the time has long since passed for AB to challenge the TMR’s view of the matter, and I shall, as a result, refer to the joint opponents in these proceedings as MI.

4. MI’s opposition (which is directed against all of the goods and services in AB’s application) consists of a single ground, based upon section 5(4)(a) of the Trade Marks

Act 1994 (as amended) (“the Act”). MI states that it has used the signs **ASIANA** and **ASIANA WEDDING** in the UK since October 2003 in relation to “printed matter, namely magazines” and that while the first show held under the sign **ASIANA BRIDAL SHOW** took place in London in 2004, “advertisements would have been circulated to a wider UK audience prior to this date.” MI states that this sign has been used in relation to the “running and operation of a bridal show, printed matter”. In its amended statement of grounds MI states, inter alia:

“7....The application covers class 3, and such goods are typical of those sold at the Asiana Bridal Shows and advertised or featured within the ASIANA and ASIANA WEDDING magazines. Class 41 covered by the application is identical to those services for which [MI] have used their mark, in particular the operating of their bridal shows and their magazine publication. The class 44 services of the application are also in direct conflict with the content that would have been in the ASIANA magazines and the ASIANA BRIDAL SHOWS.”

5. On 24 September 2009, AB filed a counterstatement which denies MI’s claims and puts MI to strict proof.

6. Both parties filed evidence. Despite the tribunal’s recommendation, neither party wished to attend a hearing, nor did they file written submissions in lieu of attendance at a hearing.

EVIDENCE

MI’s evidence-in-chief

7. This consists of nine witness statements. The first, dated 15 March 2010, is from Emma Jane Pitcher who is a trade mark attorney at BWT, who were MI’s professional representatives in these proceedings. As the majority of Ms Pitcher’s statement consists of submissions, it is neither necessary nor appropriate for me to summarise it here; I will, of course, keep its contents in mind when reaching a decision. That said, Ms Pitcher states that MI provides the services in AB’s application in classes 41 and 44 through its magazine and bridal shows. Exhibits EPJ05 and EPJ06 consist of a selection of articles taken from MI’s magazines (whose dates range from winter 2003 to winter 2008) which Ms Pitcher says supports this contention.

8. The second statement, dated 15 March 2010, is from Ashok Dhawan who is the Director of Magworld Limited and the Company Secretary of I & I Media Limited. He states that the companies are closely associated. He explains that I & I Media Limited “invented” the trade mark ASIANA in 2003 and that I & I used the trade mark continuously until 1 January 2007 when they transferred all rights to it to Magworld Limited; on the same date Magworld Limited licensed the right to use the ASIANA trade mark back to I & I for a period of 25 years. Exhibit AD01 consists of documents in support of the above.

9. Mr Dhawan states that MI produces a very successful and well known magazine under the name ASIANA, adding that a bridal version of the magazine is produced under the name ASIANA WEDDING. He states that ASIANA and ASIANA WEDDING are the best selling Asian glossy magazines in the UK. He goes on to say that MI also offers bridal shows under the name ASIANA BRIDAL SHOW and has done so since the first show was held at the Café Royal London in January 2004.

10. Mr Dhawan explains that the first ASIANA magazine was issued in winter 2003 and was distributed throughout the UK. He states that MI used to produce 7 magazines per year, 4 ASIANA magazines and 3 ASIANA WEDDING magazines. However, from 2009 MI increased production to eight issues per year (four of each magazine) with each issue costing £4.50. MI also produces a magazine called ASIANA WEDDING INTERNATIONAL which although aimed at customers outside of the UK, is requested by UK customers to the extent that 5,000 copies of this magazine are circulated within the UK each year. MI's magazines are, explains Mr Dhawan, aimed predominately at the Asian population in the UK and at Asian markets. Exhibit AD02 consists of two pages downloaded on 10 March 2010 from www.statistics.gov.uk relating to the 2001 census. Mr Dhawan notes that 4% of the population were classified in the census as "All Asian or Asian British."

11. Exhibit AD03 consists of a "To whom it may concern" letter dated 10 March 2010 from David Jones, who is the Marketing Manager of Post Scriptum, a distribution and marketing service. Mr Jones confirms that Post Scriptum are distributors of ASIANA and ASIANA WEDDING magazines in the mainstream, wholesale and retail markets and that they have been (and continue to be) distributors since their appointment on 1 November 2003. He goes on to say that Smiths News and Menzies Distribution distribute both titles to the national independent and multiple news trade and that the magazines are sold through Tesco, Asda, W H Smith and independent newsagents. The total numbers of magazines that have been distributed are provided and amount to approximately 400,000 in relation to ASIANA and 323,000 in relation to ASIANA WEDDING.

12. Mr Dhawan states that both magazines are available by subscription. MI have 1500 direct subscribers to ASIANA WEDDING magazine and 600 direct subscribers to ASIANA magazine per quarter. Both magazines have also been available since 2004 via iSubscribe which Mr Dhawan explains offers a range of magazine and newspaper subscriptions online; MI have 200 iSubscribe subscriptions per year. Exhibit AD04 consists of 159 pages, page 1 of which was downloaded from www.isubscribe.co.uk on 10 March 2010 and which indicates that both magazines are available on a subscription basis. Mr Dhawan states that the magazines have been very successful referring in particular to:

"6...ASIANA WEDDING was voted No 19 in the "Top 20 Subs this Month" by iSubscribe in February 2005 and was rated the No. 1 Wedding Magazine subscription 26 March 2004-11 December 2004, beating more mainstream titles

such as “You and Your Wedding”, “Brides”, “Wedding Day” and “Cosmopolitan Bride.”

13. The ASIANA and ASIANA WEDDING magazines have, says Mr Dhawan, also been sold directly to the public at MI’s ASIANA BRIDAL SHOW and “at other events such as wedding and lifestyle shows and other Asian orientated events.” Both magazines feature in the British Library Catalogue, a fact which is confirmed by exhibit AD05 which consist of extracts downloaded from The British Library’s Integrated Catalogue on 10 March 2010. This shows that the first issue of ASIANA magazine was winter 2003 and ASIANA WEDDING magazine spring 2004; the publisher of both magazines is shown as I and I Media.

14. Mr Dhawan states that MI runs the ASIANA BRIDAL SHOW which over the years has been sponsored by HSBC, Johnnie Walker, British Airways and Cobra Beer. Since 2004 MI have charged £10 to enter the show and £20 to both enter the show and to view the catwalk event. The show has, he explains, been held in London (2004-2009), in Birmingham in 2008 and 2009 and in Bradford in 2006. In total the shows have attracted in the order of 75,000 attendees. Exhibit AD06 consists of tickets for the 2009 show together with what Mr Dhawan describes as a “template for the 2007 tickets.”

15. Mr Dhawan goes on to say that a Guide Book is produced for each show and is given free to all attendees. Exhibit AD07 consists of copies of the guides from 2004 and 2006 both of which feature the words ASIANA Bridal Show. Exhibit AD08 consists of a pamphlet advertising the 2008 ASIANA BRIDAL SHOW in which the words ASIANA Bridal Show feature prominently. Exhibit AD09 consists of extracts taken from the ASIANA Bridal Show guides from 2004-2010, the vast majority of which contain references to the ASIANA Bridal Show. Mr Dhawan notes that major sponsors of the various shows include: HSBC, Cobra Beer, Sony Entertainment Television Asia, Johnnie Walker, Chivas, Hilton Birmingham Metropole, Joshiv Beauty International, PharmaClinix, British Airways, Kismat Radio, Veetee, Bombay stores, Payal, Littlewoods and AdiAdi beer.

16. Mr Dhawan states that since 2004 the ASIANA BRIDAL SHOW held in London has been advertised by Sunrise Radio, a radio station based in Southall, London which, he explains, is very popular with the Asian community. He adds that Sunrise is now a national radio station that attracts between 450-514,000 listeners a year. He explains that Sony Entertainment Television ASIA (SET Asia) also sponsor and advertise the ASIANA BRIDAL SHOW and record the exhibition and catwalk shows for transmission on its television channel. Exhibit AD10 consists of a “To whom it may concern” letter dated 10 March 2010 from Rajan Singh, the Executive Vice-President for International Business at SET. Mr Singh says:

“[SET Asia] has been media sponsors for Asiana Bridal Shows since their inception in 2004, and has recorded these at the following events [events in 2004 to 2009 are mentioned].

Subsequent to the recording the Catwalk and Exhibition have been broadcasted on SET Asia [a number of countries are mentioned including the UK].

Prior to our attendance at the show, we have also run regular advertisements for the Asiana Bridal Shows over the years.”

17. Mr Singh’s letter is accompanied by a number of screen shots of advertisements for the ASIANA BRIDAL SHOW from 2006, 2007 and 2008 which were broadcast on SET Asia accompanied by a DVD of the actual advertisements. Exhibit AD11 consists, inter alia, of the front page of the 2008 Midlands Edition of a free publication entitled “Ad Asia The Definitive Asian Directory!” accompanied by an advertisement for the ASIANA Bridal Show which appeared in it. Mr Dhawan explains that the directory is used to target the Asian market. The words ASIANA BRIDAL Show have also appeared on buses in central Birmingham for four week periods in 2008 and 2009. Exhibit AD12 consists of photographs of buses bearing the words, accompanied by correspondence relating to the placement of the advertisements.

18. Mr Dhawan states that MI run a website at www.asianamag.com which provides information on MI’s publications and bridal shows together with more general lifestyle issues. Its website has 57,000 registered users and much of the content of its magazines is reproduced on its website, 850,000 page impressions are made per month; each year approximately 20,000 visitors click on the banners on this website that advertise its bridal shows. Exhibit AD13 consists of printouts from this website from 2004 to 2010. ASIANA magazine was, states Mr Dhawan, an exhibitor at the Zee Carnival 2007 held at Olympia, London. Zee TV is, he explains, an Indian based satellite channel which launched in the UK in 1995. It is available on subscription on a number of platforms and is one of the leading Hindi general entertainment channels. The event attracted over 30,000 visitors. Exhibit AD14 consists of the front page of the show guide accompanied by a page indicating that Asiana magazine was an exhibitor. In addition, MI ran 30 second advertisements for the ASIANA Bridal Show on Zee TV between 20 January and 3 February 2009. Exhibit AD15 consists of printouts downloaded from the website www.zeeuk.com on 15 March 2010 accompanied by a schedule of the times and dates the advertisements were aired and a redacted copy of the advertising sales contract.

19. Mr Dhawan states that MI sponsors the catwalk and participates in the Asian Lifestyle Shows which are run by Mr Tony Lit, who is one of the show’s founders and a director of Sunrise Radio’s owner LITT Corporation Ltd. Exhibits AD16, AD17, AD18, AD19 and AD20 consist of pages taken from the official show guides for 2004, 2005, 2006 and 2007. The 2004, 2005 and 2006 shows were held at Olympia, London; approximately 40,000 people attended the 2004 show; the 2007 shows were held at the NEC in Birmingham and Olympia; approximately 8,000 people attended the Birmingham show. The pages provided refer, inter alia, to “Lifestyle Catwalk in association with ASIANA” and list Asiana/Asiana Magazine as an exhibitor at the shows.

20. Mr Dhawan states that MI spends approximately £50,000 per year on promotional activities and advertising, including television and radio advertisements. It also holds promotional parties for young professional Asians, between 12 and 14 have been held “over the past six years”. Turnover since 2004 has, he explains, “been a little over £1 million per year”.

21. Exhibit AD21 consists of a copy of an Exhibitor Manual for the ASIANA Bridal Show from 2005 which, Mr Dhawan notes, featured the sign ASIANA prominently. Exhibit AD22 consists of, inter alia, a “To whom it may concern” letter, hand dated 22 February 2010 from Munsur Ali who is a Director of a production company called Spotlight UK Limited. Mr Ali says, inter alia:

“I write to confirm that our company Spotlight UK Ltd, have covered the Asiana Bridal Show 2008, 2009 and the 2010 event.

For the 2008 Asiana Bridal Show in Birmingham we provided video coverage, filming the live events, namely the fashion show and we also separately filmed “behind the scenes” footage. Both videos were compiled for DVD and highlights were provided for web videos.

We provided the same service for 2009 Asiana Bridal Show, for London and Birmingham, resulting with the similar services and products as for 2008.

I myself was present on all occasions of the shoots and can confirm that all the events were managed or communicated by the Asiana magazine team and I and I Media.”

This exhibit also includes 3 DVDs containing footage from the 2008 and 2009 shows.

22. Mr Dhawan explains that Media Moguls are a PR agency set up in 1994 to target the Asian marketplace. Exhibit AD23 consists of a Media Report by Media Moguls dated February 2004 in relation to the ASIANA Bridal Show held in January 2004. The report indicates that the show (both pre and post event) was commented upon in, inter alia, a range of Asian and regional press and on Asian and mainstream websites. Exhibits AD24 and AD25 consist of original copies of the first edition of the ASIANA magazine (from winter 2003) and ASIANA Wedding magazine (from spring 2004) respectively. Exhibits AD26 and AD27 consist of the front covers and extracts taken from 23 issues of ASIANA magazine (from winter 2003 to autumn 2009) and from 20 issues of ASIANA Wedding magazine (from spring 2004 to spring 2010) respectively. Mr Dhawan explains that exhibits AD28 to AD35 consist of a selection of photographs taken at the ASIANA Bridal Shows held between 2005 to 2010 in many of which the ASIANA sign is prominently displayed.

23. The third statement, dated 12 March 2010, comes from the aforementioned Tony Lit, a Director of Sunrise Radio Limited which is part of the Litt Corporation Limited who operate Sunrise Radio, Kismat Radio, Buzz Asia, Punjabi Radio and Sunrise TV. The

Litt Corporation are, says Mr Lit, the market leaders in electronic Asian media in the UK. He explains that Sunrise Radio has become very successful and now broadcasts nationwide. As evidence of this success he refers to exhibit TL1 which consists of downloads obtained from www.rajar.co.uk (Radio Joint Audience Research Limited) which operates a single audience measuring tool for licensed commercial stations. The figures provided are for "all individuals 15+" for the periods ending March 2007, 2008 and 2009 and indicate that in those periods Sunrise Radio had between 466,000 and 514,000 listeners. Mr Lit goes on to say that his company has worked with ASIANA for a number of years and in particular with them on the ASIANA Bridal Shows. He states that: "The ASIANA BRIDAL SHOW" is the No. 1 show of its kind in the UK market today." He explains that exhibit TL2A consists of a Sunrise Radio transmission certificate for the ASIANA BRIDAL SHOW advertisement showing the days and times at which the advertisements for the show were transmitted; the certificate which covers the period 1 December 2008 to 25 January 2009 indicates that the advertisement was broadcast on approximately 900 occasions. Exhibit TL2B consists of two scripts which relate to the radio advertisements broadcast in 2007 and 2009, both of which mention ASIANA and the ASIANA Bridal Show. Mr Lit says:

"4. The brand appreciation in the Asian wedding market of ASIANA has been built up over several years via PR, marketing on radio and TV and via consumer ASIANA parties in the UK and abroad....

5. My company founded the Asian Lifestyle Shows and ASIANA have also sponsored the wedding and fashion pavilions at that show. The Asian Lifestyle Show takes place at Olympia in the Grand Hall."

24. The fourth statement, dated 10 March 2010, is from Gurmej Singh Pawar. Mr Pawar is the Director of Meji Media Ltd an events and media company, a business Mr Pawar has been involved with for four years, having previously worked in television as a freelance presenter. Meji offers a range of services including event management and design, venue searches and bookings, a corporate filming service, decoration and styling for events, entertainment, catering, photography and other services related to hosting of events; it has a website at www.mejievts.com. Mr Pawar is also the Director of Wedding Presenter Videography Limited which has a website at www.weddingpresenter.com which offers modern Asian wedding videography. Mr Pawar explains that he first became aware of the Asiana brand some five and a half years previously when he saw the Asiana magazine. He explains that he is also aware of the Asiana Wedding magazine, that Asiana has a website and that they host bridal shows. Mr Pawar goes on to say that:

"5. I organise parties for Asiana. I also advertise my wedding videography company in the Asiana and Asiana Wedding magazines and I hold stands at their bridal shows in order to promote my services.

6. The Asiana brand is synonymous with image, glamour, style and sophistication. It focuses on beauty, lifestyle and fashion and is treated as a directory of good style and trend setting among the Asian community...”

25. The fifth statement, dated 12 March 2010, comes from Malkit Singh Dadi. Mr Dadi explains that he is the partner of Kyles Collection who are manufacturers, wholesalers and retailers of designer jewellery; Kyles have been in business over 20 years and have a website at www.kylescollection.com. Mr Dadi explains that he has been aware of the ASIANA brand since the first Asiana magazine was issued in 2003, adding that he knows of the Asiana and Asiana Wedding magazines and the Asiana Bridal Show. Mr Dadi says:

“3. My company has advertised with ASIANA since it started. Initially my company advertised in only some of the editions but for the last two years we have advertised in every issue of both Asiana magazine and Asiana Wedding magazine. In addition, we have also started to advertise in the international edition of the magazine.

4. For the last six years my company has taken part in all of the Asiana Bridal Shows, including the fashion shows that are held as part of the event.

5. ASIANA are world leaders in their field. They have a very talented team and are well connected in the Asian fashion industry and are setting high standards for the whole world. They have helped my company to establish and grow our business. The Asiana Wedding magazine is a bible for all the brides who are in the process of planning their wedding....

6...The Asiana Bridal Shows kick starts the season.”

26. The sixth statement, dated 5 March 2010, comes from Rita Chandarana who is the Managing Director of Maz of Leicester which operates in the events and photography business. She explains that the Maz brand, which has been in existence for approximately 45 years, is her family’s business with which she has been involved for twenty years. Ms Chandarana states that she is aware of the ASIANA magazines and bridal show, and has been aware of ASIANA since 2002 or 2003. She says:

“4. My company have been advertising with Asiana since its inception and have been attending the bridal shows since they started in 2004...Asiana is a unique brand that attracts high-end Asian audiences in whatever activities they engage themselves in. The customers of Asiana are the customers that my company wish to engage with. Products and services that Asiana provide are exclusive and inspirational...”

27. The seventh statement, dated 15 March 2010, comes from Sanjay Anand MBE who is the Chairman of Madhu’s Limited. He explains that his company has been

established for over 30 years and is the biggest catering company in the UK Asian market with an annual turnover of £6 million. He states:

“2. My company aims its services at the top end of the market. We only cater for the most prestigious events and weddings at five star venues, including, The Hilton, Park Lane, The Grosvenor, Park Lane and the Natural History Museum in South Kensington. My company also regularly cater for members of the Royal family, The House of Lords, The Houses of Parliament and the Prime Minister.

3. My company is also the sole supplier of Indian foods to the world famous London department stores Harvey Nicholas (sic) and Harrods.”

28. Mr Anand goes on to say that he has known of the Asiana magazines and Asiana Bridal Shows since their launch in 2003 and 2004, adding that his company has advertised its services in the magazines since 2003; copies of these advertisements are provided as exhibit SA2; his company is also a partner in the Asiana Bridal Shows. He adds:

“7. I believe that ASIANA is the premier publication within the Asian market and my company’s association with the ASIANA brand attracts business for us from across the UK and overseas.

8. It is my view that ASIANA is a byword for excellence in the field of weddings, and as my company is the biggest caterer in the Asian wedding market, I can confidently say that ASIANA is known as the No. 1 magazine to every Asian wedding service provider in the UK.

9...We are market leaders in our field and we would not wish to associate ourselves with anyone other than another market leader – which is ASIANA.”

29. The eighth statement, dated 8 March 2010, is from Mona Vora who is a designer and Director of Mona Vora Limited, a business which started in 1995. Ms Vora’s business makes bridal wear and outfits for all family members who are attending a function. The business also sells jewellery and other accessories; it has a website at www.monavora.com. Ms Vora has been aware of the ASIANA brand for approximately eight years. Ms Vora says:

“4 Asiana is aimed at high fashion and bridal markets. As well as advertising with Asiana since the first edition of the Asiana magazine, I have taken part in the bridal shows organised by Asiana for the past four years.”

30. The ninth and final statement, dated 15 March 2010, comes from Ambreen Ahmed who is a freelance make-up artist and sole trader, prior to which he worked for MAC Cosmetics between 2003 and 2008. Mr Ahmed explains that he has been freelance for approximately three years and offers a range of make-up services, including bridal make up; he has a website at www.ambreenmakeup.com. He states that he has been

reading the Asiana magazine since it was first published and that he is aware that Asiana also have a website and run the annual Asiana Bridal Show. He says:

“3. I have worked with Asiana for over four years doing make-up for the magazine photo shoots as well as for the bridal shows. I have also held a stand for the last three consecutive years at the Asiana Bridal Show. Prior to this I did the catwalk make-up backstage in 2007 and before this I regularly attended the Asiana Bridal Shows.

4. ASIANA are simply the best in the market.”

AB’s evidence-in-chief

31. This consists of six witness statements. The first statement, dated 16 August 2010, comes from John Ferdinand who is a trade mark attorney at MC. Mr Ferdinand explains that the information in his statement comes from either his own knowledge or from information provided to him by AB. I think it is fair to say that the majority of Mr Ferdinand’s statement consists of submissions rather than evidence; I will refer to these submissions as necessary below. However, one of these submissions i.e. if there is a goodwill who owns it, appears to have been overtaken by the events I have described at paragraphs 2 and 3 above i.e. I & I Media Limited becoming a joint opponent. While I do not propose to summarise the state-of-the-register evidence provided by Mr Ferdinand as exhibit JF2 here, I will, if necessary, return to it later in this decision.

32. The second statement, dated 13 August 2010, comes from Sukhjit Kaur, nee Sanghera. Mrs Kaur states that she is the founder and Director of AB, a position she has held since the incorporation of her company in February 2009. Mrs Kaur explains that she is a hair and make-up artist who has been working in this area for over twenty years. Exhibit SK2 consists of a selection of certificates (in the fields mentioned above) awarded to Mrs Kaur, the dates of which range from February 1999 to February 2010. Exhibit SK3 consists of a number of photographs downloaded on 17 August 2010 from www.asianabridal.com which Mrs Kaur says: “show the quality of my work.” Mrs Kaur says that she has become well respected in her field and has been asked to offer her services as a make-up artist for a number of different fashion shows, magazines, television advertisements and photo shoots. Exhibit SK4 is a copy of an article which appeared in *The Birmingham Evening Mail* on 26 November 2002. The article, which is about mendhi painting, refers to: “Sukhjit Kaur who runs the Asian Hair and Beauty Service, Handsworth...”

33. Mrs Kaur states:

“7. I first began plans for use of a business name incorporating the element ASIANA in relation to the provision of hair, beauty and make-up services which were tailored to suit the needs of brides for weddings in connection with a business in India in 2002. At that time I commissioned the printing of business cards by a company called Amrik Singh and Sons based in the Punjab in

India...At the time the business I started under the name ASIANA for beauty, make-up and bridal services was known as “Asiana Bridals””.

34. Mrs Kaur explains that she chose the word ASIANA because it suggested a link with the specialist services she provides which have an Asian theme. She states that other businesses had used this name prior to her and she mentions Asiana Airlines which she says began trading in 1988. Exhibit SK5 consists of a Google® search conducted on 17 August 2010 for “asiana”. The first three pages of the search are provided, as are extracts from the websites of: www.euflyasianacom, www.asianatravel.com, www.asianagold.com and www.asianacafe.com. As far as I can tell, none of these expanded hits appears to refer to undertakings in the UK and all appear to use the word Asiana in a trade mark sense.

35. Mrs Kaur goes on to say that she registered the domain name www.asianabridals.com in March 2008 and worked on creating content and design for that website prior to selling it to a business called Millis. Exhibit SK6 consists of three pages downloaded on 17 August 2010 from www.asianabridals.com. The pages provided refer to “Millis one stop beauty” and “Millis Complete Bridal Services” but as far as I can tell make no mention of Asiana. Exhibit SK7 consists of a page obtained from www.asianabridals.com on 12 August 2010 using the Internet archive WayBackMachine which appears to show how the page looked in 2008. Mrs Kaur notes the reference to “Sukhi...Complete Bridal Services” (Sukhi being a diminutive reference to her first name). While this page also contains a reference to “Millis one stop beauty” once again the word Asiana does not appear. Mrs Kaur states that she still provides her services as a make-up artist to Millis. Mrs Kaur says:

“10. I wanted to use the name ASIANA in my plans to trade in the United Kingdom...and began plans to use this name in the UK in 2008 and incorporated my company in February 2009...”

36. Mrs Kaur states that the domain name www.asianabridal.com was registered in December 2008. Mrs Kaur describes exhibit SK8 to her statement in the following terms:

“11...an extract from my company’s website which outlines the range and type of services and training courses provided by my company including the cover page for a manual produced by my company and examples of certificates issued to students who have completed the training courses offered by my company. These services have been provided continuously since my company’s launch in February 2009 and have been promoted in conjunction with the trading name ASIANA BRIDAL & TRAINING ACADEMY.”

37. The pages provided from the website www.asianabridal.com were downloaded on 17 August 2010. All of the pages from the website contain, inter alia, a reference to ASIANA Bridal & Training Academy Ltd at the top left of each page.

38. The pages provided are headed “Bridal Services”, “Training Academy” and “Asiana Bridal Training Packages”. The exhibit also contains what Mrs Kaur describes as the cover page of a manual produced by her company and certificates issued to students. The cover of the manual entitled “Asian Bridal Make-up and Dressing” contains, inter alia, the following text:

“Asiana

Bridal & Training Academy Ltd.

Tutor: Sukhi Sanghera”

39. The two certificates (which both contain references to “ASIANA Bridal & Training Academy Ltd” and which are dated 30 July 2009 and 15 July 2010, both relate to a “Hair Styling Course”; the certificate dated 30 July 2009 has been signed by the course tutor Sukhjit Sanghera.

40. Ms Kaur explains that the training courses provided by AB in make-up, hair and beauty are accredited by well regarded industry bodies such as The Guild of Beauty Therapists, City & Guilds and the International Health and Beauty Council. Exhibit SK9 consists of pages downloaded on 17 August 2010 from www.beautyguild.com and www.cityandguilds.com providing general information on these two organisations. The Guild of Professional Beauty Therapist describes itself thus:

“Launched in 1994, The Guild of Professional Beauty Therapist is the UK’s biggest professional beauty trade body. The Guild has over 6,000 members who are all fully qualified beauty and holistic therapists. All members of the [Guild] work to a strict code of ethics. If you have a complaint against a Guild member, you can write to us at the address below. To find out more...”

41. I note that Asiana Bridal & Training Academy is listed as an “Accredited School” on page 58 of the *guildgazette* and that one of the pages from the beauty guild website contains, under the heading, “Training Directory”, a reference to Asiana Bridal & Training Academy Ltd and lists Sukhi Sanghera as the contact name. It describes the above company as offering “courses in Asian Bridal Makeup, Hair styling, Mehendi, Dressing courses”. Also included in this exhibit are 4 certificates; two are from “the guild of Beauty Therapists” and are dated 9 February 2009 and 2 February 2010. They indicate that Mrs Kaur is a full member of the Guild. The two remaining certificates are from the International Health and Beauty Council. The certificates, dated 28 and 31 October 1999, certify that Mrs Kaur has attended an approved course of training and has been awarded a certificate/diploma in “Threading Depilation” and “Mendhi/Henna Skin Decoration”; none of the certificates mention Asiana.

42. Mrs Kaur explains that the services AB provides are highly specialised, are chosen with care and are often the subject of a free consultation before the potential customer engages her company. She adds that AB are highly respected in the industry and AB

has been asked to work on/with a number of television advertisements, photo shoots fashion houses and catwalk shows. In order to promote its services, Mrs Kaur explains that AB has engaged in Google® Adword advertising since it began trading in 2009. Exhibit SK10 consists of an invoice dated 3 June 2009 from match maker marketing to AB in the amount of £149 in respect of “Google Marketing”; Mrs Kaur states that AB now purchases keywords directly from Google®. Keywords that have been acquired by AB include ASIANA BRIDAL, ASIANA, ASIANA BRIDALS, ASIANA BRIDAL MAKEUP and ASIAN MAKE UP. Exhibit SK11 consists of the results of two Google® searches for the word “asiana” and “asian make up” conducted on 17 August 2010. On page 1 of the search at item 3 is a reference to “Asiana Magazine & Wedding – Asian & Indian Fashion...” i.e. MI’s website. On page 2 of the search under the heading “sponsored links” appears an entry for AB’s business; similarly, a reference to AB’s business appears as a sponsored link on page 2 of the search for “asian make up”.

43. Mrs Kaur goes on to say that aside from Google® Adword advertising AB have commissioned advertisements and listings in various publications and online directories associated with AB’s area of commercial interest. Exhibit SK12 consists of pages downloaded from www.partyoffers.co.uk and www.yourdreamshaadi.co.uk on 17 August 2010. Also included are undated pages from the *Asian Wedding Directory*. While all of the pages provide general information on the businesses concerned, as far as I can tell none of the pages refers to AB. That said, exhibit SK13 consists of: (i) an invoice dated 20 January 2009 from Your Dream Shaadi to Asiana Bridal for £150 in relation to :”Premium Directory Listing (Bridal Makeup)” which is valid for 15 months from the date of the invoice, (ii) an advertising booking form dated 9 December 2008 for £500 from the *Asian Wedding Directory* to Asiana Brides, and (iii) an e-mail dated 10 August 2010 from jon.stebbing@partyoffers.co.uk to Mrs Kaur at her personal e-mail address in which Mr Stebbings says, inter alia:

“I write to confirm that Asiana Bridal have been listed in www.partyoffers.co.uk since 13 January 2009.

44. Exhibit SK14 consists of, explains Mrs Kaur, pages taken from www.awduk.co.uk which she points out says:

“The Asian Wedding Directory is printed on a quarterly basis with a nationwide circulation of 45,000 FREE copies. This distribution is what will allow the Asian Wedding Directory to be the only true FREE Wedding Directory in the United Kingdom.”

45. Exhibit SK15 consists of the cover page of the “1st quarter 2009” edition of the *Asian Wedding Directory* accompanied by two pages advertising AB’s services. The first page features the words “ASIANA BRIDAL TRAINING ACADEMY ” and refers to: hair styles, make-up and mehndhi” while the second page refers to “ASIANA BRIDAL”, “WWW.asianabridal.com” and “Sukhi Sanghera” and refers to: hair, make-up & mehndhi bridal services. Exhibit SK16 consists of an extract downloaded on 17 August

2010 from www.partyoffers.co.uk which contains references to “Asiana Bridal & Training Academy” and which Mrs Kaur says has appeared on this website since January 2009.

46. In the absence of a hearing in these proceedings (which the tribunal recommended) or any written submissions from AB in lieu of attendance at a hearing, the conclusions (which are in effect submissions) reached by Mrs Kaur on the basis of the evidence filed to date are reproduced below in full:

“24. All of this advertising and promotional activity as well as the quality of the services my company has meant that my company has acquired a considerable reputation and goodwill in relation to the services provided by my company under the name ASIANA BRIDAL & TRAINING ACADEMY.

25. The evidence submitted by Magworld Limited, (the Opponent), in these opposition proceedings provides information on the publication of magazines entitled ASIANA and ASIANA WEDDING and that it also includes reference to the provision of bridal shows under the name ASIANA BRIDAL SHOW.

26. I am not aware of use of trade marks or trading names incorporating the element ASIANA by any company other than my own in relation to the beauty, hairstyling and make-up services or educational services related thereto which my company provides. The evidence provided by the Opponent does not indicate that it has used trading names or trade marks incorporating the element ASIANA in relation to the services provided by my company or, for that matter, in relation to beauty products and cosmetics which are covered by my company's trade mark application in class 3.

27. The Witness Statements provided by the Opponent in support of the opposition on behalf of Ashok Dhawan (Director of Magworld Limited), Tony Lit, Rita Chandarana, Malkit Singh Dadi, Gurmej Singh Pawar and Sanjay Anand all include statements that the individuals concerned would consider that use of the mark ASIANA by any other third party would cause confusion in the marketplace. However, each of these individuals is a vested interest in the Opponent's business. Mr Dhawan is the Director of the Opponent, Mr Lit is the director of a radio station which has been commissioned by the Opponent to produce and broadcast advertisements for the Opponent, Mr Lit is also a partner of the ASIANA BRIDAL SHOW, Ms Chandarana's company has consistently advertised in the Opponent's magazine and at their bridal show, Mr Singh Pawar organises parties on behalf of the Opponent and the business of Mr Anand is a partner of the bridal show run by the Opponent and has continuously advertised with the magazine of the Opponent. It therefore seems to me that these statements are not necessarily impartial. In any event none of these individuals provide services in the field of beauty, make-up or hairstyling or education and training services related thereto.

28. However, I confirm that in the entire trading history of my company I have not been aware of any instances of confusion between my company and the Opponent. I consider that part of the reason for this must be that the services provided by my company are different from the commercial interests of the Opponent and consumers are readily able to distinguish the two. In this regard I refer to the Witness Statement of Sidra Qadir in these Opposition [see paragraph 50 below] which states that although she had heard of a magazine called ASIANA before engaging my company's services, she immediately knew there to be no connection between the services provided by my company and that magazine.

29. It is also true that, as discussed above, my company's services are highly specialist and the customers of my company are accustomed to spend a considerable amount of time before deciding whether to engage my company's services. This is partly because these services are often concerned with preparation for the enormously important occasion of the wedding day of my company's customers. It is common before purchasing the services of my company for my company's customers to engage in detailed consultations about the kind of services which may be appropriate in their individual circumstances. The fact that my company's customers are likely to take time over a decision of whether or not to engage my company's beauty, make up hair and training services is also liable to reduce any likelihood of confusion between my company and the business of the Opponent even further.

30. Finally, as discussed [above] and as shown in the contents of Exhibit SK5, there are a number of different businesses which trade under names incorporating the element ASIANA because of the connection it suggests with Asia and Asian products or services. It may be that the public is used to be able to distinguish these businesses in the marketplace on the basis that the goods and services they provide are different. Certainly, and as stated [above], I do not consider that Mr Dhawan of the Opponent "invented" the word ASIANA.

31. Accordingly I do not believe there to exist a likelihood that my company's customers would be confused between the services of my company and the business of the Opponent and believe it would be even less likely customers would be misled or deceived into thinking that my business is connected with the Opponent."

47. The third statement, dated 10 August 2010, comes from Inderjit Singh of "Company Amrik Singh & Sons" of the Punjab India. Mr Singh says, inter alia:

"2. The facts of this witness statement come from my personal knowledge and business dealings with Asiana Bridals...My company had made some business cards for a company called Asiana Bridals in year 2002 were we printed (Asiana Bridals) as company name on business cards for Sukhjit Kaur as director of company Asiana bridals.

3. Business cards subject: for hair, make-up and bridal services.”

48. The fourth statement, dated 11 August 2010, comes from Najma Ditta. Ms Ditta explains that in May 2009 she attended a course on hair, make-up and mehndi run by AB under the trading name ASIANA BRIDAL & TRAINING ACADEMY. She adds that she found out about the course from the Asian Signature Team Show. Exhibit ND1 is a questionnaire which Ms Ditta explains she was asked to complete. The questionnaire, which is headed “Questionnaire for students of the Asiana Bridal & Training Academy Ltd in the matter of UK trade mark Application No. 2510995 ASIANA BRIDAL & TRAINING ACADEMY” poses seven questions, namely:

(1) When did you take a course with Asiana Bridal and Training Academy Limited?

(2) What kind of course did you take and in what discipline?

(3) How would you rate the quality of the service that you received during the course?

(4) How did you find out about the courses run by Asiana Bridal & Training Academy Limited?

(5) Does the word ASIANA have any particular significance to you? If no please do not answer any more questions, if so please proceed with answering the remaining questions.

(6) If so what particular significance would you attach to the word ASIANA?

(7) Do you perceive there to be a connection between Asiana Bridal & Training Academy Limited and the significance attached to the word ASIANA discussed in question 6?

49. Questions 1, 2 and 4 are purely factual; the remaining questions are subjective; I have included Ms Ditta’s responses to the factual questions above.

50. The fifth statement, dated 12 August 2010, comes from Sidra Qadir; Ms Qadir also completed the questionnaire mentioned above. She explains that in February 2010 she attended a course on full bridal and occasion hairstyling run by AB under the name ASIANA BRIDAL & TRAINING ACADEMY; she found out about the course from the Internet. Ms Qadir says:

“5. I am familiar with use of the name ASIANA in relation to a magazine of the same name.

6. When I took on the abovementioned course it was very clearly apparent to me that the ASIANA BRIDAL & TRAINING ACADEMY had no connection with ASIANA magazine because I knew that the former had to do with beauty services solely and I did not associate these services with ASIANA magazine.”

51. The sixth and final statement, dated 5 August 2010, comes from Kully Chand Guru who also completed the questionnaire. She explains that in July 2010 she attended a course on hair and make-up run by AB under the name ASIANA BRIDAL & TRAINING ACADEMY; like Ms Qadir she also found out about the course from the Internet.

MI's evidence-in-reply

52. This consists of three witness statements. The first, dated 16 December 2010, is a further statement from Ms Pitcher. Ms Pitcher's statement corrects an inconsequential error in the statement of Mr Ferdinand.

53. The second statement, dated 15 December 2010, comes from Pariena Chita who was employed by I & I Media Limited from July 2008 to February 2010 as Sales & Events Manager. Ms Chita explains that one aspect of her role involved selling advertising space in ASIANA and ASIANA Wedding magazines. Ms Chita says:

“2. Around August or September 2009, I cannot remember the exact date, we received an e-mail through our website enquiring about advertising in the ASIANA and ASIANA Wedding magazines from a gentleman whose name I cannot recall, it may have been Taj or Tej. He claimed to be the husband of a woman called Sukhjit Kaur who ran a business under the name “Sukhi”. The gentlemen enquired about our rates for advertising in the magazines and the next steps. I remember the conversation as it was strange that he accepted our charges rather than trying to reduce the cost which is more normal practice. Throughout the conversation the name “Sukhi” was referred to. It was only when he confirmed that he wanted to go ahead with the advertisement that the name “Asiana” was mentioned as his wife's company name was Asiana Bridal and Training Academy Limited. I advised him that the name was likely to cause conflict and I would need to get permission from the directors of the company before the advertisement could be accepted.

3. The matter was discussed internally. I reviewed the website asianbridal.com and at the time of the enquiry the web pages referred to “Sukhi” rather than “Asiana”. Due to the company name we refused their advertisement and, as these proceedings demonstrate, further action was taken. The gentleman did not react well to being told we would not advertise their business. He called again several times towards the end of the year but I was told not to take his calls. Cauvery Gandhi, Sales Director advised me this is a matter for the directors.”

54. The third is a further witness statement, dated 16 December 2010, from Mr Dhawan. A significant part of Mr Dhawan's statement consists of submissions rather than

evidence; while it is not necessary for me to summarise these submissions here, I will keep them in mind when reaching a decision. Mr Dhawan explains that MI offers work experience to students and has done so for some time. He explains that each year MI receives a number of letters and certificates from schools and colleges to thank them for training and educating their students. Exhibit AD201 consists of a representative selection of these certificates/letters whose dates range from 2009-2011; Asiana Magazine is mentioned in a number of the letters etc.

55. Mr Dhawan says that when he and his business partner Sawar coined the word ASIANA they were not aware of Asiana Airlines as it operated in an area of trade quite different to their own. The presence of the majority of the other ASIANA trade marks on the UK register is, he argues, irrelevant as they are in different areas of trade. The exception is, he says, No. 2531483 for the following trade mark:



ASIANA WEDDING AWARDS
& THE ASIANA WEDDING 100

against which an invalidation action has been filed (exhibit AD202 refers) – and which I note has now been declared invalid. Mr Dhawan explains that MI holds over 25 domain names that include the word asiana. Exhibit AD023 consists of WHOIS details for 28 domain names all of which include the word asiana and whose dates of registration range from 2003 to 2009. The registrant of the majority of the domain names is Mr Dhawan. In relation to Mrs Kaur's comment to the effect that she is unaware of any instances of confusion, Mr Dhawan says:

“16...However, this does not mean that confusion has not or would not occur and it does not mean that [MI's] customers would not perceive a connection between us and Ms Kaur's business. Furthermore, none of the evidence provided by Ms Kaur would appear to show that she has any reputation in ASIANA or that she has a right in the UK that predates ours.”

56. Finally, in response to the other witness statement filed by AB, Mr Dhawan says:

“17...The witness statement of Inderjit Singh advises that his company made business cards for the applicant in 2002. However, it appears that these were for use in India, which is irrelevant. All of the other witnesses attended courses run by the applicant and so are unlikely to be impartial...”

57. Having commented that all of the witnesses attended courses after MI commenced use of its signs, Mr Dhawan points to the questionnaire used by AB to elicit the

responses which were later incorporated into the witness statements. Of this questionnaire he says:

“17...and I think that the questions posed in those questionnaires do in many instances prompt the answers given and the heading to the questionnaire [reproduced above] seems particularly suggestive.”

58. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

59. MI’s opposition is based upon section 5(4)(a) of the Act which reads as follows:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

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

60. In reaching a conclusion, I note the comments of the Appointed Person, Mr Geoffrey Hobbs QC, in *Wild Child Trade Mark* [1998] RPC 455. In that decision Mr Hobbs said:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The material date

61. First I must determine the date at which MI’s claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

62. The date of filing of AB’s application i.e. 12 March 2009 is, therefore, the material date. However, if AB have used its trade mark prior to this, then this use must also be taken into account. It could, for example, establish that it is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that AB’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer.

63. In paragraphs 7 and 10 of her statement Mrs Kaur says:

“7. I first began plans for use of a business name incorporating the element ASIANA in relation to the provision of hair, beauty and make-up services which were tailored to suit the needs of brides for weddings **in connection with a business in India in 2002**. At that time I commissioned the printing of business cards by a company called Amrik Singh and Sons based in the Punjab in India...At the time the business I started under the name ASIANA for beauty, make-up and bridal services was known as “Asiana Bridals””. (my emphasis)

“10. I wanted to use the name ASIANA in my plans to trade in the United Kingdom in the provision of beauty and make-up services. I also wanted to specifically target the provision of these services in the preparation of brides for weddings **and began plans to use this name in the UK in 2008 and incorporated my company in February 2009**.” (my emphasis)

64. As I mentioned earlier, the material date in these proceedings is 12 March 2009. The evidence provided by Mrs Kaur indicates that her plans to use the word ASIANA began in India in 2002 when she commissioned Amrik Singh & Sons to produce business cards bearing, inter alia, the name Asiana Bridals. However, I note that when Mrs Kaur was interviewed in November 2002 by *The Birmingham Evening Mail* (exhibit SK4) her business at that time was referred to as the Asian Hair and Beauty Service. Mrs Kaur goes on to say that her plans to use the name ASIANA in the UK began in 2008 and that she incorporated her company (AB) in February 2009. In March 2008, Mrs Kaur registered the domain name asianabridals.com, a domain name which she explains was subsequently sold to a business called Millis; as far as I can tell none of the pages provided as exhibits SK6 or SK7 contain references to ASIANA. Mrs Kaur goes on to say that the domain name asianabridal.com was registered in December 2008 and extracts from this website downloaded on 17 August 2010 are provided as exhibit SK8. The pages from the website contain the words ASIANA Bridal & Training Academy Ltd, together with references to AsianaBridal.com, Asiana Bridal, Asiana Bridal Training Academy and Asiana Bridal & Training Academy and contain a reference to “...copyright TM 2008-2010”. The two certificates provided in this exhibit are dated 30 July 2009 and 15 July 2010 i.e. after the material date in these proceedings as are the courses attended by Ms Ditta (May 2009) Ms Qadir (February 2010) and Ms Guru (July 2010).

65. Insofar as promotion of AB’s services is concerned, Mrs Kaur refers to: exhibit SK10 which consists of an invoice dated 3 June 2009 from matchmaker marketing to AB in respect of Google® Marketing; exhibit SK13 which consists of: (i) an invoice dated 20 January 2009 from Your Dream Shaadi to Asiana Bridal for £150 in relation to: “Premium Directory Listing (Bridal Makeup)” which is valid for 15 months from the date of the invoice, (ii) an advertising booking form dated 9 December 2008 for £500 from the *Asian Wedding Directory* to Asiana Brides and, (iii) an e-mail dated 10 August 2010 from partyoffers.co.uk to Mrs Kaur which confirms that Asiana Bridal have been listed in www.partyoffers.co.uk since 13 January 2009 and, finally, to exhibits SK15 and SK16

which consist of the cover page of the “1st quarter 2009” edition of the *Asian Wedding Directory* accompanied by two pages advertising AB’s services the first page of which features the words “ASIANA BRIDAL TRAINING ACADEMY ” and refers to: hair styles, make-up and mehndhi” while the second page refers to “ASIANA BRIDAL”, “WWW.asianabridal.com” and “Sukhi Sanghera” and refers to: hair, make-up & mehndhi bridal services and to an extract downloaded on 17 August 2010 from www.partyoffers.co.uk which contains references to “Asiana Bridal & Training Academy” and which Mrs Kaur says has appeared on this website since January 2009.

66. In her own words Mrs Kaur “began plans to use [the ASIANA name] in the UK in 2008”; her earlier use in India (if indeed there was any beyond having business cards prepared bearing the name Asiana Bridals) does not assist her in these proceedings. Having registered the domain name asianabridals.com in March 2008 this domain name was later sold; although pages are provided from this website (including one which may be from 2008) none of the pages contain any reference to the word ASIANA. Mrs Kaur then registered the domain name asianabridal.com in December 2008; pages from this website (downloaded on 17 August 2010) are provided and contain references to Asiana Bridal & Training Academy. However, there is no indication that these pages were created and made available on www.asianabridal.com in December 2008. In fact, in view of Mrs Kaur’s comment to the effect that:

“11....These services have been provided continuously since my company launch in February 2009”,

it appears more likely that the pages were not available until the date mentioned. There is, however, evidence that prior to the material date in these proceedings steps were taken by AB to bring its services to the public’s attention. This evidence is in the documents mentioned in exhibits SK13 to SK16 the earliest of which is dated 9 December 2008 and which I presume led to the advertisement in *the Asian Wedding Directory* for the first quarter of 2009. It also appears that AB’s services were publicised on the websites of www.partyoffers.co.uk and www.yourdreamshaadi.co.uk from 13 and 20 January 2009 respectively.

67. In summary, while it appears that AB mark may have made some use of its trade mark prior to the material date in these proceedings, nowhere in her evidence does Mrs Kaur give any indication of the quantum of turnover achieved under the trade mark or indeed the amount spent promoting it. From the evidence provided, it is, in my view, quite clear given the date at which MI first used its signs (a point I shall come to in a moment) that AB is the junior user. In addition, there is nothing to suggest that given the proximity of the date of AB’s potential first use to the material date in these proceedings, that any use that AB may have made of its trade mark prior to the material date would be sufficient to constitute common law acquiescence.

Goodwill

68. In order to succeed in an action for passing off, MI has to establish that at the material date in these proceedings there was goodwill in a business in which the words ASIANA, or ASIANA WEDDING or ASIANA BRIDAL SHOW had been used. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage 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."

69. The filing of evidence in trade mark proceedings is governed by rule 64 of the Trade Marks Rules 2008 which indicates that evidence should be in the form of a witness statement (accompanied by a statement of truth), affidavit or statutory declaration or in any other form which would be admissible as evidence in proceedings before the court. In its evidence MI relies, inter alia, upon three "To whom it may concern" letters from David Jones (exhibit AD03), Rajan Singh (exhibit AD10) and Munsur Ali (exhibit AD22). In *Duccio Trade Mark* (BL O343-09) the Appointed Person said:

"There are two ways in which "to whom it may concern letters" can be introduced in Registry proceedings. First, the writer of the letter can provide a verifying affidavit, statutory declaration or witness statement to which his or her letter is exhibited. Second, the party seeking to rely on the letter can provide an affidavit, statutory declaration or witness statement to which the third party letter is exhibited. In the first case, the letter is part of the writer's own evidence. In the second case, the letter is hearsay evidence admissible by virtue of section 1 of the 1995 Act."

70. The Civil Evidence Act 1995 provides:

"1. - Admissibility of hearsay evidence.

(1) In civil proceedings evidence shall not be excluded on the ground that it is hearsay.

(2) In this Act—

(a) "hearsay" means a statement made otherwise than by a person while giving oral evidence in the proceedings which is tendered as evidence of the matters stated; and

(b) references to hearsay include hearsay of whatever degree.

(3) Nothing in this Act affects the admissibility of evidence admissible apart from this section.

(4) The provisions of sections 2 to 6 (safeguards and supplementary provisions relating to hearsay evidence) do not apply in relation to hearsay evidence admissible apart from this section, notwithstanding that it may also be admissible by virtue of this section.

[...]

4. - Considerations relevant to weighing of hearsay evidence.

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following—

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight."

71. Tribunal Practice Notice 5 of 2009 outlined the approach to be adopted in relation to hearsay evidence. It said:

"6. Hearing Officers will give hearsay evidence of this kind such weight as it deserves (as per section 4 of the Civil Evidence Act 1995), assessing each case on its own merits. Accordingly, hearsay evidence will not be discounted simply because it is hearsay. So, for example, substantial weight may be given to a hearsay statement made in letters or documents created around the time of the issue or event to which it relates. On the other hand, a Hearing Officer may

decide to afford less weight to a hearsay statement made in a letter solicited by a party some time after an event, for the purpose of the proceedings, than he or she would have given to the same statement if it had been made in a witness statement and accompanied by a statement of truth. Further, if the person making such a hearsay statement had any motive to conceal or misrepresent matters, and the Hearing Officer decides that the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight, he or she may give the statement no weight at all.

7. A party filing a hearsay statement therefore runs the risk that the tribunal may assess its weight at a lower level than that which the party considers it should carry. Accordingly, unless it is impractical to do so, the best course of action is to file statements made specifically for the purposes of the proceedings in the form of a witness statement.”

72. I have little doubt that if called upon to do so the named individuals could have filed witness statements containing the evidence they have given. However, there is nothing to suggest that the form in which the evidence was given represented an attempt by MI to conceal or misrepresent matters or is such as to suggest an attempt to prevent proper evaluation of the evidence. In addition, none of the letters contain multiple hearsay and all are dated within reasonable proximity to the material date in these proceedings. In short, as all of the witnesses are, in my view, well placed to provide the information they do (and as their evidence stands unchallenged), I intend to take these letters into account in reaching a decision and to give them reasonable weight.

73. The evidence provided by MI to support its claim to goodwill is extensive and is summarised above. It demonstrates that I and I Media Limited first used the signs ASIANA and ASIANA WEDDING in winter 2003 and spring 2004 respectively, in relation to magazines aimed predominately at the Asian market and in particular at Asian females. Mr Jones’ hearsay evidence indicates that by the date of his letter (10 March 2010) some 400,000 copies of the ASIANA magazine had been distributed in the UK as had some 323,000 copies of the ASIANA WEDDING magazine; copies of the magazines were sold in Tesco, Asda and W.H. Smith as well as through independent newsagents. In addition, the magazines had been made available by direct subscription, via iSubscribe and on MI’s website at www.asianamag.com and had been promoted in a number of ways including at the ASIANA BRIDAL SHOW, the Zee Carnival and as sponsors of the Asian Lifestyle Show.

74. Insofar as the bridal shows are concerned, MI’s evidence demonstrates that it held its first event under the sign ASIANA BRIDAL SHOW at the Café Royal, London in January 2004; the report by Media Moguls indicates that this show attracted both pre and post show attention in a range of Asian and non-Asian regional press as well as on Asian and mainstream websites. In subsequent years shows were held in London (between 2005 and 2009) in Bradford in 2006 and in Birmingham in 2008 and 2009; in total the bridal shows attracted some 75,000 attendees as well as a range of high profile sponsors. In addition, the bridal shows were advertised on radio, television and on the

side of buses in Birmingham. Finally, Mr Dhawan explains that approximately £50,000 per year is spent on promotional activities and that turnover since 2004 has amounted to a little over £1 million per year. Although no indication is provided of what percentage of these figures relate to (i) the individual signs on which MI's opposition is based, (ii) how much to the magazine and how much to the bridal shows, and (iii) how much relates solely to the UK, given the totality of MI's evidence and what I consider to be the very close relationship between the magazines (particularly the ASIANA WEDDING magazine) and the bridal shows, these are not deficiencies with which I am greatly concerned.

75. In its evidence, AB queried whether if there was goodwill in the signs mentioned above, who owned it. As I mentioned earlier in this decision, this opposition was originally filed solely in the name of Magworld Limited. However, in April 2011 I and I Media Limited were added as a joint opponent. Given the totality of MI's evidence, I am satisfied that at the material date in these proceedings MI (or at the very least I and I Media Ltd) had conducted a business under the signs ASIANA, ASIANA WEDDING and ASIANA BRIDAL SHOW. While it is true that other undertakings have registered/used the word ASIANA (possibly because as AB says it "is clearly and simply an allusion to goods or services provided with an Asian theme"), there is nothing to suggest that the word ASIANA (either used alone or in conjunction with other elements) is so lacking in distinctive character that a business conducted under it cannot generate a protectable goodwill; (clearly AB were satisfied that when used together with the descriptive wording BRIDAL & TRAINING ACADEMY it could function as an indication of origin). In short, I have no hesitation in concluding that the business conducted by MI under the signs mentioned above had, at the material date in these proceedings, resulted in goodwill, and that this goodwill was in relation to the publishing of magazines (and the magazines themselves) and the conducting of bridal shows all aimed at the Asian market. As to the nature of MI's goodwill, I note that Mr Dhawan describes the ASIANA magazines as "the best selling Asian glossy magazines in the UK." In addition, I note that the third parties who gave evidence on behalf of MI said, inter alia:

Mr Lit:

"The ASIANA BRIDAL SHOW" is the No. 1 show of its kind in the UK market today."

Mr Pawar:

"The Asiana brand is synonymous with image, glamour, style and sophistication. It focuses on beauty, lifestyle and fashion and is treated as a directory of good style and trend setting among the Asian community..."

Mr Dadi:

“ASIANA are world leaders in their field. They have a very talented team and are well connected in the Asian fashion industry and are setting high standards for the whole world. They have helped my company to establish and grow our business. The Asiana Wedding magazine is a bible for all the brides who are in the process of planning their wedding....”

Ms Chandarana:

“Asiana is a unique brand that attracts high-end Asian audiences in whatever activities they engage themselves in. The customers of Asiana are the customers that my company wish to engage with. Products and services that Asiana provide are exclusive and inspirational...”

Mr Anand:

“I believe that ASIANA is the premier publication within the Asian market and my company’s association with the ASIANA brand attracts business for us from across the UK and overseas.

It is my view that ASIANA is a byword for excellence in the field of weddings, and as my company is the biggest caterer in the Asian wedding market, I can confidently say that ASIANA is known as the No. 1 magazine to every Asian wedding service provider in the UK.

We are market leaders in our field and we would not wish to associate ourselves with anyone other than another market leader – which is ASIANA.”

Ms Vora:

“Asiana is aimed at high fashion and bridal markets...”

76. Although I accept that all of the witnesses have a business relationship of one sort or another with MI, none the less they have all commented on the nature of MI’s use concluding that ASIANA (i) is the No. 1 bridal show of its kind, (ii) is synonymous with image, glamour, style and sophistication, (iii) are world leaders in their field, (iv) is a bible for all the brides who are in the process of planning their wedding, (v) is a unique brand that attracts high-end Asian audiences, (vi) is the premier publication within the Asian market, (vii) is a byword for excellence in the field of weddings and (viii) is known as the No. 1 magazine to every Asian wedding service provider in the UK. In short, the nature of MI’s use of its ASIANA signs has on the basis of the evidence provided resulted in its ASIANA signs being linked with market leading attributes and associations with image, glamour, sophistication and high-end Asian audiences. This is reflected in the nature and production values of the magazine.

Misrepresentation

77. Turning now to misrepresentation, the case law mentioned above indicates that in a case such as this i.e. where there has been no direct misrepresentation, two factual elements need to be in place if a likelihood of deception or confusion is to be established. The two elements are:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

78. Having explained that whether deception or confusion is likely is ultimately a single question of fact, the case law indicates that in arriving at a conclusion of fact as to whether deception or confusion is likely the following factors need to be considered:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

79. I have already commented upon point (a) in my assessment of MI's goodwill. As to point (c), consisting as it does of the word ASIANA accompanied by the descriptive words BRIDAL & TRAINING ACADEMY, AB's trade mark is clearly highly similar to the signs ASIANA (on its own), ASIANA WEDDING (in which the word WEDDING is descriptive) and ASIANA BRIDAL SHOW (in which the words BRIDAL SHOW are descriptive) used by MI. This high degree of similarity is further heightened by the fact that AB's trade mark and MI's ASIANA WEDDING and ASIANA BRIDAL SHOW signs contain similar/identical conceptual references i.e. to weddings/bridal events. Put simply, it is the word ASIANA which performs the origin function in the competing mark/signs.

80. Finally, points (b), (d) and (e) are directed at, inter alia, the proximity of the trades in which the parties carry on business and the manner in which these trades are carried

on, the manner in which AB may have used its trade mark, and the class of persons alleged to be deceived. Insofar as AB's use is concerned, my assessment of its evidence indicates that at the material date in these proceedings AB had not made any use of its trade mark in connection with the goods for which registration is sought in class 3, and little or no use in relation to the services in classes 41 and 44. MI operates in the magazine/magazine publishing and bridal show businesses; all of its business is directed at the Asian market and in particular at Asian females. AB proposes to trade in a range of goods in class 3 and to provide (broadly speaking) educational and training services in class 41 and beauty care services in class 44. In his statement AB's professional representative Mr Ferdinand said:

"14. In any event there is no use evidenced by the witness statements or other evidence of [MI] which shows that [MI's] trade marks have been used in relation to the goods or services covered by [AB's] application. None of the witness statements provided by the third parties identified by [MI] attest to a reputation of [MI] in relation to services covered by [AB's] application. Rather they relate to use of the ASIANA trade marks in relation to bridal shows and magazines exclusively..."

81. In actions for passing off there is, of course, no need for a common field of activity; the comments in *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] FSR 155 refer. However, in *Harrods v Harrodian School* [1996] RPC 697 the difficulty in establishing confusion where there is a distance between the fields of activities was considered by Millet LJ who stated:

"It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services"

82. In the same case Millet LJ held:

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

83. It is clear from the above that while a common field of activity is not fatal, it is an important and highly relevant consideration; the further apart the competing fields of activity the more difficult it will be for MI to establish that misrepresentation and damage will occur. AB's evidence indicates that its training and beauty care services are aimed at the Asian market and in particular Asian females; the class of persons targeted by both parties is therefore likely to be broadly speaking the same. In her statement Ms Pitcher for MI argued that AB's goods in class 3 are:

“6..complementary and bear similarities to [MI’s] earlier rights as such goods are typically sold at the ASIANA BRIDAL SHOWS and are advertised or featured within the ASIANA and ASIANA WEDDING magazines. For example, perfumes and cosmetics are an important feature of both the magazines and the Bridal Shows...”

84. Insofar as AB’s services are concerned, MI argues that these services are provided through the pages of its magazine and at its bridal shows. In his statement Mr Ferdinand said:

“14...In this regard the statement of Miss Pitcher and in particular paragraph 7 and its corresponding exhibit EPJ05 are not convincing evidence that [MI] has used its ASIANA trade marks in relation to education and training services. Rather these documents show that the magazines in question provide information on the areas of health and beauty in the form of written articles. In this regard readers are directed to contact third party businesses for details and further information on a subject of the articles in question.”

85. A review of MI’s magazines provided as exhibits EPJ05 and EPJ06 indicates that they contain a wide range of information and advice on general lifestyle issues such as: “Beating diabetes”, “tools of the trade: the phone” and “Money matters”. However, more importantly, in my view, they also contain a wide range of articles in relation to weddings and beauty related issues. The following are illustrative examples:

ASIANA – autumn 2007 – ASIANA BRIDAL GUIDE – Wedding Traditions”;

ASIANA Wedding – summer 2007 – “Self Service – Who says you can’t have a dream wedding without a fantasy budget? Get real by taking charge of your own day, your way...DIY MAKE-UP, DIY HAIR, DIY MEHNDI...”

ASIANA – spring 2005 – “Beauty Q&A – all your hair and beauty dilemmas dealt with by Anjana Gosai”;

ASIANA – winter 2008 – a four page article entitled “the dark side” in relation to eye shadow/eye liner:

ASIANA Wedding – spring 2007 – a 40 page article entitled: “Bridal Images – The Professional guide to this season’s new bridal looks” and which I note contains advice on, inter alia, base, eyes, lips and hair;

ASIANA Wedding – winter 2007 – which contains a two page article entitled “Bridal Beauty Countdown”.

86. Mr Ferdinand states:

“16. It is also relevant to note that the services provided by [AB] are particularly specialist and that customers of [MI] (sic) spend some time before deciding to engage such services. This is particularly true in the context of planning their wedding arrangements which are of such great personal importance to them. Mrs Kaur’s statement indicates that customers undertake consultations with [AB] before deciding on whether to go ahead with purchasing their services and this fact further reduces a likelihood of confusion between the business of [MI] and [AB], let alone a likelihood of deception.”

87. Insofar as the bridal shows and the catwalk events conducted by MI at these shows are concerned, the evidence, for example exhibit AD07 and the various third party statements, indicates that these events are attended by a wide range of businesses involved in, for example, fashion, marquees, photography, venues, jewellery, make-up, mehndi, hair and beauty, catering and finance. While I am not persuaded that MI’s involvement in work experience assists them in these proceedings, I am satisfied that there is a clear affinity (and quite a close one in my view) between the areas of trade in which AB wishes to/has begun trading and the nature and content of the magazines and bridal shows conducted by MI. I have noted the comments of Mr Ferdinand in relation to the care that a potential customer is likely to take before engaging AB, and the evidence of Ms Qadir to the effect that she was aware of MI’s magazines when she attended her training course with AB in February 2010 and did not think there was any connection between the parties. However, notwithstanding these comments/evidence, in my view, the fact that both parties activities are directed at an identical class of persons i.e. the Asian market in general and in particular Asian females and their families who are preparing for a wedding, and given that both AB’s goods and services and the content of MI’s magazines and bridal shows focus on, inter alia, the beauty related aspects of such an event, combined with the high degree of similarity between AB’s trade mark and MI signs, is still, in my view, likely to result in misrepresentation. The fact that Mrs Kaur is not aware of any instances of confusion is not determinative. The high degree of similarity between AB’s trade mark and the signs used by MI, combined with the reputation MI enjoyed in the business it conducted under these signs at the date of AB’s application may simply mean that despite the care a potential customer may take before engaging AB, that that same customer would simply assume (without feeling the need to enquire further) that AB’s business was one conducted by or in some way (economically perhaps) connected with MI. AB’s application covers a gamut of goods and services which are not limited to a particular market but the breadth of this gamut means that they cover goods and services for the markets noted above. Indeed, the evidence shows that these are the intended markets for the goods and services.

Damage

88. Having concluded that MI has goodwill in the signs indicated and that AB’s use of its trade mark would amount to a misrepresentation, I must now go on and consider the issue of damage. In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade LJ

considered the difficulty of establishing damage where the parties are in different lines of business. He said:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than a minimal loss is in my opinion a heavy one.”

89. In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 Lord Fraser commented upon what the plaintiff must establish:

“That he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.”

90. However, unlike the position in *Stringfellow* i.e. where the lines of business were completely different (nightclub services and chips), I have already concluded that there is a clear affinity between the goods and services which AB wishes to register and those in which MI have a protectable goodwill. In her statement Ms Pitcher said:

“4...The existence of the identical mark ASIANA being used on its own or in conjunction with other elements by more than one entity will cause, or is likely to cause, a deception or misrepresentation amongst the relevant class of consumers which will damage [MI's] goodwill. It is also likely that such use of ASIANA will cause confusion amongst the relevant consumers which will cause a loss of business for [MI] and damage to their goodwill if the goods and services are not of an adequate quality.”

91. In *Mecklermedia Corporation v D.C. Congress Gesellschaft mbH* [1997] FSR 627 Jacob J said:

“What about the third element of the trinity, damage? Miss Jones says none has been proved. Now in some cases one does indeed need separate proof of damage. This is particularly so, for example, if the fields of activity of the parties are wildly different (e.g. *Stringfellow v. McCain Foods (G.B.) Ltd* [1984] R.P.C. 501, CA, nightclub and chips). But in other cases the court is entitled to infer damage, including particularly damage by way of dilution of the plaintiff's goodwill. Here I think the natural inference is that Mecklermedia's goodwill in England will be damaged by the use of the same name by DC. To a significant extent Mecklermedia's reputation in this country is in the hands of DC—people here will think there is a trading connection between the German and Austrian fairs and the Mecklermedia's fairs.

92. In *Ewing v Buttercup Margarine Company, Limited* [1917] 2 Ch. 1 the court said:

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

93. The decision in *Mecklermedia* makes it clear that it is not always necessary to have separate proof of damage. In a case such as this where there is a high degree of similarity in the trade mark applied for and the signs relied upon by MI and a clear affinity between the competing areas of trade, damage in the form of dilution to MI's goodwill can be inferred. Similarly, the comments in *Ewing* indicate that the nature of the damage can be general rather than specific. In my view, the combination of the guidance in these two cases is more than sufficient to support a finding that MI's business will be damaged if AB uses/continues to use its trade mark in relation to the goods and services for which it has applied. In considering the goodwill of MI, consideration is taken not just of the goods and services which form its basis but also of the marketing and the general penumbra that surrounds it. I have summarised the nature and extent of MI's goodwill above and concluded that it has resulted in MI's magazines and bridal shows conducted under its ASIANA signs being linked with market leading qualities and associations with image, glamour, sophistication and high-end Asian audiences. In those circumstances, were AB to use/continue to use its trade mark the adverse consequences envisaged in *Ewing* are likely to ensue and the impact on MI's business may be both real and significant. For AB there will be a positive benefit from an association with the business of MI by the transfer of image and repute; leading also to the damage of dilution.

Conclusion

94. Having established the classical trinity, MI's opposition has succeeded in relation to all of the goods and services in AB's application.

Costs

95. MI has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. As MI were professionally represented until 30 June 2011 i.e. after the evidential rounds were completed, and as neither party has taken any active part in these proceedings since at least that time, there is no need for me to reduce the award of costs to MI to reflect its revised (i.e. now unrepresented) status. I award costs to MI on the following basis:

Preparing a statement and considering AB's statement:	£300
--	------

Preparing evidence and considering and commenting on AB's evidence:	£1000
Opposition fee:	£200
Total:	£1500

96. I order Asiana Bridal & Training Academy Limited to pay to Magworld Limited and I Media Ltd the sum of **£1500**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of March 2012

C J BOWEN
For the Registrar
The Comptroller-General