



Neutral Citation Number: [2013] EWHC 2200 (Ch)

Case No: HC12B04597

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
INTELLECTUAL PROPERTY
COMMUNITY TRADE MARK COURT

Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL

Date: 25/07/2013

Before:

MR JUSTICE BIRSS

Between:

BOXING BRANDS LIMITED

Claimant

- and -

(1) SPORTS DIRECT INTERNATIONAL PLC

(2) QUEENSBERRY BOXING IP LIMITED

(3) SPORTSDIRECT.COM RETAIL LIMITED

(4) LILLYWHITES LIMITED

Defendants

Iain Purvis QC and Anna Edwards-Stuart (instructed by Davenport Lyons) for the
Claimant

Roger Wyand QC and Andrew Norris (instructed by Reynolds Porter Chamberlain) for the
Defendants

Hearing dates: 8th, 9th, 10th and 12th July 2013

APPROVED JUDGMENT

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

Mr Justice Birss :

Topic	Paragraphs
Introduction	1
The witnesses	9
The witnesses who were not called	17
The 784 Mark	19
Events up to May 2008	19
The law	77
Apply to the facts	81
Passing off – s5(4)(a)	81
Bad Faith	97
s11(3) defence	101
The period from May 2008 until today	103
The issues arising from events after May 2008	122
Acquiescence / estoppel	123
s46(1)(d)	124
Conclusion on the 784 mark	126
A passing off claim by the defendants	128
Copyright claim	132
Acts of the first defendant	133
Validity of the claimant’s later marks	134
Conclusion	152
Schedule A	

Introduction

1. This is a trade mark case about the mark QUEENSBERRY. Each side claims rights in the mark. The claimant BBL is a company associated with Mr Frank Warren the well known boxing promoter. Also associated with BBL is Mr Robert Earl, the owner of the Planet Hollywood chain of restaurants. The defendants are all associated with Sports Direct, the well known retailer.
2. Each side is the owner of a number of registered trade marks comprising the word QUEENSBERRY for all sorts of goods and services. Each side has UK registered trade marks and BBL owns a CTM as well. The marks, with their rather lengthy full specifications are set out in Schedule A to this judgment.
3. The major issue is about the rights to QUEENSBERRY as a clothing brand. Each side wishes to sell clothing under this trade mark. This core issue relates to BBL’s UK registered trade mark 2,485,784 QUEENSBERRY registered inter alia in class 25 for “Articles of clothing; footwear; headgear”. The mark was applied for on 8th May 2008.
4. In November 2012 the claimant learned that a clothing brand QUEENSBERRY was being launched at the Lillywhites store in London. The claimant applied for an interim injunction. Sales J granted the order and directed the case be tried on an expedited basis. As part of the order made on 10th December 2012 the claimant undertook not to launch its QUEENSBERRY products until judgment. The scope of the undertaking

and the interim order are the same. They cover more goods than clothing but the infringement case brought by the claimant against the defendants relates to clothing.

5. The second defendant is the successor to a boxing enterprise associated with Mr Luigi La Mura and Mr Andrew Goodwin which started in Bedford in 2004 with the name QUEENSBERRY or QUEENSBERRY BOXING. The third and fourth defendants have a licence from the second defendant. The first defendant is a holding company which the defendants say does not conduct any trade relevant to this case.
6. The defendants contend BBL's 784 mark is invalid either (i) under s5(4)(a) of the 1994 Trade Marks Act on the basis that as at 8th May 2008 Mr La Mura and Mr Goodwin could have prohibited the claimant from using the mark under the law of passing off or (ii) under s3(6) of the Act on the basis that the mark was applied for in bad faith in that applicant (in effect Mr Warren or his company) applied for it knowing that the mark really belonged to Mr La Mura and Mr Goodwin or (iii) under s46 of the Act. The defendants also contend that even if the mark is valid, any sales by them of clothing under the name QUEENSBERRY would not infringe because they have a defence under s11(3) of the Act (use in a locality). The use in a locality argument is said to arise from the same facts relied on under s5(4)(a). Furthermore the defendants contend the claimant has acquiesced to the activity complained of and is not entitled to relief either on the basis of acquiescence or estoppel. This arises as a result of events after May 2008 when Mr Warren's organisation and Mr La Mura and Mr Goodwin worked together for a period.
7. I will first address the issues relating to the 784 mark which arise from the events up to May 2008. Then I will deal with the other issues relating to the 784 mark which arise from events after May 2008. I will address the other issues once I have determined the case in relation to the 784 mark. These other issues include proceedings which were before the UK IPO but which were transferred to be heard together with this claim in order to deal with all outstanding issues in one go.
8. At trial the claimant was represented by Mr Iain Purvis QC leading Ms Anna Edwards-Stuart instructed by Davenport Lyons. The defendants were represented by Mr Roger Wyand QC leading Mr Andrew Norris instructed by Reynolds Porter Chamberlain.

The witnesses

9. For the claimant I heard evidence from Mr Warren and Mr Peter Newland.
10. Over the years Mr Warren has been involved in a number of court proceedings both here and in the USA. In cross-examination Mr Wyand put a number of judgments from previous cases in which Mr Warren's evidence was not believed. One was a dispute between himself or his company Sports Network and the boxer Joe Calzaghe, the other was a case in the Southern District of New York regarding the boxer Mike Tyson. Mr Warren maintained vigorously that he had not been lying on either of those previous occasions despite the findings of the judges. In my judgment the correct thing to do in the light of these earlier judgments is to be more wary than I might otherwise be about the evidence of the witness, but ultimately to approach the evidence on its own merits. The fact that Mr Warren has not been believed before does not mean he cannot or should not be believed on this occasion.

11. However considering Mr Warren's testimony on its own merits, there were elements of it which I did not find convincing. He maintained he had never seen a business sale agreement which was to have been the basis on which Mr La Mura and Mr Goodwin were to work together with Mr Warren's organisation and would acquire 10% of a Gibraltar registered company set up for Mr Warren as part of the arrangements. Given the importance of that agreement, I thought that was unlikely. Separately, his evidence about the negotiations relating to sponsorship deals between the Gibraltar company and certain boxers was unconvincing. However standing back and looking at his evidence overall, the thrust of Mr Warren's evidence was supported by the documents and in my judgment he was setting out an essentially truthful account. That does not mean I accept every detail of his evidence but I thought the broad thrust was true.
12. Mr Newland is a graphic designer and his evidence related only to a copyright point relating to a logo comprising the word QUEENSBERRY and wings. Mr Newland was a good witness.
13. The defendants' main witness was Mr La Mura. He was a poor witness. He lied in a statement to the Intellectual Property Office about the winged QUEENSBERRY logo. In cross-examination he sought to explain what had happened but the explanation did not grapple with the plain fact that the evidence before the IPO was untrue and was obviously intended to further his own interests against those of the claimant or its predecessors. This was not the only occasion on which Mr La Mura was shown to have made deliberately false statements. There was an episode about a written assignment of trade marks and goodwill in 2009. The assignment conveyed those rights from a company set up by Mr La Mura and Mr Goodwin back to the individuals personally. It is clear that there never was a written assignment. Mr La Mura must have falsely told the defendants' solicitors (or someone else representing the defendants) that it did exist but had been lost. Another example was in an email to Ed Simons concerning purchasing of boxing equipment. Mr La Mura wanted Mr Simons' company to reimburse him. In his email Mr La Mura told Ed Simons that he (Mr La Mura) had paid for the equipment. That was not true. The truth was that he intended to pay not that he had paid. Neither the document nor the email was in itself particularly important. For example I think Mr La Mura did indeed intend to pay the sum claimed and was not seeking to defraud Mr Simons. But they are symptomatic of Mr La Mura's approach generally. There were other occasions in which it may be that Mr La Mura had not consciously set out to concoct a deliberate false story but nevertheless had made statements which, when compared to the contemporaneous materials, were demonstrably wrong or had been wildly exaggerated to support the defendants' position. Overall in my judgment what Mr La Mura says cannot be trusted. I cannot safely place any weight on his evidence unless it is supported by other materials like documents or video evidence.
14. Other witnesses called by the defendants were good witnesses, seeking to help the court with their evidence. They were Mr Arnold, a builders' merchant manager who managed an amateur football team Bedford FC at the relevant time and had dealings with Mr La Mura and Mr Goodwin; Mr Clark, a security surveillance engineer who used the gym at the relevant time; and Mr Campbell, an employee of the third defendant and the general manager of the Lonsdale brand. A point was elicited from Mr Arnold orally in chief which could and should have been the subject of a witness

statement prepared overnight in order to give the claimant a fair chance to deal with it. However nothing turns on that point.

15. The defendants also called Mr Howlett, a boxing and kick boxing trainer who worked with Mr La Mura and Mr Goodwin in the relevant period. In the witness box Mr Howlett was a good witness giving evidence honestly to the best of his recollection but his witness statement was not reliable. As written, the impression given by two paragraphs about boxing gloves was entirely wrong. Another example was a statement about his being approached by people wanting to buy t-shirts. In fact this was mostly by people he knew. It was not by the general public.
16. There was also a witness statement of Mr Alleyne, a painter and decorator who was a friend of Mr Goodwin, who helped paint the gym and used it as well. Mr Alleyne died a week before trial and his witness statement was given under the Civil Evidence Act notice.

The witnesses who were not called

17. Mr Warren's main relevant company in the period 2004-2009 was Sports Network Ltd (SNL). As far as the issues in this case are concerned Mr Ed Simons was an important individual within SNL at that time. He would have had relevant evidence to give. The reason he has not been called appears to be that he and Mr Warren have parted on bad terms. I think that is probably true. Two other individuals with a close association to Mr Warren are Dean Powell and Andy Ayling. They were involved on at least one of the relevant occasions in this case. There is no good reason why they could not have been called by the claimant.
18. Mr La Mura's associate at all material times was Mr Goodwin. I gather he was present in court throughout the trial but he did not give evidence. He was in a position to corroborate Mr La Mura's evidence on many points, much more so than the other witnesses the defendants did call. There was no good explanation why he was not called.

The 784 mark

The events up to May 2008

19. The first relevant period is from 2004 until May 2008. I need to consider what Mr La Mura and Mr Goodwin were doing in this period and separately I need to consider what Mr Warren and his associates were doing.
20. Mr La Mura is and always has been a letting agent. He is chairman of Bedford FC, a local amateur football team not to be confused with Bedford Town FC. Mr Goodwin works and has always worked at Sports Direct at a retail store near Bedford.
21. Mr La Mura and Mr Goodwin had a shared interest in boxing. In 2004 they decided to open a boxing gym at an old airfield outside Bedford on Twinwood Road. The boxing gym consisted of a large room in which boxers and others could train. There was a boxing ring, punch bags and other equipment. They chose to use the name QUEENSBERRY. The name was chosen as a result of the famous link between boxing and the 9th Marquess of Queensberry, John Douglas. He wrote the first set of

rules to regulate boxing matches in 1867. They became known as the Queensberry Rules.

22. Since 2004, Mr La Mura has held a boxing corner man's licence. In addition to setting up the gym Mr La Mura and Mr Goodwin started working with boxers and attending fights with them, as part of their team. I will deal with that "agency" exercise separately.
23. Mr La Mura said he and Mr Goodwin had planned from the outset that QUEENSBERRY would be a brand with a boxing heritage used in both boxing itself and as a clothing brand. They were going to use the gym and work as a boxing agency as a platform to promote the brand and get it known nationally as a boxing and clothing brand. Mr La Mura drew an analogy with LONSDALE, which was then and remains a major clothing brand. It has an association with boxing but is a distinct clothing brand. Mr La Mura said they had met with Karen Byers of Sports Direct in 2005 and discussed their plans for the QUEENSBERRY brand. I accept there was a meeting but I reject Mr La Mura's evidence that it had anything to do with QUEENSBERRY. It was about LONSDALE.
24. One element in Mr La Mura's evidence was that the usage of the word QUEENSBERRY on the clothing on the various occasions which I need to consider was part of the working out of their plans to promote and use the name as a clothing brand. I accept that Mr La Mura and Mr Goodwin did contemplate the idea of a QUEENSBERRY clothing brand before May 2008. There are documents which support that. However the fact they might have had the idea of doing this does not mean that what they actually did had that effect and I will need to address the impact and effect of what they did in due course.

The gym

25. It is clear that there was a gym at Twinwood but the evidence about the nature and extent of the enterprise was sparse. There are no accounts or other records. The users seemed to be primarily friends of Mr La Mura or Mr Goodwin or perhaps friends of friends. There was no advertising, no entry in Yellow Pages, and no gym staff.
26. One user of the gym was Mr Clark. He said he left a £5 note on the desk whenever he used the gym, which was about 6 times per month. That is the only reliable evidence of anyone paying for the use of the gym at all.
27. Mr La Mura seems to have paid for things out of his own pocket. He said the rent for the gym was a nominal sum and said it was £200 per month which he paid to the landlord, a friend. I am not satisfied this is true. There is no record of it. Given the scale of the enterprise £200 per month is not nominal. Mr La Mura also said that trainers paid him £20 per session to take training sessions in the gym. I thought that had a ring of truth but there is no reliable evidence of how many trainers there were and how many sessions etc.
28. Mr La Mura did not declare any earnings to the Inland Revenue. He said he thought the gym made a loss at this stage but since he made no attempt to keep any kind of financial records I cannot say whether that is true. Mr La Mura said it was not a business, by which he meant not a limited company.

29. In his witness statement Mr La Mura said the gym was open from 9.00am until 10.00pm. I am not satisfied that is true. The gym seems to have been open in the evenings and perhaps at the weekend but I am not satisfied it was open regularly at all. It had no published opening times. Mr La Mura's evidence about this in cross-examination was confused. Mr Clarke sometimes arrived and it was not open.
30. There is no reliable evidence about the number of users of the gym in the period up to May 2008. Mr La Mura said he had around 100. Given the other exaggerations in Mr La Mura's evidence on points like this I suspect the true number is much lower.
31. I am sure the name QUEENSBERRY was used in association with the gym and I accept that the users knew of the gym under that name. Nonetheless concrete evidence about how the name was used is sparse. There was a banner marked "QUEENSBERRY BOXING GYM" and there were some t-shirts marked QUEENSBERRY as well.

t-shirts

32. It is clear that there were some t-shirts printed which simply carried the word QUEENSBERRY on a plain background. I am not satisfied that prior to May 2008 the t-shirts ever had anything on them other than the word alone. I accept Mr Howlett's evidence that these t-shirts did exist in 2005. I am not satisfied the number of t-shirts actually produced bearing the word QUEENSBERRY in any form up until May 2008 was anything other than tiny.
33. The thrust of Mr Clark's evidence was that when he trained at the gym everyone at the gym seemed to wear a QUEENSBERRY t-shirt and if there was someone at the gym he did not recognise who was not wearing the t-shirt, he assumed they were new. There is no evidence of sales of the t-shirts to the general public. I find that the t-shirts were sold to persons associated with the gym. The people associated with the gym included boxers, trainers and some others. The only concrete example of other users related to Bedford FC football players, who were trained at the gym by Mr Arnold.

Sponsorship

34. Mr La Mura said they sponsored Bedford FC. On any view this was not a commercial sponsorship arrangement. Mr La Mura was the person who paid for the kit at the football team and he said he arranged for it to be printed with the words "QUEENSBERRY 1867" on it. The documentary evidence that kits were printed in this way is only a quotation for the work to be done and does not prove it actually happened. Moreover although Mr La Mura asserts that all the kits of the various senior and junior teams until 2010 were "sponsored" in his way, there is good evidence that the under 9s team in 2008 had a different sponsor and the image of those boys winning the league cup does not show QUEENSBERRY on the front of their kit, which is where it would have been if it had been applied in the same manner as shown in the quotation document (which was for other kit). However Mr Arnold, who was the manager of the first team for 18 months until November 2008, said that the kit for the 2007/08 and 2008/09 seasons was sponsored by QUEENSBERRY. I accept Mr Arnold's evidence and therefore accept that some kit (but not for all teams), was marked QUEENSBERRY at least in the 2007/08 season. I do not accept that the sponsorship was as extensive as Mr La Mura contends.

The move to Tavistock Street

35. Mr La Mura said in his first witness statement that “on 14 July 2007 after the lease to the Twinwood Queensberry gym had expired, we decided to relocate our gym to larger premises on Tavistock Street, Bedford”. In fact there was no lease at all and it did not “expire”. The arrangement with the landlord relating to Twinwood was an oral informal arrangement, probably terminable at will. Sometime in 2007 (probably July) Mr La Mura was told the gym had to leave. The reference to a lease and to expiry is an example of attempts throughout Mr La Mura’s evidence to create the impression that what he and Mr Goodwin were doing at this time was a more substantial enterprise than it really was.
36. The gym moved to Tavistock Street, Bedford. It took some months to make the new premises suitable and I am not satisfied that the gym re-started until about January or February 2008. Mr Arnold seems to have used the building for training his players in late 2007 but that does not mean it was in a fit state to be a boxing gym. At Tavistock Street the name of the gym appears to have been QUEENSBERRY BOXING GYM. There was some evidence that the name of the gym at Tavistock Street might have been “Arena” but I accept that this was probably not the case.
37. There are no better records for Tavistock Street than there were for Twinwood. There is no basis on which to say that the enterprise run from Tavistock Street, at least until May 2008, was any more extensive than it had been at Twinwood.

The gym - summary

38. It is clear that Mr La Mura and Mr Goodwin ran a gym under the name QUEENSBERRY or QUEENSBERRY BOXING GYM in the period up to May 2008. The enterprise was not being run on a realistic commercial footing.

Boxing agency

39. On 14 August 2007 Mr La Mura and Mr Goodwin incorporated a company Queensberry Boxing Ltd with themselves as directors and shareholders. Mr La Mura said that they transferred the business they had established including “the Queensberry brand and the gym” into the company. There is no document conveying anything to the company and the company never filed any accounts and never traded. What is clear is that the company was to be a vehicle for a boxing agency business. That can be seen from a letter from Mr La Mura to Graham Everett, the manager of four boxers: Sam Sexton, and three brothers named Walsh. The letter attached a “non-contractual agreement” concerning Sam Sexton and a contract regarding the Walsh brothers. The Walsh contract proposed that the company would be paid 5% of any purse. The contracts were never signed.
40. What did happen was that Mr La Mura and others working with him helped these boxers at their fights as or as part of their team. The team members included Mr La Mura himself and others acting as corner men and cutsmen. Corner men sit in the boxer’s corner and help him. The particular role of cutsmen is to tend to a boxer’s cuts and bruises. It is clear that when they attended fights with these boxers, Mr La Mura as well as the relevant corner men and cutsmen wore polo shirts bearing the words “Queensberry Boxing” or “Queensberry Boxing.com”. Some of those fights

were broadcast on television. I will deal with the individual fights below. I will refer to Mr La Mura and the corner men and cutsmen who attended these fights as the Queensberry Boxing corner men.

The Queensberry boxing design with a boxing glove

41. In August 2007 Mr La Mura and Mr Goodwin arranged for a graphic designer to create a design for them. The end result was this:



42. It is clear that this gloves design was sometimes used on polo shirts worn by the Queensberry Boxing corner men at the boxing matches. This was not the only style of polo shirt they wore. Another design had the words "Queensberry Boxing. Com" in vertical lettering on the front and the gloves design on the back, above a logo for the clothing brand "Mr Power".

The domain names and a website

43. Also in August 2007 Mr La Mura and Mr Goodwin registered the following domain names:

www.marquessofqueensberry.co.uk

www.marquessofqueensberry.com

www.queensberryboxing.co.uk

www.queensberryboxing.com

www.queensberrysports.co.uk

www.queensberrysports.com

44. It is clear that these domain names were registered but it is not clear there was ever a website associated with any of them at any material time. The fact a domain name has been registered does not mean a webpage is necessarily available or at least does not mean a webpage other than a holding page placed by the registration company is available. There is a later email which implies no website had been launched at this time but Mr La Mura maintained that there had been at least a page of information available to anyone who went to the domain www.queensberryboxing.com in this period. Mr La Mura was adamant that a webpage was available but I am not prepared to place reliance on his testimony. There is evidence of a draft webpage headed "Manage, Promote, Mentor" but I am satisfied that this page was never available on the internet. There is no evidence anyone ever paid any hosting fee. There are emails in October 2007 between a web designer Richard Billington and Mr La Mura which imply that something was visible at the relevant domain after it had been registered which indicated that it might be a shop but I am not satisfied there was anything

relevant on the website at that time. The fact that in the email Mr Billington says he assumed Mr La Mura wished to sell a range of boxing clothes does not establish he learned that from looking at a website rather than being told it by Mr La Mura. I reject the submission that there was any kind of website prior to May 2008 which could assist the defendants in this case.

The sticker

45. Mr La Mura says a sticker was produced which consisted of an oval with the words QUEENSBERRY BOXING inside. He said it was used by sticking it onto various items which would be used by their boxers during a fight. I suspect this did happen to a very limited extent on buckets and water bottles used at the ringside but it was trivial.

Boxing gloves and other equipment

46. Mr La Mura said that in 2007 they began looking to develop a professional boxing glove. I accept they did this sometime but I do not believe anything material happened prior to October 2008. Although I am primarily focussing on the period up to May 2008, it is convenient to deal with this issue up to October, the date of filing of another of the claimant's marks, UK registered trade mark 2,499,451. I am not satisfied anything relevant was done about boxing gloves or any other boxing equipment by Mr La Mura prior to October 2008.

The fights

47. The defendants rely on a number of fights as occasions on which Mr La Mura contends his and Mr Goodwin's QUEENSBERRY clothing had exposure. I will take them in turn.
48. On 13 October 2007 a boxer Sam Sexton fought at the York Hall in Bethnal Green, London. The event was promoted by Mr Warren/Sports Network. Mr Sexton was sponsored by Lonsdale. Mr La Mura said that Mr Sexton wore a t-shirt in the changing room and around the venue which had QUEENSBERRY on it. There is no evidence on this apart from Mr La Mura's testimony. I am not satisfied it is true.
49. Mr La Mura also said that he and Mr Goodwin wore the QUEENSBERRY branded polo shirts before and after the fight. Although there is no proof this happened on this occasion, since it demonstrably did happen on other occasions a few months later I am prepared to accept it happened this time.
50. Mr La Mura said that a cutsman Mick Williamson had told him that in December 2007 he had worn a QUEENSBERRY polo shirt at the Floyd Mayweather v Ricky Hatton fight in Las Vegas which was on BBC television. I am not satisfied that this had any impact at all, if it ever took place.
51. On 12th January 2008 two boxers associated with Queensberry Boxing fought at York Hall. They were Paul Butlin and Sam Sexton. Given the video evidence, this clearly took place. I accept that Mr La Mura, Mr Goodwin and others in the team wore the Queensberry Boxing polo shirts. It is probable that Paul Butlin wore shorts with the words QUEENSBERRY BOXING on them somewhere although I do not accept Mr

La Mura's evidence that these words were on both legs of the shorts. I am not satisfied that it is true, as Mr La Mura says, that he spoke to Bob Longhurst of the British Boxing Board of Control about QUEENSBERRY. Nor am I satisfied that Sam Sexton wore a QUEENSBERRY t-shirt at any stage.

52. A question with important ramifications for this case is whether Mr La Mura spoke to Ed Simons at this fight because it is a few days before Mr Simons and Mr Warren took certain steps which the defendants contend is not a coincidence. I will deal with that below.
53. 2nd February 2008 was a debut fight for the three Walsh brothers, Ryan, Liam and Michael. This took place as part of an event called the Wrath of Khan at the ExCel Centre in London due to the involvement of the boxer Amir Khan. Amir Khan's fight was the main event. It is clear that the Walsh brothers fights were broadcast although I am not satisfied the audience figures for the main event are any guide to the size of the audience for the brothers' fights either at the centre or on television.
54. I accept that Mr La Mura, Mr Goodwin and others in the team wore the Queensberry Boxing polo shirts and I find that the Walsh brothers themselves wore kit which had the word QUEENSBERRY on it somewhere. I reject Mr La Mura's evidence that fans of the Walsh brothers approached the team at the event and asked for QUEENSBERRY branded t-shirts. It is much more probable that the t-shirts the fans sought were ones marked "Team Walsh".
55. It is clear that there was contact between Mr La Mura and Mr Warren and his associates at this fight. I will deal with the details of that below.
56. On 8th March 2008 was another fight involving the Walsh brothers. It was at the O2 Arena in London. There is no video evidence but I can accept the team wore the Queensberry Boxing polo shirts and, probably, there was some use of QUEENSBERRY on the boxer's clothing. I do not accept Mr La Mura's evidence that they were being asked at the fights where people could get hold of the clothing the boxers were wearing.
57. On 11th April 2008 Paul Butlin fought at York Hall. I accept that the Queensberry Boxing polo shirts were worn as before and that Mr Butlin had shorts with the word Queensberry on them somewhere. Mr Campbell was present at that fight and noticed the QUEENSBERRY BOXING logo on the shorts.
58. The only other event prior to 8th May 2008 was a fight in Hamburg but nothing separate arises from that.

Activities of Mr Warren and Sports Network

59. Mr Warren said that from 2002 onwards he had been discussing developing a boxing brand with Mr Earl. He had considered buying LONSDALE but it was acquired by Sports Direct and in 2004 another boxing brand TITLE (which was associated with the EVERLAST branded boxing equipment) was also acquired by Sports Direct.
60. In 2005 or 2006 Ed Simons was introduced to Mark Thurston of a company called Strikeforce which owned a UK registered trade mark 2 410 709 for a device

consisting of the word QUEENSBURY and a Q on a shield surrounded by a laurel wreath with the date 1901. It is registered in class 25 for “Articles of clothing; footwear; headgear”. In July 2006 Sports Network negotiated to buy the mark from Strikeforce for £38,000. In fact the correct spelling of the word in the context of boxing is with an E, i.e. QUEENSBERRY and the date of 1901 has no significance in boxing, unlike 1867. The issue of the correct spelling was something which was discussed by Ed Simons at the time. This episode is sufficient to satisfy me that the idea of a clothing brand playing on the heritage associated with boxing of the name QUEENSBURY as well as QUEENSBERRY was being actively contemplated by Mr Warren and his associates in 2006.

61. The significance of this activity in 2006 is that it took place before there could be any suggestion of an influence from anything done by Mr La Mura and Mr Goodwin. However it is also the case that the QUEENSBURY mark itself was not in fact purchased until 2008. I will now consider what else Mr Warren’s organisation did about the mark in the intervening period.
62. Mr Warren said that in late 2007 he opened discussions with an internet media company to launch a dedicated boxing internet TV channel. I accept that. He also said that he intended the channel to be the platform he needed to attach to the QUEENSBERRY brand and that it was to be called the Queensberry Fight Network. I do not accept things are that simple. On 11th January 2008 there is evidence the channel was to be called the Frank Warren Boxing Channel.
63. On 15th January 2008 the agreement was reached with Strikeforce to buy the QUEENSBURY trade mark. It is clear that at that stage Mr Warren and Mr Earl saw it as a retail brand. Although it is not entirely clear, for what it is worth I accept that the association between the channel and QUEENSBERRY or QUEENSBURY probably occurred at that time or shortly afterwards. Also on 15th January, Ed Simons gave instructions to register a Gibraltar based company called Queensberry Rules Ltd and on 24th January Ed Simons emailed Mr Earl to let him know of a potential three year deal with the British Boxing Board of Control for the name QUEENSBERRY or QUEENSBURY to appear on referees shirts.
64. The assignment of the QUEENSBURY trade mark took place on 2nd May 2008. On 8th May the application for the 784 QUEENSBERRY trade mark was made at the UK IPO by the Gibraltar company.

Contacts between Mr Warren and Mr La Mura up to May 2008

65. The contact between these two camps is relevant to the bad faith ground of invalidity of the 784 mark.
66. It was not disputed by Mr Warren that he had met Mr La Mura in the context of Mr Warren’s work as a boxing promoter. Despite that Mr Purvis appeared to cross-examine Mr La Mura on a different basis at one point but nothing turns on that. Mr Warren also accepted that he spoke to Mr La Mura about purses and tickets for the Walsh brothers fights. That meeting was in March 2008 and I will deal with it in its place in the chronology.

67. The defendants contend that Mr Warren and his associates must have seen the polo shirts worn by the Queensberry Boxing corner men and the other instances of use of QUEENSBERRY at the relevant fights, many of which were promoted by Mr Warren. I am not prepared to draw that inference as a matter of generality. The fights in which the boxers linked to Mr La Mura were fighting were minor events or minor parts of the overall major events. The usage was not prominent. There is no reason why Mr Warren or anyone working with him should have noticed. There is evidence that Mr Clarke, who was a user of the gym, noticed the usage when he was watching a boxing match on television but since he knew the gym that does not show that others would notice. Mr Campbell of Lonsdale also noticed the usage but I find that was because of Mr Campbell's special interest in the Lonsdale clothing brand.
68. The defendants also contend Mr La Mura or others associated with him had direct contact with Mr Warren or his associates at the fights.
69. Sam Sexton was a boxer contracted to Mr Warren with sponsorship arrangements with Lonsdale and Carl Moore. I am not satisfied there was any relevant link between the two camps relating to Sam Sexton or what he might have worn.
70. The first specific allegation of contact between Mr La Mura and the Queensberry Boxing corner men on one side and Mr Warren or his associates on the other relates to the fight on 12th January 2008. Mr La Mura said that Ed Simons asked him about the QUEENSBERRY brand and that he told Mr Simons it was their own clothing and boxing brand they had launched. Mr La Mura said he vividly remembered Mr Simons commenting that he liked the polo shorts and that QUEENSBERRY was a great name. There is nothing to corroborate Mr La Mura's evidence but of course the claimant has not called Mr Simons to contradict him. A telling point is that in a witness statement before the IPO which relates to the same fight, Mr La Mura referred to Mr Simons' presence at this fight but did not mention what he now claims to vividly remember. I am not satisfied Mr La Mura's evidence is true. I find that nothing happened on 12 January 2008 to alert Mr Warren or anyone associated with him such as Mr Simons to what Mr La Mura was doing.
71. There is no doubt Mr Warren was at the Wrath of Khan event on 2nd February 2008. It is also plain that Mr Warren spoke to Mr La Mura at the ringside at that event. We know this because there is film footage of it. Mr La Mura said Mr Warren could not have failed to notice that he (Mr La Mura) and the rest of his team were wearing their polo shorts which carried the words QUEENSBERRY BOXING .COM. Mr Warren said he did not remember seeing the name at that event. Whether he remembers it or not, in my judgment Mr Warren must have noticed the QUEENSBERRY name on the polo shirts worn by Mr La Mura and his associates for the simple reason that Mr Warren was already interested in that name at that time, independently of Mr La Mura.
72. Moreover Mr La Mura said that Ed Simons, Dean Powell and Andy Ayling were present at this match and I accept that. It is inherently probable. I also accept Mr La Mura's evidence that Dean Powell and Andy Ayling noticed the word QUEENSBERRY on Mr La Mura's polo shirt since if it was not true Mr Warren could and would have called those individuals to contradict it.

73. Nothing turns on whether there was any further contact between the two camps at the fights after 2nd February 2008.
74. A meeting took place between Mr Warren and Mr La Mura on 17th March 2008. The meeting was primarily concerned with tickets and purses relating to the Walsh brothers. Mr La Mura produced a hand written note which he wrote and which is consistent with that. Mr La Mura also said that he and Mr Warren discussed the QUEENSBERRY brand at the meeting and he asked if Mr Warren would consider endorsing Mr La Mura's brand more regularly at his fights. Mr La Mura said he asked Mr Warren if he would consider endorsing the gym. He said Mr Warren seemed interested in QUEENSBERRY but "did not comment otherwise on our brand or what we were doing."
75. Mr Warren accepts the meeting took place but did not recall Mr La Mura ever mentioning QUEENSBERRY or QUEENSBERRY BOXING at all. He had not seen the handwritten note before.
76. I think it is more likely than not that QUEENSBERRY was mentioned at the meeting, given it is referred to in the note, but only in a manner which added nothing to what took place at the Wrath of Khan fight in February.

The law

77. The test applicable under s5(4)(a) of the 1994 Act is whether at the date of the application, i.e. 8th May 2008, normal and fair use of the 784 mark in relation to the relevant goods and services could have been prevented by Mr La Mura and Mr Goodwin by an action for passing off (see Wild Child 1998 RPC 14). The law of passing off, as classically stated by Lord Oliver in Reckitt & Colman v Borden requires the three elements of goodwill, misrepresentation and damage.
78. Section 3(6) of the 1994 Act provides that a mark shall not be registered if or to the extent that the application was made in bad faith. The test was summarised by Lindsay J in Gromax [1999] RPC 267 at 379 as being conduct involving dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. The CJEU in Chocoladefabriken Lindt & Sprungli (Intellectual Property) [2009] EU ECJ C-529/07 held that bad faith must be the subject of an overall assessment and also listed three factors to take into account: (i) whether the applicant knows or must know that a third party is using an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought; (ii) the applicant's intention to prevent a third party from continuing to use such a sign and (iii) the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought.
79. Mr Purvis also referred to the recent decision of the CJEU in Malaysia Dairy v Ankenævnet for Patenter og Varemærker Case C-320/12 [27 June 2013]. In this case the court held that when considering the overall assessment in relation to the bad faith ground, "*the fact the applicant knows or should know that a third party is using such a sign is not sufficient in itself to permit the conclusion that that applicant is acting in bad faith. Consideration must, in addition, be given to the applicant's intention at the time when he files the application for registration of a mark, a subjective factor which*

must be determined by reference to the objective circumstances of the particular case.” This must be right. If a business person decides entirely independently that they are going to register a given trade mark for a particular set of goods, the fact that they might happen to find out that someone else is also interested in the same thing cannot necessarily put them in a worse position. The issue will be highly sensitive to the circumstances.

80. Section 11(3) provides that a registered trade mark is not infringed by the use in the course of trade in a particular locality of an earlier right which applies only in that locality. An earlier right means an unregistered trade mark or sign continuously used in relation to goods or services by a person or their predecessor in title from a date before the registration of the registered trade mark. If and to the extent that a person has a right protected by the law of passing off then they have an earlier right.

Apply to facts

Passing off - s5(4)(a)

81. The essence of the defendants’ case is simple. Mr Wyand pointed out that the evidence showed that Mr La Mura had been selling t-shirts marked QUEENSBERRY before May 2008 and had applied the mark to other items of clothing such as polo shirts and shorts before that date. The brand had been used at the gym and at boxing matches, with exposure on television to a wide audience. He submitted this showed that the passing off ground was made out and so a registration for QUEENSBERRY for clothing filed on 8th May 2008 must be invalid under s5(4)(a).
82. Mr Purvis did not agree. He argued that there is no proof there was any business at all in existence before May 2008 to which goodwill could attach. Moreover if there was any sort of business it was a gym or agency business. The fact that some garments carried the word QUEENSBERRY on them did not mean that the sign would be understood by anyone as a clothing brand. It was not an indication of the origin of the clothing. The s5(4)(a) ground should be rejected.
83. I first need to determine what goodwill if any did Mr La Mura and Mr Goodwin have as at May 2008.
84. Mr Purvis urged on me that there was not a business at all. I do not accept that. I test the matter this way. If a rival boxing gym had opened up in Bedford under the name QUEENSBERRY then I think a successful claim for passing off could have been brought. There was (just) enough of a business to which a goodwill could attach, and sufficient goodwill among people in the boxing fraternity around Bedford, to mean that those people would associate the name QUEENSBERRY with the boxing gym which had existed at Twinwood or Tavistock Street since 2004. If another boxing gym opened up under the same name, albeit the name is not very distinctive in relation to boxing, they would be likely to be deceived. Although the evidence about who exactly was running this gym is as unclear as everything else, I think a fair inference is that the proper claimants in such a claim would have been Mr La Mura and Mr Goodwin.

85. Nevertheless the gym business was tiny and the geographical extent of its goodwill was entirely localised in and around Bedford, amongst users or potential users of a boxing gym.
86. I do not accept that the attendance of Mr La Mura and the other Queensberry Boxing corner men at fights with the various boxers means that there was any genuine boxing agency business in existence up to May 2008. At best this activity can only be regarded as promotion for the gym. I appreciate that the Queensberry Boxing corner men had appeared at a few fights which were broadcast nationally but I am not satisfied that this gave Mr La Mura and Mr Goodwin sufficient goodwill to succeed in a passing off claim relating to anything on a national scale. There was an argument about the rules of boxing which required boxers to train in local gyms. No doubt that is true but it does not make any difference. The goodwill was associated with the gym and therefore was located around the Bedford area.
87. The defendants' case is that because the word QUEENSBERRY appeared on clothing, that meant that QUEENSBERRY was a clothing brand and that Mr La Mura and Mr Goodwin had acquired a goodwill relating to the mark as a clothing mark. In order to consider that submission I need to consider what a member of public would think on seeing the t-shirt or the other garments. The fact that a word appears on clothing does not automatically mean the sign is being used as a clothing trade mark and does not mean it would be necessarily understood by anyone as such.
88. First the t-shirts. These were only sold to persons associated with the gym. In my judgment the name on the t-shirts was an indicator that the person was a member of the gym. The name QUEENSBERRY on the t-shirts was and was understood to be purely a reference to the gym. It was not being used as a clothing brand and there is no evidence anyone thought it was being used that way.
89. Second the polo shirts. These were worn by the Queensberry Boxing corner men at the fights. They could be seen by the audience at the fights and glimpses were visible on television. Absent any other evidence, I think anyone seeing these polo shirts who noticed the word QUEENSBERRY or the words QUEENSBERRY BOXING .COM would take them as the name of a boxing team or stable. Clearly the team or stable would be thought to have a website from the words ".com". There was nothing to indicate this was a sign which was an indicator of the origin of the clothing.
90. Third the shorts worn by the boxers. The defendants relied on the evidence of Mr Campbell, the manager of LONSDALE. He was present at the fight on 11 April 2008 and recalls seeing what I have called the gloves logo on the shorts of the boxer Paul Butlin. Mr Campbell said he did not know who owned the brand at that time but he recognised it was a boxing brand. I am sure the only reason Mr Campbell noticed it at all was because of his interest in LONSDALE. The boxing gloves logo was on a pair of shorts which were branded LONSDALE which Mr Butlin was supposed to be wearing. Mr Campbell thought it was a bit cheeky. The defendants contended that Mr Campbell recognised it as a clothing brand on that occasion. I do not accept that. I think Mr Campbell saw it was a boxing brand (no doubt given the fact the words are QUEENSBERRY BOXING). It was obviously a website of some sort but he did not know what sort. Finally even if Mr Campbell did think this usage indicated that the QUEENSBERRY name was being used as a clothing brand, Mr Campbell's special

position means he is not representative of the public. I reject the argument that this usage amounts to an indication that QUEENSBERRY was a clothing brand.

91. The name QUEENSBERRY may have appeared on other items (including as part of a sticker on things other than clothing) but all this was so trivial that I do not accept it had any impact at all.
92. Separately although it is not strictly relevant, I will address Mr La Mura's intentions. Although it is clear that he and Mr Goodwin did think of the idea of using QUEENSBERRY in a wide context, including as a clothing mark, I am not satisfied that at any stage up to May 2008 Mr La Mura and Mr Goodwin were seeking to actually use it in this way as a clothing brand. What they thought they were doing was using the name to refer to and promote their gym and inchoate agency business.
93. In conclusion on goodwill, I accept that Mr La Mura and Mr Goodwin had a right, protectable in passing off, to prevent someone else opening a gym in Bedford and calling it QUEENSBERRY but their goodwill did not extend any further. They had no goodwill as a boxing agency and no goodwill in or relating to clothing.
94. Even if the owner of a protectable goodwill has not generated any goodwill outside the sphere of their business, it is possible that usage outside that field could lead to passing off (*Lego v Lemelstrich* [1983] FSR 155). The question in this case is whether the rights Mr La Mura and Mr Goodwin had in May 2008 could have restrained sale of QUEENSBERRY branded clothing in May 2008.
95. Even if I consider the sale of QUEENSBERRY branded clothing in Bedford, which puts the matter as much in favour of the defendants as possible, I reject the idea that anyone seeing such clothing would think it had anything to do with Mr La Mura. The goodwill was tiny and was focussed on a gym and at best as a boxing team or stable. The small number of people associated with the gym or the team had clothes with the name on them to show they belonged to that group. That is all. No-one would be likely to be deceived by seeing an item of clothing branded QUEENSBERRY.
96. I find that at 8th May 2008 Mr La Mura had no right in the law of passing off to prevent anyone from using the word QUEENSBERRY as a trade mark in relation to articles of clothing; footwear; headgear. I reject the challenge to validity based on s5(4) of the Act. The 784 mark is not invalid on this ground.

Bad faith

97. For the purposes of considering bad faith in this case, the relevant state of mind is that of Mr Warren. I am satisfied he exercised control over and bore ultimate responsibility for all relevant aspects of the matter. Despite the claimant's case I find that prior to May 2008 Mr Warren must have known that Mr La Mura and Mr Goodwin were using the name QUEENSBERRY.
98. Thus the 784 trade mark was applied for in the knowledge that Mr La Mura and Mr Goodwin were using the sign QUEENSBERRY in some way. However that alone is not sufficient to give rise to bad faith within s3(6). There are two further critical points. First, Mr Warren had already conceived of using QUEENSBERRY (spelled this way) as something his business was interested in exploiting as a clothing brand.

Not much had been done about it but Mr Warren did not get this idea from Mr La Mura or Mr Goodwin. Second, I find that what Mr Warren must have known was that Mr La Mura and Mr Goodwin were using the name as the name of a gym and/or a boxing team or stable. The fact the name appeared on clothing did not fix Mr Warren or his associates with notice that Mr La Mura or Mr Goodwin intended to use it as a clothing brand. They were using it this way to promote their gym and agency business. The reference to a QUEENSBERRY website does not advance the defendants case since that was consistent with their use of it to promote their gym and agency business.

99. Considering the second and third Lindt factors, the registration of the 784 mark for clothing was not done by Mr Warren to stop Mr La Mura or Mr Goodwin from continuing to use the sign as the name of a gym or a boxing agency. Moreover the degree of legal protection which Mr La Mura or Mr Goodwin would have had at the time was only their rights available in passing off. All that they could have prevented was use of the word as the name of a boxing gym in Bedford.
100. Taking all this together, I find that the application for the 784 mark was entirely acceptable commercial behaviour. At the very most, on seeing or being told about what Mr La Mura and Mr Goodwin were doing, someone in Mr Warren's position might have thought that there might be a risk that in future they might diversify into clothing but even if Mr Warren thought that, and I doubt he did, it does not matter. The idea of using the mark as a clothing mark did not come from them, he had conceived it already independently. They were not using it as such at the time and a prudent business man would therefore realise he needed to apply for a registered trade mark in class 25 to secure his rights. That fact that Mr Warren could be said to have won a race to the trade mark register in these circumstances does not amount to bad faith. I reject this challenge to validity.

The s11(3) defence

101. On my findings the section 11(3) defence cannot assist the defendants. The defendants' predecessors in title were not using the mark QUEENSBERRY as a clothing mark on 8th May 2008 in any locality. If the claimant sought to prevent the defendants running a boxing gym or associated agency in Bedford that would be a different question but no such claim is made in this case.

Conclusion so far

102. Thus based on the events up to May 2008, there is nothing which impugns the validity of the 784 mark. I now turn to consider the impact of what happened after May 2008.

The period from May 2008 until today

103. The events after May 2008 do not need to be scrutinised in as much detail as the events up to that date.
104. In May 2008 Mr Earl started discussions with Mr Newland which led to Mr Newland producing a new QUEENSBERRY logo with wings and words and the words QUEENSBERRY SINCE 1867 underneath. This winged logo is the one which was registered as a trade mark by Mr La Mura in 2010.

105. After May 2008 Mr La Mura and Mr Goodwin continued to do what they were doing, attending fights and so on. On 26th June 2008 they applied to register the '149 mark in the name of QBL in classes 16, 25, 35, 41 and 42. This consisted of a device comprising the words QUEENSBERRY BOXING 1867 in a rectangle as follows:



106. Mr La Mura and Mr Goodwin used it in a similar way to the way they had used the earlier gloves device before.
107. On 24th July 2008 the claimant applied for the 623 mark (QUEENSBERRY RULES) in classes 25, 35, 41 and 42.
108. On 6th October 2008 the claimant applied for the 451 mark (QUEENSBERRY) in classes 3, 5, 9, 14, 16, 18, 24, 28, and 29 and for the 454 mark (QUEENSBERRY RULES) in the same classes.
109. On 7th November 2008 the claimant applied for a Community Trade Mark (7,376,395) in classes 3, 5, 9, 14, 16, 18, 24, 25, 28, 29, 30, 35, 41 and 42 (i.e. all the classes previously applied for).
110. In December 2008 Mr Warren's Gibraltar Company QRL filed an opposition against QBL's 149 mark. It was based on the earlier 784 mark. Ultimately the opposition was partially successful and the specification of the 149 mark was amended to remove the goods claimed in class 25 (clothing etc.) and class 42 and remove parts of classes 35 and 41.
111. On 1st March 2009 Mr La Mura and Mr Goodwin purported to assign the 149 trade mark and all associated goodwill back from QBL to themselves individually. As I mentioned above, there was no written assignment. All there has ever been is a TM16 form dated 1st March 2009 informing the UK IPO that the mark had been assigned.
112. In April/May 2009 a meeting took place between Mr La Mura, Mr Goodwin, Ed Simons and Mr Warren. At this meeting a basis was established on which the parties would work together in future. The parties were Mr La Mura and Mr Goodwin on one side and Mr Warren and Mr Earl and their companies on the other.
113. Mr Warren characterised the arrangement as one in which Mr La Mura's and Mr Goodwin's role was simply to develop the brand on boxing equipment such as gloves and punch bags but that Mr Warren's side would handle all other aspects of the venture including clothing and promotion. Although the focus of the work to be done by Mr La Mura and Mr Goodwin in this period was with boxing equipment, I do not accept Mr Warren's characterisation as a complete description of the arrangements. The basis on which the working relationship was established was summarised in an email from Mr Simons to Mr Earl on 12 June 2009 as follows:

“I met with the two guys that have the ‘Queensberry 1867 Boxing’ business and have persuaded them to fold their operation into Queensberry Rules Limited for a 10% stake of the overall operation. This will include all of the domain names that they have registered and Frank and I believe this is really worthwhile doing. They are two good guys who have managed a number of boxers and we could include all their boxers as part of the deal.

As you are aware we have objected to their Trademark Registration and certainly our Trademark precedes their application, however, they can prove they were operating prior to our application and they could succeed. In any event, it would cost more money to fight it. If we do this deal we will then have the three Marks under one umbrella:-

Queensberry Rules

Queensberry

and Queensberry Boxing 1867

and I am really confident we could make this work.”

114. This email is a fair reflection of how things stood at this stage in a number of important respects. First both sides had agreed at least in principle that they would work together. Second part of the agreement was that Mr La Mura and Mr Goodwin were to get 10% of the business. Third was a recognition that Mr La Mura and Mr Goodwin may have been operating before the 784 application, as I have found they were, albeit not to the extent they contend for.
115. It is important to stress that no binding contract was entered into at this or any other meeting. A business sale agreement was drafted which reflected the terms referred to in the email and a version of it was signed by Mr La Mura and Mr Goodwin, but the transaction was never completed. Nevertheless I am quite sure that as far as Mr La Mura, Mr Goodwin, Mr Simons and Mr Warren were concerned, from the period of the April /May 2009 meeting onward, the parties were working together with a view to setting up the business on terms the details of which would eventually be agreed. This continued until about April 2011. At that stage a final attempt to agree terms was made involving a draft Subscription Deed but no agreement was reached. After April 2011 both sides knew that they were not working together any more.
116. In the period after April 2009 various things were done by Mr La Mura and Mr Goodwin. This included use of the Queensberry Boxing 1867 device at fights sponsored by Mr Warren. There were discussions in late 2009 about a design for a logo for QUEENSBERRY. It was at this stage that Mr La Mura was sent a copy of Mr Newland’s winged QUEENSBERRY logo. He says he was not told that it had been designed a year earlier. I have no reason to doubt that but nothing turns on it. There is no doubt Mr La Mura did not design Mr Newland’s winged QUEENSBERRY logo.

117. Mr La Mura also gave evidence that he and Mr Goodwin had sold a number of QUEENSBERRY branded sparring gloves (50 or 60) and some QUEENSBERRY t-shirts and punch bags. The sale of gloves was with the consent of the claimant (strictly its predecessor) and the gloves were approved by Mr Warren. Mr La Mura had tried to be reimbursed about the costs relating to it. The sales of t shirts and punch bags were to Paul Butlin who set up his own gym in Melton Mowbray in 2010 and, at least for a period appears to have called it QUEENSBERRY although he changed its name afterwards. There is no evidence the claimant or its predecessor knew anything about the sales to Paul Butlin.
118. The Bedford gym appears to have burnt down at one stage, I think in 2010, but the evidence is unclear and nothing turns on it. It might have mattered in relation to the s11(3) defence (above) but in the end it did not.
119. On 12th October 2010 Mr La Mura applied for the 131 mark consisting of Mr Newland's winged QUEENSBERRY logo in classes 25, 28 and 35.
120. On 28th April 2011 Mr La Mura applied for the 880 mark in classes 25, 28 and 35. It is almost the same as the logo in the 131 mark and stands or falls with it.
121. In February 2012 Mr La Mura, Mr Goodwin and also Mr Goodwin's wife Theresa Goodwin (who had been involved with the domain names) assigned whatever rights they had to the second defendant. This transfer came to the attention of the claimant and on 22nd March 2012 the claimant's solicitors wrote to the second defendant. The letter pointed out that the claimant owned amongst other things the 784 trade mark and stated the claimant's position that putting QUEENSBERRY on goods covered by its marks would be an act of infringement.

Issues arising from events after May 2008

122. The significance of the events after May 2008 in relation to the 784 mark is twofold. The defendants contend that these events mean that the 784 mark is invalid under s46(1)(d) and they also contend that the claimant is not entitled to relief on the basis of acquiescence or estoppel.

Acquiescence / estoppel

123. I can deal with this point briefly. The defendants submitted that the claimant (or its predecessor) had permitted Mr La Mura and Mr Goodwin to build up a goodwill in QUEENSBERRY in the period after April/ May 2009 and that it would be unconscionable to prevent them or their successors from making use of that goodwill in future. I do not accept that for the following reasons. First I am far from satisfied that anything was done in the relevant period which built up any goodwill at all. The sales of gloves and other equipment was truly trivial. The usage of the QUEENSBERRY BOXING 1867 logo at fights might have built up some recognition but I am not satisfied about what that recognition would have related to. Second, the major steps relied on were undertaken at a time and in a context in which both sides were working toward coming to a mutual agreement. The fact the agreement was not reached does not make it unconscionable for either party to rely on their underlying legal rights. Third, the position was made clear by the claimant's letter of March 2012. The benefit of any permission or acquiescence by the claimant or its

predecessors was terminated by that letter. I reject the defence based on acquiescence or estoppel.

s46(1)(d)

124. Section 46(1) (c.f. Art 51(1)(c) of Council Regulation 207/2009) provides that the registration of a trade mark may be revoked on the ground:

(d) that in consequence of the use made of it by the proprietor of with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

125. In my judgment this point is hopeless. Nothing Mr La Mura or Mr Goodwin did before the April/ May 2009 meeting was with the proprietor's consent. The goods sold after that time were a few boxing gloves but they were approved by Mr Warren and cannot make out a case under s46(1)(d). The goods sold to Mr Butlin were not sold with the proprietor's consent. Nothing which happened after April/May 2009 has been on a sufficient scale to begin to render the mark invalid on this ground.

Conclusion on the 784 mark

126. I have rejected all the attacks on the validity of the 784 mark and I have rejected all the defences advanced by the defendants.

127. There was no dispute that if the mark was valid, the clothing the defendants intended to sell, which is all prominently branded QUEENSBERRY, did or would infringe the claimant's 784 trade mark.

A passing off claim by the defendants

128. The claimant's case is that it is entitled to use QUEENSBERRY in relation to clothing and sports equipment or licence others to use it but by a counterclaim on behalf of the second defendant, it is contended that any such use would amount to passing off on the basis that the second defendant is the owner of a goodwill associated with QUEENSBERRY relating to "*clothing, footwear, headgear, boxing services, boxing and sporting equipment, bags and other sports accessories, the operation of gymnasiums, boxing training services, management of sportspersons, sports promotional services and sporting events*" (paragraph 17 of the Re-Amended Defence and Counterclaim).

129. The second defendant is the successor in title to whatever goodwill was generated by Mr La Mura and Mr Goodwin throughout the period I have considered above. Assuming in the defendants favour that the goodwill associated with the Bedford gym continues to this day, it remains the case that the goodwill associated with the gym does not relate to clothing nor to the sale of any other articles (neither footwear, headgear, boxing and sporting equipment nor bags nor other sports accessories). The gym goodwill is extremely limited in nature.

130. The defendants' definition includes the following services: "*boxing services, boxing training services, management of sportspersons, sports promotional services and sporting events*". I rejected the claim to goodwill in a boxing agency as at May 2008. The Queensberry Boxing corner men continued to attend fights wearing their polo shorts after May 2008 and I take into account the fact that Mr La Mura's QUEENSBERRY BOXING 1867 logo appeared at a number of fight venues. At best this means that today there might be some very small recognition amongst boxing fans of this logo but all it can be associated with is the minimal activities carried out by Mr La Mura and his friends and their work with a very small number of boxers. I am not satisfied that anything carried out after that improves the defendants' position.
131. No-one seeing clothing or sports equipment sold by the claimant or its licensees would be likely to consider those goods had anything to do with the gym in Bedford or with the other activities relied on by the defendants. I reject the counterclaim based on passing off.

Copyright claim

132. The action includes a claim for copyright infringement relating to the winged logo. Clearly the claimant owns the copyright in the artistic work created by Mr Newland. Clearly Mr La Mura had no right to apply to register trade marks which comprised that logo and the defendants have accepted that those marks or applications should be revoked/withdrawn. Clearly anyone who used that mark by applying it to goods would reproduce the logo and, given the lack of any permission from the claimant, would infringe. The defendants accept all this but they contend that they have no intention of doing this at all and should not be found to be threatening to infringe. The claimant relies on the fact that the winged logo marks were assigned to the second defendant and infers that the other defendants therefore will make and sell goods under the mark. Neither party showed any enthusiasm for this issue given that the registered trade marks are to be revoked. In my judgment the defendants (as opposed to Mr La Mura) have shown no intention to use the winged logo and made no threat to do so. Accordingly I reject the claim for copyright infringement.

Acts of the first defendant

133. The defendants contend that the first defendant is not and never was going to commit any relevant acts such as selling QUEENSBERRY branded clothing. They also contend that there is no basis on which to make the first defendant liable as a joint tortfeasor in relation to any sales by the third or fourth defendants. Again neither party showed any enthusiasm for this issue. I am satisfied that the first defendant has not and was not going to commit any of the acts complained of by the claimant in this case. As for joint tortfeasance, I have not had my attention direct to any evidence which could make out a case for liability as a joint tortfeasor. I reject the claim against the first defendant.

Validity of the claimant's later marks

134. The claimant accepted that the 709 (QUEENSBURY) mark has not been used in the relevant 5 year period and should be revoked.

135. The second defendant advanced a number of other grounds of attack against the claimant's other trade marks, i.e. 623, 451, 454 and CTM 395. The second defendant pleaded attacks on these marks based on s5(3) (unfair advantage etc.) but this argument was not advanced at trial, no doubt because the earlier trade mark relied on could not be shown to have acquired a reputation in the United Kingdom. I will deal with the remaining grounds below.
136. One ground was revocation based on section 46 (or Art 51(1)(c)) but that is the same as the s46 attack on the 784 mark. It cannot succeed against the other marks if it failed against the 784 mark and so I reject that ground.
137. Next was invalidity based on bad faith (s3(6) or Art 52(1)(b)). Although the dates on which the analysis has to be applied differ for each mark, these arguments are based on the same essential point as the bad faith attack on 784 (knowledge of what Mr La Mura and Mr Goodwin were doing) and will not succeed if that attack fails. If the specifications of goods or services of these other marks had included running a gym then it might be different, but they do not. I reject those bad faith attacks.
138. Next was invalidity based on prior unregistered rights (s5(4)(a) or Art 53(1)(c)). Again although the circumstances differ for each mark, the arguments in each case are based on the same essential point as the s5(4)(a) argument about the 784 mark albeit that many of the goods and services covered by the other marks are different from those covered by the 784 mark. Given that the s5(4)(a) argument in relation to the 784 mark has failed, these attacks cannot succeed and I reject them.
139. The second defendant's best ground for challenging the validity of parts of the specifications of some of the claimant's other marks was based on the second defendant's earlier registered right (the 149 mark QUEENSBERRY BOXING 1867) and s5(2) or Art 53(1)(a) as the case may be. In closing Mr Wyand referred to a table attached to his skeleton Argument summarising the second defendant's case showing which goods or services covered by the '149 mark are applicable against which goods covered by the 451, 395 and 454 registrations. The table does not mention the s5(2) attack on the 623 mark. That is sensible. The 623 mark is for QUEENSBERRY RULES in classes 25, 35, 41 and 42. In the light of my findings about the 784 mark and even if the other s5(2) arguments summarised in the defendants' table succeeded, this attack would not succeed. I reject it.
140. The question I am left with is the s5(2) ground against the 451, 395 and 454 registrations based on the earlier 149 mark. The law on this is well established. The second defendant has to show similarity between the marks, similarity between the goods and/or services and by reason of that similarity a likelihood of confusion. The assessment is a global assessment (*Sabel v Puma* [1998] ETMR 1, *Canon v MGM* [1999] ETMR 1 etc.). The Trade Marks registry has developed a summation of the guidance of the CJEU on some aspects of the global assessment which was approved by the Court of Appeal in *Specsavers v Asda* [2012] FSR 19 at paragraph 52. I will not set it out. One element is to consider whether and to what extent the earlier mark has acquired an enhanced distinctive character through use. Another element to mention is interdependence: as the goods or services become less similar, the marks would have to be more similar in order for confusion to be likely.
141. In relation to goods in class 16 the '149 mark is registered for:

Advertising promotional and marketing materials; souvenirs and mementos; books, magazines, programmes, leaflets and newsletters; stationery of all types; photographs; posters; tickets

142. These class 16 goods are said to be relevant to the following goods in class 16 covered by all three of the claimant's marks 454, 395 and 454:

printed matter, pictures, posters, prints, printed cards, stationery, greeting cards, calendars, transfers, gift paper, gift tags

(note that for the '395 CTM, although it claims priority for some goods from the 784 application, that does not apply to these goods)

143. In relation to services in classes 35 and 41 the 149 mark is registered for:

Class 35

Agency and business management services for sporting and entertainment clients; retail services connected with the sale of stationery, books, magazines, programmes, tickets, photographs, posters, leaflets and newsletters, souvenirs, mementos and memorabilia

Class 41

Provision of training for sports and general entertainment purposes; provision of sporting and cultural activities and entertainment; provision and operation of fan clubs; provision of electronic games including through the Internet

144. These services in classes 35 and 41 are said to be relevant to the following goods in classes 18 and 28 covered by all three of the claimant's marks 454, 395 and 454:

451 mark and 395 CTM

Class 18

Sports bags, athletic bags

Class 28

Gymnastic and sporting articles, equipment and apparatus; sporting articles for use in boxing, gymnastics; balls for use in sports; sports bags

454 mark

Class 28

Gymnastic and sporting articles, equipment and apparatus;
sporting articles for use in boxing, gymnastics; balls for use in
sports; sports bags

145. The 149 mark consists of a device with the words QUEENSBERRY BOXING 1867 in a rectangular box. It is shown at paragraph 105 above. The mark is a device, with the words placed together in different sizes. The word QUEENSBERRY is prominent but the date 1867 is also an important element. The word BOXING links to QUEENSBERRY. Mr Purvis submitted that given its connections with boxing, QUEENSBERRY is not the kind of mark which the public would be particularly surprised to see two different traders using in different fields, both of which might have some connection with boxing. The Queensberry Rules and the Marquess of Queensberry who wrote them have a well known connection to boxing in the public mind. The device clearly plays on that connection by referring to boxing. I think Mr Purvis submission is right. The word QUEENSBERRY when connected with boxing does not have a high degree of inherent distinctiveness. There has not been sufficient use made of the device to create an enhanced reputation through use. There is no evidence the average consumer would understand the significance of the date and so they would take it as a purported indication of a heritage of some kind, albeit it is in fact spurious since neither the second defendant nor the claimant has any inherent right to claim any link to the 9th Marquess.
146. In terms of similarity of the goods and services:
- i) The respective goods in class 16 are identical or very similar to each other.
 - ii) The second defendant's best case is to consider the services in class 41 e.g. the provision of training for sports or the provision of sporting activities. The goods in classes 18 and 28 all have a connection with sport. They will often be offered together with services like sports training and to the same public. In my judgment the goods in question are similar to the services in question.
147. I turn to consider a likelihood of confusion. I will first consider the class 41 case in relation to the claimant's word marks 451 and 395. The second defendant's best case would be to consider ordinary use of the QUEENSBERRY BOXING 1867 device in the provision of (say) sporting training services on an ordinary scale and compare that to (say) a sports bag mark QUEENSBERRY. The word would be used on a sports bag in ordinary plain format, without the word BOXING or the date 1867.
148. The defendants emphasised that the UK IPO held in the claimant's opposition to the 149 mark that the QUEENSBERRY BOXING 1867 device had a high degree of similarity to the prior 784 mark, registered for the word QUEENSBERRY. They submitted the same findings apply in this case. I do not accept that. The fact that a device containing a prominent word is found to have a high degree of similarity with an earlier mark consisting simply of that word does not mean that if the situation is reversed and the device is the earlier mark, it will necessarily have a high degree of similarity with a later word mark. In the case when the word mark is earlier, the presence of extra matter in the later device mark may well appear to be of lesser significance and to be surplusage. Whereas in the case when the device mark is earlier, the absence in the later mark of the extra matter in the device will probably be

of more significance. Potentially distinctive elements of the earlier mark will be missing.

149. Although the two marks have a clear common element (QUEENSBERRY), I do not accept that this is the only distinctive aspect of the 149 mark. The word BOXING does not add significantly to the distinctiveness of the 149 mark but the date 1867 is not a trivial element and fact the mark is a device, albeit not one which is highly stylised, is of some significance as well. Moreover, for the reasons I have already stated, in the absence of acquired enhanced distinctiveness through use, the word QUEENSBERRY itself is not a highly distinctive word. Nevertheless it seems to me that an average consumer who had encountered sports training services under the device mark and then later saw a sports bag branded QUEENSBERRY in a different, plain style, would be likely to be confused about the trade origin of the sports bag. They would naturally assume the bag was produced by the same organisation as supplied the sports training. This applies to all the goods in classes 18 and 28 for marks 451 and 395.
150. The comparison for the goods in class 16 is different and there is no reason why the goods should be linked to sports, which may tend to reduce the likelihood of confusion. On the other hand the goods are either identical (posters) or at least very similar indeed and I find the s5(2) / Art 53(1)(a)/Art 8(1) ground is made out for all those goods.
151. I reject the attack on the 454 mark. This mark consists of the words QUEENSBERRY RULES. Clearly the common element is the word QUEENSBERRY but I think the word RULES is sufficient to tip the balance away from a sufficient likelihood of confusion in the two comparisons (sports training services and class 16 printed matter etc.).

Conclusion

152. I find:
- i) the claimant's registered trade mark 2,485,784 is valid and would be infringed by the sale of the third and fourth defendants' clothing.
 - ii) The claim for copyright infringement is dismissed.
 - iii) The second defendant's counterclaim for passing off is dismissed.
 - iv) The specifications of UK registered trade mark 2,499,451 and Community Trade Mark 7,376,395 insofar as they relate to the goods in classes 16, 18 and 28 which are set out above, are invalid. The specifications must be amended to remove those goods.

Schedule A – the registered trade marks

UK Trade Mark No. 2,410,709 (Claimant)

5 Dec 2005



<i>Class</i>	<i>Goods / services</i>
25:	Articles of clothing; footwear; headgear.

UK Trade Mark No. 2,486,784 (Claimant)

8 May 2008

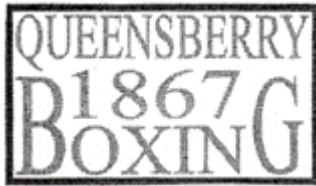
QUEENSBERRY

Queensberry

Queensberry

<i>Class</i>	<i>Goods/ services</i>
25	Articles of clothing; footwear; headgear.
35	Advertising services; marketing, developing and managing Internet advertising campaigns; gathering information for the development of new websites; business information services provided on-line from a computer database, the Internet, intranets or extranets; search engine marketing services, search engine optimisation services, search engine submission services.
41	Publishing on the Internet, intranets or extranets; providing on-line electronic publication.
42	Computer services; design services; illustration services; computer software design and web design; creating and maintaining websites; compilation of web pages on the Internet; artwork, typography, prints, publication and pre-press design services.

UK Trade Mark No. 2,491,149 (Second defendant)
26 June 2008



<i>Class</i>	<i>Goods/ services (the striking through shows the result of the opposition)</i>
16	Advertising promotional and marketing materials; souvenirs and mementos; books, magazines, programmes, leaflets and newsletters; stationery of all types; photographs; posters; tickets.
25	Sports promotional and casual clothing of all types; headgear and footwear of all types.
35	Agency and business management services for sporting and entertainment clients; retail services connected with the sale of stationery, books, magazines, programmes, tickets, photographs, posters, leaflets and newsletters, souvenirs, mementos and memorabilia. Advertisement promotion and marketing of sporting events, programmes and activities by printed matter, banners, television, radio, the Internet and similar media; production and management of television and radio advertisements; retail services connected with the sale of sports promotional and casual clothing, headgear, footwear.
41	Provision of training for sports and general entertainment purposes; provision of sporting and cultural activities and entertainment; provision and operation of fan clubs; provision of electronic games including through the Internet. Provision of publications including through the Internet.
42	Design and development of computer software and web sites; creation and maintenance of websites and web pages on the Internet

UK Trade Mark No. 2,493,623 (Claimant)
24 July 2008

QUEENSBERRY RULES

Queensberry Rules

Queensberry rules

<i>Class</i>	<i>Goods/ Services</i>
25	Articles of clothing; footwear; headgear.
35	Advertising services; marketing, developing and managing Internet advertising campaigns; gathering information for the development of new websites; business information services provided on-line from a computer database, the Internet, Intranets or extranets; search engines.
41	Publishing on the Internet, Intranets or extranets; providing on-line electronic publication.
42	Computer services; design services; illustration services; computer software design and web design; creating and maintaining websites; compilation of web pages on the Internet; artwork, typography, prints, publication and pre-press design services.

UK Trade Mark No. 2,499,451 (claimant)

6 Oct 2008

QUEENSBERRY

Queensberry

Queensberry

<i>Class</i>	<i>Goods / Services</i>
3	Soaps; toiletries; cosmetics; finger towels impregnated with cleansing preparations; towels containing non-medicated toilet preparations; hair care products; skin care products; bath lotions, deodorants, cleansers, moisturisers, perfumery, detergents, gels for use on the hair, non-medicated toilet preparations; dentifrices, shampoos, nail care preparations, antiperspirants, depilatory preparations, shaving soaps, cosmetic preparations for tanning the skin; eau de cologne, disinfectant soaps, deodorant soaps, stain removers, toilet waters; shaving preparations, hair waving preparations, hair setting preparations; cleaning preparations; shower preparations; pre shaving and after shaving lotions; creams, washing and bathroom preparations, body powder, toilet articles; body care products, beauty care products; colouring matters, tints and lotions, all for the hair and the beard, hair bleaching preparations; preparations for the care of the body, emery boards, emery paper, emery cloth all for nail grooming; dyestuffs; antiperspirant soap; bath salts, not for medical purposes; boot cream; boot polish; cleansing milk for toilet purposes; cosmetic kits; cosmetics essential oils; eye makeup; eyebrow cosmetics; eyebrow pencils; hair colorants; hair dyes, hair lotions; lotions for cosmetic purposes; makeup; makeup powder; makeup preparations; makeup removing preparations; beauty masks; medicated soap; nail polish; nail varnish; oils for cosmetic purposes; oils for perfumes and scents; perfumes; shaving preparations; shaving soap; shoe cream; shoe polish; shoe wax; shoe care products; sun tanning preparations; talcum powder; tissues impregnated with cosmetic lotions; toiletries; nail varnish; nail varnish removing preparations.
5	Kits containing medical preparations; pharmaceutical preparations and substances; medicinal preparations and substances; drugs for medical purposes; naturopathic and homeopathic preparations and substances; analgesics; vitamin, mineral and protein preparations and substances; mineral drinks; vitamin drinks; preparations for dietary use; dietetic substances adapted for medical use; nutrients and nutriments; food supplements; carbohydrates in liquid form; antiseptic preparations; plant compounds and extracts for use as dietary supplements; mineral supplements; disinfectants for hygiene purposes; vitamin and dietary supplements.
9	Protective clothing; goggles, browguards, face guards, fall protection apparatus, protective gloves and gauntlets, protective helmets and accessories therefore, ear plugs and bands, ear defenders, respirators and parts and fittings therefore; sunglasses, spectacles, spectacle cases; sunglasses cases; knee pads and elbow pads; cases for mobile telephones.
14	Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
16	Paper, paper articles; cardboard, cardboard boxes; printed matter, pictures, posters, prints, printed cards, stationery, greeting cards, serviettes, rolls of paper, napkins, table cloths, placemats, paper tableware, calendars, transfers, decalcomanias, towels of paper, table linen of paper, face towels of paper, coasters, gift paper, gift tags; document cases and portfolios; card holders.

18	Leather and imitations of leather and goods made of these materials and not included in other classes; skins and hides; luggage, cases, trunks, travelling bags, travelling cases, carry-on luggage, overnight luggage, bags for travel accessories, shoe bags for travel and garment bags; briefcases; school bags and school satchels; bags, holdalls, haversacks, backpacks, rucksacks, knapsacks, handbags, shoulder bags, clutch bags, tote bags, sports bags, athletic bags, beach bags, shopping bags, cycle bags, pannier bags, record bags, belt bags, toilet bags; hip pouches; belts; wallets, purses, pouches and key cases; baby and child carriers; camping bags; frames for handbags, umbrellas or parasols; fastenings and straps of leather; key fobs made of leather incorporating key rings; umbrellas, golf umbrellas, golf umbrellas incorporating a seat, parasols, canes and walking sticks; whips, harnesses and saddlery; baggage; articles of luggage; leather goods including whips, harnesses, saddlery, horse tack and equestrian articles; riding saddles; bags and panniers for bicycles; straps for skates.
24	Bed covers; bed linen; bedspreads; brocades; bunting; calico; calico cloth; chenille fabric; coasters (table linen); cotton fabrics; furniture coverings of textile; coverlets (bedspreads); duvet covers; covers for cushions; covers (loose) for furniture; curtains; curtain holders; eiderdowns; fabrics for textile use; furniture coverings of textile; household linen; textile material; place mats (not of paper); table napkins of textile; non-woven textile fabrics; serviettes of textile; table linen (not of paper); table mats (not of paper); table runners; tapestry (wall hangings) of textile; upholstery fabrics; rugs; travelling rugs; serviettes; handkerchiefs of textile; textile and textile goods not included in other classes; textile piece goods for household or furnishing purposes and textile articles made therefrom; fabrics; textile fabrics; furnishing fabrics; household textile goods and articles; linen and upholstery fabrics; blinds and roller blinds; wall coverings and wall hangings and ceiling coverings and hangings made wholly or principally of textile material.
28	Gymnastic and sporting articles, equipment and apparatus; sporting articles for use in boxing, gymnastics; balls for use in sports; toys, games, playthings, soft toys, souvenirs; balloons; Christmas decorations; sports bags; playing cards; parts, fittings and components for all the aforesaid goods.
29	Food preparations with added proteins and/or minerals; food protein; food supplements; food supplement in liquid or powder form; protein snack bars.

UK Trade Mark No. 2,499,454 (claimant)

6 Oct 2008

QUEENSBERRY RULES

Queensberry Rules

Queensberry rules

<i>Class</i>	<i>Goods/ Services</i>
3	Soaps; toiletries; cosmetics; finger towels impregnated with cleansing preparations; towels containing non-medicated toilet preparations; hair care products; skin care products; bath lotions, deodorants, cleansers, moisturisers, perfumery, detergents, gels for use on the hair, non-medicated toilet preparations; dentifrices, shampoos, nail care preparations, antiperspirants, depilatory preparations, shaving soaps, cosmetic preparations for tanning the skin; eau de cologne, disinfectant soaps, deodorant soaps, stain removers, toilet waters; shaving preparations, hair waving preparations, hair setting preparations; cleaning preparations; shower preparations; pre shaving and after shaving lotions; creams, washing and bathroom preparations, body powder,

	toilet articles; body care products, beauty care products; colouring matters, tints and lotions, all for the hair and the beard, hair bleaching preparations; preparations for the care of the body, emery boards, emery paper, emery cloth all for nail grooming; dyestuffs; antiperspirant soap; bath salts, not for medical purposes; boot cream; boot polish; cleansing milk for toilet purposes; cosmetic kits; cosmetics essential oils; eye makeup; eyebrow cosmetics; eyebrow pencils; hair colorants; hair dyes, hair lotions; lotions for cosmetic purposes; makeup; makeup powder; makeup preparations; makeup removing preparations; beauty masks; medicated soap; nail polish; nail varnish; oils for cosmetic purposes; oils for perfumes and scents; perfumes; shaving preparations; shaving soap; shoe cream; shoe polish; shoe wax; shoe care products; sun tanning preparations; talcum powder; tissues impregnated with cosmetic lotions; toiletries; nail varnish; nail varnish removing preparations.
5	its containing medical preparations; pharmaceutical preparations and substances; medicinal preparations and substances; drugs for medical purposes; naturopathic and homeopathic preparations and substances; analgesics; vitamin, mineral and protein preparations and substances; mineral drinks; vitamin drinks; preparations for dietary use; dietetic substances adapted for medical use; nutrients and nutriments; food supplements; carbohydrates in liquid form; antiseptic preparations; plant compounds and extracts for use as dietary supplements; mineral supplements; disinfectants for hygiene purposes; vitamin and dietary supplements.
9	Protective clothing; goggles, browguards, face guards, fall protection apparatus, protective gloves and gauntlets, protective helmets and accessories therefore, ear plugs and bands, ear defenders, respirators and parts and fittings therefore; sunglasses, spectacles, spectacle cases; sunglasses cases; knee pads and elbow pads; cases for mobile telephones.
14	Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
16	Paper, paper articles; cardboard, cardboard boxes; printed matter, pictures, posters, prints, printed cards, stationery, greeting cards, serviettes, rolls of paper, napkins, table cloths, placemats, paper tableware, calendars, transfers, decalcomanias, towels of paper, table linen of paper, face towels of paper, coasters, gift paper, gift tags; document cases and portfolios; card holders.
18	Leather and imitations of leather and goods made of these materials and not included in other classes; skins and hides; luggage, cases, trunks, travelling bags, travelling cases, carry-on luggage, overnight luggage, bags for travel accessories, shoe bags for travel and garment bags; briefcases, school bags and school satchels; bags, holdalls, haversacks, backpacks, rucksacks, knapsacks, handbags, shoulder bags, clutch bags, tote bags, sports bags, athletic bags, beach bags, shopping bags, cycle bags, pannier bags, record bags, belt bags, toilet bags; hip pouches; belts; wallets, purses, pouches and key cases; baby and child carriers; camping bags; frames for handbags, umbrellas or parasols; fastenings and straps of leather; key fobs made of leather incorporating key rings; umbrellas, golf umbrellas, golf umbrellas incorporating a seat, parasols, canes and walking sticks; whips, harnesses and saddlery; baggage; articles of luggage; leather goods including whips, harnesses, saddlery, horse tack and equestrian articles; riding saddles; bags and panniers for bicycles; straps for skates.
24	Bed covers; bed linen; bedspreads; brocades; bunting; calico; calico cloth; chenille fabric; coasters (table linen); cotton fabrics; furniture coverings of textile; coverlets (bedspreads); duvet covers; covers for cushions; covers (loose) for furniture; curtains; curtain holders; eiderdowns; fabrics for textile use; furniture coverings of textile;

	household linen; textile material; place mats (not of paper); table napkins of textile; non-woven textile fabrics; serviettes of textile; table linen (not of paper); table mats (not of paper); table runners; tapestry (wall hangings) of textile; upholstery fabrics; rugs; travelling rugs; serviettes; handkerchiefs of textile; textile and textile goods not included in other classes; textile piece goods for household or furnishing purposes and textile articles made therefrom; fabrics; textile fabrics; furnishing fabrics; household textile goods and articles; linen and upholstery fabrics; blinds and roller blinds; wall coverings and wall hangings and ceiling coverings and hangings made wholly or principally of textile material.
28	Gymnastic and sporting articles, equipment and apparatus; sporting articles for use in boxing, gymnastics; balls for use in sports; toys, games, playthings, soft toys, souvenirs; balloons; Christmas decorations; sports bags; playing cards; parts, fittings and components for all the aforesaid goods.
29	Food preparations with added proteins and/or minerals; food protein; food supplements; food supplement in liquid or powder form; protein snack bars.

CTM No. 7,376,395 (claimant)

7 Nov 2008

QUEENSBERRY

Class	Goods/ Services
3	Soaps; toiletries; cosmetics; finger towels impregnated with cleansing preparations; towels containing non-medicated toilet preparations; hair care products; skin care products; bath lotions, deodorants, cleansers, moisturisers, perfumery, detergents, gels for use on the hair, non-medicated toilet preparations; dentifrices, shampoos, nail care preparations, antiperspirants, depilatory preparations, shaving soaps, cosmetic preparation for tanning the skin; eau de cologne, disinfectant soaps, deodorant soaps, stain removers, toilet waters; shaving preparations, hair waving preparations, hair setting preparations; cleaning preparations; shower preparations; pre shaving and after shaving lotions; creams, washing and bathroom preparations, body powder, toilet articles; body care products, beauty care products; colouring matters, tints and lotions, all for the hair and the beard, hair bleaching preparations; preparations for the care of the body, emery boards, emery paper, emery cloth all for nail grooming; dyestuffs (cosmetics); antiperspirant soap; bath salts, not for medical purposes; boot cream; boot polish; cleansing milk for toilet purposes; cosmetic kits; cosmetics essential oils; eye makeup; eyebrow cosmetics; eyebrow pencils; hair colorants; hair dyes, hair lotions; lotions for cosmetic purposes; makeup; makeup powder; makeup preparations; makeup removing preparations; beauty masks; medicated soap; nail polish; nail varnish; oils for cosmetic purposes; oils for perfumes and scents; perfumes; shaving preparations; shaving soap; shoe cream; shoe polish; shoe wax; shoe care products; sun tanning preparations; talcum powder; tissues impregnated with cosmetic lotions; toiletries; nail varnish; nail varnish removing preparations.
5	First-aid kits containing medical preparations; pharmaceutical preparations and substances; medicinal preparations and substances; drugs for medical purposes; naturopathic and homeopathic preparations and substances; analgesics; vitamin, mineral and protein preparations and substances; mineral drinks (medicated); vitamin drinks; preparations for dietary use; dietetic substances adapted for medical use; nutrients and nutriments; food supplements; antiseptic preparations; plant compounds and extracts for use as dietary supplements; mineral supplements; disinfectants for

	hygiene purposes; vitamin and dietary supplements; food supplements; food supplement in liquid or powder form.
9	Protective clothing; goggles, browguards, face guards, fall protection apparatus, karabiner, protective gloves and gauntlets, protective helmets and accessories therefor, ear plugs and bands, ear defenders, respirators and parts and fittings therefor; sunglasses, spectacles, spectacle cases; sunglasses cases; knee pads and elbow pads.
14	Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
16	Paper; paper articles; cardboard, cardboard boxes; printed matter; pictures, posters, prints, printed cards, stationery, greeting cards, serviettes, rolls of paper, napkins, table cloths, placemats, paper tableware, calendars, transfers, decalcomanias, towels of paper, table linen of paper, face towels of paper, coasters, gift paper, gift tags.
18	Leather and imitations of leather and goods made of these materials and not included in other classes; skins and hides; luggage, cases, trunks, travelling bags, travelling cases, carry-on luggage, overnight luggage, bags for travel accessories, shoe bags for travel and garment bags; briefcases, document cases and portfolios; school bags and school satchels; bags, holdalls, haversacks, backpacks, rucksacks, knapsacks, handbags, shoulder bags, clutch bags, tote bags, sports bags, athletic bags, beach bags, shopping bags, cycle bags, pannier bags, record bags, belt bags, toilet bags; hip pouches; belts; wallets, purses, pouches and key cases; baby and child carriers; camping bags; frames for handbags, umbrellas or parasols; fastenings and straps of leather; key fobs made of leather incorporating key rings; card holders; umbrellas, golf umbrellas, golf umbrella seats, parasols, canes and walking sticks; whips, harnesses and saddlery; baggage; articles of luggage; leather goods including whips, harnesses, saddlery, horse tack and equestrian articles; riding saddles; bags and panniers for bicycles; straps for skates; cases for mobile telephones.
24	Bed covers; bed linen; bedspreads; brocades; bunting; calico; calico cloth; chenille fabric; coasters (table linen); cotton fabrics; furniture coverings of textile; coverlets (bedspreads); duvet covers; covers for cushions; covers (loose) for furniture; curtains; curtain holders (textile); eiderdowns (down coverlets); fabrics for textile use; furniture coverings of textile; household linen; textile material; place mats (not of paper); table napkins of textile; non-woven textile fabrics; serviettes of textile; table linen (not of paper); table mats (not of paper); table runners; tapestry (wall hangings) of textile; upholstery fabrics; travelling rugs; serviettes; handkerchiefs of textile; textile and textile goods not included in other classes; textile piece goods for household or furnishing purposes and textile articles made therefrom; fabrics; textile fabrics; furnishing fabrics; household textile goods and articles; linen and upholstery fabrics; blinds and roller blinds; wall coverings and wall hangings and ceiling coverings and hangings made wholly or principally of textile material.
25	Articles of clothing; footwear; headgear.
28	Gymnastic and sporting articles, equipment and apparatus; sporting articles for use in boxing, gymnastics; balls for use in sports; toys, games, playthings, soft toys, novelties, souvenirs; balloons; Christmas decorations; sports bags; playing cards; parts, fittings and components for all the aforesaid goods.
29	Food preparations with added proteins and/or minerals; food protein; protein snack bars.
30	Carbohydrates.
35	Advertising services; marketing, developing and managing Internet advertising campaigns; gathering business information for the development of new websites;

	business information services provided on-line from a computer database, the Internet, intranets or extranets.
41	Publishing on the Internet, intranets or extranets; providing on-line electronic publication.
42	Computer services; design services; illustration services; computer software design and web design; creating and maintaining websites; compilation of web pages on the Internet; artwork, typography, prints, publication and pre-press design services; search engine marketing services, search engine optimisation services, search engine submission services.

UK Trade Mark No. 2,561,131 (Second defendant)
12 Oct 2010



<i>Class</i>	<i>Goods / Services</i>
25	All Articles of clothing
28	All articles of sporting apparatus
35	Advertising including via the Internet

UK Trade Mark Application No. 2,579,880 (second defendant)
28 April 2011



<i>Class</i>	<i>Goods/ Services</i>
25	All Articles of clothing
28	All articles of sporting apparatus
35	Advertising including via the Internet