

BL O-0885-25

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK NO 3698920  
IN THE NAME OF JAGGER JUNK APS FOR:

**JAGGER**



IN CLASSES 29, 30 AND 43

AND CANCELLATION APPLICATION THERETO UNDER NO 506617  
BY MUSIDOR B.V.

## BACKGROUND AND PLEADINGS

1. On 22 September 2021, Jagger Junk ApS ("The proprietor") applied to register the trade mark shown on the cover page of this decision in classes 29, 30 and 43.<sup>1</sup> It was subsequently registered on 11 November 2022. The specification is as follows:

### Class 29

Meat, fish, poultry and game; prepared meals and dishes mainly consisting of meat, fish, poultry, game, potatoes and other vegetables; hamburger patties of chicken, turkey and/or fish; prepared meals mainly consisting of potatoes and/or vegetables; preserved, frozen, dried and cooked fruits and vegetables; jams and compotes; eggs; milk and milk products; milkshakes; milk-based beverages and desserts; fruit desserts; edible fats; shortening; salads consisting of fresh and cooked vegetables; coleslaw; roasted nuts; french fries; crisps and fruit chips; cheese.

### Class 30

Sandwiches; hotdogs; pizzas; pasta; bakery products, including burger buns and hot dog sandwiches; hamburgers contained in bread rolls; preparations for making bakery products; spices; coffee, tea and cocoa; rice; pastry and confectionery; ice cream; sugar; honey; dressings for salad; tarts; sauces for burgers, hotdogs and sandwiches; relish [condiment]; relish [pickles]; ketchup [sauce]; mayonnaise; mustard.

### Class 43

Restaurant, catering and café services; takeaway services; organization of reservations and bookings for restaurants; providing information regarding choice of restaurant; night clubs (providing of food and drink); pubs.

---

<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

2. Musidor B.V. (“the cancellation applicant”) seeks invalidation of the registration under the provisions of sections 47 of the Trade Marks Act 1994 (the Act). It does so on grounds under section 5(4)(a) of the Act and relies on the signs MICK JAGGER and JAGGER, which it states have been used throughout the UK since 1964. Use is claimed for the following:

Class 9

Sound recordings; Pre-recorded motion picture films

Class 41

Entertainment; Performance of shows and concerts; Entertainment in the nature of live performances by rock groups; Film production, other than advertising films; Production of documentaries and cinema films

3. The cancellation applicant claims:

*“The use of the registered owner's trade mark would constitute misrepresentation leading to (or at very least a risk of damage).*

*The respective trade marks are visually and phonetically very highly similar. They also contain the identical word element "JAGGER".*

*As will be shown in evidence, owing to the nature and breadth of the goodwill held in the earlier unregistered trade mark, there exists a common field of activity between the parties, as such the use by the registered owner would create a misrepresentation.*

*By virtue of the Cancellation Applicant's use and business activities under the earlier unregistered trade mark, use of the registered owner's trade mark would also, or in the alternative, be seen as a collaboration with the Cancellation Applicant.”*

4. The proprietor filed a counterstatement in which it denied the cancellation ground. It denied that the MICK JAGGER and JAGGER signs are similar to the contested trade

mark and put the cancellation applicant to proof of the existence of goodwill throughout the UK in respect of the signs, since 1964, throughout the UK. The cancellation applicant also denied that use of the contested mark by the proprietor would be seen as a collaboration with the applicant for invalidation.

5. The cancellation applicant filed evidence and submissions in lieu of a hearing. It was represented by Venner Shipley LLP. The proprietor filed submissions in lieu of a hearing and was represented by Novagraaf UK.

6. I make this decision having taken full account of all the papers before me.

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts that predate the UK's withdrawal from the EU.

### **Cancellation applicant's evidence**

#### Witness statement of Luke David Portnow and exhibits LDP1–LDP18

8. Mr Portnow is a trade mark attorney at the cancellation applicant's representative. His statement is dated 13 March 2024.

9. His evidence relates to the cancellation applicant's goodwill and the existence of celebrity endorsed, owned and themed restaurants. I do not intend to summarise the evidence here but will refer to it as necessary throughout this decision.

### **Preliminary issue**

10. The proprietor, in its written submissions that were filed in lieu of a hearing, said the following:

*18. The Cancellation Applicant has not proven its entitlement to bring the present proceedings. Accordingly, the Cancellation Application should be dismissed for the Cancellation Applicant's lack of standing (Part A).<sup>2</sup>*

11. As a result and having read the proprietor's submissions, the cancellation applicant went on to file supplementary arguments, in which it said:<sup>3</sup>

*"2. The Proprietor's final submissions raise the point of the Cancellation Applicant's standing. The Proprietor's submissions go on to then try to define 'the proprietor of the earlier right'.*

*3. This was the first time in the proceedings that the Cancellation Applicant's standing was raised by the Proprietor; it has not been part of the case throughout and has been raised at the last opportunity before a decision is made from the papers."*

12. The cancellation applicant requests that 'prejudicial costs' be ordered against the proprietor for 'sharp practice'. In response, the proprietor also filed supplementary arguments in which it says it had already raised the issue of cancellation applicant's lack of standing on 9 August 2024.<sup>4</sup> It concludes:

*"3. Moreover, the substance of the Supplementary Arguments appears to be that the Cancellation Applicant considers it has already submitted suitable evidence of its entitlement (see, for instance, paragraph 7). We note that the Cancellation Applicant has also not sought to file further evidence on this issue. It is therefore not apparent what prejudice the Cancellation Applicant perceives it has suffered, to justify the filing of the Supplementary Arguments and the request for costs off the scale."*

13. The proprietor did not raise, in its defence and/or counterstatement, the issue of the cancellation applicant's standing. It did not file evidence on the point or request to

---

<sup>2</sup> See the proprietor's submissions filed on 16 September 2024

<sup>3</sup> See the cancellation applicant's submissions filed on 31 October 2024.

<sup>4</sup> See the proprietor's submissions filed on 12 November 2024

amend or add to its case. On 9 August 2024, when the proprietor filed its first, albeit fairly vague, reference to the cancellation applicant's standing to initiate these proceedings, the evidence rounds had been completed on this case and the proceedings had concluded. Furthermore, the proprietor did not request a hearing or request to cross-examine the other side. Both parties are professionally represented, and it should be understood that adding a new pleading to a party's case should not be done in final submissions or in a letter at the close of proceedings, but rather at the beginning when both sides are able to respond to claims made against them and file appropriate evidence.

14. That said, I will briefly consider the cancellation applicant's position in this case.

15. On 20 March 2024, the cancellation applicant filed a witness statement in which Mr Portnow confirmed that the cancellation applicant owns the trade marks relating to The Rolling Stones:

*"15. Musidor B.V. is the owner of UK Trade Mark Registrations Nos. WO0000001700709 'JAGGER', 2177238A 'MICK JAGGER', UK00901021203 'MICK JAGGER', UK00900169680 'ROLLING STONES', and UK00911283389 'ROLLING STONES'. As will be shown in evidence Mick Jagger is the world famous frontman of the musical group Rolling Stones."*<sup>5</sup>

16. He also confirmed that Musidor B. V. has a power of attorney to act for 'Mick Jagger'. Exhibit LDP1 is that power of attorney, signed by Michael Philip Jagger (Mick Jagger) and dated 13 May 2009. It appoints Musidor B.V.:

*"(2) to protect against and safeguard the legal position of my personal name MICK JAGGER (by way of legal proceedings or otherwise) against the unauthorized registration, use and/or exploitation by third parties on a world wide basis;"*

---

<sup>5</sup> See the witness statement of Luke Portnow, dated 13 March 2024.

17. In its supplementary argument, filed in response to the proprietor's submissions filed in lieu of a hearing, the cancellation applicant submits:

*7. It is quite clear that Musidor B.V. is a company which has a legitimate interest and is entitled to sue for misrepresentations. There is a business attached to Musidor which, as pleaded and evidenced in CA000506617, has as its purpose the exploitation of the rights of the Rolling Stones and its members, in this case Sir Michael Philip Jagger or 'Mick Jagger'.<sup>6</sup>*

18. I agree. The cancellation applicant owns the registered rights of The Rolling Stones and its members. Its purpose seems to be the exploitation and protection of those rights in what appears to be a sort of leasing arrangement. I find the cancellation applicant has standing to bring this case and I will say no more about it. Although, I will return to this issue when considering costs at the close of these proceedings.

## **DECISION**

19. The relevant parts of section 47 of the Act state:

"47. (1) The registration of a trade mark may be declared invalid on the ground that the trademark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) ...

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

---

<sup>6</sup> See the cancellation applicant's supplementary arguments, dated 31 October 2024.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

20. Section 5(4)(a) of the Act reads:

“5(4) 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, where the condition in subsection (4A) is met,

(aa)...

(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.”

21. Subsection (4A) of Section 5 reads:

(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

22. In *Discount Outlet v Feel Good UK*,<sup>7</sup> 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).”

23. In its final submissions the cancellation applicant draws my attention to Halsbury’s *Laws of England* Vol. 97A (2021 reissue) and its guidance concerning the establishment of a likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

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

---

<sup>7</sup> [2017] EWHC 1400 IPEC

- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium 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 two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (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 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**

24. In terms of the relevant date for assessment of this ground, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,<sup>8</sup> Mr Daniel Alexander QC, sitting as

---

<sup>8</sup> BL O-410-11

the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:<sup>9</sup>

‘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.’”

25. The filing date of the contested trade mark in the UK is 22 September 2021. However, the application was made pursuant to Article 59 of the Withdrawal Agreement, meaning that the trade mark is deemed to have the same priority date as the EU application on which it is based, namely 11 September 2017. The proprietor makes no claim to use of the mark prior to that date and it is that date that is relevant for the purposes of this assessment.

26. The first hurdle for the cancellation applicant is to show that it had the requisite goodwill at the date of the proprietor’s application for the contested mark. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd*:<sup>10</sup>

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of

---

<sup>9</sup> BL O-212-06

<sup>10</sup> [1901] AC 217 at [224]

attraction sufficient to bring customers home to the source from which it emanates.”

27. In its submissions filed in lieu of a hearing the proprietor submits:

*“35. Having regard to all the evidence, it is not disputed that Mr Jagger’s band, The Rolling Stones, was very successful, particularly during the peak of its activities in the early 1960s to 1980s. It also appears likely that Mr Jagger gained a certain celebrity arising from his time in the band.*

*36. However, celebrity is not the same as trading goodwill, and we dispute that by the Relevant Date there was goodwill in the Unregistered Sign MICK JAGGER and JAGGER in respect of the goods and services relied on. Mr Jagger’s activities in the decade or two leading up to the Relevant Date do not appear to have had anywhere near the intensity of the work of the band.”*

28. I outline below the key points from the opponent’s evidence relating to goodwill in musical recordings and performance:<sup>11</sup>

- Mick Jagger is the lead singer of The Rolling Stones.
- The Rolling Stones first album, titled ‘The Rolling Stones’ was released on 17 April 1964 and achieved number 1 in the UK charts.
- Twenty-four Rolling Stones albums have been released, the latest dated 20 October 2023.
- Fourteen Rolling Stones albums have reached No 1 in the UK.
- Rolling Stones albums have spent 655 weeks in the top 40.
- Eight Rolling Stones songs have been No 1 in the UK, with 21 reaching the top 10 and 44 in the top 40.
- Mick Jagger has released five solo albums with sales of more than 3,140,721 albums, including 120,000 in the UK.
- His solo songs have spent 31 weeks in the top 40 with one No 1 hit.

---

<sup>11</sup> See the witness statement of Luke Portnow

- Mick Jagger has collaborated with, inter alia, Tina Turner, David Bowie, The Jacksons, Bono, Carly Simon, Eric Clapton, Lenny Kravitz, Flea of the Red Hot Chili Peppers, Pete Townshend and the Eurythmics' Dave Stewart.
- The Jagger-Stewart song 'Old Habits Die Hard,' which originally appeared on the soundtrack for the Alfie remake, won the 2005 Golden Globe Award for Best Original Song.
- Mick Jagger was inducted into the Rock and Roll Hall of Fame in 1989.
- Mick Jagger was inducted into the Songwriters Hall of Fame in 1993 as the lead songwriter and vocalist for The Rolling Stones.
- Mick Jagger has won three GRAMMYs: the Lifetime Achievement Award, Best Rock Album (for 'Voodoo Lounge') and Best Music Video (for 'Love Is Strong').
- Mick Jagger was voted into the U.K. Music Hall of Fame in 2004 as part of The Rolling Stones.
- In 2003, Mick Jagger was knighted by Prince Charles for Services to Music.

29. The Songwriters Hall of Fame entry for Mick Jagger reads:<sup>12</sup>

*"Mick Jagger is a singer, songwriter, producer and solo artist who, with Keith Richards, is responsible for the enduring, half-century of success of the imitable Rolling Stones. With his charismatic persona and ability to craft songs that are both intense and irresistible, Jagger is one of rock n' roll's most influential musicians."*

30. In 2013, The Rolling Stones headlined at Glastonbury for the first time. A review article in the Guardian includes:

*"A raucous, extended Satisfaction sounds like one of rock music's holy relics. It drives home the realisation that the most patiently pursued headliners in Glastonbury's history have finally made it, and they're right here in front of us, and they're very, very good."*

---

<sup>12</sup> See exhibit LDP7

31. In 2023, the *Telegraph* reported that The Rolling Stones had overtaken the Beatles with the most No 1 UK studio albums.<sup>13</sup> The latest album, released in October 2023, sold 72,000 copies in the first week, outselling the rest of the top five artists combined.

32. It is clear from the evidence provided that Mick Jagger has goodwill in his name, as both the lead singer in The Rolling Stones and as a singer and songwriter under his own name. It is claimed that this goodwill rests in both Mick Jagger and Jagger and no distinction is made between the signs by the cancellation applicant.

### **Use of ‘Jagger’**

33. The cancellation applicant relies on a song by Maroon 5, ‘Moves Like Jagger’. The song does not show goodwill in the sign Jagger. It was sung by Maroon 5 and does not originate from Mick Jagger or The Rolling Stones. The fact that other musicians may refer to Mick Jagger informally as Jagger provides no assistance to me in assessing the cancellation applicant’s goodwill under the sign.

34. Other references in evidence all appear after the reader is already aware that what they are reading relates to Mick Jagger. For example, song writing credits where the writer’s surname appears after a song, alone, or with other writers. In my experience, it is common to see the surnames of songwriters used to denote their contribution to a particular song or album. For example, Lennon/McCartney is commonly seen on recordings by The Beatles. However, this is not the sign under which the goods are offered to the relevant public and I don’t believe this use provides an origin message that the consumer would rely on. Similarly, the book referred to in evidence is about Mick Jagger. Use of ‘Jagger’ in the book (and in other articles that refer to Mick Jagger, such as the entry in the Songwriter’s Hall of Fame) follows, in each case, an earlier reference to The Rolling Stones or Mick Jagger in full, making it clear to the reader that the ‘Jagger’ being referred to is Mick Jagger. Accordingly, goodwill in ‘Jagger’ is not made out by the cancellation applicant.

35. I find that the relevant goodwill rests in the sign ‘Mick Jagger’.

---

<sup>13</sup> See exhibit LDP4

36. Goodwill is claimed in sound recordings, performance of shows and concerts and live performances by rock groups, all of which are goods and services that are relevant to the claimed goodwill in the sign Mick Jagger and have been shown in the evidence provided. For the record, even if the evidence had not supported such a claim, Mick Jagger's fame as a singer, both as a member of The Rolling Stones and as a solo artist, is a matter I would have taken judicial notice of.

37. Goodwill is claimed in the Mick Jagger sign for pre-recorded motion picture films, film production and the production of documentaries and cinema films. This is not made out by the evidence provided. Mick Jagger has acted in films such as the 2001 film, 'Enigma' and has had production roles in some films, including Havana Moon, a 2016 documentary about The Rolling Stones. However, this is not evidence of goodwill in an enterprise that offers films and their production to third parties under the sign Mick Jagger.

38. In conclusion, I find that there was sufficient goodwill in the sign Mick Jagger for sound recordings, performance of shows and concerts and live performances by rock groups at the relevant date.

### **Misrepresentation**

39. With regard to misrepresentation, the cancellation applicant's pleadings are somewhat unclear. In its initial pleadings it claimed (my emphasis):

*"As will be shown in evidence, owing to the nature and breadth of the goodwill held in the earlier unregistered trade mark, there exists a common field of activity between the parties, as such the use by the registered owner would create a misrepresentation."*

40. In its written submissions filed at the close of proceedings, the cancellation applicant submitted (my emphasis):

6. *What remains to then assess is whether the proven goodwill is such that it may extend from the goods and services of the unregistered marks to those covered by the Registration. We submit that the evidence, showing the strength of the goodwill enjoyed in the earlier unregistered trade marks, supports that this is the case.*

41. And (my emphasis):

*“9...The Cancellation Applicant's evidence shows a link between the average consumer of food and beverage services and famous entertainment personalities.”*

42. The cancellation applicant relies on TESLA v TESLA CHICKEN & PIZZA. The case was decided under 5(3), based on the evidence before that hearing officer and in respect of marks that have no relevance to the case before me. The outcome of that case turns on its own facts and from the evidence before that decision maker. I will make this decision based on the papers before me, applied to the relevant facts and grounds in this case.

43. The cancellation applicant has made no claim in its pleadings that the goodwill in Mick Jagger gives rise to a misrepresentation in respect of the proprietor's food goods in classes 29 and 30 (other than the often-pleaded bald assertion that the cancellation case is made in respect of all goods and services in the specification of the contested trade mark). Subsequent documentation filed by the cancellation applicant is silent on the claimed misrepresentation and damage that would occur in respect of the proprietor's use of its trade mark for goods in classes 29 and 30, which include items such as jams, cheese, ice cream and ketchup. The only evidence provided by the cancellation applicant relates to restaurants and not food goods. It seems to me, from reading all of the papers on file in this case, that the cancellation applicant's claim is that the relevant public would be familiar with celebrities owning restaurants to the extent that the contested trade mark would be seen as referring to a restaurant associated with, owned by or endorsed by Mick Jagger. In the absence of any submissions to the contrary, I will proceed on that basis.

44. In light of my comments in the previous paragraph, the cancellation application must fail in respect of the proprietor's goods in classes 29 and 30. I will go on to consider the contested trade mark in respect of the services for which it is registered in class 43.

#### **The cancellation applicant's case against the proprietor's services in class 41**

45. It is the perception of the relevant public in the UK that is important in the assessment of a claim for passing off under 5(4)(a), which in this case is members of the general public.

46. In respect of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*,<sup>14</sup> in which Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the ‘substantial number’ of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

47. In support of its claim concerning the proprietor's restaurant services, the cancellation applicant has filed evidence of US country singers who own or have owned restaurants, for example ‘Kenny Rogers Roasters’.<sup>15</sup> This evidence all relates to the US market and in most cases the restaurants do not bear the name of the singer/owner. The cancellation applicant also provided an article about the ‘Best

---

<sup>14</sup> [2013] EWCA Civ 590

<sup>15</sup> See exhibit LDP14

Celebrity Owned Restaurants’ taken from Money and dated 22 July 2019 (after the relevant date).<sup>16</sup> Again, the restaurants referred to are all based in the US, so this evidence provides no assistance in assessing the relevant market in the UK.

48. An article taken from ‘Handbook’, is dated 5 January 2023 and is titled, ‘From Ed Sheeran To Idris Elba: 8 Celebrity Owned Restaurants & Bars in London’.<sup>17</sup> None of the restaurants featured in the article use the name of the celebrity and it is not clear how the relevant public would perceive the restaurants and their celebrity owners.

49. The cancellation applicant has provided two examples of UK restaurants featuring the names of their celebrity owners. The first is Wahlburgers, owned by Mark Wahlburg<sup>18</sup> and the second is Trejo’s Tacos, owned by Danny Trejo.<sup>19</sup>

50. Alongside its claim that the relevant public will believe the proprietor’s restaurant is owned by Mick Jagger, the cancellation applicant appears to be making a claim of false endorsement. In *Irvine v Talksport*,<sup>20</sup> Laddie J provided the following definition of endorsement:

“When someone endorses a product or service, he tells the relevant public that he approves of the product or service, or is happy to be associated with it. In effect, he adds his name as an encouragement to members of the relevant public to buy or use the service or product.”<sup>21</sup>

51. In the same case, Laddie J held:

“39...Even without the evidence given at the trial in this action, the court can take judicial notice of the fact that it is common for famous people to exploit their names and images by way of endorsement. They do it not only

---

<sup>16</sup> LDP15

<sup>17</sup> LDP16

<sup>18</sup> See exhibit LDP17, ‘Wahlburgers, London WC2: A touchy -feely tourist trap’ – restaurant review, Grace Dent, The Guardian, 28 June 2019

<sup>19</sup> See exhibit LDP17, ‘Danny Trejo Has (Finally) Opened His Much-Anticipated London Taco Restaurant – Trejo’s Tacos, Secret London, 26 February 2024

<sup>20</sup> [2002] FSR 60

<sup>21</sup> Above at paragraph 9

in their own field of expertise but, depending on the extent of their fame or notoriety, wider afield also.”

52. At paragraph 46 of the same case, he said:

“It follows from the views expressed above that there is nothing which prevents an action for passing off succeeding in a false endorsement case. However, to succeed, the burden on the claimant includes a need to prove at least two, interrelated facts. First that at the time of the acts complained of he had significant reputation or goodwill. Second that the actions of the defendant gave rise to a false message which would be understood by a not insignificant section of his market that his goods have been endorsed, recommended or are approved of by the claimant.”

53. The cancellation applicant succeeds in the first part of this assessment. At the relevant date there was sufficient goodwill in the name Mick Jagger for goods and services relating to the activities of a musician, as already outlined above at 33.

54. The second requirement is more problematic for the cancellation applicant. The question is whether on the balance of probabilities, a significant portion of the relevant public for the proprietor’s fast food services would think that Mick Jagger had endorsed or recommended them or, on the broader 5(4)(a) claim was in fact, the owner of the restaurant or linked to it in some way.

55. The contested mark is JAGGER FAST FOOD, with a small degree of stylisation. The fields of activity in this case are far removed from each other. It is not enough for the cancellation applicant to contend that JAGGER will be seen as relating to Mick Jagger and that Mick Jagger may own a fast food restaurant because other celebrities own restaurants. In order to succeed, it must be the case that the relevant UK public will, on encountering the proprietor’s restaurant, believe it to be connected to Mick Jagger in such a way that it amounts to a misrepresentation. The opponent is a well-known musician, Mick Jagger, who has goodwill for recordings and performances. The proprietor provides fast food.

56. I am mindful of the comments of Slade L.J. in *Stringfellow v. McCain Foods (G.B.) Ltd.*<sup>22</sup> in which he said, the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other.

57. He added (at page 545) that:

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

58. The cancellation applicant has not shown me how damage is likely to occur to the business of the musician Mick Jagger, or how loss will be suffered as a result of the proprietor’s use of its trade mark. I have also not been provided with evidence that would enable me to draw such a conclusion. For example, there is no evidence of Mick Jagger or Mick Jagger with The Rolling Stones endorsing or promoting the goods and services of others or providing goods and/or services that are removed from their musical careers, which would have educated the relevant public to expect such activity from the cancellation applicant. In my view the cancellation applicant has not discharged the ‘heavy burden’ of showing that the goods and services of the cancellation applicant are connected with the proprietor’s fast food restaurant in the mind of the relevant public.

**59. The cancellation application fails under sections 47 and 5(4)(a) of the Act**

## **Costs**

60. The proprietor has been successful and would normally be entitled to a cost award. The proprietor did not incur any official fees and did not file evidence in these

---

<sup>22</sup> [1984] R.P.C. 501

proceedings. In addition, the proprietor raised a new issue regarding the cancellation applicant's standing to bring these proceedings after the conclusion of this case. The proprietor did not seek to amend its pleadings or file evidence to counter the cancellation applicant's position. Instead, it elected to outline its case only when the cancellation applicant had filed its submissions in lieu of a hearing.<sup>23</sup> The cancellation applicant then needed to file additional submissions to deal with the new issue.

61. Accordingly, I decline to make an award in the proprietor's favour and direct that the parties bear their own costs.

**Dated this 24<sup>th</sup> day of September 2025**

**Al Skilton  
For the Registrar,  
the Comptroller General**

---

<sup>23</sup> The proprietor's claim to have foreshadowed the issue earlier in the proceedings does not alter my view, as when a comment was made that the proprietor may challenge the cancellation applicant's standing, the evidence rounds had already concluded, and the proprietor's argument was not particularised in a way that would allow the cancellation applicant to respond to it.