

O-121-20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3290692

BY BENJAMIN SHALOM

TO REGISTER AS A TRADE MARK



**ULTIMATE
BOXXER**

IN CLASSES 25 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 412705

BY ZUFFA, LLC

Background and pleadings

1) Benjamin Shalom (“the applicant”) applied to register the trade mark no. 3290692 in the UK on 16 February 2018. The relevant details of the application are:



Publication date: 9 March 2018

Class 25: *Clothing; footwear; headgear; sports clothing; casual wear; leisurewear; t-shirts; sweatshirts; polo shirts.*

Class 41: *Arranging and operating live entertainment events; arranging and operating live sporting competitions and events; arranging and operating entertainments and sports events; sports entertainment services; sporting event organisation; entertainment services; ticket reservation services in this class; information, advisory and consultancy services relating to the aforesaid services.*

2) Zuffa LLC (“the opponent”) opposed the application, on 8 June 2018, on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition relates to all the applicant’s goods and services. In respect of the section 5(2)(b) and section 5(3) grounds, it relies upon the following four registrations:

(i) Registration no. 2447594

Mark: ULTIMATE FIGHTING CHAMPIONSHIP

Filing date: 23 February 2007

Registration date: 26 October 2007

(ii) Registration no. 2447593

Mark: ULTIMATE FIGHTING

Filing date: 23 February 2007

Registration date: 26 October 2007

Both of these registrations are in respect of the following identical list of goods and services:

Class 9: *Digital video discs, digital versatile discs and CD-ROM discs, all featuring sports events and sports programs; compact discs, laser video discs, and computer game programs all featuring sports and entertainment in the field of mixed martial arts; computer software for programming video games in the fields of sports and entertainment; motion picture films featuring sports events, mixed martial arts and profiles of athletes.*

Class 16: *Posters, event programs; books and printed instructional and teaching manuals in the field of sports and entertainment; note paper dispensers; general feature and sports magazines; fitness and entertainment magazines; newspapers in the field of sports, fitness and entertainment; calendars; mounted and unmounted photographs; trading cards; road maps; books and journals featuring athletic contests and games; catalogues for the sale of athletic merchandise; envelopes; cartoon prints on paper and cardboard; blank and picture postcards; note cards, note pads; greeting cards; cookbooks; adult and children's activity and colouring books; puffy stickers; adhesive stickers; photograph albums; memorandum books, pens, pencils; folders and portfolios for papers; binders; letter openers; memo holders; pennants made of paper and mounted on sticks; diaries; clipboards; book covers; book marks; bulletin boards; erasable memo boards; pen and pencil holders; paper clip holders; paper weights; paper napkins and towels; writing paper and stationery; drawing paper; gift wrapping paper; luminous paper; graphics paper; stickers; paper banners; decals and windshield decals strips; collector decals and collector decals with display sheets; bumper stickers and strips; memo pads; non-electric erasers; stationery holders; maps; desk sets; colour lithograph sticker books; postcard books; holographic greeting and trading cards, pencil bags; pencil sharpeners; gift wrapping paper sets; decorative gift boxes; comic books; bookmarks; poster books; paper, party and lawn signs; stamp pads; rubber stamps for impressing illustrated images; score, check and autograph books; adhesive tape dispensers*

for stationery or household use; corrugated cardboard storage boxes and corrugated closet wardrobes and storage boxes.

Class 25: *Clothing and wearing apparel, namely, shirts and caps; warm-up suits, sweatshirts, sweatpants, tee-shirts, tank tops, infant and toddler sleepwear, shorts, underwear, hats and visors; polo shirts; golf shirts; sports shirts; vests; pants for babies; baby booties; belts; neckties; suspenders; bandanas; beach sandals; robes; nightshirts and night gowns; pyjamas and loungewear; bathing suits; beach wear; infant cloth diaper sets comprised of diapers and bibs; toddler short sets; jogging suits; rompers; boys short sets; socks; playsuits; coveralls; wristbands; union suits; woven suits; skirts; blouses; pants; slacks; jackets; referees and umpires uniforms; athletic uniforms; team uniform reproductions, namely jerseys featuring reproductions of professional athletic team logos; sweaters; parkas; turtlenecks; mittens and gloves; jerseys; bowties; headwear and scarves; ear muffs; ear bands and headbands; hosiery; rainwear, namely rain ponchos and jackets; footwear, namely shoes, boots and slippers; bath thongs; shell suits; aprons; ski bibs; canvas footwear; knickers; wind resistant jackets; masquerade costumes; blazers; legwarmers; jeans; leotards; workout and sports apparel, namely jackets, slacks, shirts.*

Class 28: *Rubber balls; action figures and accessories therefor; action skill games; bean bag dolls; plush toys; balloons; golf balls; tennis balls; bath toys; Christmas tree ornaments; board games; building blocks; equipment sold as a unit for playing card games; dolls and doll clothing; doll playsets; children's play cosmetics; crib toys; electric action toys; manipulative games; golf gloves; golf ball markers; jigsaw puzzles; kites; mobiles; music box toys; party favours in the nature of small toys; inflatable pool toys; multiple activity toys; wind-up toys; target games; disc-type toss toys; bows and arrows; toy vehicles; toy cars; toy trucks; toy bucket and shovel sets; roller skates; toy model hobbycraft kits; toy rockets; toy guns; toy holsters; musical toys; badminton sets; bubble making wands and solution sets; toy figurines; toy banks; puppets; spinning disks incorporating string which rewinds and returns the disk to the hand when thrown; skateboards; scooters; face masks; hand-held electronic games playing cards; plastic water filled snow globes.*

Class 41: *Entertainment services relating to sporting activities and events; sporting activities; organization of competitions; production of radio, video tape and television programs and of shows; radio and television entertainment; conducting mixed martial arts competitions, events and personal appearances; information services relating to all the aforesaid.*

(iii) European Union Trade Mark ("EUTM") 4348819

Mark: THE ULTIMATE FIGHTER

Filing date: 18 March 2005

Registration date: 30 May 2006

Class 9: *Computer game discs, pre-recorded video cassettes featuring sports events and mixed martial arts; computer game programs; pre-recorded audio cassettes, phonograph records, compact discs, laser video discs, digital video discs, digital versatile discs and CD-ROM discs, all featuring sports events and mixed martial arts; computer software for programming video games in the fields of sports and entertainment; motion picture films featuring sports events, mixed martial arts and profiles of athletes; eyeglasses; sunglasses; video game cartridges and discs; computer game cartridges.*

Class 25: *Warm-up suits, sweatshirts, sweatpants; tee-shirts; polo shirts; golf shirts; sports shirts; tank tops; vests; pants for babies; trousers for babies; baby booties; belts; neckties; suspenders; bandanas; beach sandals; infant and toddler sleepwear; robes; nightshirts and night gowns; pyjamas and loungewear; bathing suits; beachwear; diaper sets, nappy sets, namely undergarments for infants; toddler short sets; jogging suits; rompers; boys shorts sets; socks; play suits, namely a children's play outfit consisting of a blouse and shorts; coveralls; wrist bands; union suits; woven suits; shorts; skirts; blouses; pants; trousers; slacks; shirts; jackets; referees and umpires uniforms; athletic uniforms; team uniform reproductions, namely jerseys featuring reproductions of professional athletic team logos; sweaters; parkas; turtlenecks; mittens and gloves; underwear; jerseys; bow ties; headwear and scarves; ear muffs; head bands; hosiery; rainwear, namely rain ponchos and jackets; footwear, namely shoes, boots, slippers and bath thongs, flip flops; nylon shells, namely shirts; hats; caps; visors; aprons; ski bibs; canvas footwear; knickers; wind resistant jackets; Halloween and masquerade costumes; blazers; leg warmers; jeans; leotards; workout and sports apparel, namely shorts, jackets, slacks, shirts.*

Class 41: *Entertainment in the nature of an on-going television program in the field of sports and mixed martial arts.*

(iv) EUTM 11277118

Mark: ULTIMATE FIGHTING CHAMPIONSHIP

Filing date: 18 October 2012

Registration date: 6 July 2017

Class 9: *Pre-recorded audio cassettes; phonograph records; compact discs; pre-recorded video cassettes; laser video discs; digital video discs; digital versatile discs; electronic storage media; USB flashdrives; CD-ROM discs all featuring mixed martial arts competitions, events and programs; computer game programs featuring or relating to mixed martial arts; computer games featuring or relating to mixed martial arts; computer software featuring or relating to mixed martial arts; motion picture films in the field of mixed martial arts; mp3 and mp4 recordings relating to or featuring mixed martial arts; electronic publications featuring or relating to mixed martial arts; electronic and digital music, sound, image and video recordings featuring or relating to mixed martial arts.*

Class 16: *Books and printed instructional and teaching manuals featuring or relating to mixed martial arts in the field of sports and entertainment; general feature and sports and entertainment magazines in the field of mixed martial arts; fitness and entertainment magazines featuring or relating to mixed martial arts; newspapers in the field of sports, fitness and entertainment all featuring mixed martial arts; calendars featuring or relating to mixed martial arts; mounted and unmounted photographs featuring or relating to mixed martial arts; trading cards featuring or relating to mixed martial arts; books and journals featuring athletic contests and games in the field of mixed martial arts; catalogues for the sale of athletic merchandise relating to mixed martial arts; cartoon prints on paper and cardboard featuring or relating to mixed martial arts; blank picture postcards; note cards; greeting cards; adult and children's activity and colouring books featuring or relating to mixed martial arts; puffy stickers featuring or relating to mixed martial arts; adhesive stickers featuring or relating to mixed martial arts; photograph albums featuring or relating to mixed martial arts; memorandum books featuring or relating to mixed martial arts; posters featuring or relating to mixed martial arts; event programs featuring or relating to mixed martial arts; stickers featuring or relating to mixed martial arts; decals and windshield decals strips featuring or relating to mixed martial arts; collector decals and collector decals with display sheets featuring or relating to mixed martial arts; bumper stickers and strips featuring or relating to mixed martial arts; colour lithograph sticker books featuring or relating to mixed martial arts; postcard books featuring or relating to mixed martial arts; holographic greeting and trading cards featuring or relating to mixed martial arts; comic books featuring or relating to mixed martial arts; rubber stamps for*

impressing illustrated images featuring or relating to mixed martial arts; score, check and autograph books in the field of mixed martial arts.

Class 28: *Action figures and accessories therefor featuring or relating to mixed martial arts; action skill games featuring or relating to mixed martial arts; electric action toys featuring or relating to mixed martial arts; target games featuring or relating to mixed martial arts; toy figurines featuring or relating to mixed martial arts; hand-held electronic games featuring or relating to mixed martial arts; playing cards; computer game accessories and controllers relating to mixed martial arts.*

Class 41: *Live stage shows relating to mixed martial arts; presentation of live performances featuring mixed martial arts; amusement park and theme park services relating to mixed martial arts; entertainer services featuring and relating to mixed martial arts; pleasure-ground services featuring and related to mixed martial arts; entertainment services featuring mixed martial arts rendered in or relating to theme parks; production, presentation, distribution, and rental of television and radio programs featuring mixed martial arts; production, presentation, distribution and rental of motion picture films featuring or relating to mixed martial arts; production, presentation, distribution and rental of sound and video recordings featuring or relating to mixed martial arts; entertainment information featuring or relating to mixed martial arts; production of entertainment shows and interactive programs for distribution via television, cable, satellite, audio and video media, cartridges, laser discs, computer discs and electronic means featuring mixed martial arts; provision of entertainment and news via communication and computer networks; provision of information relating to mixed martial arts via communication and computer networks; providing news and information in the fields of sports, fitness and mixed martial arts via communication and computer networks.*

3) The first three of the opponent's marks are potentially subject to the proof of use provisions contained in section 6A of the Act because they competed their registration procedures more than five years prior to the publication of the contested mark.

4) In respect of the section 5(2)(b) ground, the opponent asserts that:

- The respective marks are highly similar with the consumer focussing on the ULTIMATE element of the applicant's mark because, despite the misspelling, the word BOXXER will be perceived as a reference to a particular type of athlete and because words speak louder than devices. The opponent also

points to a claimed conceptual similarity between BOXXER and FIGHTING or FIGHTER;

- The respective goods and services “are clearly identical” and “highly similar” and “they target the same end user, have the same distribution channels and are complementary”;
- Consequently, “there is a clear likelihood of confusion *prima facie*”. It also claims that because its marks “have been used on an extensive scale in the United Kingdom” through use of its family of ULTIMATE composite marks, the consumer is likely to associate the marks and conclude that the applicant’s goods and services are somehow endorsed by the opponent.

5) In respect of the section 5(3) ground the opponent asserts that:

- The respective marks are highly similar (for the reasons summarised above);
- The respective goods and services are identical or similar;
- The opponent’s marks have been used extensively in the UK and other parts of the EU for over 15 years and enjoy a significant reputation;
- ULTIMATE composite marks are associated exclusively with the opponent and, consequently, use of the applicant’s mark would:
 - take unfair advantage of its marks’ reputation by free-riding and “arousing an association in the mind of consumers with the opponent’s marks” because of the investment made by the opponent in promoting its marks;
 - be detrimental to the reputation of its marks because the applicant’s products would not be under the opponent’s control and therefore have a negative impact on consumer’s views of the opponent’s mark;
 - be detrimental to the distinctive character of its mark because use of the applicant’s mark would “dilute and whittle away the distinctive character” of its marks resulting in consumers being less likely to purchase the opponent’s goods and services.

6) In respect of the grounds based upon section 5(4)(a), the opponent relies upon its goodwill identified by the signs ULTIMATE FIGHTING CHAMPIONSHIP, THE ULTIMATE FIGHTER, ULTIMATE and ULTIMATE FIGHTING used throughout the UK since 2002 in respect of the following services:

“Entertainment services, ticketing services for live events, organisation of sporting events and competitions; sporting events, television programmes, clothing, merchandise, sporting goods and equipment, recorded and downloadable television programmes and audiovisual content; computer games”

7) This ground is based upon a claim that the opponent has a significant goodwill in respect of the above list of goods and services which are identical or highly similar to the applicant’s goods and services. Given the similarity between its signs and the applicant’s mark and the similarity of the goods and services the relevant public would be deceived into thinking there is a connection with the opponent’s business where this is not the case. As such there would be clear misrepresentation that would be damaging to the opponent.

8) The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of its earlier marks 2447594, 2447593 and EUTM 4348819. The opponent’s EUTM 11277118 is not subject to the proof of use provisions because it completed its registration procedures less than five years before the publication of the contested mark.

9) The parties both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. The parties also both filed written submissions in lieu of a hearing. I will keep these in mind when giving my decision. As no hearing was requested I make this decision following careful consideration of the papers.

10) The opponent has been represented by Marks & Clerk LLP. The applicant identifies Stuart Shalom, at the same address as the applicant, as being his representative. The shared address and surname suggest that Stuart Shalom is not

a legal representative and the applicant has been considered as a litigant in person throughout the proceedings.

Opponent's evidence-in-chief

11) This takes the form of the witness statement of Wm. Hunter Campbell, chief legal officer and executive vice president of the opponent. He provides evidence of the claimed use and reputation of the opponent's marks.

Applicant's evidence

12) This takes the form of a witness statement by the applicant himself, Benjamin Saul Shalom. He describes himself as principal founder, shareholder and managing director of Ultimate Boxxer Ltd. Mr Shalom provides evidence of the applicant's activities, the meaning of the word ULTIMATE and state-of-the-Register evidence of third parties registering marks containing the word ULTIMATE. The statement also contains submissions regarding the similarity of the marks.

Opponent's evidence-in-reply

13) This is a witness statement by Lawrence Epstein, senior executive president and chief executive officer for the opponent. He addresses Mr Shalom's claims regarding the distinctiveness of the opponent's marks, the relationship between the respective sports promoted by the parties and the cross-over of the terms "fighter" and "boxer".

DECISION

Approach

14) The opponent's case is that the misspelling present in the word BOXXER will not displace the meaning of a type of athlete. It is my view that, with this in mind the opponent's best case (subject to proof of use considerations) resides with its mark THE ULTIMATE FIGHTER. The conceptual identity between this mark and the applicant's mark is closer than when comparing the applicant's mark with the other of

the opponent's marks because, based upon the opponent's submissions, both marks describe a boxer/fighter that is the ultimate. The other of the opponent's marks refer to the act of "fighting" rather than the noun "fighter". I will discuss the precise conceptual identities in more detail later.

15) In light of the above, I intend to begin by considering the issue of proof of use of the opponent's mark THE ULTIMATE FIGHTER. If, following the proof of use considerations, it is my view that it no longer presents the opponent's best case (in total or in part), I will go on to consider the opponent's case based either upon its marks 2447593 ULTIMATE FIGHTING and 2447594 ULTIMATE FIGHTING CHAMPIONSHIP.

Proof of Use

16) The proof of use provisions are set out at Section 6A of the Act:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the period of five years ending with the date of
publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

17) Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29];

Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at

[22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19) It is for the opponent to provide evidence to show that it has made use of its mark, during the relevant period. The relevant period in these proceedings for demonstrating genuine use is the five-year period ending with the publication date of the contested application, namely, 10 March 2013 to 9 March 2018.

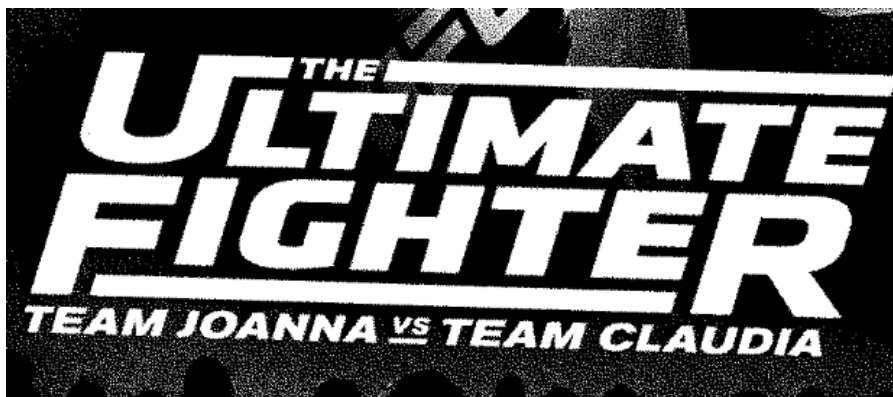
20) In respect of the mark THE ULTIMATE FIGHTER, the evidence can be summarised as follows:

- “The Ultimate Fighter” was a reality television series where fighters competed for an Ultimate Fighting Championship (“UFC”) contract and was launched on Spike TV in January 2005. It was viewed as an instant success¹. This is before the relevant date and, further, the geographical reach of Spike TV is unknown;
- The second season launched in August 2005 and two more seasons appeared in 2006. New seasons continued to be created with Spike TV up to

¹ From the Wikipedia entry for “Ultimate Fighting Championship” provided at Exhibit HC1.

2012 when, after the 14th season, the show moved to FX in 2012. Season 15 began in the Spring of 2012². This evidence suffers from the same shortcomings as in the previous bullet point;

- The popularity of the UFC surged in 2009 credited, in part, to two rival coaches from “The Ultimate Fighter: United States vs. United Kingdom” who fought each other³. Again, it is not known where this was broadcast and, further, it relates to a time before the start of the relevant period;
- Copies of three advertisements for “The Ultimate Fighter” appearing on the UK television channel BT Sport 2 between September to December 2015, April to July 2016, and August to November 2016 are shown⁴. The broadcast time is given as 3am, with a repeat at 10pm the following day. A stylised form of the mark (“the stylised mark”) is used as shown below:



- A further copy of an advertisement for “The Ultimate Fighter” is provided⁵ also using the stylised mark. It promotes the series showing at 10pm on the UK television channel Sky Sports HD, but no year is indicated;
- A press release from the television channel ESPN announces that it will broadcast “two new series of the UFC’s popular reality show, *The Ultimate Fighter*.” It was scheduled to begin on 16 September of an unspecified year being aired at midnight. The footer of the press release shows that ESPN is available to view through Sky, Virgin, BT Vision and TalkTalk⁶;

² ditto

³ ditto

⁴ Exhibit HC7

⁵ At Exhibit HC11

⁶ Exhibit HC17

- Data is provided from EurodataTV Worldwide and shows that “ULTIMATE FIGHTER”/“The Ultimate Fighter” was broadcast in numerous EU member states including the UK between 2010 and 2012 (before the relevant period)⁷;
- In addition, more recent data is also provided⁸. Here the programmes are identified by abbreviations. One of these abbreviations is “TUF” that I am prepared to accept is a reference to “The Ultimate Fighter”. The listings are accompanied by various figures that are not explained (Mr Campbell does provide a limited explanation of the figures in the previous exhibit, but this does not appear to match the column headings in this later exhibit). One of the column headings is “A18-49 Reach (000s)”. Reading this in context it may be a reference to the number of all viewers aged between 18 and 49, measured in thousands. I note these figures in brackets when showing below the salient information from these tables:
 - The following occurrences (some of these are repeats) of episodes being broadcast on BT pay-TV:
 - 5 occurrences of episodes from Series 21 on 13 July 2015 (15, 14, 15, 2, 24, 35);
 - 6 occurrences from Series 22 on 12 December 2015 (37, 45, 53, 19, 48, 35, 66, 48, 66);
 - 3 occurrences from Series 23 on 12 July 2016 (0, 13, 15);
 - 9 occurrences from Series 24 on 4 December 2016 (6, 20, 18, 5, 13, 5, 3, 21, 7);
 - 6 occurrences from Series 25 on 8 July 2017 (20, 23, 20, 1, 33, 23);
 - 6 occurrences from Series 25 on 10 July 2017 (0, 0, 0, 28, 23, 28);
 - 9 occurrences from Series 26 on 2 December 2017 (11, 19, 11, 7, 15, 16, 15, 9, 15);
- Three screenshots of the title of *YouTube* videos of “The Ultimate Fighter” are provided⁹ but no dates are legible (except in the third that merely refers to “Nov 30 Fri”, but there is no indication of the year). Mr Campbell provides

⁷ Exhibit HC18

⁸ In the table at Exhibit HC18A

⁹ Exhibit HC28

viewing figures of the opponent's *YouTube* videos for the years 2013 to 2017 which range between 44 million and just over 197 million;

- Tables are provided, recording the sale of merchandising at the Capital FM Arena in Nottingham in 2012¹⁰. This was before the relevant period and does not obviously detail any merchandising featuring the mark “The Ultimate Fighter”. The same criticisms apply to a table recording the sale of merchandising at the Royal Albert Hall¹¹;

21) There is no evidence relating to the relevant period to support use of this mark in the EU, other than in the UK. The evidence supporting use in other member states predates the start of the relevant period for assessing proof of genuine use.

Therefore, I must consider if the above identified use in the UK is sufficient to demonstrate genuine use of the earlier EUTM in the relevant period.

22) In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“the CJEU”) noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it

¹⁰ Exhibit HC13

¹¹ Exhibit HC14

cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

23) The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main

proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

24) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion

of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

25) The General Court ("the GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a EUTM). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the EU corresponding to the territory of one member state may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the EU.

26) With this guidance in mind, I acknowledge that use only in the UK will not necessarily result in a negative appraisal of genuine use of an EUTM. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the EU during the relevant five-

year period. In making the required assessment I am required to consider all relevant factors, including those identified below.

The scale and frequency of use

27) Between July 2015 and December 2017, episodes of the opponent's "The Ultimate Fighter" reality show aired in the UK on a BT pay TV channel forty-four times covering six consecutive series. I have been left to interpret the table listing the broadcasts. If I have interpreted this correctly, of the forty-four episodes shown, 4 had less than 1000 viewers and the maximum for any one episode in each of the six series was 35,000, 66,000, 21,000, 33,000, 28,000 and 19,000 respectively. Other evidence is undated or dated before the start of the relevant period and does not assist. Evidence is provided of visits to the opponent's website and views of its *YouTube* videos from within Europe. However, these appear to only relate to its activities under the ULTIMATE FIGHTING CHAMPIONSHIP mark and do not relate to its reality show.

The nature of the use shown

28) There is little evidence to show how the mark was presented in respect of these broadcasts, but the advertisements provided all show use in a stylised form. The broadcast information in these advertisements do not map exactly to the broadcasts detailed in the eighth bullet point and therefore, it is not clear whether the advertisements refer to further broadcasts or the same broadcasts.

The goods and services for which use has been shown

29) Use was in respect of a reality-TV show.

The nature of those goods/services and the market(s) for them

30) These services are in the nature of recorded or live programmes broadcast on television. It is not clear whether they were subsequently made available on catch-up or on-demand platforms. In this age of digital television, there is a plethora of

channels and methods of consuming such services with a correspondingly large marketplace.

The geographical extent of the use shown

31) The broadcast of “The Ultimate Fighter” has been on a BT channel. This suggests that the broadcasts were available throughout the UK.

Conclusion on EU use

32) From the above evidence, I conclude that “The Ultimate Fighter” reality show has been aired in the UK, being part of the EU, during the relevant period, however, I must draw my findings of fact together to make an assessment of whether this qualifies as genuine use in the EU. In addition to the authorities cited earlier, I also keep in mind the decision of Daniel Alexander QC, sitting as the Appointed Person in *Jumpman Trade Mark*, BL-O-222-16 who considered whether the sale of 55,000 pairs of footwear in Bulgaria was sufficient for a finding of genuine use in the EU. He took into account the leading authorities including *Reber*¹² and *Leno*¹³ and concluded that the hearing officer was entitled to find that it was not.

33) I take all of the above into account. I recognise that the viewing figures suggest that 66,000 watched one episode but that viewing figures were more typically in the region of 20,000 to 30,000. I find that such use is sufficient to reach a different conclusion to that of Mr Alexander in *Jumpman*. The opponent’s use of THE ULTIMATE FIGHTER amounts to use that is not token nor trivial, even taking into account that the size of the market for television programmes in the EU is very large. The use spans a number of years in the relevant period and has occurred on a television channel that is available across the whole of a member state of the Union, namely the UK.

¹² *Reber Holdings GmbH & Co KG v. OHIM* C-141/13P

¹³ *Leno Merken BV v Hagelkruis Beheer BV* [2012] EUECJ C-149/11

34) There is no evidence identifying this earlier mark in use in respect of any clothing footwear or headgear.

35) I conclude that the use shown is sufficient to conclude that a stylised form of the mark has been genuinely used in the EU in respect of a reality television programme relating to MMA.

Variant Use

36) As I have noted above, the mark used by the opponent is a stylised version, shown in paragraph 20. Consequently, it is necessary that I consider whether use of this stylised version of the mark qualifies as acceptable variant use for the purposes of assessment of genuine use of the mark as registered. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

37) Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered.

38) In *Hyphen GmbH v EU IPO*, Case T-146/15, the GC held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



39) The court set out the following approach to the assessment of whether the addition of additional components is likely to alter the form of the registered mark to a material extent:

“28. ...a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).

32 It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009.”

40) These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark.

41) In *Menelaus BV v EUIPO*, Case T-361/13, the GC found that use of the marks shown on the left and middle below constituted use of the registered mark on the right.



42) The court held that the word VIGAR was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

“73 [The first sign] sign differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term ‘vigar’, are minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

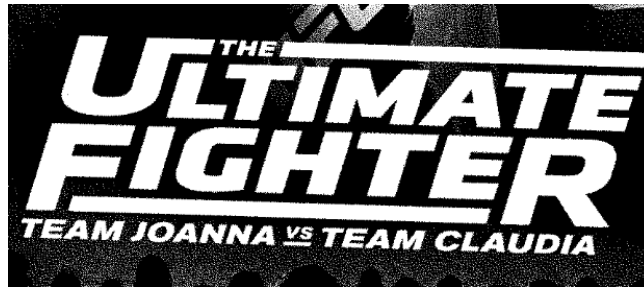
74 That finding is not called into question if the second form of use, reproduced in paragraph 63 above, is taken into account inasmuch as, even though, in that case, the basic background disappears and the word ‘spain’ is present, the latter will be understood as a merely descriptive addition.”

See also the judgments of the GC in *Sony Computer Entertainment Europe v OHIM*, case T-690/14, *LTJ Diffusion v OHIM*, case T-83/14 and *PAL-Bullermann v EUIPO*, case T-397/15.

43) In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Philip Johnson, sitting as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

dreams

44) The mark relied upon by the opponent is THE ULTIMATE FIGHTER. Its distinctive character resides in the specific combination of the three words. The mark used is shown below:



45) This mark is superimposed on to a photograph of the contestants that feature in that particular series of the programme and this background does not form part of the mark. Further, the words TEAM JOANNA vs TEAM CLAUDIA are also used to identify the contestants and, consequently, are non-distinctive elements that do not change the distinctive character of the mark. The other differences between the earlier mark and the mark as used are that the latter is presented with the word THE being placed in small letters above the first "T" of the word ULTIMATE and the letter U is presented in a slightly larger font with a long right hand arm extending above the rest of the word, and the letters F and R of the word FIGHTER being presented in the same, but slightly larger font. These differences do not change the distinctive character that resides in the words THE ULTIMATE FIGHTER and I conclude that the use shown is an acceptable variation of the earlier mark for the purposes of proving genuine use.

Fair Specification

46) Next, I must consider what would be a fair specification that reflects the use demonstrated in the opponent's evidence. I keep in mind the guidance of Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10 where he stated:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

47) I have found use in respect of *reality television shows*. Such services fall into Class 41 and the registration for this mark contains the following specification in this class: *Entertainment in the nature of an on-going television program in the field of sports and mixed martial arts*. This term, whilst broader than the actual use shown, nevertheless, describes a category of services within which the use has been shown. I recognise that the category may be described in alternative ways, but I find that the opponent is entitled to rely on the term.

48) There is no evidence that the opponent's mark has been used in respect of any other goods or services, including Class 25 goods, and it cannot, therefore, rely upon and other goods and services in these proceedings.

Proof of use of the opponent's marks 2447593 ULTIMATE FIGHTING and 2447594 ULTIMATE FIGHTING CHAMPIONSHIP

49) In light of my finding that there has been no genuine use of the opponent's THE ULTIMATE FIGHTER mark in respect of any Class 25 goods, reliance upon this earlier mark in the opponent's case against the applicant's Class 25 goods is greatly weakened. With this in mind, I also consider if the opponent has demonstrated genuine use of its ULTIMATE FIGHTING and ULTIMATE FIGHTING CHAMPIONSHIP marks. However, I will restrict my considerations to genuine use in respect of the goods listed in Class 25 because use in respect of other goods and

services is unlikely to materially improve the opponent's case against the applicant's Class 25 goods.

50) The opponent's evidence on this point can be summarised as follows:

- Numerous declarations are provided¹⁴ from third parties linked to the opponent and/or involved in the field of martial arts all attesting to the belief that its marks have become distinctive in the EU. These are all dated in 2005 or earlier and do not refer specifically to the mark THE ULTIMATE FIGHTER;
- A photograph taken at the "ISPO" event (a trade show for sports businesses¹⁵) in Munich in 2011 shows t-shirts hanging up behind an ULTIMATE FIGHTING CHAMPIONSHIP stand¹⁶. However, it is not possible to see what appears upon the t-shirts. This also relates to an event that took place before the relevant date;
- In the same exhibit, a further photograph is provided showing a stand selling "UFC" branded clothing. It is not possible to discern any greater detail. Mr Campbell states that this shows third parties were also exhibiting UFC products at the ISPO event in 2017 and 2018¹⁷;
- As noted earlier, the evidence relating to merchandising sales at the Capital FM Arena, Nottingham and at the Royal Albert Hall do not assist because they relate to a time before the relevant period for demonstrating proof of use;
- Extracts from a Google search conducted on 5 March 2013 (five days prior to the commencement of the relevant period) show three instances of t-shirts for sale identified as either "Ufc Ultimate Fighting Championship" or "Ultimate Fighting Championship"¹⁸. In the same exhibit, two further t-shirts are shown bearing ULTIMATE FIGHTING CHAMPIONSHIP on the chest. These pages are undated, but in his witness statement¹⁹ Mr Campbell states that these pages show "a more recent search ..." than the one conducted on 5 March 2013. This statement does not make it clear if "more recent" relates to a time

¹⁴ At Exhibits HC3 and HC4

¹⁵ See Exhibit HC9, page 56

¹⁶ Mr Campbell's witness statement, para 10 and Exhibit HC9

¹⁷ Mr Campbell's witness statement, para 10

¹⁸ Exhibit HC21

¹⁹ At para 24

in the relevant period or after. Therefore, I cannot conclude that the results of the search are relevant to the assessment of genuine use in the relevant period;

- In Internet extracts from the opponent's "UFC Store" show various hoodies and t-shirts and a cap²⁰, a number of which bear the mark ULTIMATE FIGHTING CHAMPIONSHIP either with the stylised mark "UFC" or in stylised form. The details of these are not easily readable because of their small size on the page. The exhibit is undated;
- Mr Campbell identifies²¹ figures contained in tables showing revenue of the opponent between 2010 and 2016²² as relating to the clothing shown in the previous bullet point. The tables record UK "merchandise costs" for these years. However, no denomination is given and it is not possible to identify what proportion, if any, relates to Class 25 merchandising goods bearing the marks in question. Figures are also provided for numerous other EU member states, but these all suffer from the same deficiencies i.e. it is not possible to ascertain what proportion, if any, relates to Class 25 merchandising goods. Further, none of the categories of sales shown appear to relate to merchandise of any kind;

51) What is clear from the evidence is that the opponent has provided merchandising in the form of, at least, t-shirts, however, because of the deficiencies in the evidence it is not possible to reach a conclusion regarding the scale of the trade or the precise marks used. Section 100 of the Act puts the onus firmly upon the opponent to produce cogent evidence of its use in respect of the goods and services on which it claims the mark has been genuinely used. In the current case, the opponent has failed to do this, despite it being within its gift. There is no evidence demonstrating use of its marks in respect of any Class 25 goods in the relevant period. In conclusion, I find that the opponent has failed to demonstrate that it has genuinely used its marks in respect of Class 25 goods.

Evidence relating to other goods

²⁰ Exhibit HC22

²¹ At para 25 and para 35

²² At CONFIDENTIAL Exhibit HC30

52) The opponent also provides evidence showing it has licensed its brand to the makers of online computer games. Its merchandise offering also included DVD recordings of fight compilations, mini-figures, backpacks, shot glasses, wrist watch bracelets, bar stools. The evidence relating to these suffers from the same deficiencies as discussed above.

Conclusions regarding genuine use

53) I have found that:

- (i) The opponent may reply upon the mark THE ULTIMATE FIGHTER in respect of *Entertainment in the nature of an on-going television program in the field of sports and mixed martial arts*;
- (ii) Genuine use has not been shown in respect of any of the opponent's earlier marks for goods proper to Class 25.

54) I have not summarised the opponent's evidence regarding its core activities, namely its provision of entertainment in the form of live and televised MMA events under the mark ULTIMATE FIGHTING CHAMPIONSHIP, but I record here that it is the opponent's primary mark in respect of its live and televised MMA events.

55) There is no separate use of ULTIMATE FIGHTING, but rather the opponent relies upon the mark being part of its ULTIMATE FIGHTING CHAMPIONSHIP. However, applying the criteria referred to earlier, the use of ULTIMATE FIGHTING CHAMPIONSHIP does not qualify as an acceptable variant use. Its conceptual identity as indicating a "championship" is different to the conceptual identity of ULTIMATE FIGHTING that indicates the activity of "fighting". Therefore, the concept of the first is of the best fighting championship and the second of the best fighting. One describes the act of fighting, the other a championship competition. The addition of the word CHAMPIONSHIP to the words ULTIMATE FIGHTING creates a different conceptual identity. Consequently, the former differs in distinctive character to the latter and, therefore, the opponent is not able to rely upon the mark ULTIMATE FIGHTING in respect of any of the goods or services claimed.

Section 5(2)(b)

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

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods and services

57) In the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

58) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular

whether they are, or are likely to be, found on the same or different shelves;
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

59) In *Gerard Meric v Office for Harmonisation in the Internal Market (MERIC)*, Case T-133/05, the GC stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

60) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

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

Class 25 goods

61) Following my conclusions regarding genuine use, the opponent has no Class 25 goods that it may rely upon. There is no obvious similarity between the applicant's *clothing; footwear; headgear; sports clothing; casual wear; leisurewear; t-shirts; sweatshirts; polo shirts* and the opponent's Class 41 services, namely, *entertainment in the nature of an on-going television program in the field of sports and mixed martial arts*. Goods and services are fundamentally different in nature and the

respective goods and services also, self-evidently, have different purposes and methods of use. They are not in competition, nor are they complementary in the sense expressed in *Boston Scientific*.

62) Further, there is no objective similarity between Class 25 goods and the opponent's entertainment services. Merely because a provider of entertainment also provides merchandising in the form of clothing is not sufficient for a finding of similarity. This approach would mean that the same goods and/or services might be regarded as being similar or dissimilar, depending on the reputation of the earlier mark. Taken to its logical conclusion it would also mean that any potential merchandise could be regarded similar to entertainment services, notwithstanding the absence of any objective similarity between the goods and services. Adopting such an 'elastic' approach to similarity of goods/services would undermine the requirement in section 5(2) of the Act for the respective goods/services to be objectively similar, at least to some extent. It would also make it unduly difficult for other operators in the market sectors concerned to assess whether a particular mark is free for use in relation to particular goods/services.

63) Users of the opponent's entertainment services will wear clothing but this is not sufficient to justify a conclusion that the respective goods/services are similar. I keep in mind that the courts have rejected similar attempts to broaden the protection afforded to marks under provisions of law equivalent to section 5(2) of the Act when it comes to marks claiming to have a particular kind of reputation with the public. For example, in *Compagnie des montres Longines, Francillon SA v OHIM*, Case T-505/12, paras 54 and 55, the GC rejected the argument that sunglasses, jewellery and watches were similar to clothing on the basis that they were all types of luxury goods and the earlier mark had a reputation as a luxury brand. Similarly, in the current case, clothing and entertainment services are not similar just because clothing may be sold by certain entertainment service providers.

64) In conclusion, I find that the respective goods and services have different natures, purposes, methods of use and do not share trade channels. They are not in competition nor are they complementary. They do not share any similarity.

Class 41 services

65) In respect of the applicant's *entertainment services* and *sports entertainment services* these are broad terms that obviously include the opponent's Class 41 services and, with the guidance from *Meric* in mind, I conclude that the respective services are identical.

66) In respect of the applicant's *arranging and operating live entertainment events; arranging and operating live sporting competitions and events; arranging and operating entertainments and sports events; ...; sporting event organisation* are not identical to the opponent's services because they are, on the one hand, services relating to arranging and operating live entertainments and on the other, a television programme. Of course, a television programme may include the broadcasting of a live event and, consequently, there is some similarity. Their respective services will both have the intended purpose of entertaining and they may be in competition where the consumer is faced with a choice of attending the live event or watching it on television. Further, the event organiser may also provide a television programme of the event and consequently, there may be overlap of trade channels. Taking all of this into account, I conclude that the respective goods share medium or slightly higher level of similarity.

67) The applicant's *ticket reservation services in this class* are further removed from the opponent's services. The nature of these services is that of a booking function rather than an entertainment function, the purpose is to provide access to an event whereas the opponent's services are to entertain via a television programme and, consequently, they have a different purpose. However, there may be overlap in trade channels where a provider sells tickets to a live event and also provides a television programme about or showing the event. The respective services are not in competition, nor are they complementary. Tickets are not required to watch a television programme. Whilst I acknowledge that the opponent's television programmes appear to be broadcast on pay-per-view channels and that this has some parallels to purchasing a ticket, such a parallel does not disturb my analysis. I conclude that the similarity is no more than low.

68) Finally, in respect of the applicant's *information, advisory and consultancy services relating to the aforesaid services*, this includes information, advice and consultancy relating to *sports entertainment services* and, therefore, includes information, advice and consultancy related to identical services to those of the opponent. As a result, the trade channels may overlap and there is complementarity between the respective services in the sense described in *Boston Scientific*. I conclude that there is a medium level of similarity. In respect of *information, advisory and consultancy services relating to the aforesaid services*, namely "ticket reservation services", these could relate to ticket reservations for the type of events organised by the opponent. Therefore, despite the respective goods and services being different in nature, purpose and methods of use and are not in competition, there is an element of synergy where the consumer may reserve tickets for the opponent's events through a ticket reservation provider. This points to the possibility that the consumer may be exposed to both marks during the purchasing process of the opponent's services. This will create some similarity, but I would put it no higher than low.


Comparison of marks

69) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

70) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take account of the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

71) The respective marks are:

Opponent's mark	Applicant's mark
THE ULTIMATE FIGHTER	

72) The opponent's mark consists of the three words "THE", "ULTIMATE" and "FIGHTER" that combine to create a term that will be perceived as referring to the best individual at fighting. As submitted by the applicant, its distinctive character resides in the interaction between the three words. The applicant's mark consists of a device positioned at the top of the mark, with the words "ULTIMATE" and "BOXXER" positioned one below the other underneath the device. Taking account of the size and position of these elements, the device shares equal dominance with the words "ULTIMATE BOXXER". Despite the misspelling, as the opponent submits, the second word combines with the first word to create a phrase that will be understood as a reference to the best boxer.

73) Visually, the marks coincide in that they share the word ULTIMATE. However, in other respects the marks are different. The word "FIGHTER", present in the opponent's mark, is absent in the applicant's mark and the device and the word "BOXXER", present in the applicant's mark, are absent in the opponent's mark. I conclude that they share somewhere between a low and medium level of visual similarity.

74) Aurally, the opponent's mark consists of six syllables THE-UL-TEE-MATE-FIGHTER. As the opponent points out, the device element is not likely to be referred to in the applicant's mark. It consists of the five syllables UL-TEE-MATE-BOX-ER. Therefore, the marks share the three syllables UL-TEE-MATE but differ in that the other syllables are different. Taking account of these similarities and differences, I conclude that they share a medium level of aural similarity

75) Conceptually, it is helpful to understand the most relevant and normal meanings of the words "ultimate", "boxer" and "fighter":

Ultimate *adjective*

2 Being the best or most extreme example of its kind.

'the ultimate accolade'²³

Boxer *noun*

1 A person who takes part in boxing, especially for sport.²⁴

Fighter *noun*

1 A person or animal that fights.²⁵

76) In his witness statement, the applicant submits 'that the word "fighter" conveys to the generally public only a general impression namely "the use of physical force to defeat another person"'. The opponent submits that in addition to sports people crossing from one discipline to the other, MMA competitors are often referred to as "boxers"²⁶ and a selection of articles are provided²⁷. The most relevant are:

- a "top trainer" listing his "top five boxers in MMA" in an article dated 26 March 2012. It is not clear whether this article was targeted at the UK;

²³ <https://www.lexico.com/definition/ultimate>

²⁴ <https://www.lexico.com/definition/boxer>

²⁵ <https://www.lexico.com/definition/fighter>

²⁶ Mr Epstein's witness statement, para 18

²⁷ Exhibit HC43

- an article dated 2 August 2011 discussing whether a particular competitor was “the Best Boxer in MMA?”. Once again it is not clear what geographical area was targeted by the article;
- an article dated 13 June 2019 discusses an MMA competitor who has returned to boxing. Again, the geographical target of the article is unknown;

77) These articles originate from either some 6 or 7 years before the relevant date (the filing date of the contested application, namely, 16 February 2018) or over a year after. This, combined with the lack of clarity as to whether these articles influenced the perceptions of the UK consumer, means that collectively they have little impact in demonstrating that, at the relevant date, the UK consumer was aware that MMA fighters are also called “boxers”.

78) Secondly, the opponent submits that boxers are also referred to as “fighters” and a selection of articles are provided²⁸ to support this. The most relevant of these are:

- an article dated 23 December 2016, published on the website metro.co.uk talks about various boxers and naming “our fighter of the year”;
- an article of unknown origin discussing a “journeyman” boxer at a boxing bout in Brighton. It is dated 8 December 2016 and makes a number of references to the individual being a “fighter” and his opponent as a “local fighter”;
- an article dated 17 July 2017, from the talkSPORT website referring to a boxer as “a fighter”;
- a BBC Sport article merely dated “15 Sept” with a title that includes the words “Bloodied British fighter takes points victory...”;
- an Evening Standard article with the date 19 July 2019 with a title including the words “Heavyweight boxing rankings: Top 10 ... fighters and world champions”;

79) These indicate to me that the words “boxer” and “fighter” are used interchangeably in the UK to describe a contestant in the sport of boxing. Such an

²⁸ At Exhibit HC44

indication is consistent with my own experiences as an ordinary UK consumer of sports entertainment (but not specifically boxing or MMA).

80) As I have already noted, the opponent has submitted that despite the misspelling of the “BOXXER” element of its mark, it will still be perceived as a reference to a “boxer”. I agree. It is not obvious to me that the misspelling will be immediately apparent to the consumer, but even where it is, it is not sufficient to dispel the concept of a “boxer”.

81) Keeping all of this in mind, the words “THE ULTIMATE FIGHTER” and “ULTIMATE BOXXER” are likely to be perceived as having very similar concepts and possibly even the same concept in circumstances where the consumer is familiar with boxers being described as “fighters”. The applicant submitted that the word ULTIMATE will be perceived by the average consumer as having the descriptive meaning identified in the dictionary. I agree, it is a readily understood word. I keep in mind that the device element present in the applicant’s mark does nothing to counteract this conceptual identity. With all of this in mind I find that the respective marks are conceptually very similar and, in some circumstances identical.

Average consumer and the purchasing act

82) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

83) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

84) The average consumer of the respective services is likely to be the section of the general public with an interest in sporting and other live events. The purchasing process is likely to be primarily visual in nature with the consumer purchasing tickets from the venue or, as increasingly so, via an online ticket provider. Tickets may also be sourced by telephone and, because of this, I keep in mind that aural considerations may play a part. Attendance at such events, whilst not an everyday occurrence, may be reasonably regular and the level of care and attention is likely to be average, being not particularly low, not particularly high.

Distinctive character of the earlier trade marks

85) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

86) The opponent’s mark consists of the words THE ULTIMATE FIGHTER. The services of the registration include television shows with the purpose of finding the best MMA competitor i.e. the best fighter. In light of the meaning of the separate words, discussed earlier, in respect of such services, the mark is endowed with only a low level of inherent distinctive character.

87) The opponent claims that its marks have been used on an extensive scale in the UK. I must assess whether the evidence of use supports this and what impact the use shown has upon the distinctive character of its THE ULTIMATE FIGHTER mark. The evidence illustrates that between July 2015 and December 2017, 44 episodes of a reality show bearing the name aired in the UK. Four episodes had less than 1000 viewers and the maximum for any one episode in each of the six series was 35,000, 66,000, 21,000, 33,000, 28,000 and 19,000 respectively. When this scale of use is considered in the context of the popularity of UK’s television sport and reality shows, such use does not demonstrate that the opponent’s mark benefits from any enhanced level of distinctive character. If I am wrong, the use shown will not have a material impact upon the mark’s distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

88) The following principles are obtained from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

89) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

90) In respect of my considerations in the current case, I have found that:

- The applicant's Class 25 share no similarity with the opponent's goods and services;
- Its Class 41 services are either identical or variously share a low, medium or higher level of similarity to the opponent's services;
- The dominant and distinctive element of the opponent's mark is the term THE ULTIMATE FIGHTER in its totality. In the applicant's mark the ULTIMATE BOXXER element shares equal dominance with the device element;
- The parties' marks are both likely to be perceived as references to the best competitor in a combative sporting activity. I have found that boxers are sometimes referred to as "fighters" and that the conceptual identity of these words overlaps;

- The respective marks share a low to medium level of visual similarity, a medium level of aural similarity and a high level of conceptual similarity, or even conceptual identity;
- The average consumer of the respective services is the general members of the public who have an interest in sporting and other live events. They are likely to take an average degree of care during the purchasing act. The purchasing process is likely to be visual in nature, but I recognised that aural considerations may play a part;
- The opponent's mark has a low level of inherent distinctive character and this is not enhanced through use, but if it is, it is only to a level that will have no material impact on my findings.

91) Where the opponent has failed to establish that the respective goods or services share any similarity, its opposition under section 5(2)(b) must fail because it was established in *Waterford Wedgwood*²⁹ and *eSure Insurance*³⁰ that some similarity must be present for a finding of likelihood of confusion. Therefore, this ground fails in respect of the applicant's Class 25 goods.

92) In respect of the applicant's Class 41 services, some of these factors, such as the low level of distinctive character of the opponent's mark, point to a finding of no likelihood of confusion. However, I must consider the impact of all the factors considered above.

93) Additionally, the opponent submits that because of its use of its marks ULTIMATE FIGHTING CHAMPIONSHIP, ULTIMATE FIGHTING and THE ULTIMATE FIGHTER, it has a family of "ULTIMATE" marks and the applicant's mark will be perceived by the average consumer as another of the opponent's marks and will, therefore, result in a likelihood of confusion. I am unconvinced by this submission. Firstly, there is no evidence that it uses ULTIMATE FIGHTING other than as part of the mark ULTIMATE FIGHTING CHAMPIONSHIP. Therefore, it does not form a separate part of any family of marks. Secondly, the opponent's marks that have been used both consist of a

²⁹ *Waterford Wedgwood plc v OHIM* – C-398/07 P

³⁰ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para. 49

combination of words that form a unit with the result that the word “ULTIMATE” does not have its own individual distinctive character within the mark. In the first of these marks, the three words combine to create the message of the best championship involving the activity of fighting. The second mark creates the message of the highest quality fighting, and the third creates the message of the best individual fighter. Consequently, I find that the opponent does not have a family of “ULTIMATE” marks.

94) The applicant submits that there is a clear distinction between MMA and boxing and its cage fighting events. This may or may not be the case, but such a distinction is not relevant here because neither sport is identified in the respective specification of services. The broad wording of both parties’ specifications cover boxing, MMA as well as other sports. It is necessary to consider the opponent’s mark to have been used in relation to all the goods/services covered by the registered specification or, if a new specification has been arrived at as a result of a challenge to the use of the earlier mark, that specification³¹. Further, I have found that boxers are also referred to as “fighters”. This creates a conceptual similarity between the marks that goes beyond the conceptual similarity that would otherwise still exist between a “boxer” and a “fighter”. In addition, the average consumer may not notice the misspelling of the word “boxer”, but even if the misspelling is noticed, it would not dilute the overriding impression that the misspelt word is still referring to a “boxer”.

95) The opponent submits that there is a likelihood of direct confusion. I do not agree. The device element present in the applicant’s mark shares equal dominance to the ULTIMATE BOXXER element and is not likely to go unnoticed. As a result, even taking account of imperfect recollection, the average consumer will be likely readily to differentiate the marks. Therefore, I find that there is no likelihood of direct confusion, where one mark is confused with the other. However, this is not the end of the matter, as I must also consider if there exists a likelihood of indirect confusion.

96) In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

³¹ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, para 78

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

97) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

98) In light of the comments of Mr Mellor in *Duebros*, and my finding that the word “ULTIMATE” does not have an independent distinctive role in either party’s mark, the mere coincidence of this word in both marks is insufficient to find indirect confusion. However, I have found that the last word in each mark (“FIGHTER”/“BOXXER”) when combined with the word “ULTIMATE” creates a conceptual identity that overlaps and may even be perceived as identical. This strong conceptual link is likely to lead the consumer to believe that the services provided under the respective marks originate from the same or linked undertaking. The addition of the word “THE” at the start of the opponent’s mark and the misspelling of the word “boxer” do not dispel this. Finally, the presence of the device in the applicant’s mark is also insufficient to dispel such a perception.

99) In summary, based on the meaning and usage of the words “fighter” and “boxer”, they create a similar and overlapping concept in the minds of the consumer that, when combined with the other words present in the marks, lead to a likelihood of

indirect confusion in respect of the applicant's Class 41 services that share a medium or higher level of similarity, i.e. *Arranging and operating live entertainment events; arranging and operating live sporting competitions and events; arranging and operating entertainments and sports events; sports entertainment services; sporting event organisation; entertainment services; ...; information, advisory and consultancy services relating to the aforesaid services*. The difference between the opponent's goods and services and applicant's *ticket reservation services in this class* and its *information, advisory and consultancy services* relating to the same is sufficient for there to be no likelihood of confusion.

100) The opponent also relies upon its mark ULTIMATE FIGHTING CHAMPIONSHIP. I have not discussed the opponent's case based upon this mark because it is visually, aurally and conceptually more distant from the applicant's mark than is its THE ULTIMATE FIGHTER mark. Whilst keeping in mind the closeness of the respective services and that this appears to be the primary mark of the opponent, I would conclude that the differences between the respective marks and the low level of distinctive character of both marks is sufficient for there to be no likelihood of direct or indirect confusion. Consequently, reliance upon this mark would not improve the outcome for the opponent.

Section 5(4)(a)

101) Section 5(4)(a) states:

“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.”

102) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

103) The opponent relies upon its unregistered signs that correspond to its registered marks and, in addition, the sign ULTIMATE. As I have already commented, the word ULTIMATE does not have its own independent distinctive character within the opponent’s marks and there is no evidence that it is used alone. Consequently, I find that the opponent’s goodwill is not identified by the sign ULTIMATE. The same applies to the sign ULTIMATE FIGHTING.

104) I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that this is the case here. I accept that the opponent has the requisite goodwill in respect of organising and

offering MMA events for entertainment and provided under the sign ULTIMATE FIGHTING CHAMPIONSHIP and a reality show about MMA fighters under the sign THE ULTIMATE FIGHTER.

105) The opponent claims that its goodwill extends to clothing, merchandising and sporting goods and equipment. This is not made out in the evidence. Therefore, in respect of the applicant's Class 25 goods, whilst I recognise that the parties need not be operating in the same field of activity it is, nevertheless, an important and highly relevant factor³². The opponent's goodwill insofar as it extends to its reality show is relatively modest, and it is not sufficient to lead to confusion of the common customers of the opponent's services and the applicant's *ticket reservation services in this class* and its Class 25 goods.

106) In respect of the opponent's reliance upon its ULTIMATE FIGHTING CHAMPIONSHIP sign, this is attached to the opponent's goodwill in the field of organising MMA events and its goodwill in respect of such services is greater, but this is offset by the greater differences between the marks (as discussed under section 5(2)(b)).

107) The opponent also submits that misrepresentation will occur because the parties both using the word ULTIMATE and that this will occur especially amongst fans of both MMA and boxing. I have already found that the word ULTIMATE does not have an independent distinctive character within the parties' marks. I find that this, combined with the low level of distinctiveness, is not likely to result in misrepresentation.

108) In conclusion, reliance upon its goodwill does not extend the opponent's success in this opposition beyond the success under section 5(2)(b). Whilst there is no requirement, under section 5(4)(a), for the parties to be in the same field of activity, the distance between the parties' goods and services is a decisive factor when considered together with the extent of goodwill and the level of similarity between the respective marks.

³² *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

109) In summary, the ground based upon section 5(4)(a) is successful to the same extent as the ground based upon section 5(2)(b).

Section 5(3)

110) Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

111) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any

financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

112) In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

113) The requisite reputation of an EUTM requires that the opponent's mark is known by a significant part of the public concerned by the products or services

covered by that mark in a substantial part of the territory of the Community³³. I have found earlier that the opponent's THE ULTIMATE FIGHTER mark has been genuinely used in the EU by virtue of its use in the UK. However, the test for the requisite reputation is a higher hurdle and one that the opponent does not meet. The use shown does not allow me to conclude that this mark is known by "a significant part of the public concerned", in this case the sports entertainment consuming public in the EU. Forty-four episodes of a reality show bearing the mark were broadcast over the period July 2015 to December 2017. Some of these were in the early hours and attracting less than 1000 viewers. The highest recorded viewing figure was 66,000. I would describe these viewing figures as being very modest and insufficient to generate the requisite reputation. I acknowledge that there was some additional evidence regarding broadcasts on Sky and ESPN, but this evidence was undated. In the absence of further information, this fails to enhance the evidence of the broadcasts on BT pay-per-view television

114) In respect of the opponent's ULTIMATE FIGHTING CHAMPIONSHIP, this is its primary mark as reflected in its evidence and, for the sake of procedural economy, I will proceed on an assumption that it has the requisite reputation in respect of its Class 41 services of its UK registration 2447594 and its EUTM 11277118.

The Link

115) My assessment of whether the public will make the required mental 'link' between the applicant's mark and the opponent's ULTIMATE FIGHTING CHAMPIONSHIP mark must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

Visually and aurally, the respective marks coincide because of the common occurrence of the word ULTIMATE. There are no other visual or aural similarities but significant differences. Conceptually, the opponent's mark is

³³ *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, para 30

likely to be perceived as indicating the best championship for contestants involved in fighting each other. The applicant's mark is likely to be perceived as indicating the best boxer. These concepts share some low conceptual similarity, but I would not put it higher than that. Whilst a boxer may participate in an MMA event, there is nothing before me that suggests that boxing matches are referred to as "fighting championships" even if boxers are sometimes referred to as "fighters".

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

The opponent's services for which I assume it has the requisite reputation are various services relating to MMA in Class 41 (there is nothing before me to suggest that its reputation relates to any other services). The applicant's goods and services that survive the section 5(2)(b) and section 5(4)(a) grounds are (i) clothing, footwear and headgear in Class 25 and (ii) *ticket reservation services in this class and information, advisory and consultancy services* relating to the same in Class 41. In respect of the applicant's Class 25 goods, there is no obvious closeness even where the applicant's goods are sports clothing. Such goods and services are different in nature, purpose, methods of use and they are not in competition nor are they complementary. In respect of the applicant's *ticket reservation services in this class and information, advisory and consultancy services* relating to the same in Class 41, I found some similarity, but this is no more than at low level.

The strength of the earlier mark's reputation

I proceed on an assumption that the opponent's mark benefits from a reasonably strong reputation in the UK;

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

The opponent's mark is of low inherent distinctive character because it indicates that the services relate to the best championship for identifying the champion fighter, but its registration is *prima facie* evidence that it has sufficient distinctive character for registration. I proceed on the basis that it benefits from an enhanced level of distinctive character because of the use made of it elevating its distinctive character to, at best, medium.

116) Taking account of all of this, I find that even proceeding on the assumption that the opponent's mark benefits from a reasonably strong reputation in the UK, the differences between the marks is not likely to lead to the link being established, or where it is, it will only be very weak. As a result, there is no link, or it is insufficiently strong to result in any detriment or unfair advantage, and this ground of opposition fails in respect of the applicant's Class 25 goods, its *ticket reservation services in this class* and *information, advisory and consultancy services* relating to the same in Class 41.

117) The finding regarding the remainder of the applicant's Class 41 services is much more finely balanced. However, it is clear to me that even if the link is established in respect of these services, it would not improve upon the scope of success the opponent has achieved under section 5(2)(b).

118) The opponent cites other of its marks such as ULTIMATE INSIDER, ULTIMATE KNOCKOUTS and ULTIMATE FAN EXPERIENCE to support its view that the existence of a link is strengthened by the existence of this enlarged family of marks. I dismiss the line of argument. These three additional marks have not been relied upon as "earlier marks" under section 6 of the Act and, therefore, cannot be relied upon for the purposes of the section 5(3) grounds. Further, I have already considered the "family of marks" argument and dismissed it. The same reasons would apply here.

119) The opponent also relies on the decision of the EUIPO Board of Appeal³⁴ where the mark *Red Dog* (figurative) was found to create a link to the mark *RED BULL*. The considerations in that case are different to here where I am considering the opponent's case based upon its mark *ULTIMATE FIGHTING CHAMPIONSHIP*. As I have already discussed, this mark has the concept of a "championship" that is additional to the concept present in the applicant's mark. The impact of this is to create a concept that is further removed from the concept of the applicant's mark and, therefore, my considerations are not on "all-fours" with the *Red Dog* decision.

Summary

120) The opposition succeeds against the following of the applicant's Class 41 services:

Arranging and operating live entertainment events; arranging and operating live sporting competitions and events; arranging and operating entertainments and sports events; sports entertainment services; sporting event organisation; entertainment services; ...; information, advisory and consultancy services relating to the aforesaid services.

but fails against *ticket reservation services in this class and information, advisory and consultancy services* relating to the same in Class 41 and all of the applicant's Class 25 goods.

³⁴ Decision R 70/2009-1

COSTS

121) The parties have achieved a reasonably equal level of success in these proceedings and, consequently, I decline to make an award of costs and order each party should bear their own costs.

Dated this 26th day of February 2020

Mark Bryant
For the Registrar,
The Comptroller-General