

O-010-17

TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED OPPOSITIONS

UNDER NO 404245 BY JOSEPH GRAHAM SUGG (AKA THATCHER JOE)

TO APPLICATION NO 3089624

IN THE NAME OF ABT MERCHANDISING LIMITED

AND

UNDER NO 404894 BY ABT MERCHANDISING LIMITED

TO APPLICATION NO 3106420

IN THE NAME OF JOSEPH GRAHAM SUGG (AKA THATCHER JOE)

Background

1. This decision relates to two applications as follows:

1. Application No 3089624 which stands in the name of ABT Merchandising Limited (“ABT”), has a filing date of 15 January 2015 and seeks registration of a series of two trade marks: **ThatcherJoe** and **Thatcher Joe** for the following goods:

Class 25

Clothing; headgear; footwear; t-shirts; sweatshirts; vests; jumpers; trousers; shorts; baseball caps; bandanas; trainers; socks; gloves; scarves

Following publication of the application in the *Trade Marks Journal* on 30 January 2015, notice of opposition was filed by “Joseph Graham Sugg (AKA Thatcher Joe)”. There are two grounds of objection. The first, under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”), is brought on the basis of alleged earlier rights in THATCHER JOE and THATCHERJOE. Mr Sugg claims to have been providing social networking, blogs, forums, on-line content, internet channels, uploading videos, gaming videos and reviews, recording and editing videos, sound recordings, books, publications, films, events and shows, compere services, motivational speaking and on-line publication of electronic books and journals under these signs throughout the UK since 1 January 2010 and claims to have acquired goodwill under those signs. Use of the trade mark would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

The other objection is brought under section 3(6) of the Act. Mr Sugg claims the application was made in bad faith.

ABT filed a counterstatement in which it notes that it is for Mr Sugg to prove his claimed rights under section 5(4)(a) and denies the claims made under section 3(6) of the Act.

2. Application No 3106420 which stands in the name of “Joseph Graham Sugg (DBA Thatcher Joe)”, has a filing date of 29 April 2015 and seeks registration of a series of two marks **THATCHER JOE** and **THATCHERJOE**. It seeks registration for a wide range of goods and services in classes 9, 16, 18, 25, 28, 35, 38, 41 and 45.

Following publication of the application in the *Trade Marks Journal* on 22 May 2015, notice of (partial) opposition was filed by ABT. Its grounds of opposition are founded on sections 5(1) and 5(2)(a) of the Act based on its trade mark application No 3089624 and is directed at the application only insofar as it seeks registration for the following goods in class 25:

Clothing, namely, shirts, T-shirts, hoodies, trousers, jeans, shorts, sports shorts, swimwear, beachwear, bikinis, swimming costumes, fitted swimming costumes with bra cups, beach cover-ups; underwear, lingerie, boxer shorts, teddies, slippers, camisoles, chemises, negligees, sleepwear, robes, pyjamas, pyjama sets, baby doll nightdresses, nightdresses, bras, sport bras, bralets, bustiers, bra accessories, namely bra straps, bra extenders, bra pads, self-adhesive support tapes for wear, panties, g-strings, thongs, boylegs, bikinis, briefs, garter belts, girdles, tracksuits, articles of outerwear, coats, jackets, jumpers and cardigans, pullovers, twinsets, knitwear, leggings, neckties, waistcoats, headbands and wristbands, skirts, wraps, jerseys, blouses, dresses, sweatshirts, bibs, stockings, ties, shawls, blazers, headbands and wristbands, overalls halter tops, tank tops, crop tops, sweaters, dresses, blazers, blouses, slacks, suits, vests, sweatpants, sweatshirts, socks and hosiery, stockings, pantyhose, tights, leotards saris, sarongs, ties and belts, scarves, shawls, gloves, mittens, belts (being articles of clothing), aprons, footwear, namely, boots, shoes, slippers, sandals, trainers, booties, workout shoes and running shoes, beach shoes, soles for footwear, headgear, namely, headbands, hats, caps, berets, earmuffs, top hats, visors, baseball caps, headbands, beanies.

Mr Sugg filed a counterstatement in which he denies the claims made.

2. The proceedings were consolidated. Both parties filed evidence and written submissions which I will refer to as necessary in this decision. Matters came before me for a hearing on 26 October 2016 where ABT was represented by Fiona Clark of Counsel instructed by Agile IP LLP. Mr Sugg was represented by Steven Jennings of Lewis Silkin LLP.

The evidence

3. As indicated above, both parties filed evidence. It consists of:

Mr Sugg's evidence

A witness statement, with exhibits PH1 to PH24, dated 13 October 2015 of Philip Hughes, Director of Business Affairs and Strategy of Gleam Futures Limited ("Gleam"), the company that manages Joseph Graham Sugg;

A witness statement, with exhibits IZ1 to IZ2, dated 5 April 2016 of Iram Zaidi, a registered trade mark attorney with Lewis Silkin LLP;

A witness statement, with exhibit IC1, dated 5 September 2016 of Ian Stephen Collier, an IP Analyst with Lewis Silkin LLP;

A witness statement, with exhibits SJ1 to SJ3, dated 8 September 2016, of Steven Jennings, a registered trade mark attorney with Lewis Silkin LLP.

ABT's evidence

A witness statement of Mr Karam with exhibits SK1 and SK2 dated 18 January 2016 was attached to written submissions of the same date;

A witness statement of Mr Bassam Karam, founder and director of ABT, with exhibits SK1 and SK2 and dated 3 April 2016;

A witness statement of Mr Karam with exhibits ABT1 and 2 dated 16 August 2016.

Preliminary point

4. The day before the hearing, those representing Mr Sugg sought to have admitted a witness statement of Lucy Lendrem dated 25 October 2016. Given the timing of its filing, I dealt with this as a preliminary point at the hearing.

5. Mr Jennings submitted that the witness statement should be admitted. He referred to the covering letter which had accompanied the witness statement and which indicated that as ABT had:

“benefitted from sight of our client’s skeleton arguments in advance of finalising, filing and serving its own, we feel that it would only be equitable for the UKIPO to accept [the witness statement] into these proceedings”.

This refers to the fact that the hearing was originally set down for August but had been postponed when ABT made and was granted a request to file late evidence. I shall return to this in due course.

6. Mr Jennings submitted that the witness statement was “central to this case in that my client is a celebrity, a social media personality”. He stated that the witness statement “shows that [Mr Sugg] has made a significant amount of money through being himself, living his own brand as it were [and] gives an insight into Mr Bassam (sic) in that I think he is perhaps much more astute than it may appear”.

7. When prompted to explain why the witness statement had not been filed at an earlier point, Mr Jennings apologised and said it was “pure oversight” and “an omission” but that he had seen that it was “an area of our evidence which could be strengthened”.

8. In response, Ms Clark submitted that it is usual, when seeking to file late evidence, to write a letter “which says that the person seeking to rely upon it has done everything they can to bring it before the tribunal as soon as possible and

obviously [to] the other side". She acknowledged that her client had itself been granted leave to file late evidence which had led to postponement of the originally appointed hearing after the filing of a skeleton argument but said that "to come along, without any proper explanation and to seek to rely on something apparently prepared yesterday, frankly is unacceptable." She referred to the fact that the witness statement included a reference to yet more (unspecified) evidence which it said could be provided if kept confidential to ABT's lawyers. She submitted that this would make it impossible for her to take instructions on it and for her client to know the case against it. Her main objection, however, was in relation to the timing of its filing submitting that "to do it on the day of the hearing is just, frankly, a travesty in terms of procedure". She submitted that:

"to try and hang it on the back of some sort of argument that my side could have benefitted in some way, improperly, from seeing my friend's skeleton argument, which frankly is extremely short and extremely concise, if I can put it that way---it is not clear to me what benefit I could have obtained from it anyway even if I had seen it---is really quite unacceptable...We say that this is an application which certainly the tenor, accusing us of wrongdoing, smacks a little bit of paranoia. Overall, the reality is if you just apply the usual rules that apply in these sorts of hearing; has this particular party satisfied you that it took all proper steps to bring all relevant matters to your attention beforehand? Has it explained precisely what happened? No. Has it explained when it first become apparent that this was necessary? No. Is there any explanation as to why it came in now rather than back in September? No. Can you be satisfied it is crucial, on the basis of what you are told? No. Can my clients deal with it today? No, insofar as it says anything that is material at all because, to be able to deal with it, you need to know what the figures are that are being referred to. We say this is just a plainly inappropriate case for admitting further evidence...".

9. I refused to admit the witness statement of Lucy Lendrem.

10. The fact that ABT had previously sought and been granted leave to file additional evidence cannot be relied on, of itself, as justification for allowing Mr Sugg to file late

evidence. As I indicated at the hearing, such requests cannot be considered on a tit-for-tat basis even where ABT's own late evidence led to postponement of the substantive hearing subsequent to the filing of a skeleton argument. Each request is considered on its own merits. In respect of Mr Sugg's request, there is no doubt that it was made on the latest possible date before the hearing. In terms of the reasons for its lateness, this was said to be because of an error or omission. There was nothing to explain why the error or omission might have occurred or who may have omitted to do what but it seems to me that seeking to file the witness statement the day before the hearing indicates that neither Mr Sugg nor his representatives paid sufficient attention before or during the standard evidence rounds, either to the identification of evidence which they might need to file given the basis of the attack or to the actual compilation of its evidence. Any review of the case and identification of the information as is included in Ms Lendrem's witness statement, would appear to have been carried out at a very late stage. That said, I note that the timing of the request is but one factor that I am required to take into account when considering late evidence.

11. Materiality or otherwise of the evidence is another factor to be taken into account therefore I reviewed the witness statement of Ms Lendrem *de bene esse*. The witness statement is brief. Mr Jennings' submission that the evidence in some way sheds light on Mr Karam is not supported in any way by the content of the witness statement which makes no reference to ABT, its business or any of its officers.

12. Ms Lendrem states that her witness statement seeks "to demonstrate how Thatcher Joe is monetised and to show the revenue streams and the goodwill associated with his name". It refers to three ways in which Mr Sugg's YouTube channels are "monetised". The first is said to be though "display advertising before, during, after and surrounding video content" produced by him. No details of or exhibits showing any display advertising are included. Figures are given in US dollars but that sum is not broken down in any way and it is not possible to say how much, if any, of this figure relates to income derived in the UK at the relevant date (evidence already admitted shows his YouTube channels have a following in the US and a number of other countries). Secondly, there is a reference to Mr Sugg executing "brand endorsements within video content" said to include "a video on at

least one of his YouTube channels”. The video is not exhibited or otherwise identified and, whilst a figure in £ sterling as at January 2015 is stated, the evidence does not give any further information of e.g. who, specifically, may have engaged Mr Sugg to endorse their brand, where they were based, what, specifically he may have endorsed, or who or how many people are likely to have seen these endorsements or when. Thirdly, the witness gives a “current” figure in US\$ of income derived “through multiple contractual partnerships with YouTube”. No details of any such partnerships are given nor is there any indication of what the position was at the relevant date in the UK.

13. In short, Ms Lendrem’s evidence raises more questions than it would answer and would not enable me to establish what the position may have been in relation to the UK at the relevant date. I did not consider the evidence would assist me in reaching a determination in the substantive issues. The evidence was sought to be admitted at the very latest moment with no proper explanation given as to why this was the case. In view of its content and bearing in mind other evidence which had already been admitted on behalf of Mr Sugg, I did not consider that he would be prejudiced by the refusal to admit the late evidence.

Decision

The objection under section 5(4)(a) of the Act

14. I begin by considering the opposition brought by Mr Sugg under section 5(4)(a) of the Act to ABT’s application No 3089624. In his notice of opposition, he puts his claim under this ground as follows:

“[Mr Sugg] is a major Internet personality and well-known online prankster and video blogger...Therefore, [Mr Sugg] has long standing and extensive use of the unique name THATCHER JOE/THATCHERJOE. [ABT] has no legitimate reason to file an application for the stage/personality/business name of another person...

He is extremely well-known in the online community and has a substantial reputation in the name Thatcher Joe in the UK.

The Application implies and misrepresents that there is connection between [ABT] and [Mr Sugg], or that [Mr Sugg] has authorised [ABT] to use its name.

This connection will damage the reputation and business of [Mr Sugg].”

15. Section 5(4)(a) of the Act states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

16. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

17. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

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

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

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

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

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

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

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

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

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

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

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

18. Matters must be considered at a particular point in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C. as the Appointed Person considered the relevant date for the purpose of section 5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be

established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

19. ABT has filed evidence which gives some detail of its trade before the date of its application. In his witness statements, Mr Bassam Karam states that ABT was incorporated on 12 November 2013, by himself and his father-in-law. He states that it sells:

“clothing carrying unique designs through various online channels such as ebay.” and that it specialises in: “creating designs combining current trends, commonly known in the trade as “mash-ups”, and printing them on clothing.”

He states that in or around February 2014 he came up with:

“a design concept to create a range of branded clothing with a design incorporating a common name associated with various trades...[those designs] were finalised in late 2014. It was decided to use the name “Joe” as a common thread through the designs.”

20. At SK1 Mr Karam exhibits a printout showing two of the designs. They look like this:



21. At ABT1 Mr Karam exhibits screenshots of an eBay listing. Whilst they appear to have been downloaded on 16 August 2016, there is no suggestion that the listing was materially different at any earlier date. The screenshots show a number of t-

shirts with designs on their fronts which are in similar form to those shown above. One of the t-shirts shown has a design on the front of it which includes the words "I MIGHT BE THATCHER JOE BUT I CAN'T FIX STUPID". At ABT2, Mr Karam exhibits an invoice dated 9 October 2014 addressed to a building company in Birmingham. The invoice is from Fretshirt.com ABT Merchandising Ltd and includes charges for 15 x "I might be thatcher Joe" T-shirts. I note that in his witness statement, Mr Karam states:

"We trade under the name Fretshirt."

22. In his witness statement and at the hearing, Mr Jennings sought to cast doubt on the authenticity of this evidence. No cross-examination of Mr Karam was sought but, supported by the evidence of Mr Collier, he challenges whether the eBay evidence is, in fact, linked with ABT. As regards the invoice provided, he challenges the existence of the claimed purchaser of the goods as well as whether such goods were, in fact, sold. Whilst these are serious issues, I do not consider it necessary to make a decision on these points. This is because I do not consider the evidence shows there has been any use by ABT of the mark THATCHER JOE as a trade mark. The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. Neither the eBay listing nor the invoice nor any other material show use of THATCHER JOE in any way other than describing what is printed as part of the decoration on the front of t-shirts. Mere decorative use of a sign on a T-shirt is not sufficient (see: *Wild Child Trade Mark* [1998] RPC 455 (AP)). I consider the only use shown of the words THATCHER JOE before the date of application is decorative use and not use as a trade mark.

23. I therefore intend to consider the objection under section 5(4)(a) of the Act as at the date of application. In any event, the period between 9 October 2014 and the filing date of 15 January 2015 is very short, there is no indication of what level of sales might have accrued to this period nor has anything been filed which indicates that matters would have been materially different at the earlier date.

24. As set out above, the first hurdle for Mr Sugg is the requirement to show that he has the necessary goodwill. In the case of *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

25. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

26. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

27. ABT's application seeks registration in respect of goods set out above at paragraph 1 which are, in essence, clothing, headgear and footwear.

28. In his notice of opposition, Mr Sugg claims to have used the mark in the UK since 1 January 2010 on a wide range of services. No claim has been made that he has carried out any trade in relation to clothing, headgear or footwear. That said, in his witness statement, Mr Hughes states:

“As shown in the Exhibits, [Mr Sugg] has a loyal fanbase who have been eagerly awaiting the launch of official branded merchandise.”

I have not been directed to any particular exhibits which would support Mr Hughes' statement in this regard nor have I been able to identify any such material.

29. Mr Hughes goes on to state:

“My company has been assisting [Mr Sugg] with the design of the merchandise.”

He gives no further details of what merchandise may be involved but does go on to say:

“Attached at Confidential Exhibit PH21 is a design presentation for the ThatcherJoe logo sent to my company’s Head of Operations...containing the logo as it may appear on merchandise including clothing.”

30. Whilst the exhibit has been made subject to an order for confidentiality, as Mr Hughes states, it includes the words Thatcher Joe shown on a number of articles including a t-shirt. The presentation is not dated but it clear from Mr Hughes’ use of the words “as it may appear” that the design has not yet been finalised and that consequently, there has been no use of the name in the course of trade (whether in relation to T-shirts or any other goods) at any point in time and certainly not at the relevant date.

31. That is not an end to the matter, however, as, at the hearing, Mr Jennings submitted that “although English law does not recognise the right of personality...it is clear that there is recognition that where someone has a reputation, has a celebrity, that it is actionable to use that name in a connection which gives a false impression.” It is arguable whether this was a ground set out in the notice of opposition, however, Ms Clark responded to it so I will consider it for the sake of completeness.

32. Mr Jennings referred me to the case of *Irvine v Talksport Ltd* [2002] FSR 60 in which the Court found that an action for passing off could be based on false product endorsement. It found that Mr Irvine had enjoyed a significant reputation or goodwill at the time of the acts complained of, that the defendant’s actions in including a photograph of Mr Irvine holding a sign which had the words Talk Radio superimposed on it and which appeared in a brochure it had distributed, had created a false message which would be understood by a not insignificant section of its market as meaning that its goods had been endorsed by the claimant and that he had suffered damage as a result. The Court heard expert evidence that endorsement fees had become a particularly important part of the income of F1 drivers such as Mr Irvine, whose period at the top of their respective sports was likely to be short-lived.

33. In his evidence, Mr Hughes states that Mr Sugg “is a YouTuber, online vlogger, internet celebrity, producer, presenter and published author”. He states that he has three YouTube channels: ThatcherJoe, created on 13 November 2011,

ThatcherJoeVlogs, created on 13 January 2013 and ThatcherJoeGames, created on 16 May 2013. These channels are said to have had approximately 3.5m, 1.3m and 487,000 subscribers and 202m, 66m and 15m views respectively up until the relevant date. At PH5, PH6 and PH7 are what Mr Hughes says are printouts from Google Analytics showing these figures. Neither Mr Hughes nor the printouts give any details as to how many of the subscribers or views are from people in the UK. Mr Hughes states that all of these channels “have been verified by Google+ and contain the verification badge or tick” which he states is a “method [-] used to verify that the page in fact belongs to the celebrity or brand...”. At PH8 he exhibits a copy of YouTube’s guide on verification which shows that the verification is applied “with discretion to applicable official businesses, brands, organizations, and public figures”. Neither Mr Hughes nor the exhibit gives any details of when the verifications took place.

34. Mr Hughes states that “Joe Sugg and his nickname ThatcherJoe often appear in the press and news articles”. At PH18 and PH 20 he exhibits a number of such articles (some of which are duplicates). Whilst in some of these articles little more than a mention of the name ThatcherJoe is made, in others more details are given. At PH18, page 56, for example, an article from *The Daily Telegraph* of 10 January 2015 refers to him and describes his specialism as Entertainer/Pranks. At PH 20, page 131, is an article from the German publication *Broadmark* dated 30 November 2014. The article is a “Portrait” of “Joe Sugg aka ThatcherJoe” and raises the question “So who or what is the reason behind this success” (my translation “Was oder wer steckt also eigentlich hinter diesem Erfolg?”). At page 136 is an article taken from the US *Vanity Fair* website dated 7 November 2014 which “takes a look at some of the most popular new videos on YouTube”. One of those referred to is a ThatcherJoe video described as “typically just stunty “challenge” collabs that accomplish nothing but reifying their public friendships and upping subscriber counts”. At page 161 is an article from *Red17* dated 4 February 2015. In Spanish, the article is entitled “The best photos of Joe Sugg nude” (my translation “Las mejores fotos de Joe Sugg desnudo”). The article shows a link to further photos of “Joe Sugg, “ThatcherJoe””.

35. Mr Hughes refers to Mr Sugg's film and television appearances. There is evidence that he appeared in a video produced for City & Guilds which sought to promote to "young people...the opportunities open to [them] for a future in construction" which was published on the City & Guilds' YouTube page in October 2013. At PH2 is a screenshot taken from the City & Guilds YouTube page. The video is entitled "Construction at the Olympic Park with Joe Sugg" and the screenshot includes the following:

"Joe Sugg, aka Thatcher Joe, is an apprentice thatcher and YouTuber, Watch as he takes two apprentices on a journey with City & Guilds, around the regeneration in the Olympic Park, to learn more about the possibilities and opportunities open to you for a future in construction."

36. The screenshot shows it to have had 95,716 views at the date it was downloaded but there is no indication of what date that might have been. The video itself has not been exhibited.

37. In relation to film, Mr Sugg is said to have "made a cameo voiceover as a seagull in the 2015 UK version of the film *The SpongeBobMovie: Sponge out of Water*". At PH22 Mr Hughes exhibits an article published on the website of Entertainment-focus.com. Posted on February 2015, it refers to "YouTube sensations Joe Sugg (Thatcher Joe)..." having "re-voiced comedy characters exclusively for the UK" and indicates that the film will have special previews on March 21 and be released nationwide on 27 March 2015. No indication is given as to whether Mr Sugg was named in the credits (and if so whether under his own name or his assumed name) but the article and release date of the film are all after the relevant date.

38. Whilst the evidence does not establish what the position may have been in the UK at the relevant date, there is no dispute that Mr Sugg is an internet blogger and video performer who goes under the name ThatcherJoe. As Mr Jennings submitted at the hearing, vlogging is a relatively new occupation. This is supported by an article exhibited at PH18, page 83 which was published in the *Daily Telegraph* on 16 August 2014. It quotes Mr Dominic Smales, said to be the founder of Gleam, as saying that he began work on setting up his company in 2010 because he could see

“[social media] was just beginning to be massive”. The article is entitled: “Vlogging On. Over-20s may never have heard of them, but to tween-and teenagers these prolific video bloggers are worthy of mobbing”. ThatcherJoe is mentioned as one of the company’s clients who are said to:

“Now make a living as a result of their vlogging. In fact they make more than enough to pay the bills despite it not being their primary motivation....Smales and his vloggers turn down potentially lucrative deals in favour of the bigger picture. ‘Our absolute priority is preserving the relationships between them and their audience, because that is much more valuable than any kind of deal,’ Smales says. ‘If a commercial third party approached and offered the world in terms of money, you wouldn’t find many of them would take that deal if it meant damaging their relationship with their viewers. I say that with confidence. If you talked to any of them they would say the same.’”

39. Whilst this indicates that some vloggers derive an income from their vlogging activities, the evidence does not show that at the relevant date, vloggers, as an occupational group, had an established reputation for obtaining sponsorship or endorsements such as was the case in *Irvine*. The facts of this case are therefore very different to those in *Irvine*.

40. Reference was also made to the case of *Fenty v Arcadia Group Brands Limited* [2015] EWCA CW 38 where a well-known pop singer had pursued a claim against the retailer for unauthorised use of her image on t-shirts. The Court found that the sale of a particular t-shirt by the retailer did amount to passing off. This was because it was likely to lead people to buy it in the belief that the pop star has authorised or approved it. The Court found the retailer had made a considerable effort to emphasise its connection with her and referred to a previous collaboration it had had with her whereby it had run a competition offering entrants the chance to meet her for a personal shopping experience at one of its stores. There is no evidence in these proceedings that Mr Sugg has entered into any previous collaborations in such a way.

41. In short, the evidence does not show that Mr Sugg had any trade in the relevant goods (or indeed in any goods) at the relevant date nor does it show that he had the requisite reputation for endorsing any goods or services under the name ThatcherJoe in the UK at the relevant date. The objection under section 5(4)(a) of the Act fails.

The objection under section 3(6) of the Act

42. I go on to consider the opposition brought by Mr Sugg against application no 3089624 on grounds under section 3(6) of the Act. Section 3(6) of the Act states:

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

43. In his Notice of Opposition, Mr Sugg’s claim is put in this way:

“The name Thatcher Joe is a unique mark because it is an inversion of the usual order of names. For example, when considering forenames and surnames together with the trade or profession of a person, it usual (sic) to have the name first followed by the trade, i.e. ‘Bob the Builder’. Also, it is an extremely usual combination of words because the word ‘Thatcher’ is highly distinctive word and not common name.

The Opponent’s real name is Joseph Sugg, but he developed the name Thatcher Joe during his career as a roofing thatcher, which is not a common trade. Since then, his online and stage persona has been Thatcher Joe. The Applicant is clearly seeking to carve out an exclusive position in the marketplace in respect of this name, which would effectively prevent the Opponent from launching his own range of merchandise under his own name and legitimately expanding his business.

The Opponent is known as Thatcher Joe/ThatcherJoe and has used this name for several years. The Opponent has an immense following on social networking websites such as YouTube, Twitter, FaceBook, Instagram,

Google+ and Tumblr. The Opponent's reputation is so great that anyone who searches the name 'Thatcher Joe' in a search engine will find the profile of the Opponent.

The registration 'Thatcher Joe' in relation to goods applied for will lead to confusion amongst the public as to the origin of those goods.

The Opponent's name is not the only famous mark which the Applicant has applied to register as a trade mark...Based on the pattern of trade mark applications made by the Applicant, they have clearly acted in bad faith by filing the Application.

The Applicant has no legitimate right to register the name or any background involving use of an identical name. Therefore they have simply attempted to file the Application in bad faith to block and/or benefit from the Opponent's reputation."

44 The objection under 3(6) has to be based on something other than that already considered under section 5(4) therefore the only claim under this ground is that the application is part of a pattern of behaviour by ABT in applying to register famous marks belonging to others.

45. I dismiss the objection under this ground.

46. There is no dispute that ABT is a business supplying clothing. In response to this ground of objection, in his witness statement of 3 April 2016 Mr Karam stated:

"Recently (we have) invested heavily in state of the art printers which allow three-dimensional printing on clothing whereby the entire surface of the clothing (back, front and sides) is printed with an all encompassing design.

In or around February 2014, I came up with a design concept to create a range of branded clothing with a design incorporating a common name

associated with various trades...One of the designs chosen was for a roofer or thatcher.”

From SK1 above, it appears that plumbers and electricians were other designs chosen. Mr Karam states that he:

“Seeks to file trade mark applications for any marks that sell particularly well within our clothing range.”

47. Leaving aside the distinction between decorative use and use as a trade mark, whilst it might be somewhat surprising that his company has sought to register a mark where the goods are likely to have a limited market (in the sense that there are likely to be far fewer people employed as thatchers than there are employed as e.g. plumbers or electricians), that, of itself, does not mean that ABT’s application was made in bad faith. In any event, it is not a matter for ABT to defend itself, it is a matter for Mr Sugg to prove his claims. As Arnold J. stated in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

“133... a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].”

48. The notice of opposition lists four marks which are said to be famous and for which registration has been applied. Mr Sugg also puts forward details of parties he says has or “will most likely” oppose or object to them though how he is a position to know independent third parties’ future intentions remains unexplained. No details of the relevant application numbers have been provided in the notice of opposition

though this information is given in written submissions dated 15 October 2015. Nowhere in the notice of opposition is there any explanation of why the marks referred to are considered to be “famous”; it is certainly not obvious to me that they are and evidence filed on behalf of Mr Sugg is silent in this regard. Indeed I can see nothing in any of the witness statements filed on behalf of Mr Sugg which makes any reference to the claim of bad faith and Mr Jennings did not direct to me to any in his oral submissions at the hearing. In the circumstances, the objection under section 3(6) cannot hope to succeed.

ABT’s opposition to application No 3106420

49. In view of my earlier findings, ABT is entitled to rely on its application no 3089624 in its opposition to Mr Suggs’ application no 3106420 and I go on to consider this opposition further.

50. I intend to consider the matter under section 5(1) of the Act which states:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied are identical with the goods or services for which the earlier trade mark is protected.”

An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

51. Under this ground, ABT relies on its application No 3089624 which would be an earlier trade mark subject to its being so registered.

52. The first matter for me to consider is the identity or otherwise of the respective marks. For ease of reference, I set these out below:

Mr Sugg’s mark	ABT’s marks
THATCHER JOE	ThatcherJoe
THATCHERJOE	Thatcher Joe

In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the Court of Justice of the European Union commented on what constitutes an identical trade mark. The Court concluded:

“54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

53. Both applications consist of a series of two marks comprising the words THATCHER and JOE (separate and conjoined). The only difference between them is the fact that in the case of Mr Sugg’s application, the words are presented in plain block capitals whereas in ABT’s application, they are presented in title case. It is well-established that these are differences which are so insignificant that they will go unnoticed by the average consumer. I find the respective marks to be identical.

54. As regards the respective goods, ABT opposes Mr Sugg’s application insofar as it seeks registration for goods in class 25 only. The respective goods are therefore as follows:

Mr Sugg's application	ABT's application
<p>Clothing, namely, shirts, T-shirts, hoodies, trousers, jeans, shorts, sports shorts, swimwear, beachwear, bikinis, swimming costumes, fitted swimming costumes with bra cups, beach cover-ups; underwear, lingerie, boxer shorts, teddies, slips, camisoles, chemises, negligees, sleepwear, robes, pyjamas, pyjama sets, baby doll nightdresses, nightdresses, bras, sport bras, bralets, bustiers, bra accessories, namely bra straps, bra extenders, bra pads, self-adhesive support tapes for wear, panties, g-strings, thongs, boylegs, bikinis, briefs, garter belts, girdles, tracksuits, articles of outerwear, coats, jackets, jumpers and cardigans, pullovers, twinsets, knitwear, leggings, neckties, waistcoats, headbands and wristbands, skirts, wraps, jerseys, blouses, dresses, sweatshirts, bibs, stockings, ties, shawls, blazers, headbands and wristbands, overalls halter tops, tank tops, crop tops, sweaters, dresses, blazers, blouses, slacks, suits, vests, sweatpants, sweatshirts, socks and hosiery, stockings, pantyhose, tights, leotards saris, sarongs, ties and belts, scarves, shawls, gloves, mittens, belts (being articles of clothing), aprons, footwear, namely, boots, shoes, slippers, sandals, trainers, booties, workout shoes and running shoes, beach shoes, soles for footwear, headgear, namely, headbands, hats, caps, berets, earmuffs, top hats, visors, baseball caps, headbands, beanies.</p>	<p>Clothing; headgear; footwear; t-shirts; sweatshirts; vests; jumpers; trousers; shorts; baseball caps; bandanas; trainers; socks; gloves; scarves.</p>

55. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme

v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

56. Mr Sugg’s specification of goods covers clothing, footwear and headgear per se but also sets out named goods each of which are included within the terms clothing, headgear and footwear as are specified in ABT’s application. Consequently, the respective goods are identical.

57. Subject to ABT’s application achieving registration, as I have found the respective marks and goods to be identical, it follows that the opposition founded on section 5(1) of the Act will succeed.

Summary

58. Mr Sugg’s opposition to ABT’s application No 3089624 fails in its entirety. Subject to ABT’s application being registered, its opposition to Mr Sugg’s application no 3106420, which was directed only at those goods in class 25, will succeed and the application will be refused insofar as it seeks registration for goods in class 25. It will be allowed to proceed to registration in respect of all other goods and services which were not subject to opposition.

Costs

59. ABT has succeeded in defending the opposition against its application and succeeded in its (partial) opposition to Mr Sugg’s application. It is entitled to an award of costs in its favour to reflect this success. Both parties agreed that this was a case where costs from the usual scale applies.

60. I note that the two cases were consolidated at an early stage and that whilst the application by ABT to file late evidence led to the postponement of the original hearing and would have led to an amount of additional expense to Mr Sugg, these expenses are likely to have been cancelled out by the additional costs caused to

ABT by Mr Sugg's own application to file late evidence. Taking all things into consideration, I make an award in the sum of £1,850 made up as follows:

For filing a notice of opposition and reviewing the other side's counterstatement (opposition 404894):	£200
Fees:	£100
For filing a counterstatement and reviewing the other side's notice of opposition (Opposition 404245):	£300
For filing and reviewing evidence:	£750
Preparation for and attendance at hearing:	£500
Total:	£1,850

61. I order Joseph Graham Sugg to pay ABT Merchandising Ltd the sum of £1,850 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of January 2017



Ann Corbett
For the Registrar
The Comptroller-General