# O/0939/24

## TRADE MARKS ACT 1994

**TRADE MARK REGISTRATION No. 3554542**

**IN THE NAME OF PIZZA TEXAS BULLS INC.**

**AND**

**APPLICATION No. 504125 BY NBA PROPERTIES, INC.**

**FOR THE ABOVE TRADE MARK TO BE DECLARED INVALID**

**AND CANCELLED**

## BACKGROUND AND PLEADINGS

1. This is an unusual case because it concerns an application to cancel a trade mark which has already been declared invalid and removed from the register.

2. On 10 September 2021, NBA Properties, Inc. ("the applicant") made an application for a declaration of invalidity under section 47(2) of the Trade Marks Act 1994 ("the Act") in respect of the trade mark shown below:

| Trade Mark 3554542 | Goods/services | Proprietor |
|---|---|---|
|  | Class 30: Pizzas and pizza products namely, pizza crusts, pizza pies, pizza mixes, pizza flour, pizza dough, pizza sauces, prepared pizza meals, preparations for making pizza bases and pasta for incorporating into pizzas; sauces and spicy sauces.<br><br>Class 39: Pizza delivery services; delivery of food and drinks by restaurants.<br><br>Class 43: Restaurant services; restaurant services featuring in-restaurant dining and carryout services; catering services; cafes; services of preparation of takeaway. | Pizza Texas Bulls Inc. |

2. The contested mark was applied for on 11th November 2020 ("the relevant date").

3. The application for invalidation was based upon sections 5(2)(b), 5(3), 5(4)(a) and 5(4)(b) of the Act. The grounds under sections 5(2) and 5(3) of the Act were partly based on six earlier trade marks registered in the name of the applicant, and partly on

two marks claimed to be well-known in the UK. According to the applicant, it was entitled to protect the two marks shown below on that basis under article 6*bis* of the Paris Convention.


4. A different Hearing Officer issued a decision dated 7th July 2023 in which he rejected all the grounds for invalidating the contested trade mark and ordered the applicant to pay the registered proprietor £400 towards its costs. The applicant appealed to the High Court, but only against the Hearing Officer's decision to reject the grounds for invalidation based on sections 5(2) and 5(3) of the Act in respect of the two allegedly well-known marks shown above.

5. The relevant statutory provisions are set out below:

> *"6. Meaning of "earlier trade mark".*
>
> *(1) In this Act an "earlier trade mark" means—*
>
> *(a) -*
>
> *(ab) -*
>
> *(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well-known trade mark."*

*“56. Protection of well-known trade marks: Article 6bis.*

*(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well-known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who—*

*(a) is a national of the United Kingdom or a Convention country, or*

*(b) is domiciled in, or has a real and effective industrial or commercial establishment in, the United Kingdom or a Convention country,*

*whether or not that person carries on business, or has any goodwill, in the United Kingdom.*

*References to the proprietor of such a mark shall be construed accordingly.”*

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

*(a) -*

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

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*“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 the United Kingdom 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.”*

6. There was no appeal against the original Hearing Officer's decision to reject the section 5(2) and 5(3) based grounds for invalidation in relation to the applicant's six earlier registered marks (which are very similar to the marks shown above). Nor was there any appeal against the Hearing Officer's decision to reject the further grounds for invalidation based on the applicant's claimed common law rights in signs resembling the marks shown above, or the applicant's claim that use of the contested mark would infringe its copyright in the original graphical works embodied in the earlier marks. Consequently, those decisions became final.

7. The appeal was heard by Mrs Justice Joanna Smith who gave judgment on 15th November 2023.[1] Essentially, the judge found that the Hearing Officer failed to consider the two specific marks the applicant had relied on for its article 6*bis* based section 5(2) and 5(3) grounds, or the specific goods/services for which they were claimed to be well-known in the UK (as opposed to whether there had been use of those marks in relation to those goods/services in the UK). The judge then proceeded to determine the applicant's article *6bis* based section 5(2) case herself. She said:

> *"33. I have already mentioned that the Contested Mark is registered with respect to pizza, pizza products and pizza-related services.*
>
> *34. By contrast, the Device Marks are said to be well-known in the UK for the "sale of food and beverages", as well as branded merchandise, advertising, marketing and promotional services for sports teams, and sporting events, the organising and conducting of sporting activities and events, educational services, the providing of training, entertainment services, sporting and cultural activities, and information services relating to sports events in the US, Canada and Europe.*
>
> *35. Of this list, the only likely area of similar use of the competing marks is the "sale of food and beverages". The Appellant has pointed me to a very limited set of evidence to support the proposition that the Device Marks have been used for selling food and beverages, even in the United States. That evidence is: (1) a couple of photos evidencing the use of the Device Marks in the*

[1] [2023] EWHC 3040 (Ch)

*packaging and advertising of food sold at the Chicago Bulls own basketball arena; (2) a couple of promotional tie-ins with Coca Cola and Papa Johns, the most recent of which appears to be from 1992; (3) the promotion of charitable initiatives involving food that are local to Chicago; and (4) the use of the Device Marks on a reuseable sports drink bottle, alongside the logo of the energy drink Gatorade.*

*36. These appear to be isolated examples spread over almost 40 years. They are not evidence of a sustained use by the Chicago Bulls of the Device Marks for the promotion of food and beverage sales anywhere other than in their own stadium.*

*37. Accordingly, in my judgment, the use of the Device Marks in connection with the sale of food and beverages would not give rise to a likelihood of confusion here in the UK on the part of the public. On the available evidence, the similarity of the goods and services used in connection with the competing marks is extremely limited. There is no evidence whatever that the use of the Device Marks in the US for the sale of food and beverages is well-known in the UK. Indeed, on the evidence, such use appears extremely limited in any event, even in the United States.*

*38. As Mr Muir Wood anticipated in his helpful and candid submissions, this finding weighs so heavily in my overall consideration of the likelihood of confusion that it makes it unnecessary to make findings on the distinctiveness of the Device Marks and the similarity of the competing marks. I note, however, that both were considered by the Hearing Officer in some detail in his judgment with respect to his determination on the section 5(3) applications. None of his findings on those issues were subject to appeal.*

*39. In all the circumstances and for the reasons I have given, I dismiss Ground 4 of the appeal."*

8. By contrast, the judge decided that the article 6*bis* based ground for invalidation under sections 5(3) and 47(2) of the Act required that matter to be remitted to the

registrar for a decision by a different Hearing Officer. The judge explained her thinking as follows:

> *"40. …….. Unlike the analysis under section 5(2)(b) in Ground 4, section 5(3) does not require a focus on food and drink or on the degree of similarity between the goods and services for which the Contested Mark is registered and the goods and services for which the Device Marks are used.*
>
> *41. Instead, and in summary only, it necessitates an analysis of the full scope of goods and services connected with the Device Marks with a view to determining whether the use and reputation of the Device Marks elsewhere (i.e. in the US, Canada and Europe) has led to the Device Marks being well-known in the UK for those goods and services, and whether the average consumer would make a link between them and the Contested Mark and, if so, whether there is potential for unfair advantage in the use of the Contested Mark."*

9. The judge ordered that the costs of the appeal and any decision regarding the costs awarded at first instance were reserved for the new Hearing Officer.

10. The registered proprietor took no part in the appeal.

11. The applicant requested a further hearing to determine the matter remitted by the court. A hearing took place on 18th April 2024 via video link before me. Mr Jamie Muir Wood appeared again on behalf of the applicant. The registered proprietor was not represented. Indeed, three days prior to the hearing the applicant's representatives advised the registrar that the registered proprietor's UK representatives had resigned on 4th April, which appeared to leave the registered proprietor without a UK address for service.

12. The hearing went ahead on 18th April when I heard submissions on the remitted matter from Mr Muir Wood. I was subsequently provided with the applicant's (appellant's) schedule of costs for the appeal hearing, which came to a little over £26k.

## THE PROPRIETOR'S STANDING IN THESE PROCEEDINGS

13. On 19th April 2024, a letter was sent by email and post to the registered proprietor in the USA, which included the following notice and directions:

> *"In accordance with Rules 11 and 12 of the Trade Mark Rules 2008, the proprietor of a UK trade mark who opposes an application to invalidate the registration is required to have an address for service in the UK.*
>
> *You are therefore directed under Rule 12(1) of the Rules to file a UK address for service within one month of the date of this notification by 19 May 2024.*
>
> *If you fail to so, you will be deemed to have withdrawn from these proceedings."*

14. The registered proprietor did not provide a new UK address for service or reply to the letter of 19th April. Consequently, it is deemed to have withdrawn from the proceedings on 19th May 2024. This means it is not liable for any costs the applicant incurred after this date.

15. Ordinarily, this would still require the registrar to make a decision on the merits of the applicant's application on the article *6bis*-based section 5(3) ground remitted by the court, and to determine the appropriate costs in respect of events prior to 19th May 2024. However, these proceedings have been effectively overtaken by parallel invalidation proceedings commenced by Chicago Professional Sports Limited Partnership. I note the application for invalidation filed by that party was served on the registered proprietor's UK representatives on 20th March 2024 (i.e., before it resigned), and subsequently on the registered proprietor in the USA. The registered proprietor did not file a counterstatement to that application. Consequently, the application succeeded in accordance with Rule 41(6) of the Trade Mark Rules 2008 and the trade mark was declared invalid on 29th July 2024. That decision is now final.

16. This means that these proceedings are now without purpose, except as to costs. I will, therefore, examine the merits of the remitted matter only to the extent this is necessary to determine the appropriate award of costs.

**ENTITLEMENT TO PROTECTION**

17. The applicant is a US corporation. The US is a member of the WTO. Therefore, the applicant is entitled to protect a well-known mark in the UK.

**WHETHER THE EARLIER MARKS ARE WELL-KNOWN AND, IF SO, FOR WHAT?**

18. The relevant factors[2] include:

> (1) The degree of knowledge or recognition of the mark in the relevant sector of the public; the relevant sector of the public for these purposes includes but is not limited to consumers of the goods and services to which the mark applies, people involved in the distribution of the type of goods in question and business circles dealing with the goods or services in question;
>
> (2) The duration, extent and geographical area of any use of the mark;
>
> (3) The duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
>
> (4) The duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
>
> (5) The record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognised as well-known by competent authorities; and
>
> (6) The value associated with the mark.

19. The applicant pleads the earlier marks are well-known in the UK for:

> Basketball games, competitions and exhibitions; branded merchandise including toys, clothing, footwear, headgear; advertising, marketing and

[2] These are drawn from WIPO Guidelines and were applied by Arnold J. in *Hotel Cipriani* [2008] EWHC 3032 (Ch)

promotional services for sport teams and sporting events; organising and conducting of sporting activities and events; educational services; providing of training; entertainment services; sporting and cultural activities; information services relating sports events.

20. Based on the evidence of Mr Anil V. George for the applicant, the applicant's counsel put its case like this in his skeleton argument:

*"a. the Chicago Bulls team was formed in 1966;*

*b. it adopted its logo in 1966, which appears in the form of the* [bull's head logo]*, on its kit and has barely been altered since then, with its home games being played on a court featuring prominent use of the* [bull's head logo] *on the floor and around the arena;*

*c. the Chicago Bulls is the most successful franchise in the history of the National Basketball Association (the "NBA") in the US, which in turn is the most successful basketball league in the world;*

*d. the Chicago Bulls has achieved significant sums from merchandising across Europe and in the UK, which is advertised for sale using the Signs from its website accessible from Europe and the UK;*

*e. similar merchandising has been sold to customers in the UK through Amazon;*

*f. whilst the evidence of tie-ins between the Chicago Bulls and providers of foodstuffs is not extensive, this shows that the average consumer will be familiar with such tie-ins;*

*g. the Signs have also been extensively promoted through computer games;*

*h. the Chicago Bulls has a large social media presence, including in the UK; and*

*i. the UK audience for NBA fixtures, including those for the Chicago Bulls, has grown exponentially to millions of viewers in 2020, the year of the Relevant Date."*

21. The applicant says that, in the circumstances, the marks are plainly well known in the UK for *"at least sporting and entertainment events, if not also associated merchandise."*

22. I remind myself that the judge found that:

*"There is no evidence whatever that the use of the Device Marks in the US for the sale of food and beverages is well-known in the UK. Indeed, on the evidence, such use appears extremely limited in any event, even in the United States."*

23. I have the same evidence before me. Consequently, I do not think it is open to the applicant to advance point 'f' in paragraph 20 above.

24. I accept the applicant's marks are well-known in the UK for basketball entertainment services.

25. For present purposes, I also accept that the marks are well-known for merchandise in the nature of clothing, footwear and headgear.

26. The evidence of use of the marks in the USA, Canada, EU and UK does not establish that the marks are well-known here for anything else. That remains the case even when the enquiry is focused on the sections of the UK public interested in sport, American sport and/or basketball (each of which the applicant submits should be considered).

**THE CASE UNDER SECTION 5(3)**

27. The case law is well established and can be summarised 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.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public.

(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.

(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.

(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.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark.

(g) 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.

(h) 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.

(i) 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. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it.

(j) 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.

**REPUTATION**

28. I accept the earlier marks have a qualifying reputation for basketball entertainment services.

29. For present purposes, I also accept the earlier marks also have a qualifying reputation for merchandise in the nature of clothing, footwear and headgear.

**LINK**

30. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel*[3] are:

The degree of similarity between the conflicting marks

31. The applicant submits that:

> (i) The composite mark including the words CHICAGO BULLS is visually similar to the contested trade mark to a moderate degree. The Bulls head logo is visually similar to the contested trade mark to a higher degree.
>
> (ii) The composite mark including the words CHICAGO BULLS is at least aurally similar to the contested trade mark to a moderate degree because both marks include the word BULLS. The Bulls head logo will not be verbalised, and so aural comparison is possible with the contested mark.
>
> (iii) The marks all point to a bull, emphasised in the earlier composite mark the contested trade mark by the word 'BULLS'. The composite mark and the contested trade mark also point to the US, through use of the words 'CHICAGO' (a city) and 'TEXAS' (a state). Therefore, the respective marks are conceptually similar to a moderate to high degree.

32. I accept the applicant's submissions. As regards the visual similarity between the Bull's head logo and the contested mark, I find the differences between the representations of the bull's head and the addition of the words PIZZA, TEXAS and BULLS provide significant visual differences such that the overall level of visual similarity is medium.

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

[3] *Intel* CJEU Case C-252/07

33. The applicant's position is set out as follows in Mr Muir Wood's skeleton argument as follows:

> *"28. It is accepted that the Earlier G&S are not highly similar to the G&S. Entertainment services are, however, arguably similar to restaurant services, since they are complementarity to one another: the average consumer might expect entertainment services to be provided in a restaurant or that a venue offering entertainment services would also provide restaurant services.*
>
> *29. For example, a bowling alley, providing entertainment services, would be expected to provide restaurant services, under the same brand. Similarly, a jazz club or cabaret venue would be expected to provide restaurant services."*

34. The applicant's marks are not well known for the services of bowling alleys, jazz clubs or cabaret venues. However, I accept the general proposition that undertakings who provide entertainment services often offer services offering food and drink. Normally, the services would be provided at the same location(s). This is consistent with the examples given in the applicant's skeleton argument, and the position indicated in the applicant's covering letter of 30th September 2021, which accompanied its statement of case and was referred to therein. The letter stated (albeit by way of elaboration of the section 5(2)(b) ground) that:

> *"…. it is common for food and beverages, including pizza, to be sold at sports events. The goods of the trade mark owner are therefore complimentary to those of the Applicant and are usually sold at events hosted by the Applicant."*

On this basis I accept there is a degree of similarity between *basketball entertainment services* and the following services in class 43:

> *Restaurant services; restaurant services featuring in-restaurant dining and carryout services; catering services; cafes; services of preparation of takeaway.*

35. This similarity extends, albeit to a lesser extent, to some of the goods in class 30 which could be sold to users of *basketball entertainment services* through the services in class 43, i.e.

*Pizzas and pizza products namely, pizza pies, prepared pizza meals.*

36. By contrast, the connection between *basketball entertainment services* and goods for use in making pizzas is highly tenuous when considered from the perspective of an average consumer of those products or *basketball entertainment services.* Consequently, I find there is no connection between those services and:

> *Pizzas and pizza products namely, pizza crusts, pizza mixes, pizza flour, pizza dough, pizza sauces, preparations for making pizza bases and pasta for incorporating into pizzas; sauces and spicy sauces.*

37. Nor do I see any connection between the above listed goods and merchandise in the nature of *clothing, footwear and headgear*. The same applies to (sports) bags and watches, which may also have been marketed under the applicant's marks, but for which the evidence is too thin to permit me to find (even taking the most generous view of the evidence) are goods for which the applicant's marks are well-known in the UK.

38. I turn next to consider the closeness or otherwise of, on the one hand, *basketball entertainment services* and merchandise in the nature of *clothing, footwear and headgear,* and on the other hand, the proprietor's *Pizza delivery services; delivery of food and drinks by restaurants* in class 39.

39. The connection I have accepted between *basketball entertainment services* and catering services is based on the argument that entertainment venues often include catering services. In my view, the same argument does not extend to services for delivering food and drink, which usually means delivering it to the customer's home or workplace.

39. Nor do I see any connection between the proprietor's food and drink delivery services in class 39 and merchandise in the nature of *clothing, footwear and headgear.*

40. Apart from the services described in paragraph 34 above, the most that can be said about the goods/services at issue is that they are all offered to the general public and may be of interest to fans of American sport and basketball.

The strength of the earlier marks' reputation

41. I accept that the applicant's marks have a strong reputation with fans of American sport and basketball. They are also likely to known, albeit to a much lesser extent, to those interested in sports generally. I doubt they have any reputation among those with no particular interest in sport.

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

42. I accept the earlier marks are highly distinctive to fans of American sport and basketball. They are also likely to distinctive to a medium degree to those interested in sports generally, but not particularly in American sport and basketball.

Whether there is a likelihood of confusion

43. Taking account of the above and the fact that the relevant average consumer is likely to pay no more than an average degree of attention when selecting the goods/services at issue, I accept there could be a likelihood of confusion. That risk exists if the contested mark is used in relation to the services specified in paragraph 34 and the goods specified in paragraph 35. There is no risk of confusion if the contested mark is used in relation to the remaining goods and services for which it is registered.

Conclusion on Link

44. Relevant average consumers will make a link between the marks if the contested mark is used in relation to:

> *Class 43: Restaurant services; restaurant services featuring in-restaurant dining and carryout services; catering services; cafes; services of preparation of takeaway.*
>
> *Class 30: Pizzas and pizza products namely, pizza pies, prepared pizza meals.*

45. The differences between the marks and the respective goods/services are sufficient to rule out any mental link being made between the parties' marks if the

contested mark is used in relation to the remaining goods in class 30 and the services in class 39.

**UNFAIR ADVANTAGE/DETRIMENT**

46. The applicant's pleaded case under sections 5(2) and 5(3) is covered by the brief statement set out below:

> *"The Applicant has sponsorship, advertising and licensing relationships for the NBA Teams' marks for a very wide range of goods and services, including the sale of food and beverages. Such goods and services also include but are not limited to a variety of CHICAGO BULLS branded merchandise including toys, clothing, footwear, headgear; advertising, marketing and promotional services for sport teams and sporting events; organising and conducting of sporting activities and events; educational services; providing of training; entertainment services; sporting and cultural activities; information services relating sports events.*
>
> *Use of the Proprietor's mark incorporating a close imitation of the Applicant's mark, for such similar goods and services would therefore be liable to cause confusion and is therefore objectionable on such grounds."*

47. Unlike the sections 5(2) and 5(4)(b) claims, the section 5(3) claim was not further elaborated in the covering letter filed with the applicant's statement of case. The only particularised claim is, therefore, that use of the contested mark would "*be liable to cause confusion."* This is consistent with the section 5(3) claims made in greater detail (but dismissed without appeal) in relation to the applicant's earlier registered marks. All such claims of unfair advantage and/or detriment were based on the assertion that the public would be caused to believe there is a connection between the user of the contested mark and the user of the applicant's earlier registered marks (i.e., there is a likelihood of confusion).

48. At the hearing, Mr Muir Wood was constrained to accept that the applicant's case under section 5(3) was limited by its pleadings. In these circumstances, the applicant's case under section 5(3) cannot succeed against the registration of the contested mark

in relation to goods/services for which I have found there is no risk of confusion. Consequently, the ground would have failed in relation to the goods specified in paragraph 36 above, and against *pizza delivery services; delivery of food and drinks by restaurants* in class 39.

49. Section 5(3) provides protection against junior trade marks which, without due cause, take unfair advantage of earlier mark(s) with a reputation, and/or would cause detriment to the reputation or distinctive character of the earlier mark(s). It is necessary for the applicant to show that use of the contested mark would have one of these effects. My finding that there is a likelihood of confusion if the contested mark is used in relation to the goods/services specified at paragraphs 34/35 above is not automatically sufficient to establish any of the conditions set out in section 5(3). Nevertheless, a finding that the relevant public concerned with the parties' goods/services would likely think the contested mark signalled a trade connection with the user of the earlier marks, will usually make it easy to accept that use of the contested mark would take unfair advantage of the earlier marks' reputation, and/or be detrimental to their distinctive character.[4] If it still mattered, I would have accepted the applicant's section 47(2) claim succeeded so far as the contested mark is registered in relation to:

> *Class 30: Pizzas and pizza products namely, pizza pies, prepared pizza meals.*
>
> *Class 43: Restaurant services; restaurant services featuring in-restaurant dining and carryout services; catering services; cafes; services of preparation of takeaway.*

50. I would have rejected the applicant's case in relation to:

> *Class 30: Pizzas and pizza products namely, pizza crusts, pizza mixes, pizza flour, pizza dough, pizza sauces, preparations for making pizza bases and pasta for incorporating into pizzas; sauces and spicy sauces.*
>
> *Class 39: Pizza delivery services; delivery of food and drinks by restaurants.*

[4] See, for example, the recent case of *AGA Rangemaster v UK Innovations Group* [2024] EWHC 1727 (IPEC)

## COSTS

51. The applicant's grounds for invalidation under sections 5(2) and 5(3) (so far as it was based on its earlier registered marks) and sections 5(4)(a), 5(4)(b) of the Act, all failed at first instance and were not appealed.

52. The appeal under sections 5(2) and 5(3) based on the applicant's entitlement to protect well-known marks under article *6bis* of the Paris Convention would have succeeded in certain respects, but would ultimately have failed in respect of the claim based on section 5(2) of the Act.

53. So far as the remitted matter is concerned, I find that even taking the applicant's case at its highest, the claim based on its well-known marks and section 5(3) would have partially succeeded and partially failed.

54. In all the circumstances I direct that each party should bear its own costs in respect of all the proceedings set out above.

**Dated this day 30th September 2024**

**Allan James**
**For the Registrar**