

O-772-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 246 314: WALDO IN
CLASSES 05, 09, 35 AND 44 BY AINSLY LTD

AND

IN THE MATTER OF OPPOSITION THERETO BY DREAMWORKS DISTRIBUTION
LIMITED

Background and pleadings

1. Ainsly Ltd (name of applicant) applied to register the trade mark No 3 246 314 WALDO in the UK on 26th July 2017. It was accepted and published in the Trade Marks Journal on 11th August 2017 in respect of the following goods and services:

Class 05:

Solutions for contact lenses; contact lens cleaning, rinsing or neutralising preparations; eyewashes and eye sprays; preparations for treating dry eyes; eye drops; eye moisturisers and ointments for medical use; ocular vitamins; eye patches; eye care preparations for medical use; pharmaceuticals for treatment of eye disorders; medicated preparations for the care of the eyes, skin and face; vitamins for care of the eyes; vitamins for care of the skin and face; skincare preparations (medicated); eye masks and eye patches impregnated with medicated preparations; face masks impregnated with medicated preparations.

Class 09:

Eyepieces; glasses; sunglasses; contact lenses; containers for contact lenses; reading glasses; spectacles; lenses; parts, fittings and accessories for spectacles or sunglasses; glasses cases; protective eyewear; prescription protective eyewear; cords for spectacles or sunglasses; cases adapted for holding goggles or protective eyewear.

Class 35:

Retail services (including on-line retail services) in connection with vision related products namely, solutions for contact lenses, contact lens cleaning, rinsing or neutralising preparations, eyewashes and eye sprays, preparations

for treating dry eyes, eye drops, eye moisturisers and ointments for medical use, ocular vitamins, eye patches, eye care preparations for medical use, pharmaceuticals for treatment of eye disorders, medicated preparations for the care of the eyes, skin and face, vitamins for care of the eyes, vitamins for care of the skin and face, skincare preparations (medicated), eye masks and eye patches impregnated with medicated preparations, face masks impregnated with medicated preparations, eyepieces, glasses, sunglasses, contact lenses, containers for contact lenses, reading glasses, spectacles, lenses, parts, fittings and accessories for spectacles or sunglasses, glasses cases, protective eyewear, prescription protective eyewear, cords for spectacles or sunglasses, cases adapted for holding goggles or protective eyewear; arranging subscription of contact lenses for others; administration of consumer loyalty programs; rental of advertising space on website.

Class 44:

Opticians' services; fitting of contact lenses.

2. DreamWorks Distribution Limited (the opponent) opposes the trade mark on the basis of Section 3(6) of the Trade Marks Act 1994 (the Act). It argues that this is on the basis of the applicant being aware of the opponent's property in respect of WHERE'S WALDO and that the applicant has deliberately chosen WALDO to derive benefit from the opponent's property¹. In particular, the opponent's property is recognised for particular aspects of its imagery, for example the WALDO character is recognised for his round glasses. The applicant's business is in contact lenses and related products and services and has additionally applied to register its mark for a range of eyewear and retail services for eyewear. The applicant has also selected marketing and advertising terms and images which seek to associate its products with those of the opponent. For example it uses the hashtag #wearwaldo on its social media sites. This is phonetically very similar to the opponent's property in respect of WHERE'S WALDO and is a clear reference to the opponent's

¹ From the evidence filed by the opponent, it appears that the opponent operates in the field of books, specifically children's puzzle books.

property. In addition the applicant has selected imagery which mimics typical poses of the WALDO character. The application therefore, has been made in bad faith.

3. The applicant filed a counterstatement denying all of the claims made.
4. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both parties filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Evidence filed

5. This is a witness statement, dated 13th April 2018, from Ms Rachel Jane Harrison. The statement merely introduces a number of exhibits which are as follows:
 - Exhibit RJH1 which is a print obtained on 13th April 2018 from Wikipedia page “Where’s Wally”. This explains that “Where’s Wally” is a long standing British series of children’s puzzlebooks created by English illustrator Martin Handford with a central character, who wears glasses, called Wally. The entry also confirms that in the USA and Canada, these books are published as “Where’s Waldo”. The opponent claims that UK consumers are well aware that different names will be used in different jurisdictions. However they offer no evidence on the point.
 - Exhibit RJH2 are prints obtained on 13th April 2018 from a search on Google.co.uk for the term “waldo glasses”. The search result appears to bring back images of Waldo/Wally aswell as examples of other glasses which seem to be similar in style to those worn by the character. The opponent claims that its character is well known for its imagery (and for wearing round glasses).

- Exhibit RJH3 is a copy of an article published by Business Insider UK on 31st July 2017 entitled “Waldo: contact lens start up, making dailies affordable”. The opponent notes that the article states that the applicant is aware of the association with the children’s “Where’s Waldo” series and relies upon this quote in the article from the applicant’s founder, Ashleigh Hinde “the ultimate PR would be to get him wearing contacts”. The opponent claims this is proof that the applicant was aware of the opponent’s earlier rights and that there was likely to be an association between them and the later WALDO trade mark.
- Exhibit RJH4 are prints from Twitter and Facebook showing use of the hashtag #wearwaldo by the applicant. The opponent claims this is phonetically highly similar to its own “Where’s Waldo”.
- Exhibit RJH5 is a comparison of images used by the applicant and the property of the opponent. These were obtained from Google.co.uk on 13th April 2018. The images show the illustrated character Waldo on the left hand side and images of real life customers, specifically the top half of their faces, presumably wearing contact lenses on the right hand side. The opponent claims, in its submissions that this is proof of mimicry of the opponent’s imagery.

Submissions

6. The pertinent issues from the opponent are included in the evidence summary already included above. The applicant has not filed evidence in reply but has filed submissions which address the evidence of the opponent. This can be summarised as follows:
 - The opponent has not referred to any UK rights in WALDO and has provided no evidence in support;

- Exhibit RJH1 is from Wikipedia, a collective encyclopedia, published on the internet, the content of which can be amended anonymously at any time. This evidence should therefore be given little, if any weight;
- The opponent has provided no evidence of its assertion that “consumers are aware of the different names used in different parts of the world”;
- The assertion that WALDO is known for his round glasses is not proven in the UK. The evidence from searches does not show that the UK consumer recognises WALDO for his round glasses;
- The opponent refers to an article published four days after the application date in these proceedings. The article suggests nothing more than that, at the time of the article the applicant (who, as the article notes, has lived in the US for a number of years) was aware of the WALDO character and was asked a light hearted question by the interviewer and responded in like-fashion. Furthermore, the applicant was already the registered proprietor of another WALDO (UK) trade mark, applied for on 4 April 2017;
- Exhibit RJH4 is merely a set of screenshots from the applicant’s Twitter pages which proves nothing more than the applicant does use the hashtag #wearwaldo. This is a clear reference to wearing the applicant’s Waldo-branded contact lenses;
- In respect of Exhibit RJH5, the images bear no resemblance to one another and it is unclear why the opponent deems them to be relevant.

Legislation

7. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

8. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the

allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT*

WEEKLY Trade Mark [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

Conclusion – Bad Faith

9. It is considered that the evidence filed by the opponent suffers from a number of defects and I am reminded that bad faith is a serious allegation which must be distinctly proved by cogent evidence. Looking at the information filed, there is nothing whatsoever to suggest that “Where’s Waldo” is known in the UK jurisdiction; rather, it is “Where’s Wally” that appears to be widely used (and known) in the UK. An internet search on “waldo glasses” does not assist the opponent in this regard as it merely demonstrates that the character WALDO (known outside of the UK in the US and Canada) wears glasses. The search has also been set in order to return only photographs rather than hits. Further an internet search, by its very nature is conducted across the whole of the internet and is not UK specific. It does not provide cogent evidence of bad faith.

10. The opponent also relies upon an article about the applicant’s business, published 4 days after the filing date in these proceedings (the relevant date) the content of which is described above. It is of limited value. This is because the context is unclear in that the reader is unaware of the exact question posed to Ashleigh Hinde, the applicant’s founder. As such, it is entirely possible that it was the interviewer who introduced to Ms Hinde a potential association with “Where’s Waldo” and Ms Hinde then responded in kind. It is considered that absence any further detail, this cannot be said to demonstrate bad faith on the part of the applicant. Further, even if the context was clear and the applicant was aware of “Where’s Waldo”, the case law on the point is clear: in *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12, the CJEU held that merely knowing that a trade mark was in use by another in another jurisdiction did not amount to bad faith under Article 4(4)(g) of the Directive (s.3(6) of the Act). The court found that:

“2. Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that, in order to permit the conclusion that the person making the application for registration of a trade mark is acting in bad faith within the meaning of that

provision, it is necessary to take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration. The fact that the person making that application knows or should know that a third party is using a mark abroad at the time of filing his application which is liable to be confused with the mark whose registration has been applied for is not sufficient, in itself, to permit the conclusion that the person making that application is acting in bad faith within the meaning of that provision.

3. Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that it does not allow Member States to introduce a system of specific protection of foreign marks which differs from the system established by that provision and which is based on the fact that the person making the application for registration of a mark knew or should have known of a foreign mark.”

11. Further, in *Wright v Dell Enterprises Inc.* (HOGS AND HEFFERS), BL O/580/16, Professor Ruth Annand, as the Appointed Person, upheld the registrar’s decision to reject an opposition on the ground that the applicant had copied a trade mark with a reputation the USA (but not in the UK) and applied to register it in relation to the same services. Professor Annand ruled that, given the territorial nature of IP rights, the mere appropriation of a name registered/used abroad was not enough under UK law: there must be something else involved before this can justify a finding of bad faith.

12. In these proceedings, it is considered the matter is even more stark: there is nothing to suggest that Where’s Waldo is even being used in respect of the same or similar goods and services. Indeed, the evidence suggests that the parties operate in dissonant fields: eyewear (and related goods and services) versus children’s puzzle books. The article therefore, does not help the opponent.

13. There is also the evidence regarding the “wearwaldo” use by the applicant as well as screenshots showing people presumably wearing waldo contact

lenses and a comparison to a the cartoon character wearing glasses. In respect of the former, this is merely the applicant advertising its products and indeed, encouraging its customers to wear and use them. I consider it a significant leap to suggest that it demonstrates copying on the part of the applicant. In respect of the latter, it is unclear as to how this aids the opponent in any way. It categorically does not demonstrate that the applicant has acted in bad faith.

14. Taking into account all of the evidence as a whole, it is considered that it wholly fails to establish a prima facie case of bad faith on the part of the applicant. The opposition therefore fails in its entirety.

COSTS

15. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering notice of opposition and accompanying statement and statement of case in reply - £500

Considering evidence - £500

TOTAL - £1000

16. I therefore order DreamWorks Distribution Limited to pay Ainsly Ltd the sum of £1000. The above sum should 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 3rd day of December 2018

Louise White

**For the Registrar,
The Comptroller-General**