

**O/0249/26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3967457**

**BY THE WOOF PACK LTD**

**TO REGISTER:**

**Train Up Pup**

**AS A TRADE MARK IN CLASSES 28, 31 & 41**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO**

**UNDER NO. 445600 BY**

**PICK N MIX PUP LTD**

## BACKGROUND AND PLEADINGS

1. On 13 October 2023, The Woof Pack Ltd (“the applicant”) applied to register **Train Up Pup** as a trade mark in the United Kingdom in respect of the following goods and services:

Class 28

*Toys for dogs.*

Class 31

*Dog treats [edible]; Edible dog treats; Dog biscuits.*

Class 41

*Training in dog handling; Animal training; Obedience training for animals.*

2. The application was accepted and published for opposition purposes on 27 October 2023.

3. On 29 January 2024, the application was opposed by Pick N Mix Pup Ltd (“the opponent”). The opposition is based on sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods and services in respect of which registration is sought.

4. Under section 5(4)(a), the opponent claims to have used the sign **TRAIN UP PUP** throughout the UK since 2018 for the following services: *Dog training services (online and in person); e-commerce store for dog related products; dog related toy workshops.* The opponent claims that it has acquired substantial goodwill under the sign and that use of the contested mark would give rise to a misrepresentation that the applicant is connected or affiliated with the opponent. The opponent would suffer damage through loss of sales, disruption to its business and dilution to the distinctiveness of the earlier sign and the reputation and goodwill attached to it. Consequently, use of the contested mark would be contrary to the law of passing off.

5. Under section 3(6), the opponent claims that it became aware of the applicant’s use of the contested mark for dog-related products and services and contacted the applicant on 11 October 2023 to ask that it cease using the contested mark. The application was made two days after this contact. The opponent claims that this

application was made in bad faith in order to prevent the opponent from using the sign. The opponent also notes that the applicant registered the company Train Up Pup Ltd at Companies House on 16 October 2023.

6. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of the claimed goodwill.

7. Both parties filed evidence. I shall summarise this to the extent that I consider necessary.

8. Neither side requested a hearing and I have taken this decision following a careful consideration of the papers, that are listed below. In these proceedings, the opponent is represented by Virtuoso Legal LLP and the applicant by Sonder & Clay.

## **EVIDENCE AND SUBMISSIONS**

9. The opponent's evidence in chief comes from Tesla Raessi, director and shareholder of the opponent, a position she has held since the company's incorporation on 6 January 2023. Her witness statement is dated 29 July 2024 and goes to the claimed goodwill in the sign **TRAIN UP PUP** and the claims that the contested mark was filed in bad faith. It is accompanied by a single exhibit, containing several documents.

10. The applicant's evidence comes from Ellen Greenwood-Sole, the director and shareholder of the applicant, a position she has held since January 2018. Her witness statement is dated 26 September 2024 and is accompanied by seven exhibits. Her evidence goes to the origin of the contested mark, preparations to trade under it, and the results of searches for the opponent's website and of its social media accounts.

11. The opponent filed evidence in reply in the form of a second witness statement from Ms Raessi dated 23 December 2024. It primarily consists of submissions on the applicant's evidence and is accompanied by a single exhibit consisting of two pages with information on the setting up of the website and social media accounts and examples of contacts from third parties. These pages had previously been filed in Exhibit TR1.

12. Both parties filed written submissions in lieu of a hearing on 10 February 2025.

## RELEVANCE OF EU LAW

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

## DECISION

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

“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 or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

15. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

16. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the “classical trinity” that must be proved in order to reach a finding of passing off at [406]:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the

public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

### **Relevant Date**

17. In *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220, Kitchin LJ (as he then was) said:

"165. ... Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the [contested] trade mark would have amounted to passing off. But if the [contested] trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began."

18. Ms Greenwood-Sole states that she began preparations to use the sign that is the subject of her trade mark application in autumn 2022, but the first public use shown in the evidence dates from 12 March 2023. These are the first posts on Instagram and

Facebook.<sup>1</sup> As Thomas Mitcheson QC, sitting as the Appointed Person, explained in *CASABLANCA Trade Mark*, BL O-349-16, it is not necessary for the applicant to demonstrate that it had goodwill at this point: see paragraphs 35-37. I shall treat 12 March 2023 as the relevant date.

### **Goodwill**

19. The opponent must show that it had goodwill in a business at the relevant date and that the sign relied upon is associated with, or distinctive of, that business.

20. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

21. 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 RPC 97 as qualified by *BALI Trade*

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<sup>1</sup> Exhibit EGS7.

*Mark* [1969] RPC 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.”

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

“8. [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.”

23. In *Starbucks (HK) Limited & Anor v British Sky Broadcasting Group Plc & Ors* [2015] UKSC 31, Lord Neuberger (with whom the rest of the Supreme Court agreed) stated that:

“47. I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. ...”

24. The most obvious evidence to file to prove the existence of customers consists of sales figures. I note that Ms Raessi states that she has been unable to provide any

sales information dating from the period before January 2023, when her business was reorganised into two separate entities, Boomerang Dogs Ltd (her first business) and the opponent.<sup>2</sup> The absence of sales figures is not necessarily fatal to the opponent's case, but I would expect to see evidence of activities carried out under the sign and promotional materials. The fact that a domain has been purchased does not in itself indicate that there have been any customers.

25. The same applies with respect to the setting up of social media accounts. Exhibit TR1 contains seven social media posts.<sup>3</sup> Not all of them show the sign. Of the three that do, the earliest is dated 5 November 2020 and begins: *"Welcome to the Train Up Pup Puppy Support Group"*. This announces the setting up of a Facebook group by Ms Raessi and another dog trainer to offer advice on puppy training. It refers to the experience of the two experts in their businesses, but does not name those businesses. There is also a post dated 22 December 2020 focusing on play. It has had 2 reactions, 13 comments and 197 views as at the date when the post was captured for the purposes of preparing this exhibit. Finally, there is an undated post headed *"Step by Step Puppy Toilet Training Guide by Train Up Pup"*. This has a copyright marking of 2020. In her first witness statement, Ms Raessi refers to *"a large following"* on social media, but does not give any figures.<sup>4</sup> I note that Ms Raessi says that historical posts were deleted at the start of January 2023 *"in line with a new marketing strategy"*.<sup>5</sup> She does not say what period was covered by these deletions.

26. Ms Raessi submits that:

"20. Given the Opponent's longstanding use of the Earlier Mark (Train Up Pup), the public associate the Earlier Mark as being derived from the Opponent in the field of dog related goods and services. The very fact that our customers have contacted us about the Applicant and its use of the Opposed Mark proves that the Opponent has good will."

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<sup>2</sup> First witness statement, paragraph 8.

<sup>3</sup> Page 3.

<sup>4</sup> First witness statement, paragraph 14.

<sup>5</sup> Ibid, paragraph 11.

27. Page 2 of Exhibit TR1 contains five undated screenshots that Ms Raessi states seek clarification “*as to whether we have a connection with the Applicant’s business*”.<sup>6</sup> I accept that three of these clearly refer to the applicant’s business. The other two refer to another business using the opponent’s name, without indicating which of the opponent’s names is relevant.

28. In her second witness statement, Ms Raessi refers to Exhibit ESG7 which, the applicant submits, shows that the first posts made on the opponent’s “Train Up Pup” Instagram and Facebook accounts date from 18 October 2023 and 7 May 2023 respectively. Ms Raessi says:

“15. ... this completely correlates with my First Witness Statement and the fact that I undertook a rebrand exercise. The rebrand was undertaken without the knowledge that I would subsequently have to produce evidence about the Opponent’s business for the purposes of any Opposition.”

29. I have already referred to the paragraph from Ms Raessi’s first witness statement in which she states that historical posts were deleted in January 2023. She does not seek to rely on the posts I have described in paragraph 25 above, although given the small number of posts it is unlikely that these would have made a difference in the context of the evidence as a whole. Rather, she draws my attention to the contents of Exhibit TR2, which show the dates of the purchase of the domain trainuppup.com and the setting up of the Facebook and Instagram accounts, and the comments seeking clarification as to whether there is a connection between the parties. Ms Raessi does not explain why there is a gap from 2020 to 2023. If there had been posts in this period, it should have been a simple task to supply them in evidence. I have already noted that she does not clearly state what period was covered by the deletions of historical posts.

30. The law may protect a small level of goodwill, but the burden is still on the opponent to demonstrate that it has a protectable level of goodwill in the form of customers. In my view, this is a burden that has not been discharged, and so the section 5(4)(a) claim falls at the first hurdle.

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<sup>6</sup> Ibid, paragraph 23.

## Section 3(6)

31. Section 3(6) of the Act is as follows:

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

32. In *Skykick UK Ltd & Anor v Sky Ltd & Ors (Rev1)*, [2024] UKSC 36, the Supreme Court considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, *Sky plc & Ors v Skykick UK Limited & Anor*, Case C-371/18, *AS v Deutsches Patent- und Markenamt*, Case C-541/18, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, *Hasbro, Inc. v European Union Intellectual Property Office*, Case T-663/19, *pelicantravel.com s.r.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-136/11, and *Psytech International Ltd v OHIM*, Case T-507/08. Lord Kitchin summarised the law and I reproduce below the principles that are relevant to the instant case:

“240. The general principles are these:

(i) ...

(ii) The date for assessing whether an application to register an EU trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation in the European Union, and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*Malaysia Dairy*, para 29; *Sky CJEU*, para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the

course of trade. Further, it must have regard to the objectives of the EU law of trade marks, namely the establishment and functioning of the internal market, and a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; *Koton*, para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*Hasbro*, paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

...

33. Further relevant points arising from the case law are the following:

(a) An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies. However, Arnold J (as he then was) said that “*cogent evidence is required due to the seriousness of the allegation*”. This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited & Anor* [2012] EWHC 1929 (Ch), paragraph 133;

(b) It is necessary to ascertain what the applicant knew at the relevant date: see *Red Bull*, paragraph 137; and

(c) Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: see *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors*, [2008] EWHC 3032 (Ch), paragraph 167.<sup>7</sup>

34. The opponent claims that the objective of the applicant was to prevent the opponent from using the sign relied upon under section 5(4)(a) as an earlier right. The Court of Justice of the European Union (“CJEU”) confirmed in paragraph 53 of its judgment in *Lindt* that in claims of such a kind all relevant factors must be taken into account, in particular:

“- the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which the registration is sought;

- the applicant’s intention to prevent that third party from continuing to use such a sign; and

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<sup>7</sup> Approved by the Court of Appeal in *Hotel Cipriani Srl & Ors v Cipriani (Grosvenor Street) Limited & Ors* [2010] EWCA Civ 110.

- the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought."

35. The opponent claims that the applicant knew about its use of the earlier sign as it had contacted the applicant on 11 October 2023. Copies of the messages between the two parties are reproduced in Exhibit TR1. In short, the opponent made the initial contact and followed this up on 13 October 2023 when it had not received a reply. The applicant explained that they had just seen the message and asked what the opponent would like to discuss. The opponent explained that it was the brand name "Train Up Pup" and that it provided similar goods and services. The applicant said that they were away in Scotland with patchy communications.

36. This is the only evidence that goes to the applicant's knowledge. The weaknesses of the evidence adduced to show goodwill are such that I am not prepared to infer from it that the applicant is likely to have known about the opponent prior to the approach in October 2023.

37. I remind myself that an allegation of bad faith is a serious one that must be distinctly proved. In *Lindt*, the CJEU said:

"46. Equally, the fact that a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that the sign enjoys some degree of legal protection is one of the factors relevant to the determination of whether the applicant was acting in bad faith.

47. In such a case, the applicant's sole aim in taking advantage of the rights conferred by the Community trade mark might be to compete unfairly with a competitor who is using a sign which, because of characteristics of its own, has by that time obtained some degree of legal protection.

48. That said, it cannot however be excluded that even in such circumstances, and in particular when several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration is sought, the applicant's registration of the sign may be in pursuit of a legitimate objective.

49. That may in particular be the case, as stated by the Advocate General in point 67 of her Opinion, where the applicant knows, when filing the application for registration, that a third party, who is a newcomer in the market, is trying to take advantage of that sign by copying its presentation, and the applicant seeks to register the sign with a view to preventing use of that presentation.”

38. The applicant submits that the opponent’s messages constitute a vague threat of undefined legal action and required a response in a very short timescale before referring the matter to a solicitor. The applicant argues that in this context its actions were reasonable and intended to protect the position of its business. In *Hotel Cipriani*, Arnold J (as he then was) said:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”<sup>8</sup>

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<sup>8</sup> This part of the judgment was also approved by the Court of Appeal.

39. Following the case law cited I have cited, I find that the facts that are before me are equally as capable of supporting a claim of good faith as one of bad faith, and so I find that the opponent has not established a *prima facie* case of bad faith.

40. The section 3(6) claim fails.

## **OUTCOME**

41. The opposition has failed and, subject to a successful appeal, Application No. 3967457 may proceed to registration.

## **COSTS**

42. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 1/2023. In the circumstances, I make the following award:

*£300 for preparing a statement and considering the other side's statement;*

*£600 for preparing evidence and considering the other side's evidence;*

*£400 for preparing written submissions in lieu of a hearing.*

***£1300 in total.***

43. I therefore order Pick N Mix Pup Ltd to pay The Woof Pack Ltd the sum of £1300. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24<sup>th</sup> day of March 2026**

**Clare Boucher**

**For the Registrar,**

**Comptroller-General**