

O-315-19

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3310463
BY TOP MUM PROMOTIONS
TO REGISTER

Whitby Goth Festival

AS A TRADE MARK
IN CLASS 41
AND OPPOSITION THERETO (UNDER NO. 413451)
BY
SCARBOROUGH BOROUGH COUNCIL OF TOWN HALL

Background & Pleadings

1. Top Mum Promotions ('the applicant') applied to register the trade mark **Whitby Goth Festival** on 14 May 2018. The mark was published in class 41 for the following specification of services on 1 June 2018.

Class 41: Organisation of festivals; Festivals (Organisation of -) for entertainment purposes; Organisation of festivals.

2. Scarborough Borough Council ('the opponent') opposes the mark on the basis of sections 3(6) and 5(4)(a) of the Trade Mark Act 1994 ('the Act').

3. Under section 3(6), the opponent argues that the applicant is unlikely to use the contested mark as it already owns other trade marks which it uses in respect of the same services. Further the opponent alleges that the applicant should not use the contested mark as it does not organise or run all of the events which comprise what the opponents describes as the Whitby Goth Festival and the opponent also alleges that the applicant chose to apply for the contested mark following a contractual dispute with the operator of a venue, which had previously been hired by the applicant for music related events, in order to prevent the opponent and the venue operator from using the contested mark.

4. Under section 5(4)(a), the opponent opposes the applied for mark on the basis of its alleged earlier rights in the words **Whitby Goth Festival**. It claims to have been providing services, namely *promotion of the festival in print and online* under this sign since May 2018 and has acquired goodwill under the sign. Furthermore the opponent claims that use of the applied for mark would be a misrepresentation to the public and would result in damage to the aforementioned goodwill.

5. The applicant filed a counterstatement denying the claims made.

6. Both sides filed evidence in these proceedings and the applicant filed written submissions. A hearing was not requested. I make my decision from the material before me.

Opponent's evidence

7. The opponent filed two witness statements in support of its opposition. The first of these witness statements was made in the name of Janet Deacon in her role as Tourism Marketing Manager for the opponent and appended one exhibit. The second witness statement was made in the name of Dominic Stokes, head of a company called SIVLive.

8. Taking Ms Deacon's witness statement first, the declarant states that the opponent used the words **Whitby Goth Festival** to promote a number of events which took place in Whitby in North Yorkshire between 26-28 October 2018.

9. In the exhibit JD1, on page 2, there is a screenshot of a social media page titled 'Discover Yorkshire Coast' dated 23 August (no year given but I am presuming 2018) referencing the Whitby Goth Festival and giving a hyperlink to a website for whitbygothfestivals.com.

10. On pages 3-7 there is a further screenshot dated September 2018 from DiscoverYorkshireCoast.com headlining forthcoming events in the area and on page 4 there is a reference to Whitby Goth Festival on 26-28 October and a hyperlink for more information.

11. On page 8 there is a screenshot of another social media post from 'Discover Yorkshire Coast' dated 12 September promoting an event titled 'Tomorrow's Ghosts Festival' on 26-28 October which is stated to be part of the Whitby Goth Festival. At the foot of the screenshot, it is stated that the post reached 1311 people.

12. On page 9 there is a screenshot of another social media page from 'Discover Yorkshire Coast' dated 20 September promoting an event titled 'Marquis Masquerade' on 26 October which is stated to be part of the Whitby Goth Festival.

13. On pages 10-14 there are screenshots of a newsletter from 'Discover Yorkshire Coast' dated Halloween 2018 promoting a number of Halloween events taking place


in the area. There is a reference to Whitby Goth Festival at the foot of the title page and again on page 11.


14. Turning now to the witness statement of Dominic Stokes, the declarant makes reference to his company, SIVLive, who manage a venue known as the Whitby Pavilion. The declarant states that his company took over the management of this venue from the opponent in 2012 and inherited an 'events contract' to stage Goth events with the applicant from that date. The declarant further states that the said contract with the applicant ended in April 2018. The contract was not renewed due to parties being unable to continue a working relationship as 'part of the Whitby Goth Festival'.

Applicant's evidence

15. The applicant filed a witness statement in the name of Jo Hampshire, a sole trader trading as the applicant, and appended one exhibit. Notable points from the witness statement include the following,

- Ms Hampshire states that she founded a music festival in Whitby in 1994 known as the Whitby Goth Weekend. In 1997 the Whitby Goth Weekend moved from an annual event and has been subsequently held twice yearly in April and October.
- The declarant also states she has trade marks registrations for the following,

namely **Whitby Goth Weekend, WGW,**  and **Whitby Gothic Weekend.**

- Ms Hampshire also states that in addition to the events she organises, there are a number of other 'official fringe' events which take place at the same time and for whom she has given permission to display her  trade mark.

- Ms Hampshire further states that by 2016, her event was being referred to as the Whitby Goth Festival and she subsequently sought to make a trade mark application for that mark.
- The declarant also states that she is aware that other parties are organising events for the same dates as the Whitby Goth Weekend to which she has no connection nor does she consider them to be official fringe events and has made complaints regarding the unauthorised use of her registered trade marks.

16. In the exhibit JH1, pages 1-8 comprise a Wikipedia entry for Whitby Goth Weekend dated 13 November 2018 detailing the event, its history and an archive of the music acts who have performed each year. On page 2 there is a reference to the ending of the relationship in June 2018 between the applicant and SIVLive regarding use of the Whitby Pavilion for music events.

17. Pages 11-12 comprise screenshots dated 13 November 2018 of a Google search for the term 'Whitby goth festival' and pages 13-16 comprise screenshots of a Google search for the terms 'Whitby goth festival' 'jo hampshire', which the declarant states returns results for the Whitby Goth Festival and the Whitby Goth Weekend.

18. Pages 17-20 consists of a copy of a Guardian newspaper article dated 29 October 2010 regarding the Whitby Gothic Weekend. The words 'Whitby goth festival' are featured in the article's title and the article refers to the 'official weekend' organised by the declarant.

19. Pages 21-23 consist of a Mail Online article dated 5 November 2016 and refers to the 'Whitby Goth Festival'. The article further mentions that the 'festival' started in 1994 and refers to the declarant as the organiser.

20. Pages 24-25 consists of a screenshot dated 13 November 2018 from a website called youngdracula.wikia.com which refers to the Whitby Goth Festival as a 'fictitious event' based on the Whitby Goth Weekend and refers to the declarant as having founded the event.

21. Page 26 consists of an undated screenshot from Whitbygothweekend.co.uk detailing a 'frequently asked questions' feature about the weekend events and pages 27-28 consist of advertising material dated 5 & 6 November 2016 for official fringe events. There are no references to the contested mark.

Opponent's evidence in reply

22. The opponent supplied a second witness statement in the name of Janet Deacon, in which the declarant states in reply to the applicant's claim that she has made complaints about unauthorised use of her registered trade marks that the opponent believes it should be free to promote all events under the contested trade mark and the applicant may still complain about unauthorised use of her registered trade marks.

23. That concludes my summary of the parties' evidence.

The Law – Section 5(4)(a)

24. 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.”

25. In addition Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

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

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

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

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

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

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

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

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

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

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

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

The relevant date

26. Whether there has been passing off must be judged at a particular point in time. 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 Allan 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.’ ”

27. The filing date of the application for registration is 14 May 2018. There is no evidence from the applicant that she has used the mark prior to this date. As such the matter will be assessed as of 14 May 2018.

The passing off claim

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

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

a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

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

Goodwill

29. The first hurdle for the opponent to clear is to show that it had the required goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

"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."

30. 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 off 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.”

31. 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.”

32. The opponent provided evidence dated from August, September and October 2018 from a range of social media and other online postings promoting a number of events under the term Whitby Goth Festival. Although the opponent stated in the notice of opposition that the date of first use of the earlier right was May 2018, it did not provide any evidence to demonstrate that it had used the contested trade mark prior to August 2018. As such it has failed to demonstrate that it had any goodwill at the relevant date 15 May 2018. Therefore it has failed to clear the first hurdle.

The law – Section 3(6)

33. 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.”

34. 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)."

35. The relevant date for the assessment to be made under section 3(6) is the date of the application of the contested mark, namely 14 May 2018. The opponent claimed the following in its Notice of opposition,

We question whether the applicant will use the trade mark given that;

- they run Whitby Goth Weekend under that registered trade mark
- we are not aware that the applicant has been using the mark given the widely recognised mark of Whitby Goth Weekend
- in our view, the applicant does not run Whitby Goth Festival, which includes other Goth events happening at the same time as Whitby Goth Weekend.

We cannot see why that position would change should the mark be registered to the applicant.

Further, we consider that a contractual dispute / termination between the applicant and the operator of a venue in Whitby (which is continuing to put on Goth events) has resulted in the application so as to prevent the Council and others from using the mark.

36. Firstly, I would say that applicants have 5 years after registration to use their mark and no evidence has been presented to support the claim that there is no intention to use the mark at issue.

37. With regard to the opponent's claim that the applicant does not run a festival which includes other events ancillary to those she has organised under the auspices of the title 'Whitby Goth Weekend', the applicant provided evidence to support that over a period of time she has allowed other event organisers to become official fringe events primarily by authorising them to use her registered trade marks. I further note from the applicant's evidence that the contested mark has been attributed by other third parties to the events that she organises. As such I dismiss the claim that the applicant does not run a festival to which the words Whitby Goth Festival have been attributed.

38. The opponent also raises an issue that the termination of the contract between the applicant and the operator of the Whitby Pavilion venue caused the applicant to act in bad faith by making the trade mark application. I could not find anything in the evidence that supports this claim even on a prima facie basis. The witness statement of Dominic Stokes stated that the parties were unable to continue a working relationship and the applicant makes no reference to it in her witness statement, but a reference to the contract ending appears briefly in the Wikipedia entry that formed part of the applicant's exhibit. The onus is on the opponent in a claim of bad faith to prove its case on the balance of probabilities and from the

evidence and claims filed I do not find anything in the applicant's behaviour in this matter to fall short of the standards of acceptable commercial behaviour.

39. As such I find the case for section 3(6) has not been made out and therefore fails.

Conclusion

40. The opposition has failed. Subject to appeal, the application may proceed to registration.

Costs

41. As the applicant has been successful, she is entitled to a contribution toward her costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs to the applicant as follows:

£300 Considering the Notice of Opposition and filing a defence.

£500 Filing evidence and considering the other side's evidence

£200 Filing written submissions

£1000 Total

42. I order Scarborough Borough Council to pay Top Mum Promotions the sum of £1000. This sum is 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 3 June 2019

June Ralph

For the Registrar

The Comptroller-General