

O-549-15

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3061589
BY SPORTS TOURS INTERNATIONAL LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS**



**& APPLICATION No. 3061585
BY SPORTS TOURS INTERNATIONAL LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS
WALK 2 WALK
Walk 2 Walk**

BOTH IN CLASS 39 & 43

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER Nos. 403120 & 403121
BY WALK THE WALK WORLDWIDE**

BACKGROUND

1) On 26 June 2014 Sports Tours International Limited (hereinafter the applicant), applied to register the four trade marks shown above. The goods applied for were identical in each application and were as follows:

Class 39: Arrangement of travel; transportation services; travel agency services; providing travel information; reservation of transport tickets; transport of persons; organizing group travel and holiday trips; rental of vehicles; services of a tour operator, namely the transport of travellers; arranging for travel visas, passports and travel documents for persons travelling abroad; gathering, collating and providing information about all aforementioned services.

Class 41: *Education; provision of training; entertainment; sporting and cultural activities; educational and training services relating to health and fitness; organisation of sporting and cultural activities and events.* (withdrawn: see paragraph 4 below).

Class 43: Provision of temporary accommodation; provision of food and drink; intermediary services in the field of the rental of hotel rooms; services of a hotel, restaurant and café not included in other classes; reservation of temporary accommodation and intermediary services related thereto; gathering, collating and providing information about all aforementioned services.

2) The applications were examined and accepted, and subsequently published for opposition purposes on 25 July 2014 in Trade Marks Journal No. 2014/031.

3) On 24 October 2014 Walk the Walk Worldwide (hereinafter the opponent) filed a notices of opposition in respect of the two applications. The grounds of the oppositions are identical, and are in summary:

a) The opponent is the proprietor of the following trade marks which are registered for a range of goods and services, only some of which are relied upon in the opposition:

Mark	Number	Date of filing / Registration	Class	Goods /services relied upon:
Walk the Walk	UK 2390892	30.04.05 13.10.06	9	Photographic, cinematographic and optical representations and equipment; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; audio tapes; recording discs; sound recordings; video recordings; computer discs; recording discs for visual images and sound; computers; downloadable electronic publications; downloadable website pages; glasses; sunglasses; cameras; parts and fittings for all of the aforesaid goods.
			14	Jewellery; lapel pins made from precious

				metals and/or their alloys or coated with precious metals and/or their alloys; ornamental pins; badges; brooches; pendants; horological and chronometric apparatus and instruments; watches; clocks; stopwatches; key rings; key fobs; cufflinks; tie clips; tiepins; medals; parts and fittings for all of the aforesaid goods.
			16	Books; newsletters; printed matter; journals; business cards; stationery; diaries; printed website pages; instructional and teaching material; Christmas cards; training materials including overhead projection transparencies; paper cardboard and goods made from these materials; printed publications; leaflets; booklets; brochures; magazines; sponsor forms; application forms; posters; cards; postcards; banners; advertisement boards; flags; certificates; photographs; calendars; office requirements; pens; pencils; boxes for pens and pencils; maps; stickers; carrier bags.
			18	Leather goods
			25	Clothing; footwear; and headgear.
			26	Lapel pins made from all materials excluding precious metals and their alloys.
			28	Sporting articles not included in other classes.
			35	Advertising; and business administration.
			36	Financial affairs; charitable fundraising; financial sponsorship; charitable collections; organisation of collections; organisation of fundraising activities and events; organisation of fundraising walks and marathons.
			41	Education; provision of training; entertainment; sporting and cultural activities; educational and training services relating to health and fitness; organisation of sporting and cultural activities and events.
			42	Scientific research.
			44	Medical services
			45	The provision of personal and social services rendered by others to meet the needs of persons with cancer or other illnesses by providing and assisting in the provision of information, care, emotional support and practical help for such

				persons and by providing and assisting in the provision of advice and other assistance for the families and carers of such persons.
Walk the Walk	CTM 5597471	04.01.07 15.02.08	9	Photographic, cinematographic and optical representations and equipment; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; audio tapes; recording discs; sound recordings; video recordings; computer discs; recording discs for visual images and sound; computers; downloadable electronic publications; downloadable website pages; glasses; sunglasses; cameras; parts and fittings for all of the aforesaid goods.
			14	Jewellery; lapel pins made from precious metals and/or their alloys or coated with precious metals and/or their alloys; ornamental pins; badges; brooches; pendants; horological and chronometric apparatus and instruments; watches; clocks; stopwatches; key rings; key fobs; cufflinks; tie clips; tiepins; medals; lapel pins; parts and fittings for all of the aforesaid goods.
			16	Books; newsletters; printed matter; journals; business cards; stationery; diaries; printed website pages; instructional and teaching material; Christmas cards; training materials including overhead projection transparencies; paper cardboard and goods made from these materials; printed publications; leaflets; booklets; brochures; magazines; sponsor forms; application forms; posters; cards; postcards; banners; advertisement boards; flags; certificates; photographs; calendars; office requirements; pens; pencils; boxes for pens and pencils; maps; stickers; carrier bags.
			18	Leather goods.
			25	Clothing, footwear, headgear.
			28	Sporting articles not included in other classes.
			35	Advertising; and business administration.
			36	Financial affairs; charitable fundraising; financial sponsorship; charitable collections; organisation of collections; organisation of fundraising activities and

				events; organisation of fundraising walks and marathons.
			41	Education; provision of training; entertainment; sporting and cultural activities; educational and training services relating to health and fitness; organisation of sporting and cultural activities and events.
			42	Scientific research.
			44	Medical services.
			45	The provision of personal and social services rendered by others to meet the needs of persons with cancer or other illnesses by providing and assisting in the provision of information, care, emotional support and practical help for such persons and by providing and assisting in the provision of advice and other assistance for the families and carers of such persons.

- b) The opponent relies upon both its earlier marks in respect of the section 5(2)(b) grounds. The opponent contends that the class 41 services covered by its marks are similar to the class 41 services applied for and that the marks of the two parties are similar which will lead to a likelihood of confusion.
- c) The opponent relies upon both the above marks and all the goods and services for which they are registered, and contends that the marks in suit offend against Section 5(3). The opponent states that it is a well known charity which organises events to raise funds for charitable purposes and that many of the events are walks. It states it has raised almost £100 million and includes events such as the “Moonwalk” which attracts 17,000 entrants in London each year. The opponent organises fund raising walking events under the “Walk the Walk” mark worldwide and provides travel, accommodation and food as part of these overseas trips. Because of the similarity of the marks and services the average consumer will assume that there is a link between the two parties.
- d) The opponent has used its marks in the UK since January 1998. It states that it has used its marks upon the following (which happen to be identical to the services for which the application is sought to be registered):

Arrangement of travel; transportation services; travel agency services; providing travel information; reservation of transport tickets; transport of persons; organizing group travel and holiday trips; rental of vehicles; services of a tour operator, namely the transport of travellers; arranging for travel visas, passports and travel documents for persons travelling abroad; gathering, collating and providing information about all aforementioned services. Provision of temporary accommodation; provision of food and drink; intermediary services in the field of the

rental of hotel rooms; services of a hotel, restaurant and café not included in other classes; reservation of temporary accommodation and intermediary services related thereto; gathering, collating and providing information about all aforementioned services.

e) The opponent contends that the services and marks of the two parties are similar/identical such that misrepresentation will occur with supporters / customers of the opponent believing that in using the services of the applicant they are supporting the opponent. This would damage the opponent as funds would not be received. The marks in suit therefore offend against section 5(4)(a).

4) On 29 December 2014 the applicant filed counterstatements. These put the opponent to strict proof of use of its trade marks, whilst also contending that there is no likelihood of confusion due to the differences in the marks and the goods and services. On the same date the applicant also filed an amendment to its application deleting the whole of class 41 from the application in an effort to resolve the opposition. As a result the opponent contends that the 5(2)(b) opposition which was solely in relation to these services is no longer relevant.

5) Both sides filed evidence. Both seek an award of costs in their favour. The matter came to be heard on 14 September 2015 when the opponent was represented by Miss Michaels of Counsel instructed by Messrs McCarty Denning Limited; the applicant was represented by Mr St Quintin of Counsel instructed by Messrs Brabners LLP.

OPPONENT'S EVIDENCE

6) The opponent filed four witness statements. The first, dated 9 March 2015, is by Nina Lizzette Barough Aubertin the Founder, Trustee and Chief Executive of the opponent. I take the following from her statement and exhibits:

- Ms Aubertin started her fundraising in 1996 as an individual and because of the success of her activities she decided to register as a charity. The charity was formed in 1999 after the success of a series of fund raising walks meant that a proper organisation was required to cope with the number of participants. The money raised is used for breast cancer causes. The opponent has funded scientific research, provided medical equipment, assisted in the delivery of treatments and personal care to aid those undergoing cancer treatment.
- Each year since 1999 the annual "MOONWALK" has taken place in London the night prior to the London marathon. Since 2007 there have been 17,000 participants each year, a number which is capped to maintain the personal feel. In addition the opponent has organised participation in Moonwalks in Scotland, Iceland and New York, Sun-walks in Bristol, London, Newcastle and Southampton and also the Arctic marathon and Peru challenge. The overseas events are on a smaller scale and designed to be a challenge to the participants.

- Annual income during the period 2010 – 2014 inclusive in relation to the mark WALK THE WALK has been approximately £9.5 million per annum. The opponent promotes the charity at events using visual, aural and printed media; it provides medals, maps, sponsor forms and training tips to participants and sells items such as wristbands, lapel pins, physical training manuals, Christmas cards, sports equipment, clothing, footwear and headgear to supporters. All these items have the mark WALK THE WALK upon them. The opponent seeks corporate sponsorship as well as individual donations and collections. The approximate figures for these items are as follows:

Item	First use	Sales during 2009-2013 unless otherwise stated
Wristbands	1998	Since inception £100,000
Lapel pins	1998	£60,000
Clothing	2001	£317,470
Headgear	2001	£11,305
Training manuals	1996	£3,732
Christmas cards	1996	£6,590
Sports equipment	2005	£150,000

- In addition to organising events and participation in events (both in the UK and overseas), the opponent provides training advice to all who are considering participating. The opponent has also assisted those who wished to participate in the New York marathon that raises funds for the opponent. The New York marathon is organised by the New York Road Runners (NYRR) a charity registered in the USA. Entries are tightly controlled and overseas entries are only permitted through appointed agents. In the UK the only two agents authorised to sell places on the marathon are 2:09 Events Ltd and the applicant.
- Between 1996 and 1999 the applicant sold places on the New York Marathon to the opponent's predecessor as well as arranging accommodation and travel for the participants. From 2000 the opponent arranged entry to various other events and used different travel companies to supply flights and hotels. The applicant did not have any involvement with these services, other than for the New York Marathon. For this, the applicant, following discussions with the opponent, booked hotel rooms and flights, which the opponent then advertised to its supporters. The supporters booked the accommodation and flights from the selection offered by the opponent. It is acknowledged that prior to 2001 communications were sent to the entrants by the applicant. As the style of these communications was deemed unhelpful, it was agreed that the applicant would not have any further direct contact with participants. Shortly after 2001 the opponent's website was developed and all bookings were made via the opponent's website.
- Charities are not permitted to engage directly in primary purpose trading and so a trading subsidiary was set up (Walk the Walk in Action Ltd (hereinafter Action). Action is responsible for organising all of the opponent's events, as well as providing travel and accommodation to participants. Action acts as the middle man between

the participants and travel agents and event agents. ABTA and ATOL bonds are provided by the travel agents not Action.

- The participant numbers in Walk The Walk events are as follows:

Event	2010	2011	2012	2013	2014	Total
Artic Marathon	0	0	0	11	23	34
Celebrity Sunwalk	772	0	0	0	0	772
Moonwalk Iceland	0	41	40	37	60	178
Moonwalk London	17,533	17,822	17,604	17,837	17,801	88,597
Moonwalk Scotland	10,180	8,343	6,851	4,038	4,329	33,741
Inca trail Peru	17	0	0	9	24	50
Sun Walk Bristol	1,265	0	0	0	0	1,265
Sun Walk London	0	2,105	1,780	915	665	5,465
Sun Walk Newcastle	724	0	0	0	0	724
Three Land Challenge	0	0	46	62	30	138

- The participant numbers for third party events such as the New York Marathon, Berlin Marathon, etc average out at 166 persons per annum.

7) The second witness statement, dated 9 March 2015, is by Laura Pincus a supporter of Walk the Walk (WTW) living in the UK. She describes how she has taken part in the London Moonwalk and also New York marathons to raise money for WTW. She booked her place on the New York marathons using the WTW website. WTW use agents to arrange places on the marathon and also to book accommodation. The accommodation was guaranteed by the agent not WTW, but Ms Pincus states that she regarded WTW as providing her with travel services as all communications were received from WTW. Having informed WTW of her accommodation requirements and dates the necessary services were booked. On one occasion she had to change dates and informed WTW of the change required. The fee for making the change was paid to WTW and again no other organisation was in contact with her. She is aware that the agent used by WTW was the applicant, but since 2014 has been 2:09 Events Ltd. She provides copies of emails between herself and WTW organising the trip to New York and entry into the marathon. Also included are correspondence from the applicant and also 2:09 Events Ltd providing details of the event and accommodation. She describes how WTW had people on the ground in New York to act as liaison officers which was particularly relevant at the 2012 event which was cancelled due to Super-storm Sandy, shortly after she had arrived in New York.

8) The third witness statement, dated 8 March 2015, is by Sally Shaw a supporter of WTW based in the UK. She also describes taking part in the London Moonwalk and also the New York marathon. She also describes booking her place in the marathon, accommodation etc via the WTW website. She states that she was aware that a travel company was providing support behind the scenes but considered that she was dealing with WTW to arrange everything. She believed that doing it this way enabled WTW to keep down its staff costs and hence more of the money raised went to charitable works. She also describes officers of WTW being at the New York event to ensure participants were alright and these were

particularly needed in 2012 when the event was cancelled after she had arrived in New York. Ms Shaw states that in her view the travel and accommodation were organised by WTW.

9) The fourth Witness statement, dated 8 March 2015, is by Jo O'Connor who lives in the UK and is a supporter of WTW. Her experience is similar to Ms Shaw and Ms Pincus in that she took part in the London Moonwalk and various other events around the world including the New York marathon. She describes booking all her travel via the WTW website and regarding WTW as having provided these services. She describes how on each event she was accompanied by a team from WTW and she does not recall meeting representatives from any other company. She states that she believes that all payments were made to WTW and she does not recall any involvement of any other organisation. She states that subsequent to being asked to provide a statement she has discovered that the travel arrangements are made by the applicant, but as it was done on behalf of WTW she would assume any travel services offered in the name WTW or even Walk 2 Walk would be by the charity.

APPLICANT'S EVIDENCE

10) The applicant filed a witness statement, dated 9 June 2015, by Colin Bell the applicant's Trade Mark Attorney. He provides the following exhibits:

- CB1: Print outs from the applicant's website (walk2walkholidays.com) which are said to show that the applicant's services are entirely related to walking holidays. The print outs are dated 2015 and show the applicant offering walking holidays worldwide. Included in the services offered are hotel accommodation, local support, luggage transfer maps and routes.
- CB2: Details of trade marks incorporating the word WALK in classes 36 and 41, or starting with the word WALK in classes 39 and 43 unconnected with either party in the instant case. These include marks such as, inter alia, Walker Texas Ranger / Walkabout Inn / Walkopedia / Walker and Woodhouse. There is no detail as to whether the marks have been used or the extent of the use. As such it is state of the Register evidence and of little assistance.
- CB3: Internet printouts, dated June 2015, of parties unconnected with the opponent who use the word WALK in relation to charity events and walking holidays and activities. These include, inter alia, the British Walking Federation, Eat walk Edinburgh, Walkhighlands, walkcornwall, WalkLondon, Arlington Bluebell Walk and Farm Trail, Walk4life and Nordic Walking. The majority of these appear to be public information websites using the term WALK in a purely descriptive fashion.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

12) The ground of opposition based upon section 5(2)(b) of the Act which related solely to the class 41 services originally applied for is negated by the amendment to the specification filed by the applicant which deleted the whole of the class 41 specification.

13) In respect of the other grounds of opposition I will take into account the applicant's offer to restrict its specification by the addition of the words "but none of the aforesaid services being provided for charitable fundraising". I note that the opponent did not deem this sufficient to withdraw its opposition.

14) I first turn to consider the ground of opposition under Section 5(3) which reads:

"5-(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 3 the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) 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.

Proof of use

15) The opponent is relying upon its two trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant requested that the opponent provide proof of use and, given the interplay between the dates of both parties' marks, all of the opponent's marks are subject to proof of use. Section 6A of the Act states:

"6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

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

(b) there is an earlier trade mark 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 Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (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.
- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
 - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

16) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its marks has been made. In the instant case the publication date of application 3061589 was 25 July 2014, therefore the relevant period for the proof of use is 26 July 2009 – 25 July 2014. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires*

Goemar SA (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

17) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

18) Also in *Laboratoire de la Mer* Trade Mark [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

“31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in *Ansul* and *La Mer*, to the rather slender facts found by Dr Trott.”

32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of *consumers and end users* of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.

33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on

the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users.”

19) Whilst Neuberger L.J. (as he then was) stated:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

20) In considering whether the opponent has used its trade marks I shall not consider the opponent’s Community Trade Mark, but only its UK trade mark. This is because both sides drew my attention to the tension between the decisions in *Sofa Workshop v Sofaworks* [2015] EWHC 1773 and Case T-278/13 *Now Wireless Ltd v OHIM*. As the marks of both registrations are identical and have identical specifications (other than the UK registration has the following items in class 14: lapel pins; and in class 26: Lapel pins made from all materials excluding precious metals and their alloys), consideration of only the UK mark does not prejudice the opponent.

21) The applicant questioned the weight which should be attached to the opponent’s evidence. In respect of Mrs Aubertin’s evidence it contended:

“As an initial point it is well established that statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence partly due to the fact that the perception of the party involved in the dispute may be more or less affected by its personal interests in the matter (decision of 11/01/2011, R 0490/2010-4-BOTODERM. Para 34; decisions of

27/10/2009, B1086240 and of 31/08/2010, B1568610). Accordingly such a witness statement is generally considered to be of lower probative value by its very nature.”

22) The opponent contended:

“a. It is suggested that Mrs Barough Aubertin’s evidence is of low probative value as she is an officer of the Opponent. Reliance is placed on some OHIM decisions. However, those decisions do not reflect the approach of the UKIPO and UK courts, whose concern generally is whether a witness statement made by an interested party is supported by appropriate documentation. Here plainly Mrs Barough Aubertin’s evidence is well supported by the documents she exhibits, as well as by the evidence of the other witnesses. It is the Opponent’s case that there is no reason to exclude Mrs Barough Aubertin’s evidence and it is of course for the Hearing Officer to decide what conclusions may be drawn from it.”

23) I fully accept the opponent’s position. It is clear that the Registry and English Courts are content to rely upon the evidence of officers of a company. The weight given to the evidence depends upon the claims made and the corroboration offered in supporting documents. In the instant case the evidence of Mrs Aubertin was not challenged in evidence and no request was made to cross examine. I also note that the applicant has accepted much of her evidence as providing proof of use for a variety of goods and services.

24) The applicant also raised in its written submissions issues regarding the other witness statements of Jo O’Conner, Sally Shaw and Laura Pincus. The following points are made:

- i) No mention of these statements was made in the witness statement of Mrs Aubertin and so there is no explanation as to how they were selected. Nor is any information provided regarding the questions they were asked; whether any other witnesses were approached and what their responses were. It was questioned whether these were selected via a survey.
- ii) The applicant pointed out that out of 130,000 participants, 3 cannot be said to be representative, let alone be “the average consumer”.
- iii) It was suggested that a pre-prepared template had been used.
- iv) Little weight should be given to the comments on confusability made by these witnesses, as this is an issue for the hearing officer to decide. Also the fact that these witnesses are supporters of the opponent means that they are not impartial.
- v) That there is a significant self-contradiction with both the witness statement of Sally Shaw and Laura Pincus. Both Sally Shaw (at paragraph 2.6 and 3.1) and Laura Pincus (at paragraph 2.6, 2.7, 2.8, 2.13, 3.1) state that they were aware that WTW used an agent/travel company to organise travel aspects and that the travel

company was involved in the travel bond. Laura Pincus specifically notes she was aware WTW used Sports Tours International for accommodation and travel services (2.7) and that Sports Tours were involved in the travel services (2.8). However at the same time they are willing to state that the Opponent provided such services. This it is claimed is a fatal contradiction.

25) The opponent denied that it had carried out a survey to select witnesses. I accept that the views expressed cannot be regarded as the views of all consumers but they do offer an insight into how some supporters of the opponent may view the issues. I accept that they may be somewhat biased in favour of the opponent but do not accept that they would deliberately lie or deceive in a witness statement. I note that no request to cross examine was made. In my opinion the evidence is admissible although the weight I attach to the various parts of these statements may vary. An important factual point I take from these statements is that all three state that they booked accommodation via the WTW website.

26) The applicant also contended that:

“Nina Barough-Aubertin also confirms at paragraph 4.3 that the Opponent is not permitted to engage in trading. Nina Barough-Aubertin further states at 4.3 that "arranging fundraising events is considered to be trading and the Opponent conducts all of its trading activities through wholly owned trading companies which pass their profits to the Opponent under the Gift Aid scheme. The Opponent generally organises all fundraising activities through Walk the Walk in Action Limited (Action) and undertakes the sale of clothing through WalkWear Limited (WalkWear). The Opponent provides no evidence of any licence or other agreement between the Opponent and either or both Action and WalkWear respectively. Accordingly the Opponent has no use of the mark.”

27) Despite this assertion the applicant accepted in its written submissions and skeleton arguments that, regarding UK mark 2390892, the opponent has shown proof of use upon the following goods and services:

Class	Specification accepted
14	Wristbands [which fall within jewellery]; lapel pins; all of the aforesaid for charitable fundraising
16	Instructional and teaching material; training materials; Christmas cards; all of the aforesaid for charitable fundraising
25	Polo shirts; t-shirts; hooded sweatshirts; all of the aforesaid for charitable fundraising
28	Sports water bottle holders; sports holdalls; bumbands; wrist pockets; all of the aforesaid for charitable fundraising [snap bands are reflective materials for road safety and therefore only proper to class 9. There is no part of the registration within which they fall].
36	Charitable fundraising; charitable collections; organisation of collections; organisation of fundraising activities and events; organisation of fundraising walks and marathons.

41	Education, provision of training; sporting and cultural activities; educational and training services relating to health and fitness; organisation of sporting and cultural activities and events, all of the aforesaid for charitable fundraising.
42	Scientific research
44	Medical services
45	The provision of personal and social services rendered by others to meet the needs of persons with cancer or other illnesses by providing and assisting in the provision of information, care, emotional support and practical help for such persons and by providing and assisting in the provision of advice and other assistance for the families and carers of such persons.

27) To my mind, the applicant cannot have it both ways, either the opponent has used its mark or it has not. At the hearing Mr St.Quintin accepted that the opponent had used its UK mark upon the above and so I take this concession at face value. In any event, the requirement is for the mark to have been used with the consent of the proprietor. This does not require a formal licence. It is plain that the proprietor consented to the use. Indeed, the evidence is that it set up Action for the very purpose of trading under the mark. The applicant justified the inclusion of the limitation “all of the aforesaid for charitable fundraising” which appears a number of times in the above table as it contends that the use shown by the opponent is, similar in nature to that shown in the *Silberquelle* case referred to at paragraph 16(4b) above. The applicant contends:

“19. This principle is not, it is submitted, limited to free gifts, but also applies to other goods or services that are only made available to consumers as an adjunct to some other principal service provision. For example, British Gas does not make genuine use of a registered trade mark for stationery because envelopes containing gas bills bear that trade mark – no user of gas has made a conscious decision to acquire British Gas branded envelopes. Equally, in the context of this case, participants in the Opponent’s fundraising events do not make a conscious decision to acquire the goods or mementos provided for free as a result of their participation.”

28) The opponent countered that the words “all of the aforesaid for charitable fundraising” are not the appropriate sort of sub-categorisation which should be applied the light of Case T-126/03 *Reckitt Benckiser (“Aladin”)* because it is not a natural qualification that would be imposed on a subcategory of goods by the average consumer.

29) The opponent also referred me to the judgment of the Court of Appeal in *Maier v Asos* where “specialist clothing for cyclists” was deemed a category of clothing. I fully understand this judgment and respectfully agree with it. But to my mind it is not on all fours with the current case. It is relatively easy to name clothing which would be specialised for cyclists, but the same is not true of “charitable fundraising”. This is because the words “all of the aforesaid for charitable fundraising” does not describe the goods at all. It describes where the profits from the sale go, but that should be no part of a specification of goods.

30) I note that income figures for items such as clothing, headgear, wristbands etc have been provided (see paragraph 6 above). These are not particularly extensive in the overall UK market however they show that the items are purchased and not handed out free of charge. The principal issue is whether the proprietor has put the marks to genuine use. If there are sales figures then the use is commercial in nature. The fact that consumers know that the profits go to charity does not mean that the trade in goods is not a genuine commercial transaction. It is not comparable to free gifts to promote other products or the envelopes used to deliver British Gas's bills to its energy customers. No one buys those envelopes

31) Clearly the services in classes 36 and 41 are the most crucial to the success of the opponent under this ground of opposition. There is little difference between the concession given by the applicant and the services which the opponent has registered under its UK trade mark. In class 36 the applicant does not accept that the opponent has shown use on "Financial affairs; financial sponsorship." The opponent did not take issue with this omission and so I believe that the class 36 specification, for which use has been proven, must be regarded as:

"Charitable fundraising; charitable collections; organisation of collections; organisation of fundraising activities and events; organisation of fundraising walks and marathons."

32) The only differences between the opponent's class 41 specification and the use accepted by the applicant is the omission of the term "entertainment" which the opponent was not concerned about at the hearing and the addition of the words "all of the aforesaid for charitable fundraising" which the opponent contended was contrary to the accepted authorities. The opponent submitted:

"21. Moreover, Mrs Barough Aubertin's evidence shows the provision of travel and/or accommodation services by the Opponent under the WTW Marks in relation to the Opponent's fundraising walks/challenges. Some of these events include the provision of cultural activities as well as accommodation etc, see e.g. the details of the Inca Trail and Arctic Marathon trips. Although numbers of entrants have not been on the scale of the UK events, the income for entry fees/donations for the overseas events is substantial, see §8.6 and p 147 of NLB3. Moreover, participants in events are informed of the range of international events offered (see e.g. NLB76 at p 893, 78 at p 1102, 85 at p 1209, 93 at p 1362)."

33) I fully accept that many of the trips organised by the opponent include cultural and activities other than fundraising. For the reasons set out previously in this decision the words "all of the aforesaid for charitable fundraising" do not describe the services of organising the activities etc. Therefore, in my opinion the class 41 specification upon which use has been shown reads:

"Education, provision of training; sporting and cultural activities; educational and training services relating to health and fitness; organisation of sporting and cultural activities and event."

34) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 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; *Adidas 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*).

35) The onus is upon the opponent to prove that its earlier trade marks enjoy a reputation or public recognition and it needs to furnish the evidence to support this claim. The applicant accepted, at paragraph 42 of its skeleton, that the opponent has reputation in relation to its class 36 services but disputes that it has shown any reputation in relation to any other goods or services. Given that the applicant has accepted that the opponent has shown proof of use on a range of goods and services, in particular those in class 41, I find this position difficult to understand. The evidence of the opponent shows that whilst its activities, outside of fundraising are relatively modest in terms of turnover but, to my mind, the opponent has just about satisfied the General Motors reputation requirement in relation to the class 41 services and clearly meets the requirement in relation to the class 36 services.

36) Once the matter of reputation is settled any opponent must then show how the earlier trade mark would be affected by the registration of the later trade mark. In the instant case the opponent alleges only that the relevant form of damage arises from confusion as to origin due to claimed similarities between the marks and their goods and services. The applicant contended:

“29. The likelihood of confusion as to origin (including the likelihood of association) is ordinarily dealt with under s.5(2)(b). The Registry has developed a well-known summary of the principles to be applied when making the assessment of the likelihood of confusion under that section. Much the same considerations will apply when considering whether harm arises under s.5(3) as a result of this confusion as to origin: the characteristics of the average consumer are the same (see e.g. *Intel Corp Inc v CPM United Kingdom Ltd* (C-252/07) [2008] E.C.R. I-8823 at [60]) and so the structured approach to the assessment of the likelihood of confusion must be applicable. That summary of factors for the assessment of the likelihood of confusion under s.5(2)(b) will be quite familiar so it is also set out in an annex to this skeleton.”

AND:

“44. There is no similarity between the goods and services for which the earlier marks are registered and the services for which use has been proven: there is no commonality in uses, users, physical nature, or trade channels, and they are neither complementary nor competitive.

45. There is no reason for the average consumer even to consider that the Opponent's goods and services and the Applicant's services might come from the same or linked undertakings.

46. The marks themselves are clearly distinguishable from one another:


a. The earlier trade marks are visually distinct from the Word Marks applied for because of the difference in central element. The earlier trade marks are different from the Device Marks applied for because of the difference in the central element and because they lack all of the figurative details of the Device Marks.

b. The marks are aurally distinct because of the central element.

c. The marks have a clear conceptual difference: the earlier marks are a commonly used phrase to indicate or request that someone actually performs to a stated or desired standard, while the marks applied for have no such conceptual connotation, and instead allude to a detail of the types of holidays that the Applicant offers (that is, point-to-point walks).

47. When a global assessment is made, the differences in the goods and services, and the differences in the marks means that there is no risk of confusion."

37) For ease of reference the marks of the two parties are as follows:

Applicant's marks	Opponent's mark
3061585 WALK 2 WALK Walk 2 Walk	Walk the Walk
3061589 	

38) I shall first compare the applicant's 3061585 mark to that of the opponent. Although a series of two the only difference is that one is all in upper case whilst the other is a mix of upper and lower case. I do not consider this difference to be of any significance. Clearly, both have the word "walk" as the first and last word. Between these two words the applicant's mark has the number "2" whereas the opponent's mark has the word "the". Visually and aurally the marks have a medium to high degree of similarity. Conceptually, both marks convey the meaning of walking, particularly when used in relation to walking

activities. But the opponent's mark has a second meaning of someone being able to back up their talk with action. The marks have a medium degree of conceptual similarity. Overall, the marks have a medium to high degree of similarity.

39) Moving onto the applicant's 3061589 mark, this is again a series mark with the only difference being that one is in colour and the other in black and white. Again the difference is such that it is of no significance. The comparison of the word elements of the marks is as set out in the previous paragraph. Although the applicant's mark has a device element of two people walking, given the two words in the mark are both "walk" it is merely reinforcing the message that the mark relates to the activity of walking. The presence of the device element does affect the overall similarity of the marks of the two parties but only by a relatively minor amount. Overall, the marks are similar to a medium degree.

40) Although it is not necessary for the goods and services of the two parties to be similar under this ground of opposition it is a factor which I must take into account in determining whether the consumer will make a link between the marks of the two parties. The services of the two parties are:

Applicant's services	Opponent's services
<p>Class 39: Arrangement of travel; transportation services; travel agency services; providing travel information; reservation of transport tickets; transport of persons; organizing group travel and holiday trips; rental of vehicles; services of a tour operator, namely the transport of travellers; arranging for travel visas, passports and travel documents for persons travelling abroad; gathering, collating and providing information about all aforementioned services.</p>	<p>In Class 36: Charitable fundraising; charitable collections; organisation of collections; organisation of fundraising activities and events; organisation of fundraising walks and marathons.</p>
<p>Class 43: Provision of temporary accommodation; provision of food and drink; intermediary services in the field of the rental of hotel rooms; services of a hotel, restaurant and café not included in other classes; reservation of temporary accommodation and intermediary services related thereto; gathering, collating and providing information about all aforementioned services.</p>	<p>In Class 41: Education, provision of training; sporting and cultural activities; educational and training services relating to health and fitness; organisation of sporting and cultural activities and events.</p>

41) The evidence provided shows that in organising its fundraising walks and marathons the opponent arranges for transportation and accommodation albeit through a third party. Although the opponent's actual services as registered have little similarity to the applicant's services, it is clear that the provision of what can loosely be described as "travel agency services" are a natural extension of the opponent's services. Indeed the applicant until recently was the third party supplier of precisely the services that it now seeks to register to the participants on the fundraising walks and marathons of the opponent. In providing travel agency services, even through a third party, the charity makes it easier for its supporters to participate and so ensures that more take part thus providing additional funding for the

charity. When these travel agency services are provided under an entirely different mark it is clear to the consumers that the charity is merely acting as a conduit for these services to be provided.

42) Given the similarity of the marks it is my view that the average consumer would form a link between the marks and would believe that the opponent has forgone the use of third parties and started to provide such services as those which the applicant seeks to register. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there would be confusion as to the origin of the services. The likelihood of confusion means that the requirement for the link required by the case law is satisfied (paragraph 34 point c above). A likelihood of confusion means that the applicant stands to benefit from associating itself with the opponent's reputation for services in class 36 and 41. In any event, if there is confusion it will inevitably be detrimental to the distinctive character of the opponent's mark. **The opposition under Section 5(3) therefore succeeds.**

43) I now turn to the ground of opposition under section 5(4)(a) which reads:

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."

44) In deciding whether the marks in question offend against this section, I intend to adopt the guidance given by Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

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

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

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

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

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

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

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

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

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

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

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

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

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

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

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

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

46) The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP)

47) First I must determine the date at which the opponent’s claim is to be assessed; this is known as the material date. *In Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

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

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

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent’s goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from

that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

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

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

49) There is no evidence of use of the applicant's marks; I shall therefore regard the relevant date as 26 June 2014.

50) The applicant has maintained that the opponent has not provided any evidence of goodwill, despite accepting that the opponent had provided sufficient evidence to overcome the requirements of proof of use on goods and services across a range of classes (see paragraph 27 above) and also accepting that the opponent had reputation for its class 36 services. It is contended that because the opponent is a charity and is prevented from trading all such activities were undertaken by a subsidiary company and so all the goodwill belongs to the subsidiary known as Walk the Walk In Action Ltd.

51) The applicant contended:

“49. It is alleged that goodwill has been generated in the services listed at paragraph 6, above. [All the goods and services for which the marks are registered]

50. However, there is absolutely no mention of any trade that could give rise to a goodwill in the “arranging for travel visas, passports and travel documents for persons travelling abroad; rental of vehicles, provision of food and drink”, so those elements must be disregarded.

51. Further (notwithstanding the fact, as set out below, that it is not the Opponent but Action that has been involved in any potentially relevant activity), the suggestion that the Opponent has undertaken the provision of “*transportation services; transport of persons; provision of temporary accommodation;*” should be dismissed because it is clear from the evidence that those services have only ever been provided by third parties.

52. That leaves the claim that a goodwill has been generated in the following services:

“arrangement of travel; providing travel information; reservation of transport tickets; organising group travel and holiday trips; gathering, collating and providing information about all aforementioned services” and

“intermediary services in the field of the rental of hotel rooms; reservation of temporary accommodation and intermediary services related thereto; gathering, collating and providing information about all aforementioned services”.

53. Even if those services have been provided, there is no information that states or allows one to calculate the number of people to whom those services were offered, the location of the people to whom they were offered (i.e. whether or not they were in the UK), or of the marks under which they were offered. Even without the fact that, to the extent that any services were offered they were plainly not offered by the Opponent, the evidence is simply inadequate to establish a necessary goodwill in those services.

54. Further, as any such services have only been provided in connection with walking events for charitable fundraising, the name or mark “Walk the Walk” is highly descriptive of those services, meaning that the generation of goodwill will be harder than if a distinctive name or mark had been used.

55. Even if a goodwill is established, then it is plain that the services have only been offered in connection with services provided for the purpose of walking events for charitable fundraising, and the goodwill must be limited to that field of activity.”

52) I take account of the comments in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

53) I also note that in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

54) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

55) I also note that in *Hart v Relentless Records* [2003] FSR 36, Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

56) However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

57) The opponent contended that the applicant has previously in this case accepted that the opponent has used its mark upon a variety of goods and services and also accepted that it has reputation in certain services. To my mind, it is common ground that the applicant provided what I have described as travel agent services (arranging travel and accommodation etc) for the participants on the various charity walks and events arranged by the opponent. The applicant is well aware of the types of services that have been provided via the opponent's website.

58) In its ground of opposition the opponent cited the following services as ones in which it has goodwill.

Arrangement of travel; transportation services; travel agency services; providing travel information; reservation of transport tickets; transport of persons; organizing group travel and holiday trips; rental of vehicles; services of a tour operator, namely the transport of travellers; arranging for travel visas, passports and travel documents for persons travelling abroad; gathering, collating and providing information about all aforementioned services. Provision of temporary accommodation; provision of food and drink; intermediary services in the field of the rental of hotel rooms; services of a hotel, restaurant and café not included in other

classes; reservation of temporary accommodation and intermediary services related thereto; gathering, collating and providing information about all aforementioned services.

59) At the very least the opponent must be said to have goodwill in its charitable fundraising including the organisation of fundraising walks and marathons and the travel and accommodation of the participants. As such the opponent passes the first hurdle.

60) Despite the concessions referred to in paragraph 57 the applicant now seeks to maintain that all trading was carried out by a wholly owned subsidiary of the opponent and so any goodwill accrued must belong to the subsidiary not the opponent. The applicant referred me to the following:

“32. The leading case on the identification of an owner of goodwill is *Scandecor Development v Scandecor Marketing* [1999] FSR 26. In *Wadlow on passing off*, 4th edition, at 3-134 the impact of that case is stated to be the following:

...identifying the owner of goodwill is really a two stage process because of the dual character of goodwill as a reflection of a public state of mind on the one hand, and as legal property on the other... The two aspects are easily reconciled by saying that the initial vesting of goodwill in one trader or another is always a matter of fact; but that having vested there on its creation it may be transferred to another trader by prior or subsequent agreement, or by operation of the general law, always provided that the transfer does not offend against the rule prohibiting assignments in gross.

33. In respect of the initial ownership, *Wadlow* goes on to say at 3-135:

“Goodwill is legal property. It can be assigned by the owner, dealt with in other ways, and protected against damaging misrepresentations by the action for passing-off. Goodwill is created by trading activities, but it often happens that more than one business is involved in the sequence which results in goods or services being made available to the consuming public. If so, then the question arises of which of those businesses is the owner of goodwill which the law recognises as damaged when a person passes off his goods or business as those with which the public is acquainted. The problem arises in two main contexts. One is where two or more businesses which have previously worked together fall out. The other is where a passing-off action is brought by a claimant who considers himself damaged by the activities of the defendant but who is not, in law, the owner of any relevant goodwill.”

34. And at 3-137:

“The following questions are relevant as to who owns the goodwill in respect of a particular line of goods, or, mutatis mutandis, a business for the provision of services:

- Are the goods bought on the strength of the reputation of an identifiable trader?
- Who does the public perceive as being responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory?
- Who is most responsible in fact for the character or quality of the goods?
- What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? For example, goodwill is more likely to belong to the manufacturer if the goods are distributed through more than one dealer, either at once or in succession. If more than one manufacturer supplies goods to a dealer and they are indistinguishable, the dealer is more likely to own the goodwill.”

35. It should finally be noted that the rule against assignments in gross, mentioned at 3-134, includes a rule prohibiting bare assignments of goodwill without any element of a business being transferred with it – see Wadlow at 3-194:

“An assignment in gross can take two forms. The more common is for the owner of goodwill to purport to grant to a third party the bare right to use a mark which is distinctive of the assignor, there being no connection between the two which would justify its use by the assignee. The less common is for the assignor to purport to assign his goodwill in whole or in part without the assignee taking over any relevant interest in the business to which the goodwill related. An example is to be found in *Barnsley Brewery Co. Ltd v RBNB* in which the goodwill and name of the former Barnsley Bitter were purportedly assigned to the plaintiffs 20 years after the relevant business had been discontinued. Both categories of transaction are regarded at common law as being inherently deceptive. They are consequently ineffective to confer any rights on the assignee as against the world at large, and are likely to result in the relevant goodwill becoming unprotectable. The same principle applies to transactions such as licences which are not assignments as such but which have similar effects.”

61) The applicant further contended:

Goodwill – Ownership

“56. It is absolutely plain that the Opponent does not itself offer any of the services in which it alleges that it has a goodwill – it is expressly stated, that in order to avoid a restriction placed on the Opponent’s activities, all services are provided through a separate company, Action.

57. It is clear (despite the incorrect claims to the contrary in part 7 of Ms Barough-Albertin’s witness statement), that to the extent that participants in fundraising events enter into contractual relations, they enter into those relations with third party tour operators, or with Action. That can be the only consequence of the structure that has

been set up by the Opponent, and is made completely clear by the contractual terms at exhibit NLB106.

58. As a consequence of that fact that any contractual terms are with Action, and because that fact will be abundantly clear to any relevant member of the public (i.e. to any member who does not fall into the description of a moron in a hurry), it is clear that the public will understand that the party responsible for the quality of any service they are provided is Action.

59. There is no suggestion that there is any agreement whereby the goodwill that accrues to Action (if any) is assigned to the Opponent. Given the clear intent in the creation of Action to separate the activities of it from the activities of the Opponent, that is not surprising: it is reasonable to assume that the separation requires the goodwill to remain with Action.

60. Further and in any event, such an assignment would necessarily, in the arrangements made by the Opponent, offend the rule against assignments in gross, and could not validly transfer the goodwill.

61. As a consequence, it is clear on the evidence that, if to any extent goodwill has been generated in the alleged fields of activity, that goodwill is not owned by the Opponent. The s.5(4)(a) opposition must therefore fail.”

62) Ms Michaels pointed out that the annual accounts filed shows that the single set of accounts relates to both the opponent and its subsidiary. She also referred me to the fact that some events such as the Arctic challenge could only be undertaken if one booked accommodation and transfers, as set out in the terms and conditions at exhibit NLB106. She also pointed out that the opponent had referred to paragraphs 3-135 and 3-137 of Wadlow but for some reason not paragraph 3-136 which reads:

“**3-136** The factors which influence the ownership of goodwill were encapsulated by Lord Reid in *Oertli v Bowman* [1959 RPC 1, 7, HL]:

“Bowmans made and marketed the *Turmix* machines without the appellants [plaintiffs] having controlled or having had any power to control the manufacture, distribution or sale of the machines, and without there having been any notice of any kind to purchasers that the appellants had any connection with the machines.”

There are two distinct, and not necessarily consistent, standards in this passage. One is to ask who is in fact most responsible for the character or quality of the goods; the other is to ask who is perceived by the public as being responsible. The latter is (perhaps surprisingly) the more important, but it does not provide a complete answer to the problem because in many cases the relevant public is not concerned with identifying or distinguishing between the various parties who may be associated with the goods. If so, actual control provides a less decisive test, but one which does yield a definite answer.”

63) Ms Michaels referred me to the evidence of the independent witnesses, who all identified the opponent as having provided the travel and accommodation services, despite all three of the witnesses being aware that the actual bookings were carried out by an agent/third party. Despite the fact that these witnesses are supporters of the charity they state clearly that they booked their travel and accommodation via the opponent's website and considered that these had been provided by the opponent despite acknowledging that the opponent used an agent. **In all the circumstances, not least of which was the acceptance by the applicant that the opponent had used its mark and had reputation, I regard the opponent to have shown it has goodwill in relation to arranging the participation of its supporters on various charity walks and marathons and the travel and accommodation issues surrounding the participation.**

64) In case I am wrong in relation to the goodwill issue, a request was made at the hearing to include the subsidiary Walk the Walk In Action Ltd (Action) as a joint opponent. This would therefore resolve the issue on goodwill. The inclusion of Action was challenged by the applicant as it did not have an opportunity to file additional evidence. However, I think this is spurious as having contended that on the evidence filed the goodwill would lie with Action it is difficult to imagine what if any evidence it could have filed.

65) I now turn to consider the issue of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

66) Earlier in this decision I considered the marks of the two parties and found that there would be confusion as to origin of the services of the two parties. However, there is a difference between the test for likelihood of confusion under trade mark law and the test for misrepresentation under the law of passing off. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

67) In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“The role of the court, including this court, was emphasised by Lord Diplock in *GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

68) In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the Advocate case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

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

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

69) Earlier in this decision (paragraph 59) I found that the opponent had goodwill in its charitable fundraising including the organisation of fundraising walks and marathons and the travel and accommodation of the participants. I also found (paragraph 41) that the provision of, what can loosely be described as, “travel agency services” are a natural extension of the opponent’s services.

70) The applicant also contended that the opponent’s mark was descriptive of walking holidays and as such there could not be misrepresentation. They relied upon the comments in *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 R.P.C. 39 at p.43:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered”

71) In my opinion, the opponent’s mark is distinctive even when used on organising walks. The phrase, although a well known one, is not descriptive of walking holidays or charity walks. The applicant was well aware of the activities under the opponent’s mark when, for

reasons best known to itself, it decided to apply for a mark which is similar to that of the opponent and which would cause misrepresentation. Prior to the hearing and in the hearing itself the applicant offered two restrictions to the specifications. The first offer was to add “but none of the aforesaid services being provided for charitable fundraising” to the end of each specification. The second would have added the words “each of the aforesaid only in relation to walking holidays” to the end of each specification.

72) To my mind neither restriction alleviates the misrepresentation as consumers would simply view the walking holidays as an extension of the activities already carried out under the opponent’s mark.

73) I now move onto the issue of damage. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

74) In the instant case given the closeness of the activities and marks of the two parties, if there is confusion about an economic connection, the fact that the applicant does not operate for charitable purposes appears to have clear potential to damage the opponent’s goodwill as a charity. **The ground of opposition under section 5(4)(a) succeeds in full.**

COSTS

75) The opponent has been successful under both grounds of opposition that were left to be resolved as such it is entitled to a contribution to its costs. The applicant contended that the evidence filed by the opponent was excessive and of little use. I do not entirely agree with this view.

Preparing statements and considering the other side’s statements x 2	£400
Preparing evidence and considering the evidence of the other side	£1000
Expenses	£400
Preparing for and attending the final hearing	£1200
TOTAL	£3,000

76) I order Sports Tours International Limited to pay Walk the Walk Worldwide the sum of £3,000. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of November 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**