O-409-18

TRADE MARKS ACT 1994

IN THE MATTER OF THE APPLICATION UNDER NO. 3193965

BY

TRUMP INTERNATIONAL LIMITED

TO REGISTER THE TRADE MARK

TRUMP TV

IN CLASSES 38 AND 41

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 409064

BY DTTM OPERATIONS LLC

Background and pleadings

1. On 30 October 2016, Trump International Ltd. ("the Applicant") applied to register the words "TRUMP TV" as a UK trade mark in respect of the following services ("the Application"):

Class	Wording of Applicant's specification
38	Telecommunication services; communication services for the electronic transmission of voices; transmission of data; electronic transmission of images, photographs, graphic images and illustrations over a global computer network; transmission of data, audio, video and multimedia files; simulcasting broadcast television over global communication networks, the Internet and wireless networks; provision of telecommunication access to video and audio content provided via an online video-on-demand service; satellite communication services; telecommunications gateway services.
41	Production of radio and television shows and programmes; film production services; education, teaching and training; entertainment services; presentation of movies; film distribution; provision of non-downloadable films and television programs via a video-on-demand service; arranging and conducting of workshops and seminars; arranging and conducting of congresses; organization of exhibitions for cultural and educational purposes; publication of electronic books and journals online.

2. The mark was published for opposition purposes on 20 January 2017. The whole of the Application is opposed by DTTM LLC ("the Opponent") relying on various grounds under the Trade Marks Act 1994 ("the Act"), namely sections 5(2)(b), 5(3), 5(4)(a) and 3(6).

Section 5(2)(b) claim

3. The Opponent relies for its section 5(2)(b) claim on its ownership of EU trade marks (EUTMs) registered as detailed below. It claims that they are earlier marks that are similar to the mark applied for and are registered in respect of goods and

services that are identical or similar to the services applied for such that there is a likelihood of confusion on the part of the relevant public as to the origin of the goods and services at issue.

EU010289064 "TRUMP" (word mark)

Filing Date: 23 September 2011

Registered: 28 May 2012

Relying on all its goods and services registered in classes 9, 28, 41 and 43 as detailed at the **annex** included at the end of this decision.

EU012629648 "TRUMP" & CREST DEVICE being the figurative mark shown below

Filed: 24 February 2014

Registered: 23 October 2014

Relying on all its goods and services registered in classes 18 24 25 28 36 41 43 and 44 as detailed at the **annex** included at the end of this decision.

4. The Opponent explains the similarity between the marks in its statement of grounds, claiming that the Application contains as its most dominant and distinctive component the word TRUMP, which is identical to the word-only registration relied

on by the Opponent, and is phonetically and conceptually identical, and visually similar to the device mark relied on by the Opponent.

5. The Opponent explains in its statement of grounds the similarity between the goods and services, claiming that the services in Class 41 of the Application are identical to the goods and services covered by the Opponent's registrations, and where not identical they are similar.[1] The Opponent claims the Applicant's services in Class 38 are similar to goods and services in the Opponent's registrations.

Section 5(3) claim

6. The Opponent relies for its section 5(3) claim on its ownership of EUTM **10289064** "TRUMP" as detailed above. The Opponent claims to have a substantial reputation in that earlier word mark in relation to some of the goods and services covered by its registration, namely:

Class 28: Sporting articles not included in other classes: golf bag tags, golf bags, golf ball markers, golf balls, head covers for golf clubs, golf tees, and divot repair tools for golfers.

Class 41: Education; providing of training; entertainment; sporting and cultural facilities: organizing and conducting parties, festivals and entertainment events; entertainment information; education information; recreation information; providing on-line electronic publications not downloadable; provision of recreation, amusement and sport facilities; provision of golf facilities; entertainment and night club services; health club facilities and services; golf courses; golf club services; entertainment in the nature of golf tournaments, competitions, and training sessions; organization of sports competitions; rental of sports equipment.

[1] See full list of goods and services at Annex. I note, for example, that the Opponent's own services in **Class 41 under its word mark** include entertainment; musical, radio, dramatic and television entertainment; recording; production of films and of recordings; direction of films and of performances; TV shows; television entertainment.

Class 43: Provision of conferences and meeting facilities; arrangement, reservation, information. research, advice and assistance relating to the aforesaid.

7. Again opposing the whole of the Application, the Opponent claims that use of the Applicant's mark in relation to any or all of the services applied for would, without due cause, take unfair advantage of and/or be detrimental to, the distinctive character and/or repute of the earlier trade mark and would have done so and been so at the date on which the Application was filed. The statement of grounds sets out particulars of the claimed unfair advantage and detrimental impact.

Section 5(4)(a) claim (passing off)

8. The Opponent claims to have earlier unregistered rights in relation to the trade mark "TRUMP", which it claims to have used throughout the UK since at least 2007. Opposing the whole of the application, the Opponent claims that use of the Applicant's trade mark would be contrary to law, in particular, the law of passing off. The statement of grounds claims that the Opponent owns a substantial goodwill and reputation under the trade mark TRUMP throughout the UK (and EU) in relation to the following goods and services:

Cosmetics; perfumery; software; bags; shoe bags; suit bags; travel bags; umbrellas; crystal and glassware; furniture; towels; clothing; headgear; sporting articles; golf bag tags, golf bags, golf ball markers, golf balls, head covers for golf clubs, golf tees and divot repair tools for golfers; chocolate; wine; whisky; retail services connected with the sale of cosmetics, perfumery, yardage books for golf, bags, leather goods, belts, umbrellas, crystal, glassware, furniture, towels, clothing, headgear, sporting articles, golf apparatus, golf accessories, golf equipment, gifts, food and drink; real estate services, provision of hotels, hotel reservation and concierge services, resorts, golf club services, golf accessories and golf equipment, sporting facilities, restaurant, bar and catering services, providing food and drink, lounge, café and cocktail services, catering services, entertainment services, education and providing of training on how to play golf, organizing and conducting parties, festivals and entertainment events, providing of entertainment, educational and recreational information, providing on-line electronic publications not downloadable, provision of recreation, amusement and sport facilities, entertainment and night club services, health club facilities and services, spa services, entertainment in the nature of golf tournaments, competitions, and training sessions, organization of sports competitions, rental of sports equipment, provision of conferences and meeting facilities, arrangement, reservation, information, research and advice relating to the above listed services, real estate affairs, real estate brokerage, real estate leasing, listing, operation, rental, real estate management, providing real estate listings and real estate information via the internet.

9. The Opponent claims that the goodwill and reputation was established prior to the date on which the Application was filed and that the trade mark TRUMP has been

used by the Opponent or their predecessors in title for at least ten years in the UK and EU, and internationally for 30 years. The Opponent claims that consequently, at the filing date of the Application and all other material times, the trade mark TRUMP was and continues to be distinctive of goods and services provided by the Opponent, or their predecessors in title, or with their consent, with the result that a significant number of members of the public in the UK (and EU) expect, and have at all material times expected, that the claimed goods and services supplied under or by reference to that trade mark are connected in the course of trade with the Opponent, or their predecessors, and no other.

10. The Opponent claims that there is a high degree of similarity between the (unregistered) trade mark TRUMP and the Applicant's mark, and that the services in the Application are identical, or at least highly similar, to the above claimed goods and services offered under the TRUMP mark. In view of such similarity, the Opponent claims that use of the mark in the Application for the services specified therein would at all material times have constituted a misrepresentation that those services were and are connected with the Opponent (or its predecessors). Such misrepresentation would have caused damage to the Opponent and their undertaking including through loss of sales, loss of distinctiveness and damage to reputation, and would continue to do so.

Section 3(6) claim (bad faith)

11. The Opponent's narrative statement of grounds in its Form TM7 leads with the claim that the Application should be refused on the basis of section 3(6) of the Act and sets out various reasons why the Application is objectionable on the basis of bad faith follows:

    (i) The Applicant company was incorporated on 31 October 2016. This is after the date the Application was filed, and so, as they did not exist, the Applicant cannot have held property, and hence owned the Application, at the date it was filed. Therefore, the Application either should be refused as no valid applicant was indicated, or under Section 3(6) of the Act as whoever filed the Application

knowingly misled the Registrar as to the ability of the Applicant company to hold it.

(ii) Further or alternatively, as the Applicant company did not exist at the date the Application was filed, it cannot have used the mark therein, it cannot have consented to such use, and it cannot have had a bona fide intention to use the mark or given any relevant consent. Therefore the requirements of section 32(3) of the Act were not fulfilled, the Registrar was misled when the Application was filed, and the Application should be refused under Section 3(6) of the Act.

(iii) Further or alternatively, the sole director of the Applicant company is Mr. Michael Gleissner, who is also the sole principal of at least several hundred companies registered in the UK in the last few years, and many more in other territories. These companies own a significant number of disparate intellectual property rights around the world. Therefore it is improbable that the Applicant was using or had a bona fide intention to use the mark, either itself or with its consent, at the date and time of application.

(iv) Further or alternatively, the Applicant cannot have failed to be aware of the international reputation of the TRUMP trade mark asserted by the Opponent, and the subject Application was filed to take advantage of that reputation, damage it, or otherwise disrupt the legitimate interests of the Opponent, in a manner below the standards accepted in industrial or commercial matters, and the Application should be refused under Section 3(6) of the Act.

(v) Further or alternatively, in the hands of the Applicant the Application is an instrument of fraud in the nature of that described in Glaxo v Glaxowellcome Ltd [1996] FSR 388, and hence the Application should be refused under Section 3(6) of the Act.

Applicant's counterstatement

12. The Applicant filed a Form TM8 Notice of defence and counterstatement. It did not put the Opponent to proof of use of its earlier word mark "TRUMP", despite its having been registered for more than five years when the Application was filed. The Applicant resists all the grounds of opposition and puts forward points to support its mark being registered. I note the following extracts from the Applicant's counterstatement.

13. In relation to the **section 5(2)(b) ground**, I note the following:

- The Applicant accepts that the parties' services in Class 41 are similar as they broadly concern 'education' and 'entertainment services'. It accepts "a small degree of similarity" between some of the Opponent's goods in Class 9 (which it specifies and the Applicant's Class 38 telecommunications services, but highlights the distinction that "the nature of goods is generally dissimilar to services."
- The Applicant contends that *"in general, the established similarities between trade marks are retained in the average consumer's recollection, rather than the differences*." It then states that in relation to the parties' respective word marks, the Applicant states that they are visually "*not similar*" because the Applicant's mark is made up of two words as against the Opponent's single word "TRUMP". It states that the earlier figurative mark, is visually "*entirely different*" from the Applicant's mark.
- It states that phonetically the parties' respective marks are "*dissimilar*" as the Applicant's mark has three syllables, changing the "*rhythm and reading of the marks entirely. Accordingly there is no possibility that the relevant consumer could be confused between the two marks*."
- The Applicant argues that in relation to the parties' respective marks "*conceptually, the word 'TRUMP' has many meanings in the English language. Firstly, it is the suit of cards ranking above the others in a particular hand. Secondly, it is a valuable resource that may be used, especially as a surprise, in order to gain an advantage. Thirdly, TRUMP' means to surpass something by saying or doing something better*."[2] It argues that "*in contrast the relevant*

[2] It attributes these definitions to https://en.oxfordictionaries.com/definition/trump.

consumer will read its 'TRUMP TV' mark in its entirety and not proceed to analyse each individual component, the subject mark has no real conceptual meaning in the English language. Neither the earlier mark nor subject mark share any commonality in their conceptual meanings. As such, there can be no conceptual comparison" between the parties' respective marks.

- It concludes that in the global assessment "*the goods and services offered by the respective marks are entirely different. This level of dissimilarity is sufficient to offset any potential similarity between the marks. As a result, a likelihood of confusion cannot exist and the relevant consumer would easily be able to differentiate between the goods and services offered under the two marks*." (Clearly this point is at odds with the first bullet point noted above.)

14. The Applicant's counterstatement states that **section 5(3) ground** must be rejected in its entirety on the basis that the Opponent had provided no evidence to support its claim of established reputation. However, the Applicant made that point at a stage of the proceedings in advance of the evidence rounds. It also argues that "*applying the global comparison, the respective marks are so different that the applicant is clearly not trying to exploit the coat tails of the earlier mark.*"

15. In relation to the **section 5(4)(a) ground**, the Applicant states that the Opponent has the burden of proof to show that it has "*a good name and reputation and connection of a business, which is an attractive force which brings in custom*" and that evidence must show that it is more than trivial in nature. The Applicant's says in its counterstatement that "*the Opponent has failed to produce any evidence relating to the extent of advertising, promotion, sales, or media coverage of its alleged brand with prior rights*." The counterstatement says that the Opponent provides no evidence to substantiate its claim of goodwill and argues that the claim falls at the first hurdle and must be dismissed. However, once again the Applicant makes all such points as to a lack of evidence at a stage of the proceedings in advance of the evidence rounds.

16. The Applicant also points out that the Opponent has the burden of proof to *"show a false representation (intentional or otherwise) to the public to have them believe that goods / services of the Applicant are those of the Opponent*." It states that no

link will be made and that "*although there are potential similarities between the goods and services offered, the differences between the marks are such that the relevant public will in no way confuse the two*." It states that "*the relevant consumer circles will not recognise any earlier unregistered mark or alleged brand in the subject mark but will consider the subject mark as a different and clear badge of origin for the services provided by the Applicant. In addition, the Applicant is an entity completely unrelated to the Opponent's company. It has neither knowledge of any involvement with, nor goodwill existing between, the Opponent and their customers in the UK or any damages caused thereto; further, the Applicant does not try in any way whatsoever to pass off.*"

17. In relation to the **section 3(6) ground**, the Applicant sets out the standard case law and states that its application for registration was not submitted in bad faith. It states that "*there is a presumption of good faith unless the contrary is proven. In the case at hand, the Opponent has not provided sufficient arguments or evidence to show that the application of the subject mark was made in anything other than good faith*." The remainder of the counterstatement as to the bad faith claim is as follows:

"Furthermore, it must be noted that according to the law of the UK, the owner of a trade mark is not expected to make genuine use of the mark while examination or opposition proceedings are pending or, under any circumstance, before the five year 'grace period' has begun.

Considering the above, there is no requirement for the Applicant to show intent to use the subject mark, as the registration is pending and the application is under opposition proceedings. In any case, a registered proprietor is entitled to make use of a trade mark at any point during the five-year grace period; there is no strict requirement to prove the intent to put a mark to use immediately before or after the registration. In certain cases, according to the UK law, an owner is not required to put its trade mark to use until 1 day before the expiration of the grace period granted by the Act upon registration. The bona fide intention to make use of the subject mark if and when it achieves registration can, according to UK law, only be evaluated in the course of a revocation action due to non-use after 5 years of

registration. Accordingly, and in any other circumstance, the present application for registration was made in good faith and the claims of the Opponent to the contrary should be dismissed."

18. The Applicant requests costs in the opposition. The Opponent also requests its costs.

Papers filed and representation

19. The Applicant draws on its own legal affairs department to represent itself in these proceedings. The Opponent is represented by Beck Greener.

20. The Opponent filed evidence in chief on 5 October 2017. On 5 December 2017 the Applicant filed material in response to the Opponent's evidence, which the Applicant explicitly characterised as "SUBMISSIONS IN REPLY", attaching a document it referred to as Exhibit A. Those submissions were dated and signed by a member of the Applicant's legal affairs department. The Applicant filed no submissions in lieu of a hearing, whereas the Opponent filed detailed submissions in lieu of a hearing addressing each of its claims, totalling 36 pages, further supplemented by print outs of cited case law. I shortly identify the evidence in this case to the extent I consider necessary for my decision.

My approach to this decision

21. I have above set out at some length, for the record, contents from the Opponent's statement of grounds and from the Applicant's counterstatement, to reflect the detailed presentation of the various claims against the Application and to set out the substance of the response from the Applicant, since it made no submissions in lieu of a hearing and filed only two pages of submissions in reply to the Opponent's evidence-in-chief.

22. The order in which the grounds of opposition are recorded above simply reflects the order in which the respective sections of the Form TM7 invites the framing of claims. However, as I have indicated, the Opponent's narrative statement of

grounds leads with the various bases for the claim under section 3(6) of the Act that the Applicant acted in bad faith in filing its Application. My approach in this decision will be to consider first the Applicant's claim on that ground, directed against the whole of the Application. I consider the Applicant's other grounds only to the extent necessary in light of my findings under the bad faith ground.

EVIDENCE

23. The Opponent filed evidence-in-chief comprising:

    (i) A witness statement by **Alan Garten** ("WS AG") dated 4th October 2017, along with exhibits A–F. (This evidence totals around 190 pages.)

    (ii) A witness statement by **Duncan Morgan** ("WS DM") dated 5th October 2017, along with exhibits DM1 – DM10. (This evidence totals around 120 pages.)

Evidence of Alan Garten

24. Mr Garten is a US citizen and has been Vice-President of the Opponent since 2016. He states his evidence is filed to demonstrate the extensive goodwill and reputation enjoyed in the trade mark TRUMP in the UK and EU in relation to the goods and services listed in its statement of grounds under section 5(4)(a), which include entertainment services, education and providing of training on how to play golf, real estate affairs, provision of hotels, resorts and sporting facilities.

25. Mr Garten states that the Opponent is an established and world-renowned business engaged primarily in residential real estate, commercial real estate, golf courses and many other business holdings all carried on under the name TRUMP. In addition to TRUMP-branded buildings featuring in skylines of cities in the USA, the Opponent carries numerous golf courses and clubs, including in Scotland, where in 2014 Donald Trump acquired Turnberry golf resort and hotel, which has been the site of four British Opens. Mr Garten states that for at least the last 20 years, the TRUMP trade mark has been internationally renowned with reference to luxury hotels and resorts. The first such TRUMP-branded property in Scotland opened in 2012 and has been booked by customers from the UK and EU since its

opening. The bulk of activities under the TRUMP trade mark in the UK by the Opponent or with its consent relate to golf and luxury hotel complexes in Scotland, in particular:

- Trump International Golf Links, Balmedie, Aberdeenshire ("Trump International Golf Links")

- Trump Turnberry, Ayreshire ("Trump Turnberry")

26. **Exhibit B** is a list of awards and accolades received including for Trump International Golf Links, Scotland, for example, a 5-star hotel grading by Visit Scotland, 2014.

27. **Exhibit C** are extracts from the websites trumpgolfscotland.com and turnberry.co.uk, detailing some of the various goods and services offered at the above-mentioned TRUMP properties in Scotland. Mr Garten confirms all the goods and services detailed thereon were offered by these facilities since their launch, or soon thereafter, and in any event for several years prior to the 30 October 2016. The domain names are owned by businesses related to the Opponent and are duly authorised to use the TRUMP trade mark on behalf of the Opponent. Mr Garten includes a table that shows the number of visits each of these websites receives per year from both the UK and EU as a whole. I note, for example, that in 2015, both sites received over 150,000 visits from the UK.

28. **Exhibit D** shows photographs of TRUMP-branded merchandise for sales at the above-mentioned properties in Scotland such as clothing and headgear, golf balls and whisky.

29. **Exhibit E** are various advertisements said to have been distributed in the UK and EU prior to 30 October 2016 promoting the TRUMP-branded goods and services described above. The advertisements show pictures of the golf links at Balmedie and are overlaid with promotional information relating to “Trump International Golf Links”. The single word “TRUMP” features prominently in block capitals beneath

a crest and above the words (in smaller font) “International Golf Links” and “SCOTLAND”. Bookings are indicated to be through trumpgolfscotland.com. The adverts include the price per person for a “stay, play and dine package” in 2016 and 2017 and refer to “THE WORLD’S GREATEST GOLF COURSE”.

30. **Exhibit F** are extracts from the UK and EU press. These include a piece in www.golf.com dated July 11, 2012, ahead of the opening of the Trump International Golf Links, under the headline “Trump Scotland is on its way to being one of the best courses in the world”. It includes a quote attributed to the chief executive of the British PGA that “… it will certainly be in the top three in the world ...”. Another article is from The Scotsman newspaper dated 16 November 2011 covering the completion of construction of the same £60 million golf course at Balmedie. The article refers to the Trump Organisation and a statement issued from Trump Tower in New York by the “tycoon” Donald Trump. Another article in the same issue refers in its headline to “Donald Trump’s links at Balmedie may just live up to the hype”. Another article is from the travel section of the online version of The Telegraph newspaper dated 16 July 2015 promoting the Turnberry as one of the best golf hotels in Britain, stating it was bought in 2014 by Donald Trump for £35.7 million cash.

Evidence of Duncan Morgan

31. Mr Morgan is a trade mark attorney at Beck Greener and he gives his statement to provide evidence in support of the opposition insofar as it is based on section 3(6) of the Act.

32. **Exhibit DM 1** is a print-out from the UK Companies Register at Companies House showing details of Trump International Limited (the "Applicant"), indicating that it was incorporated on 31 October 2016. It also shows that the Applicant company has a single director, Michael Gleissner, appointed on 31 October 2016. Mr. Morgan states that Mr Gleissner is sole director of over 1000 UK companies (almost all of which are believed not to be trading) and is also reported to be behind a significant number of companies in other territories.

33. **Exhibit DM2** is a printout of an article (23 August 2016) from World Trademark Review (a prominent trade publication for the trade mark attorney profession) identifying Mr. Gleissner as being behind, or linked to, a network of company name registrations, internet domain name registrations and trade mark applications/registrations in various jurisdictions over the last few years. Mr. Gleissner's companies have also been behind a considerable number of trade mark cancellation actions brought around the world. Annexed to the article at **Exhibit DM2** is a list of over 1000 UK companies for which Mr. Gleissner was listed as director as at 19 August 2016 compiled by World Trademark Review.

34. **Exhibit DM3** are copies of two related decisions by Mr Allan James, Head of the Trade Mark Tribunal, as the hearing officer. The first is decision No. O-015-17 of 18 January 2017, wherein the tribunal explained why 68 applications by entities controlled (it seems) by Mr Michael Gleissner to revoke for non-use UK trade mark registrations owned by Apple Inc, should be struck out as an abuse of process. The second decision (No. O-118-17 of 15 March 2017) explains the basis for the tribunal's award of costs in the sum of £38,085 in that case (the "Apple Case").

35. Mr Morgan identifies that the hearing officer found in the Apple case that Mr. Gleissner's evidence was not credible, and that he materially misstated the Applicants' true motivations for filing the applications for revocation. The hearing officer joined Mr. Gleissner as joint Applicant, and made him, alongside the original applicants for revocation, jointly and severally liable to pay costs to Apple. Mr Morgan stated that whilst the motivations behind Mr Gleissner or his companies may not always be clear, the article in World Trademark Review and the Apple Case suggest that Mr Gleissner's companies have at times attempted to register famous trade marks associated with third parties as their own. **Exhibit DM 4 - DM7** identifies numerous instances, including: IPHONE (for inter alia "apparatus for recording, transmission or reproduction of sound or images"); APPLE (for inter alia "computers"); the mark EUIPO, where Mr. Gleissner is the sole director of the UK company EUIPO International Ltd where registration was sought inter alia "providing legal information; trademark agent services; trademark monitoring services; licensing of intellectual property; monitoring of intellectual property; intellectual property consultancy".

36. **Exhibit DM 9** highlights the link between a lawyer named Marco Notarnicola employed between March 2015 and February 2017 by Bigfoot Entertainment, a media company founded by, and understood to be controlled by, Michael Gleissner. Mr Notarnicola's Linkedln profile during the course of his time at Bigfoot reveals cynical and manipulative strategic use of the IP system.

37. **Exhibit DM10** relates to the most recent contentious trade mark proceedings handled by Mr Morgan's legal firm with clear links to Mr. Gleissner. Those proceedings concerned a registration under 5 years old for a clearly identical or similar mark, for goods and services clearly identical and similar to those opposed. Although it was clear from the outset that the oppositions would succeed the applicant refused to withdraw its application. Oppositions therefore had to be filed, which were defended despite the applicant having almost no chance of success, leading to Mr Morgan's client incurring significant further costs, only some of which they were awarded at the close of proceedings (both costs awards have yet to be paid). Notwithstanding the above, the applicant has filed a corresponding EU Trade Mark application raising the prospect of further opposition costs.

Applicant's submissions in reply to Opponent's evidence

38. The Applicant filed two pages of submissions in reply, dated 5th December 2017 and signed in the name of Alfean Samad of the Legal Affairs Department of Trump International Ltd. Mr Samad argues that the evidence filed by the Opponent "*has failed to substantiate each and every element for an opposition based on Section 5(2)(b), 5(3) 5(4)(a) and 3(6) of the Act*." His submissions comment on several aspects of the Opponent's evidence-in-chief, notably:

- **Incorporation date:** Mr Samad states that although the Applicant was incorporated on October 31, 2016, the application on Form IN01 to register the Applicant company, was filed on October 30, 2016, the same date as the application to register the mark at issue. The submissions include a document described as Exhibit A, which appears to be a copy of the Companies House

Form IN01 (with an identifying bar code), stating that it was received for filing in electronic format on 30 October 2016.

- **Alleged bad faith and the Apple Case**: "*The Apple Case involved numerous cancellation applications and the issue of abuse of process in relation thereto. As such, the factual matrix is distinctively different when compared to the current application for a trade mark at the UKIPO. More importantly, the Apple Case involved Michael Gleissner in his personal capacity, whereas, in this case, Michael Gleissner is the sole director of the Applicant. As such, the Applicant ought to be afforded the protection of being a separate legal entity*."

DECISION

39. Section 3(6) of the Act states: **"**(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith." Both parties included in their claims and submissions established case law on bad faith and the principles are not in dispute. In the circumstances, I need not again set out those principles, but I bear in mind their summary by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*[3].

40. In deciding the section 3(6) ground, I must determine whether the Opponent has proved on the balance of probabilities that in seeking, on 30 October 2016, to register the trade mark TRUMP TV for the services under this Application, the conduct of Trump International Limited, judged by ordinary standards of honest people, was somehow dishonest or otherwise fell short of the standards of acceptable commercial behaviour.

41. The Opponent clearly set out (in some detail) in its statement of grounds, several limbs for its bad faith claim. I note that the Applicant, having had an opportunity to consider the points raised, responded to the bad faith allegations by arguing in its counterstatement only that *it is under no obligation to show an intention to use the mark at issue, and that if the mark becomes registered it will have five years in*

[3] [2012] EWHC 1929 (Ch)

which to put the mark to genuine use the mark before being vulnerable to revocation proceedings.

42. During the evidence rounds, the Opponent filed its evidence as indicated above, relating to the use and profile of the TRUMP brand in the UK and elsewhere, and further bolstering the bases for its allegations of bad faith. In this context, I note in particular that evidence from Mr Morgan claims that bad faith arises in light of:

    (a) the **pattern of behaviour** outlined in his witness statement, involving a large number of disparate companies and IP rights registered by Mr. Gleissner around the world, together with no evidence in this instance that either the Applicant or its principal has traded under the mark applied for (indeed the Applicant did not exist when the Application was filed) and that at the time of filing the Applicant had **no bona fide intention** to use (or consent to the use of), the mark applied for.

    (b) Rather, Mr Morgan alleges that the Application was filed to take advantage of the reputation of the **TRUMP** mark, damage it, disrupt the legitimate interests of the Opponent in that mark, and/or to cause the Opponent to incur unnecessary time and expense in trade mark proceedings.

43. I consider these points together in deciding whether the Opponent has made out its case for bad faith.

44. Confronted with the evidential basis for the bad faith claims, I note that the Applicant limits it response to the two points outlined above: the first attempting to address the more technical objection that the Applicant was not incorporated at the date of the Application (to which point I shall return); the second distinguishing the circumstances of the Apple Case from those of the current application. On the latter point, I fully recognise the factual differences at play, but I find that the numerous instances identified in the evidence of legal challenges and sectoral interest in the Applicant remain relevant to the case at hand. I attach no significance to the fact that Mr Gleissner was joined in a personal capacity in the Apple case; it seems uncontested that it is he who is the controlling interest behind

the large array of companies referenced and he is shown to be the sole director of the Applicant in this case.

45. I note the Opponent's points as to a pattern of behaviour by companies under Mr Gleissner's control making it highly improbable that the Applicant had a bona fide intention to use the mark. Although the pattern of behaviour is well-evidenced, it cannot of itself sustain a claim of bad faith for any and all applications by Mr Gleissner or companies under his control. However, when taken in the context of this particular Application, where the Applicant's mark involves the distinctive name of an exceptionally well-known businessman and public figure (being Donald Trump Jr), and when taken with the further allegations of a motivation on the part of the Applicant to interfere with the legitimate interests of the Opponent in the TRUMP mark, then I find the combination easily overcomes the presumption of good faith and founds a prima facie basis for bad faith. Yet the Applicant offered no evidence or alternative account to counter the clear allegations, indeed nor do the Applicant's submissions of 5 December 2017 even deny them.

46. There has been no request for an oral hearing to challenge any of the Opponent's evidence. Indeed only the Opponent filed written submissions in lieu of a hearing, which included reference to the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person for the decision in *Alexander*[4], which the Opponent submits is highly analogous to the present case. In *Alexander*, the claimed defence was effectively, as in the present case, that notwithstanding the provisions of s.3(6) of the Act, there was an entitlement to obtain and retain a trade mark registration for as long as it might take for the five year period of immunity from revocation on the ground of non-use to begin and end. Mr Hobbs referred to the judgment of the General Court in the *Copernicus Trademarks* case[5] which makes clear that the "first-to-file" principle is qualified in the face of bad faith on the part of an applicant.

47. Mr Hobbs noted[6] in *Alexander* that:

"*The key questions for determination by the Hearing Officer were:*

(1) What, in concrete terms, was the objective that [the Applicant] had been accused of pursuing?

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5 Case T-82/14 *Copernicus-Trademarks v EUIPO* EU:T:2016:396 at paragraphs 26 – 27.

6 At paragraph 8 of the decision.

(2) Was that an objective for the purposes of which the contested application could not properly be filed?

(3) *Was it established that the contested application was filed in pursuit of that objective?*"

48. In the context of the current case, I find that with regard to the first question, the Opponent has set out its accusations of the Applicant in very clear and concrete terms, ensuring procedural fairness and clarity of analysis. The second question, entails applying the principles of law summarised in *Red Bull GmbH v Sun Mark Ltd* and the third question involves drawing rational inferences from proven facts without allowing the assessment to degenerate into an exercise in speculation. As the Appointed Person noted in *Alexander*, the CJEU has confirmed that there must be an overall assessment which takes into account all factors relevant to the particular case. As part of that assessment, it is necessary to consider the intention of the Applicant at the time when the Application was filed, with intention being regarded as a subjective factor to be determined by reference to the objective circumstances of the particular case.

49. I must consider what the Applicant knew about the matters in question on 30 October 2016. Although the Applicant has offered little by way of response to the bad faith allegations, I note that elsewhere in its counterstatement it exclusively attributes dictionary definitions to the word Trump. I consider it disingenuous to deny that there would be widespread public awareness of the surname significance of the word. I accept the Opponent's submission that the Applicant cannot have failed to be aware of the international reputation of the Trump trade mark and I am satisfied that the Application forms part of a series of abusive registrations made by Mr Gleissner under the guise of one of his companies to seek protection over a famous third-party marks (as indicated in the evidence from Mr Morgan). While motives are not certain, I find that it unlikely that there was an intention by the Applicant to use the mark as a trade mark in trade – no such intention having been supported by evidence, notwithstanding that Mr Gleissner is known to have a professional connection to television production under other names.

50. I also find it likely that the intention was to gain some advantage deriving from the notoriety of the businessman Donald Trump Jr. There are some shortcomings in the evidence of Mr Garten, which seems intended mainly to address the reputation and goodwill aspects of the sections 5(3) and 5(4)(a) grounds. It is, for example not clear where or when the advertisements at Exhibit E were placed, nor does the evidence provide sales information. However, the evidence certainly shows the presence of Trump, as a brand, investing many tens of millions in real estate in the UK, particularly in the form of golf courses and luxury accommodation, at which resorts the brand is further promoted through merchandising. I also particularly note the Press coverage at Mr Garten's Exhibit F, which evidence implicitly highlights the notoriety of Mr Trump, running his name in headlines and referencing Trump Tower in New York.

51. Mr Morgan also refers to Mr Trump being at the time of the Application a political candidate and I consider it common knowledge and fair to observe that the Application was filed less than three months before the inauguration of Mr Trump as the President of the United States of America. Mr Trump's exceptional notoriety and profile undoubtedly encompassed not merely services pertaining to golfing or hospitality (the focus of Mr Garten's evidence) but his wider impact as a business tycoon, reality television star and prospective US Head of State.

52. Mr Morgan states in his submissions in lieu of a hearing that the Opponent is no longer linked to Donald Trump, but there is, as Mr. Geoffrey Hobbs QC made clear at paragraph 19 of his decision in *Alexander*, referring to CJEU case law "… *no requirement for the objector to be personally aggrieved by the filing of the application in question, it is possible for an objection to be upheld upon the basis of improper behaviour by the applicant towards persons who are not parties to the proceedings provided that their position is established with enough clarity to show that the objection is well-founded*."

53. I find that the Applicant has acted below the standards of acceptable commercial behaviour judged by ordinary standards of honest people[7], and the Application is accordingly refused for bad faith.

54. Having found bad faith, it is not necessary to explore the other limbs of the section 3(6) claim. In the circumstances, in the interests of efficiency, I also decline to consider the other grounds of opposition, although I note patent inconsistencies in the counterstatement and I have no doubt that I would have found in the Opponent's favour in other aspects of its claims.

Outcome

55. The Application is refused in its entirety.

Costs

56. The Opponent has been successful and has requested compensation of all costs incurred by the Opponent, since it claims it was wholly unreasonable for the Applicant even to have filed the Application. The Opponent's submissions in lieu of a hearing itemised its costs within an annex as follows:

Item	Cost
Opposition fee	£200
UK attorneys' fees and disbursements	£9565.70
US attorneys' fees and disbursements	US$5340

57. There is no doubt that section 68 of the Act and Rule 67 of the Trade Mark Rules 2008 give the registrar a wide discretion to award reasonable costs. And in his well-known Rizla decision[8] Anthony Watson QC sitting as a deputy judge accepted that the registrar has the power to award costs on a compensatory basis: "*As a matter of jurisdiction, I entertain no doubt that if the Comptroller were of the view that a case had been brought without any bona fide belief that it was soundly based*

[7] (or such behaviour "observed by reasonable and experienced men in the particular area being examined" as it was expressed in *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].)

[8] Rizla Ltd's Application [1993] RPC 365 at 377

or if in any other way he were satisfied that his jurisdiction was being used other than for the purpose of resolving genuine disputes, he has the power to order compensatory costs. It would be a strange result if the Comptroller were powerless to order more than a contribution from a party who had clearly abused the Comptroller's jurisdiction."

58. Although the courts have endorsed the registrar's power to award compensatory costs in cases of unreasonable behaviour, it does not follow that compensatory costs must be awarded whenever there is unreasonable behaviour. Rather, as stated in *Rizla's Application,* the question is whether *"the behaviour in question constituted such exceptional circumstances that a standard award of costs would be unreasonable."* This must be assessed taking into account all the relevant factors.

59. A finding that an application has been made in bad faith is not sufficient of itself to require an off-scale approach to costs. However, in this case I find that there are aspects of the conduct of the Applicant that, taken together, are sufficient to warrant an off-scale award of costs.

60. I note that the Applicant is without legal representation in this case, but relies on its own legal department. Nonetheless, the companies of Mr Gleissner, who is the Applicant's sole director, undoubtedly have extensive experience of trade mark disputes and I find that there are aspects of the case where the Applicant can have had **no bona fide belief that its defence of the Opponent's claims was soundly based**.

61. For example, although my decision did not resolve the section 5(2)(b) claim, it is plainly **not credible** to maintain that there is no likelihood of confusion between "TRUMP TV" for such services in class 41 as *production of radio and television shows and programmes; education, teaching and training; entertainment services* where the Opponent holds an earlier mark for TRUMP for services in class 41 that include *production of films and of recordings; TV shows; television entertainment; education; providing of training; entertainment*, which are plainly identical or highly similar. Yet the Applicant denied the grounds, even though its counterstatement

at one point not only accepted that the parties' services in Class 41 are similar, but put forward the contention that *"in general, the established similarities between trade marks are retained in the average consumer's recollection, rather than the differences*" and yet denied those marks are similar.

62. The adoption of such an indefensible position illustrates to me a flagrant degree of cynicism on the part of the Applicant, where other related companies have demonstrated a pattern of similar behaviour (as shown in **Exhibit DM10) including a disdainful disregard for the opposition costs of the other side**.

63. In considering whether off-scale costs are here warranted, I particularly bear in mind the **well-evidenced pattern of abusive behaviour** on the part of Mr Gleissner and his related companies as shown, for example, in the Apple cases referenced above - which decisions were published well in advance of the current opposition – and in the more recent decisions in the Alexander case.

64. I also particularly bear in mind that the Applicant applied for a TRUMP TV trade mark, with no evidenced intention to use as a trade mark in trade, at a time when the businessman and TV personality Donald Trump Jr had gained especial global prominence in light of his final stages of presidential campaigning. This obvious coincidence appears **calculated to maximise potential interference** with the Trump brand in which the Opponent has a central interest, and which is an **illegitimate purpose**.

65. It is possible that the Applicant saw nothing wrong in its behaviour, but that changes nothing, since its behaviour must be judged against an objective standard. Looked at in that way, I have no doubt that the applicants acted unreasonably.

66. Although the costs claimed are not itemised in detail, I take note of the evident work that the Opponent has had to carry out and I consider the costs sought to be reasonable. Converting the dollar amount to pounds (£4050), I award the sum of £15,105.70.

67. I order Trump International Limited to pay DTTM Operation LLC the sum of £15,105.70 (fifteen thousand, one hundred and five pounds and seventy pence) which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 04th day of July 2018

Matthew Williams

For the Registrar,
the Comptroller-General

Annex

Full list of Opponent's goods and services registered under its earlier trade marks (underlining by Hearing Officer)

EU010289064 "TRUMP"

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computer software and telecommunications apparatus to enable connection to databases, local area networks and the Internet; computer software to enable teleconferencing, videoconferencing and videophone services; computer software to enable searching and retrieval of data; computer software for accessing databases, telecommunications services, computer networks and electronic bulletin boards; sound, video, television and radio apparatus and instruments; communication, telecommunication, telephone and mobile telephone

apparatus and instruments; telephones, mobile telephones, communications devices and cases therefor; magnetic data media; electronic notice boards; ringtones [downloadable]; screen savers and screen wallpaper; communication, wireless communication and mobile communication devices; reading tablets and other devices for reading and viewing text, images and audio-visual content; software applications (apps), including apps for installation on telephones, mobile telephones and communications and wireless communication devices; accessories for telephones, telephone handsets, communication and wireless communication devices; battery chargers and adapters including battery chargers and adapters for use with and telephone, mobile telephone, communication and wireless communication devices; desk or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free; telephone handset cradles and in-car cradles; bags and cases for smartphones and laptops and for smartphone and laptop accessories; bags and cases adapted for holding or carrying cameras, optical equipment, telephones, mobile telephones communications and wireless communications equipment and accessories; electronic and computerised personal organisers; aerials; batteries; micro processors; keyboards; modems; calculators; display screens; electronic global positioning systems; electronic navigational, tracking and positioning apparatus and instruments; apparatus and instruments for geolocation; monitoring apparatus and instruments; recordings; digital recordings; films; animations; cartoons; sound, audio, visual and audio visual content and recordings; recordings and sound, audio, visual and audio-visual recordings and content, all provided by downloading and/or streaming from computers and communications networks, including the Internet and the world wide web; apparatus for access to broadcast or transmitted programmes; holograms; satellite broadcast receiving and decoding apparatus and instruments; apparatus and instruments for use in recording, storing, generating, carrying, transmitting, manipulating, processing, reproducing and playback of sounds, images, signals, data, software, code, information and audiovisual content; computer hardware, firmware and software; computer game programmes; video games and video game programmes; computer games and entertainment hardware, firmware and software; television games; electronic coin freed apparatus; electronic amusement apparatus including apparatus adapted for use with television receivers; computer games; instructional apparatus and instruments; non-printed, electronic, optical and digital publications; data cards; memory cards; electronic, magnetic, and optical identity

cards; payment cards, credit cards, charge cards, debit cards and smart cards; cameras; photographic transparencies and films; cinematographic films; spectacles; sunglasses; cases for spectacles and sunglasses; parts, fittings and accessories for all the aforesaid goods.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; gaming and casino machines, apparatus and equipment and machines, apparatus and equipment for playing casino games; golf accessory pouches, golf bag covers, golf bag tags, golf bags, golf ball markers, golf balls, golf clubs, golf club heads, golf club inserts, golf club shafts, hand grips for golf clubs, head covers for golf clubs, golf flags, golf gloves, golf irons, golf putter covers, golf putters, golf tee markers, golf tees, and divot repair tools for golfers; tennis racquets, tennis balls, tennis bags, tennis strings and tennis grip; computer arcade games; parts, fittings and accessories for all the aforesaid goods.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; examining for and granting of qualifications and awards; organising and operating talent shows and fashion shows; organising and operating games and competitions; organising and conducting parties, festivals and entertainment events; musical, radio, dramatic and television entertainment; performances; gaming; game services provided on-line from a computer network; entertainment information; education information; recreation information; providing and operating lotteries, gambling, casino services, casino facilities and gaming services; providing and operating on-line lotteries, on-line gambling, on-line casino and on-line gaming services; providing on-line electronic publications, not downloadable; publishing; art gallery services; photography services and photographic syndication services; provision of recreation, amusement and sports facilities; provision of golf facilities; provision of tennis facilities; recording; production of films and of recordings; direction of films and of performances; entertainment and night club services; health club facilities and services; golf courses; golf club services; entertainment in the nature of golf tournaments, competitions and training sessions; organization of sports competitions; rental of sports equipment; sport camp services; beauty pageants; TV shows; television entertainment; educational services, namely conducting classes and

providing instruction in connection with the aforesaid services; arrangement, reservation, information, research, advice and assistance relating to all the aforesaid.

Class 43 Provision of conference and meeting facilities; arrangement, reservation, information, research, advice and assistance relating to all the aforesaid.

EU012629648 "TRUMP" & CREST DEVICE:

Class 18

Leather and imitations of leather; leather cloth; leather straps; bags made of leather; boxes made of leather; animal skins, hides; trunks and travelling bags: umbrellas, parasols and walking sticks: whips, harness and saddlery: leather belts; handbags: purses; clutches: clutch bags: clutch purses; totes: beach bags: shopping totes: shopping bags; duffel bags; magazine totes: sports bags; athletic bags: school bags and cases; backpacks: fanny packs: wallets: pocket wallets: billfolds; credit card cases: business card cases: coin holders: luggage; luggage tags; suitcases; garment

bags for travel; attaché cases: briefcases; portfolios; jewelry rolls: key cases: leather key chains, cosmetic bags sold empty: toiletry bags; vanity cases; valises.

Class 24

Textiles and textile goods, not included in other classes; bed and table covers.

Class 25

Clothing, footwear, headgear.

Class 28

Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; gaming and casino machines, apparatus and equipment and machines, apparatus and equipment for playing casino games; golf accessory pouches, golf bag covers, golf bag tags, golf bags, golf ball markers, golf balls, golf clubs, golf club heads, golf club inserts, golf club shafts, hand grips for golf clubs, head covers for golf clubs, golf flags, golf gloves, golf irons, golf putter covers, golf putters, golf tee markers, golf tees, and divot repair tools for golfers; tennis racquets, tennis balls, tennis bags, tennis strings and tennis grip; computer arcade games; parts, fittings and accessories for all the aforesaid goods.

Class 36

Insurance; financial affairs; monetary affairs; real estate affairs; real estate brokerage; real estate investment; real estate management; real estate acquisition; real estate agencies; real estate development; purchase, sale, leasing, financing, listing, management, operation, rental and brokerage of commercial and residential real estate, apartments, condominiums, timeshare properties, vacation and resort communities, shopping malls and facilities and amenities related thereto; providing real estate listings and real estate information via the internet; credit card services.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; provision of recreation, amusement and sports facilities; entertainment and night club services; health club facilities and services related thereto; art gallery services; entertainment information services; provision of conference and meeting facilities;

beauty pageants; model and talent management services; TV shows; golf courses, golf club services, entertainment in the nature of golf tournaments, competition and training sessions; gambling, casino services and the provision of casino facilities; on-line gambling; on-line gaming; educational services, namely conducting classes and providing instruction in connection with the aforesaid services.

Class 43

Services for providing food and drink; temporary accommodation; hotel, restaurant, lounge, cafe and cocktail services; catering services; exchange arrangements for temporary accommodation, including timeshare properties and other interval ownership properties; providing facilities for meetings, conferences and functions; hotel reservation services; hotel concierge services.

Class 44

Hygienic and beauty care for human beings; spa services; health-related, beauty and cosmetic services.
