O/0332/26

TRADE MARK ACT 1994

CONSOLIDATED PROCEEDINGS

BEING

TRADE MARK APPLICATION NO.3684680

IN THE NAME OF FAY BOSWELL

AND

OPPOSITION NO.431080 IN THE NAME OF DENTON LAMBERT

AND

TRADE MARK APPLICATION NOS.3738381, 3738382, 3738384 & 3738379

IN THE NAME OF DENTON LAMBERT

AND

OPPOSITION NOS.432838, 432840, 433489 & 433490

IN THE NAME OF FAY BOSWELL

Background & Pleadings

1. These five consolidated cross proceedings concern two parties, Fay Boswell (hereinafter FB) and Denton Lambert (hereinafter DL)[1]. A table detailing all the contested marks, the respective applicant and opponent details, and relevant dates is set out below:

Opp.431080 (lead case) **TM No.3684680**	**Opp.432838** **TM No.3738381**	**Opp.432840** **TM No.3738382**	**Opp. 433489** **TM No.3738384**	**Opp. 433490** **TM No.3738379**
			EXCELLENCE	EXCELLENCE BLACK EDITION
Applicant: Fay Boswell **Opponent:** Denton Lambert	**Applicant:** Denton Lambert **Opponent:** Fay Boswell	**Applicant:** Denton Lambert **Opponent:** Fay Boswell	**Applicant:** Denton Lambert **Opponent:** Fay Boswell	**Applicant:** Denton Lambert **Opponent:** Fay Boswell
Filing date: 22 August 2021	**Filing date:** 31 December 2021	**Filing date:** 31 December 2021	**Filing date:** 31 December 2021	**Filing date:** 31 December 2021
Publication date: 12 November 2021	**Publication date:** 21 Janury 2022	**Publication date:** 21 Janury 2022	**Publication date:** 25 February 2022	**Publication date:** 25 February 2022

2. FB's application was opposed by DL under sections 5(4)(b)(copyright) and 3(6) of the Trade Marks Act 1994 ("the Act").

[1] Denton Lambert is also known by the forename Max and there are various references to Max within the substantive evidence.

3. DL's applications were opposed by FB under sections 5(2)(b), 5(3), 5(4)(a), 5(4)(b)(copyright) and 3(6) of the Act.

4. Both sides filed their respective counterstatements denying the opposition grounds brought against them.

5. From the start of these proceedings in 2022 until May 2024, FB was represented by Trademark Eagle Limited. Subsequent to May 2024, FB has represented herself. DL was represented initially by Trademark Wizards Limited up to September 2023, when representation was taken over by Trowers & Hamlins LLP.

6. Both sides filed evidence and written submissions. A hearing was held before me in person on 8 December 2025, at which FB represented herself with the assistance of a McKenzie friend and DL was represented by Michael Hicks of Counsel, instructed by Trowers & Hamlins LLP. Both parties were cross examined, and I make this decision having considered all the written material, information from the cross examination and from submissions made by both parties at the hearing. However given the volume of material in these proceedings I should point out that this decision does not seek to address every point given in evidence or at the hearing as to do so would be disproportionate. I include only the points which I considered relevant to the issues which I need to consider in order to decide if the opposition(s) succeeds or fails. If I have not mentioned a particular point, it does not mean that I have overlooked it, but rather I did not consider it relevant to the issues I need to determine or considered it necessary to refer to in this decision. This approach was considered as the correct one to take by Professor Phillip Johnson, sitting as the Appointed Person, in his recent *Loch Lomond Distillers Limited vs Glens of Antrim Potatoes Limited* decision.[2]

Relevance of EU law

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated

[2] BL O/0121/26 at [12].

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.

Preliminary issues

8. There are a number of aspects to this case involving other parties which have a bearing on each ground of opposition. Consequently, I will begin by setting out the other significant people in relation to the dispute. Justine Lambert (hereinafter JL) is DL's wife and is also the other director of Excellence Games Limited alongside FB, the significance of which will become apparent in the course of the decision. Daniel Blackett (hereinafter DB) is FB's husband. I note these parties were previously known to each other, prior to the dispute, as part of a friendship group through their respective spouses. DB had known JL for some years prior and FB had worked at DL's restaurant for a period of time in 2018 and 2019. Sering Sambou (hereinafter SS) was the graphic designer working with the parties in the Autumn of 2020.

EVIDENCE

DL's evidence

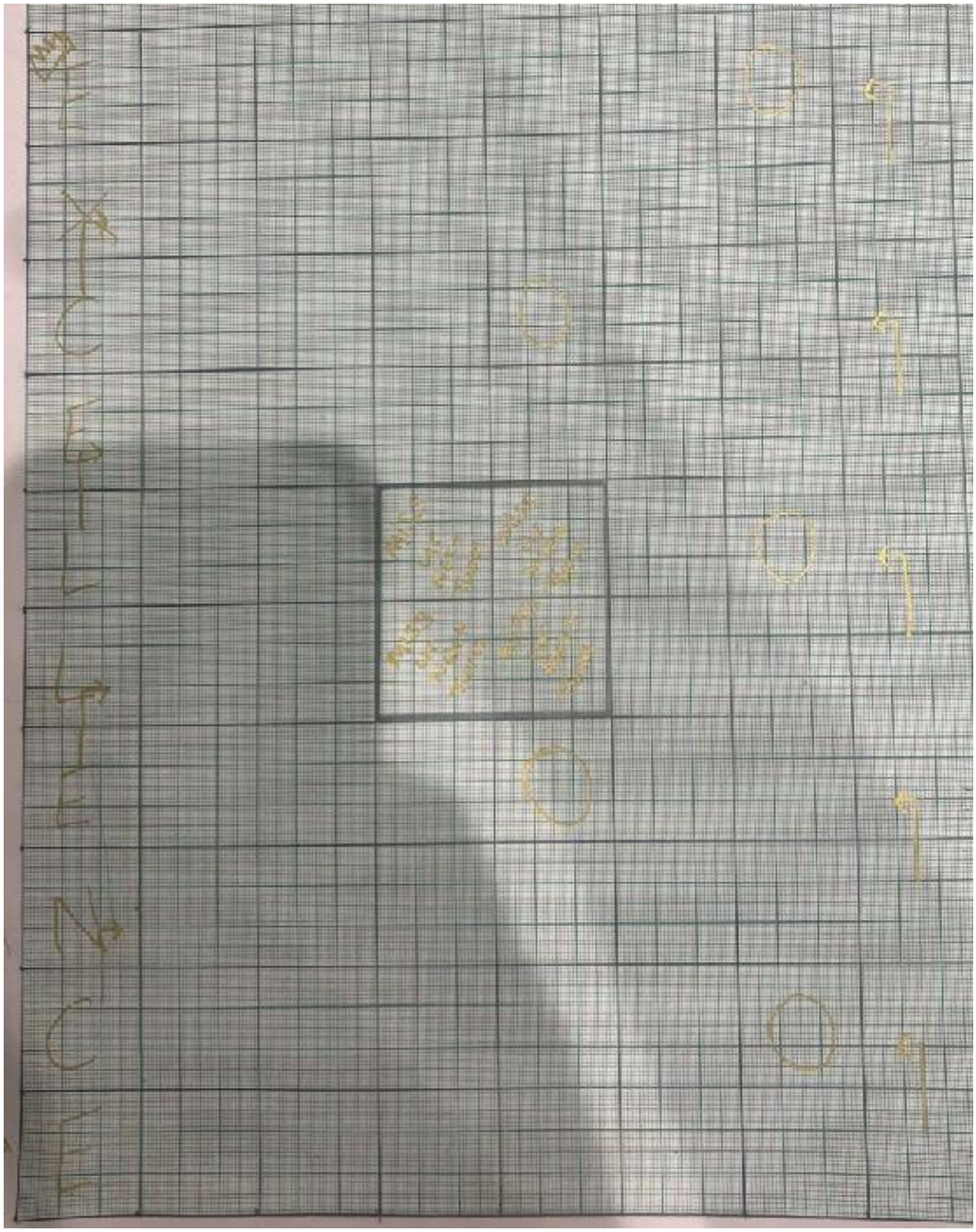
9. DL filed four witness statements at various stages of the proceedings and annexed six large exhibits. In addition to DL's own evidence, two further witness statements were filed in support of his case. The first being in JL's name and the second in SS's name. I will not summarise the evidence in full here due to its volume, but I draw out the most pertinent points below.

10. DL states in his first witness statement, dated 25 October 2022, that in October 2019, he and his wife had an idea for a game focussed on black history and culture. The idea evolved in April 2020 with discussion between them of using the word "Excellence" and the image of a crown, both of which are used prominently in the Black community. DL states he and his wife held an online games night in April 2020 which FB and DB attended, with DL and JL providing the content and questions. On 4 July 2020, and still continuing to develop the board game idea, DL states that he and his wife decided to use a map of Africa on the board itself and to use a black and gold

colour scheme, which was similar to the colour scheme used by DL in another business venture relating to cosmetics.[3]

11. Specifically in relation to the contested marks DL, in his third witness statement dated 13 October 2023, exhibited some undated sketches of the boards using the word EXCELLENCE and a crown device which he says he created in August 2020.[4] I reproduce an example below including a sketch where the crown is positioned on the top left of a capital letter E:

[3] Exhibit DL1, page 5.
[4] Exhibit DL3, pages 1 & 2.



12. DL states that in early August 2020, he and his wife invited FB and DB to their house to discuss the Excellence board game project. He further states that FB was invited only to write up the rules and the “how to play” elements of the game, with JL working on questions and DL working on game design.

13. DL exhibits an Instagram message dated 21 August 2020 sent by JL to a friend, Carli Pryce, asking for assistance with a logo and board design.[5] Also exhibited is a

[5] Exhibit DL1, pages 2 & 3.

quote addressed to JL from Ms Pryce for £275, for “Hand Drawn Logo – Upper Case Letter E”.[6] DL states that nothing further came of the enquiry to Ms Pryce.

14. DL exhibits an invoice from account.godaddy.com dated 4 September 2020 for the purchase of two domain names namely excellencegames.co.uk and excellencegames.com.[7]

15. On 24 August 2020, DL states he was introduced to SS, who was a graphic designer. DL states he met with SS on 3 occasions during September 2020 to commission graphic images for the logo based on the sketches DL had produced, in addition to other images for the box, cards and board. In Exhibit DL1 at page 9, there are two photographs, taken by a mobile phone and send via text message dated 1 September 2020, of two hand drawn images of a three dimensional box with compartments, a list of requirements for the game such as colour, size, map of Africa and a logo comprising a cursive letter E topped by a crown device followed by a hyphen and the word Excellence.

[6] Exhibit DL1, page 4.
[7] Exhibit DL1, page 6.

16. DL also exhibits a contract[8] dated 10 September 2020 signed by himself, SS and witnessed by DL's brother, Aaron Watt. The contract stipulates the graphic design work to be undertaken by SS, which is set out below, as well as the timetable for completion and the price for the work.

A complete graphical design of a board game including but not limited to:

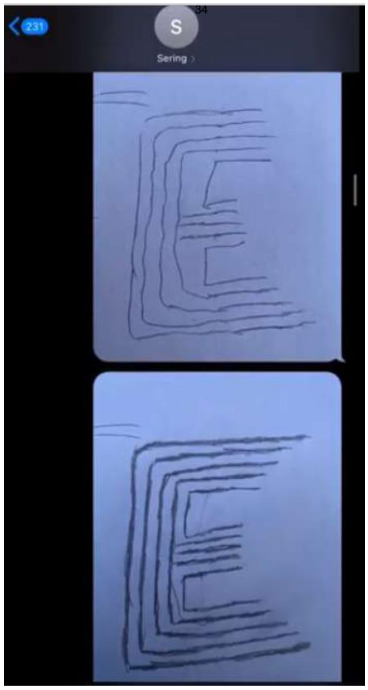
Excellence logo – Gold 'E' with a crown
Font design – Excellence
Complete design of board to include an African map
Complete design of box (wording to be confirmed)
Design of cards

17. The contract also includes the following clause:

Should Mr Lambert delay or fail in processing scheduled payments, I will stop production of designs until such payments are fulfilled. Once this project is complete and payment is settled in full, all entitled rights will be given to Mr Denton Lambert.

[8] Exhibit DL1, page 13.

18. DL then exhibits a further text message dated 15 September 2020[9] in which he sends SS three hand drawn images of a capital letter E comprised of lines, as set out below:



19. On the same date namely 15 September 2020 SS replied to DL's text message with the following images, viz.

The image was followed by the message "The first one on the left is meant to be your drawing. Is that what you meant?"[10]

20. On the following day, namely 16 September 2020, SS sent the image below:

[9] Exhibit DL1, page 33.

[10] Exhibit DL1, page 36.

21. DL further exhibits text messages from SS[11], dated 16 October 2020, in which SS enclosed an image of the board game box design which includes the word and device element, namely 

.

22. DL further exhibits a series of message exchanges with SS between September and December 2020 in relation to the logo, the box design, the board design, the colour scheme and the question cards.[12] In several of the message exchanges, SS indicates that he is seeking DL's approval before sending the images he has created to "the group".[13] Specifically in relation to the board design DL exhibits a message from SS dated 21 October 2020 in which the image of the board itself is enclosed, marked "final file", with an additional message by SS saying "I haven't sent it to your whole team yet bro just to you first".[14]

23. DL also exhibits a Deed of Assignment dated 31st December 2021[15] between SS and DL in which SS assigns all rights, title and interest in the copyright of all the images set out in Schedule 1 of the deed to DL. The images in Schedule 1 are set out below, namely:

[11] Exhibit DL1, page 61.
[12] Exhibit DL1, pages 36-74.
[13] Exhibit DL1, page 36.
[14] Exhibit DL1, page 70.
[15] Exhibit DL1, pages 78-85.

FB's evidence

24. In total FB filed five witness statements and ninety-six exhibits.[16] In addition FB's evidence also contains two witness statements in the name of DB, and a witness statement in name of Gemma Walker (hereinafter GW) who is FB's friend. Also in evidence is a report drawn up by Louie Holbrook, a digital forensic examiner employed at Keith Borer Consultants. The forensic expert was commissioned by the parties to examine all emails, extant and deleted, in the justfay2020@gmail.com email account (hereinafter the justfay2020 email) before 1 December 2021. This was felt necessary as FB had made submissions in the prior case management conferences relating to these proceedings that she had been locked out of the Justfay2020 email account by DL and he had deleted a number of critical emails in an attempt to prevent FB from fully presenting and evidencing her case.

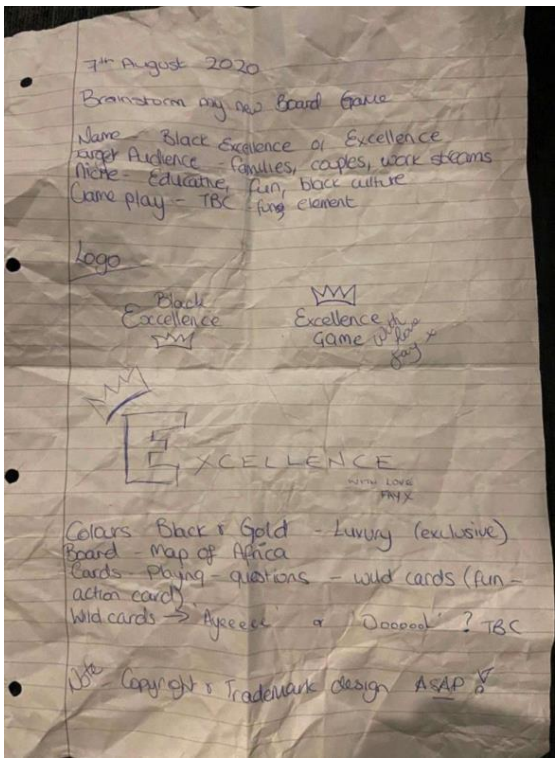
25. As previously stated, I will not summarise the evidence in full here due to its volume, but I draw on the most pertinent points below.

26. In her first witness statement FB states that she had started to develop board game ideas between January and July 2020. Moreover she states by July/August 2020 she

[16] FB's 5th witness statement dated 1 December 2025 sought to make corrections to her 1st witness statement dated 4 October 2022 which was prepared by her previous representative.

had come up with the name “Excellence - the black edition”, the crown device above the letter E and the black/gold colour scheme. In her second witness FB states that she approached GW in July 2020 seeking advice on her board game idea. GW’s witness statement is at exhibit FB75. GW states that on 15 July 2020 FB drew a picture of the logo for her, told her about the word EXCELLENCE and the black and gold colour scheme. GW says the logos shown to her were those at exhibits FB2 and 3, which I refer to below. GW also states that during this conversation she “mentioned [to FB] the importance of trademarking her logo”.[17]

27. FB exhibits the following sketch dated 7 August 2020 at FB2, viz.



28. Exhibit FB3 contains the following image, viz.

[17] Gemma Walker witness statement, paragraph 5.

29. FB states that on 10 August 2020 she approached JL with a view to starting a company under the name Excellence Games Limited. Moreover FB states that JL had agreed that FB would own the trade mark and IP rights.[18]

30. On 18 August 2020, FB emailed JL with a draft of some game play and the image of the cursive letter E, set out above in paragraph 28, about which FB says in the email, "the logo is just something I done real quick, I know it's not how we want it, but just to get a feel".[19]

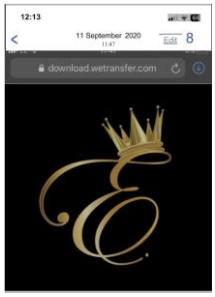
31. FB goes on to state that the board game business was to be undertaken by her and JL with DL acting only in the capacity of investor.[20] She states that DB paid monies to DL to cover a contribution to the cost of the graphic design work undertaken by SS. DL also made a payment to cover the cost of the games production. To that end FB exhibits a contract document dated 16 May 2021 which sets out the details of the loan arrangement DL set up with FB and JL, as directors of Excellence Games Limited, to pay for the production of the games by Cartamundi.[21]

32. FB states that it was she who commissioned SS to undertake the design work based on her drawings. Moreover she exhibits an unsigned non-disclosure agreement (NDA) dated 9 September 2020 between Excellence Games Ltd and SS.[22] FB states that the document was actually signed on 11 October 2020 but had been backdated to take account of their previous meetings. FB further claims that the original signed NDA was held by JL and the email to which it was attached and sent to the justfay2020 email address was deliberately deleted by either JL or DL to prevent FB having a signed copy.

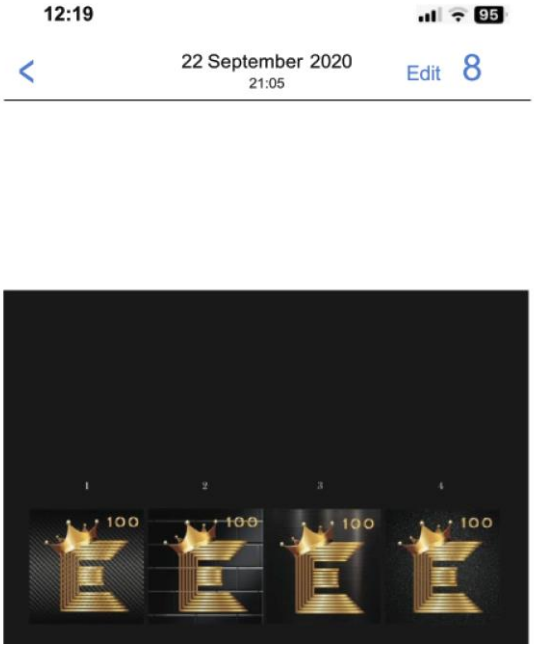
33. FB exhibits a number of emails from SS sent to the Justfay 2020 email account and dated between 11 -24 September 2020 in which SS encloses a number of jpg files via the WeTransfer platform.[23] The content of most of the jpg files is not exhibited, but

[18] FB 1st witness statement, paragraph 5.
[19] Exhibit FB3.
[20] FB 1st witness statement, paragraph 5.
[21] Exhibit FB24.
[22] Exhibit FB14.
[23] Exhibits FB8-12.

SS's email text indicates they contain "logo design concepts". In exhibit FB79, FB exhibits the image from the WeTransfer platform dated 11 September 2020, viz.



34. In exhibit FB81, FB exhibits the following image which she states was sent from SS to the justfay2020 email account on 22 September 2020, viz.



35. FB states that she published a copy of the board design including the  contested mark on Instagram, set out below, dated 25 September 2020[24], viz.

[24] Exhibit FB13.

36. FB has accused DL of deleting a number of relevant emails from the Justfay2020 email account for the purpose of removing evidence that she might otherwise have used to prove her claim. In FB's fourth witness statement she provides a forensic examiner's report which indicates that some emails were deleted from Justfay2020 email account and the content of these emails was not retrievable.[25] FB states that she took screenshots of some of the deleted emails between SS and the Justfay 2020 email address[26] which she states proves her point that DL was deliberately deleting emails.

DECISION FOR OPPOSITION NO. 431080

Statutory Provisions for Section 5(4)(b)

37. Section 5(4)(b) of the Act is as follows:

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented–
> […]
> (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright, or the law relating to industrial property rights.
> 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."

[25] Exhibits FB88.1 – 96.1.
[26] Exhibits FB88 – 96.

38. In deciding this ground, I must address the following questions:

- Is the earlier mark a work under the Copyright, Designs and Patents Act 1988 ("CDPA") and therefore capable of being protected by copyright?
- Does the work meet the qualification criteria for copyright protection?
- Who is the owner of the work and when was it created?
- Would use of the contested mark constitute an infringement of any copyright?

Whether the earlier mark is a work under the CDPA

39. Section 1 of the CDPA states that:

> "Copyright is a property right which subsists in accordance with this Part in the following descriptions of work–
> (a) original literary, dramatic, musical or artistic works,
> (b) sound recordings, films or broadcasts, and
> (c) the typographical arrangement of published editions."

40. Section 4 of the CDPA is as follows:

> "(1) In this Part 'artistic work' means-
> (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
> (b) a work of architecture being a building or a model for a building, or (c) a work of artistic craftsmanship.
> (2) In this Part – …
> 'graphic work' includes – (a) any painting, drawing, diagram, map, chart or plan, and (b) any engraving, etching, lithograph, woodcut or similar work;
> …"

41. In *Griggs Group Ltd v Evans*,[27] Peter Prescott Q.C., as a deputy judge of the High Court, said:

[27] [2003] EWHC 2914 (Ch).

> "18. … a drawing is capable of being a 'work'. So if an artist uses his skill and labour to draw a word or phrase in a stylised way, as in the case of a logo, his drawing is capable of being an original work, protected by copyright law."

42. I consider that DL's work is a graphic work and therefore capable of being protected by copyright.

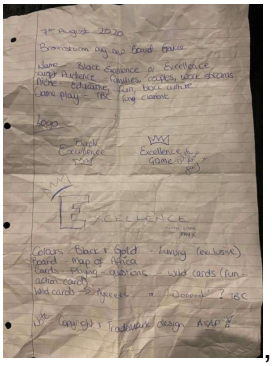
Whether the work meets the qualification criteria for copyright protection

43. Section 153 of the CDPA states that copyright does not subsist in a work unless certain conditions are met. These are set out in the following sections of the Act and relate to the citizenship or residence of the author at the time the work was created or published, or the place where it was first published. DL's works were first published in the UK and DL is a citizen and resident of the UK.

Ownership of the work and its creation

44. During my examination of the evidence what emerged regarding ownership and creation was a very confusing picture of several individuals, namely FB, JL and DL, all making various contributions towards the Excellence board game project. However with specific focus on the relied on work, I noted within DL's evidence that he provided a sketch of a capital letter E comprised of lines, namely  , to SS on 15 September 2020. Subsequently on the same date SS sent DL this letter E and device, namely  , based on DL's hand drawn sketch of the letter E comprised of lines. Subsequently SS sent the word and device mark, namely 

on 16 October 2020. These two components essentially form the basis of the contested trade mark. FB has not been able to produce evidence of a capital letter E comprised of lines, although under cross examination she stated that DL's sketches were based on her idea and were sent to SS under her supervision. FB's own evidence namely

the hand drawn sketch dated 7 August 2020, i.e.  , contains a crown device and a capital letter E but without lines whereas the image in the email message to JL dated 18 August 2020, namely 

, contains a crown device and a cursive letter E. A cursive letter E with a crown was also developed by SS and sent to FB as seen in the image in paragraph 33. Under cross examination FB stated that the image included in the 18 August 2020 email to JL was generated by a free online software tool called Logo Maker. What is apparent from all evidence filed in these proceedings is that both sides have exhibited some documents which give examples of letters E with crown devices solus and forming part of the word Excellence. However the copyright question I am asked to consider is not about the idea of a capital letter E with a crown device, but is about the creation of the very specific capital letter E comprised of lines with a crown device at its top left point as the first letter of the word Excellence.

45.Taking the above into account, I am left to consider the situation whereby FB cannot prove in documentary evidence she was the originator of the capital letter E comprised of lines which forms the basis of the contested trade mark, whereas there is evidence from DL dated 15 September 2020 that he provided the sketch of the capital letter E comprising lines, from which SS created the graphic images which form the contested trade mark. What I also have before me are a number of key documents, namely:

- The contract signed between DL and SS dated 10 September 2020 in which SS says all “entitled rights” will be transferred to DL upon final payment.
- An unsigned NDA dated 9 September 2020 between SS and Excellence Games Limited in which the latter entity is designated as the inventor.

- The deed of assignment dated 31 December 2021 in which SS assigns all rights in the created image to DL.

46. Turning first to the 10 September contract, the veracity of which was challenged by FB who submitted that it was manufactured after the event for the purpose of supporting DL's claim. When asked to disclose the date properties of this word document DL was unable to do so, stating in his third witness statement that he did not have an electronic copy of the document and when he asked SS for the document properties, SS responded that he no longer had the document as there had been damage to his computer's hard drive. [28] This is clearly unhelpful. However on the face of it, the wording of the contract indicates that SS regarded DL as his client for the purpose of this commission, as is also apparent by the number of messages exchanged between the two where SS states that DL is seeing files etc before either FB or JL and often asks for DL's agreement before files are sent on. In his witness statement dated 30 October 2022, SS states that,

> "Mr Lambert asked me to liaise with his wife, Justina, and Mrs Boswell using the email address justfay2020@gmail.com ("the email address"). I confirmed this with him by text (page 7 of Exhibit SS1). He explained that they would be my points of contact going forward but I understood that it was his project based on his ideas and that I should liaise with him if I had any concerns."[29]

47. With regard to the NDA document, I find this is unhelpful to FB because Excellence Games Limited is designated as the inventor. Although only an unsigned copy of the NDA is in evidence, the area set out for signatures has a space marked up for a signature on behalf of Excellence Games Limited and the signature of SS. Therefore whether FB or JL (or both) signed the document, they were doing so on behalf of Excellence Games Limited. Sections 2(b) and 10 of the NDA concern confidentiality as it relates to intellectual property (IP) and essentially states that SS should not disclose any information about the inventor's IP rights, nor should he assume rights to use the inventor's IP. However the actual IP rights the NDA refers to are not specified.

[28] Exhibit DL1, page11.
[29] Witness statement of Sering Sambou, paragraph 11.

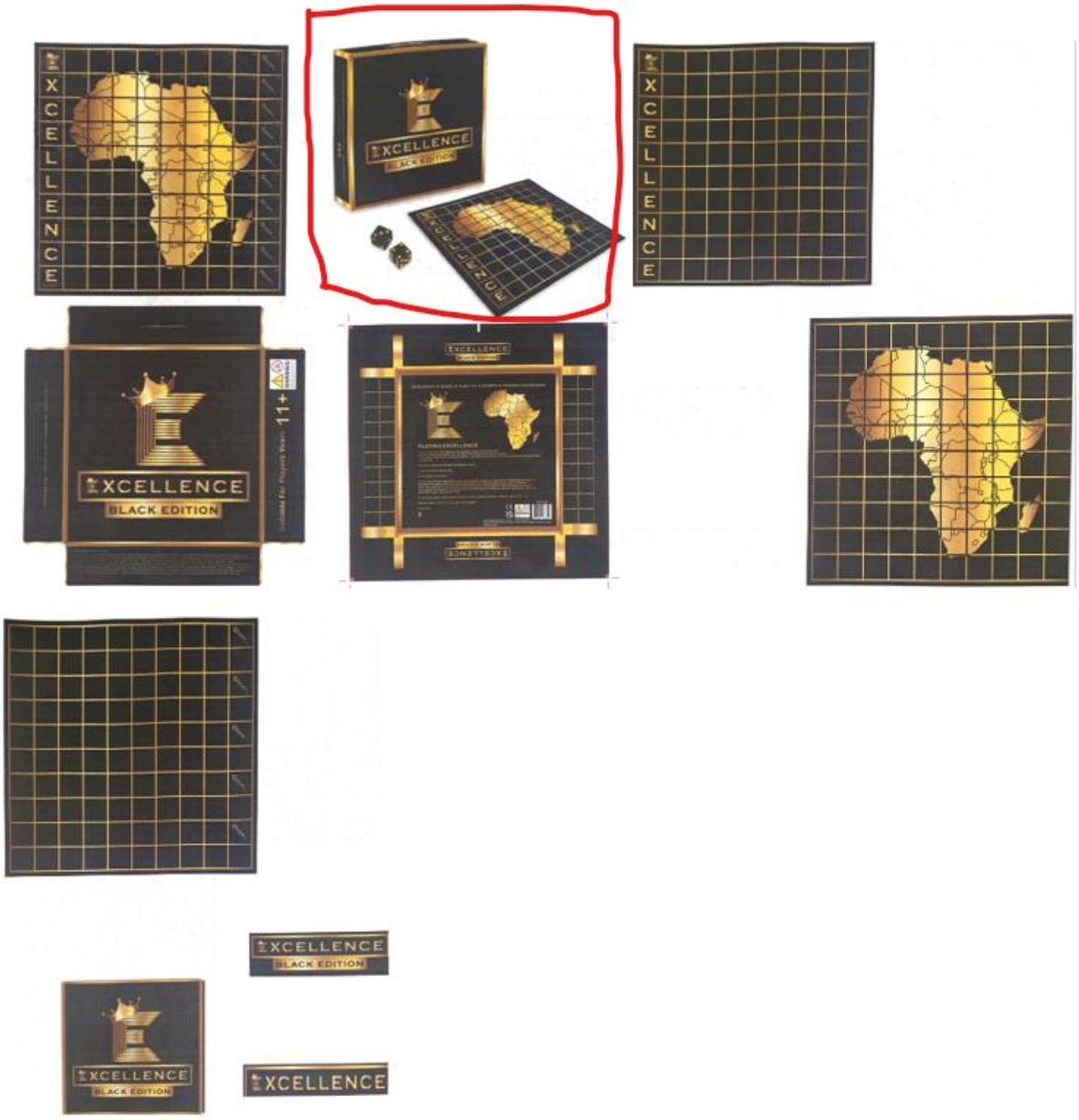
Within his evidence, DL exhibits a copy of a text message exchanged between JL and FB dated 8 September 2020 set out below:[30]

This appears to indicate that all IP rights were intended to be held by Excellence Games Limited by agreement of both FB and JL. This contradicts FB's evidence in her first witness statement, at paragraph 5, where she says JL consented to FB owning all the IP rights. Although nothing turns on this, it is also apparent that SS did not adhere to the conditions set out in the NDA as he was disclosing information to DL, who was not part of Excellence Games Limited.

48. Lastly I turn to the other document before me, which is the deed of assignment dated 31 December 2021. It is important to bear in mind section 9(1) of the CDPA which sets out that the author of a copyrighted work is the person who creates it. In this case, the person who created the image which is now the relied-on work was SS. In section 90 of the CDPA, it states that copyright is transmissible by assignment, and it must be in writing signed by or on behalf of the assignor. In the assignment document SS assigns the copyright in his created work to DL. It strikes me that in the normal course of events SS should have properly assigned the copyright in the relied on work to Excellence Games Limited, and should have probably done so at the point the commissioned work was completed, i.e. December 2020. However for whatever reason he did not but instead assigned the relied-on work to DL on 31 December 2021.

[30] Exhibit DL2, page 2.

I also think it is worth pausing at this point to consider the created works in Schedule 1 which was attached to the Deed of Assignment. For ease of reference these are:



49. The image above, which I have highlighted in red, is specifically referenced within SS's witness statement, namely:

> "On 31 December 2021, I assigned the copyright in the artwork I had created to Mr Lambert (pages 53-60 of SS1) (the "Assignment"). I note that the images in the appendix to the Assignment include a three-dimensional picture of the game with the board and two dice. I confirm that I did not create that image but

that it is an image containing the copyright works that I created (i.e. it is derived from my work). I believe that image was included to illustrate the copyright works. I note, expressly, that the copyright works include the Logo and a further version of the logo including the word 'EXCELLENCE' beneath it."[31]

50. The highlighted image was, I believe, taken from a Whatsapp Group message exchange dated 28 June 2021.[32] The Whatsapp group is titled "Excellence ❤️" and its members appear to include DL, JL and FB although it is not apparent to me if there are other members of the group from the exhibit. The image is accompanied by a message from Queen B that "JJ came through", which I understand refers to JJ Illustrates who were the second graphic designers involved in the board game design prior to production. In my view nothing turns on this point, JJ Illustrates was undertaking refinement work on images created by SS and, until such time as the copyright was assigned, still owned by him. As the created images were assigned on 31 December 2021, and based on the evidence provided, I find that ownership of the work resides in DL.

Whether use of the mark would constitute an infringement of the copyright in the work

51. Section 16 of the CDPA is the relevant legislation and reads as follows:

"(1) The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom –

(a) to copy the work (see section 17);

(b) to issue copies of the work to the public (see section 18);

(ba) to rent or lend the work to the public (see section 18A);

(c) to perform, show or play the work in public (see section 19);

(d) to communicate the work to the public (see section 20);

(e) to make an adaptation of the work or do any of the above in relation to an adaptation (see section 21);

[31] Witness statement of Sering Sambou, paragraph 23.
[32] Exhibit DL1, page 90.

and those acts are referred to in this Part as the 'acts restricted by the copyright'.

(2) Copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorises another to do, any of the acts restricted by the copyright.

(3) References in this Part to the doing of an act restricted by the copyright in a work are to the doing of it –
(a) in relation to the work as a whole or any substantial part of it, and
(b) either directly or indirectly; and it is immaterial whether any intervening acts themselves infringe copyright."

52. Section 17 of the CDPA provides that:

"(1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies should be construed as follows.
(2) Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form. This includes storing the work in any medium by electronic means.
(3) In relation to an artistic work copying includes the making of a copy in three dimensions of a two-dimensional work and the making of a copy in two dimensions of a three-dimensional work.
…
(6) Copying in relation to any description of work includes the making of copies which are transient or are incidental to some other use of the work."

53. In *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/a Washington DC*),[33] Lord Millett set out the approach to assessing whether artistic copyright has been infringed at [2425]-[2426]. He said:

[33] [2000] 1 WLR 2416

> “The first step in an action for infringement of artistic copyright is to identify those features of the defendant’s design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying.
>
> …
>
> Once the judge has found that the defendant’s design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the copyright work. It does not depend upon its importance to the defendant’s work, as I have already pointed out. The pirated part is considered on its own (see Ladbroke (Football) Ltd v William Hill (Football) Ltd [1964] 1 WLR 273, 293, per Lord Pearce) and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose.”

54.DL’s claim is that FB’s mark is identical to his copyrighted work such that it may lead to a likelihood of consumer confusion.

55. The respective marks of DL and FB are set out below:

DL's work	FB's mark
	

56. Clearly the respective marks contain an identical capital letter E comprised of lines with the crown device positioned at an angle on the top left point of the letter and the word EXCELLENCE in a border where the initial letter E of the word is the same capital letter E comprised of lines with the crown device. As such I find that the contested mark would constitute an infringement of the copyright in DL's work

57. The opposition claim brought under section 5(4)(b) succeeds.

Section 3(6)

58. 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."

59. In his amended notice of opposition DL claims that FB,

> "has not designed her logo of her own accord but has deliberately copied and/or taken elements from the Opponent's Mark. As such, the Opponent contends that, at the time of filing, the Applicant knew, or must have known about his logo and the sole purpose of making the application was to either to disrupt the business of the Opponent or prevent the Opponent from using the Opponent's Mark. It is therefore submitted that the act of filing the Application by the Applicant, falls well short of the standards of acceptable commercial

behaviour observed by reasonable and experienced persons in the particular sector at issue, or indeed the marketplace at large."[34]

60. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)*,[35] Lord Kitchin SCJ considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

> "152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.
>
> 153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO) (C-104/18) EU:C:2019:724 ("Koton"), paras 46 and 47 […]."

[34] Amended Notice of Opposition, paragraphs 7-9.
[35] [2024] UKSC 36

61. Lord Kitchin also summarised the general principles applicable to bad faith, at [240] of his judgement, as follows:

> "(i) […]
> (ii) The date for assessing whether an application to register [a] 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 […], 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 Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*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 […] law of trade marks, namely the establishment and functioning of […] 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 Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*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 Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*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).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

62. The mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). The applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Limited & Ors [2008]* EWHC 3032 (Ch). However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat Trade Mark* [2003] RPC 11, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited v DDTM Operations LLC* [2019] EWHC 769 (Ch).

63. According to *Alexander Trade Mark*,[36] the key questions for determination in a claim of bad faith are:

> (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
> (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
> (c) Was it established that the contested application was filed in pursuit of that objective?

64. It is also necessary to ascertain what FB knew at the relevant date.[37] Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date.[38] The relevant date for assessing bad faith is the date of the application for the contested trade mark. In this case the relevant date is 22 August 2021.

65. I must consider whether the application to register the contested mark is an act of bad faith. My consideration depends on whether FB's motivation amounts to a dishonest intention or other sinister motive which must be judged by assessing whether it involves conduct which departs from accepted standard of ethical behaviour or honest commercial and business practice.

66. The evidence provided by both FB and DL is that they independently came to the idea of creating a board game using the name Excellence and the device of crown. As previously stated, a great deal of evidence has been provided by both parties on the roles played by each significant player in these proceedings. It appears to me that in FB's view, DL's role was merely that of investor whereas DL has made his case out that he was an integral part of the creation and development of the board game. Based on the evidence before me DL, FB and JL all appear to be contributing in different ways to the development of the board game. However, DL was not listed as a director in the company set up of Excellence Games Limited which appears to be an unusual

[36] BL O/036/18.
[37] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).
[38] *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

omission for someone who states that they were heavily involved in the creation and development process as the company was intended to be the vehicle to take forward the board game into production and eventually retail. The role of Excellence Games Limited as an entity should also be examined especially as it is designated in the 9 September 2020 NDA, as the inventor. By her own admission at the hearing FB states that the company was set up to sell the game. She also stated that she and JL wanted to go into business together and that they "created the game together".[39] According to FB, again at the hearing, the game was intended to be an asset of the company which suggests in the normal course of commerce, any IP rights would be held in the company's name. The unsigned NDA in evidence designates Excellence Games Limited as the inventor and therefore intended to be the holder of any IP rights. FB accepted at the hearing that she was unclear about the difference between the copyright and trade mark IP rights and that she made a misguided assumption about what protection either right entailed.

67. In terms of the business activities during the Autumn of 2020, it appears to be the case from the evidence provided by FB that work was under way on behalf of Excellence Games Limited to perfect the logo, game play, question cards and the board set up and communications to this effect were exchanged between SS and the justfay2020 email account. This work continued into 2021 with exchanges between JJ Illustrates, Cartamundi and the Justfay2020 email account to make the Excellence board game ready for production. In FB's evidence, she exhibits a copy of a loan agreement for £27,468 dated 16 May 2021 made between DL as the loan provider and FB and JL as directors of Excellence Games Limited with each director being liable for repayment of £13,734.[40] There is also an email dated 14 January 2022 from Cartamundi which states that the contractual relationship was between them and Excellence Games Limited.[41] I accept that this email was written after the relevant date as a response to the dispute, but in my view it helps to cast light backwards on the situational relationship prior to the relevant date. I take from all this activity that FB and JL were working together on behalf of Excellence Games Limited to develop and produce a viable board game.

[39] Hearing transcript, page 67.
[40] Exhibit FB24.
[41] Exhibit FB36.

68. The trade mark application was made by FB on 22 August 2021 which was at or around the time the relationship between FB and JL broke down. It is logical for me to conclude that the trade mark application was made as a reaction to the breakdown of the relationship as no previous trade mark application was made either by FB, JL or indeed Excellence Games Limited despite IP rights being listed as necessary on the handwritten notes dated 7 August 2020 at exhibit FB2. It is possible that FB wanted to make the trade mark application to protect what she perhaps misguidedly believed to be her intellectual property, although at this time the images on which the trade mark was based had not been formally assigned in writing and were still in the ownership of SS. However, I must also consider the possibility that her intention may have been to frustrate the subsequent actions of Excellence Games Limited, or perhaps more particularly JL. Her interactions with DL at the relevant date are less clearcut and appear to be limited to discussions about finance rather than IP rights.

69. Taking all of the above into account, the evidence before me suggests that the effort and work which had gone into the Excellence board game project was done on behalf of Excellence Games Limited. The company was not dissolved or otherwise wound up when the falling out occurred. Therefore all assets would still be regarded the property of the company. As such, in making a trade mark application in her own name, FB appears to be acting against the best interests of the company of which she was a joint director. This would suggest a breach of her legal and moral duty as a director. I find that, based on the evidence before me, the balance of probability points to FB acting in a retaliatory manner consistent with a consequence of frustrating the subsequent commercial actions of Excellence Games Limited in pursuit of its objectives to promote and sell the product. In these circumstances I consider that reasonable business people would not consider the making of the trade mark application to be in line with honest business practices. I find FB's action in making the trade mark application does amount to an act of bad faith.

70. The opposition claim brought under section 3(6) succeeds

Conclusion in relation to opposition no.431080

71. DL's claim against FB succeeds in full under sections 5(4)(b) and 3(6).

Approach

73. FB's grounds of opposition were raised under 5(2)(b), 5(3), 5(4)(a), 5(4)(b) and 3(6) of the Act. For the sake of expediency, I intend to start with my assessment under section 5(4)(b) and 3(6) before moving on to the other grounds, as I have already set out the timelines, evidence summary, statutory provisions and relevant case law for these grounds above.

Section 5(4)(b)

74. I believe this ground can be dealt with quite swiftly. I have already considered the same evidence on the copyright issues and found that DL owns the copyright and therefore this ground fails.

Section 3(6)

75. I have already set out the statutory provisions and case law relating to section 3(6) above. The question I must consider is whether DL's applications to register the contested marks is an act of bad faith. My consideration depends on whether DL's motivation amounts to a dishonest intention or other sinister motive which must be judged by assessing whether it involves conduct which departs from accepted standard of ethical behaviour or honest commercial and business practice. In my assessment of the evidence provided, I found that there was a confusing situation in which DL, JL and FB were all involved in some way with the development of the board game. This is most apparent in the period between August and December 2020 when there were multiple interactions between DL and SS over the creation of the contested images. However, I must also consider the notable absence of DL from the directorship cohort of Excellence Games Limited, when the company was incorporated. Moreover DL did not appear to be involved with the further design work undertaken by JJ Illustrates and appeared only to be involved with Cartamundi, at least prior to the dispute, with regard to invoicing.

76. The question I must consider is what the motivation of DL was in making these trade mark applications. The applications were made several months after the falling out occurred between JL and FB, and after FB made her own trade mark application.

Moreover the applications were not made in the name of Excellence Games Limited but in DL's own name, although he knew that the company had been set up to take forward the board games project into production and retail. Moreover the company was still extant. He should also have known that any IP assets would belong to the company and therefore he could be seen to be misappropriating company property. At the relevant date, i.e. the date on which DL made his trade mark applications, was the same date as SS assigned the copyright to him, namely 31 December 2021. This seems unlikely to be a coincidence, and I therefore infer that DL felt more secure in making these trade mark applications because he considered the copyright issue to be settled in his favour.

77. Notwithstanding the above, in an agreement dated 28 January 2022, DL agreed to accept 300 games in lieu of any outstanding debt owed to him by FB.[42] This left FB with 1200 games. I am unclear as to what DL thought would happen to the 1200 games if they were not going to be marketed and sold by FB under the contested Excellence trade mark, as there was no licensing element within the agreement. It was a reasonably foreseeable consequence in my view. Yet the notice of threatened opposition (Form TM7A) against FB's trade mark application was filed on 12 January 2022.

78. Taking the above into account, I find that DL has not acted in accordance with honest business practices and he has made his trademark applications in bad faith. The section 3(6) ground of opposition succeeds.

Section 5(4)(a)

79. Under section 5(4)(a), FB claim uses of the unregistered sign, as set out below, in the UK since 2020 for *board games.*

[42] Exhibit FB37.

80. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> (aa) […]
>
> (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

81. Subsection (4A) of Section 5 states:

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

82. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

83. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,[43] Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off:

> "First, [the plaintiff] 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

[43] [1990] RPC 341, HL, page 406.

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."

84. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

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

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

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

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

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

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

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

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

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

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

Relevant date

84. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited,*[44] Mr Daniel Alexander QC (as he was then), sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in SWORDERS Trade Mark:[45]

> '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.'"

85. The filing date of DL's application is 31 December 2021, which is the relevant date.

Goodwill

86. The first hurdle for FB is to show that she had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*[46] viz*,*

[44] BL O-410-11
[45] BL O-212-06
[46] [1901] AC 217 (HOL)

> "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."

87. In *Smart Planet Technologies, Inc,* Thomas Mitcheson K.C., sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> *".. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."*

88. Goodwill arises as a result of trading activities and accrues to the business that the public thinks is responsible for the goods. The relevant market for assessing goodwill is the UK. At the relevant date, it is not apparent that FB or Excellence Games Limited was trading, i.e. retailing the board games, as Cartamundi only delivered the finished games in February 2022. In her first witness statement FB stated that she had been denied access to use the website domains excellencegames.co.uk and excellencegames.com which were printed on the game boxes. She subsequently had to amend the website addresses on her game boxes to a different website address. She did not specify what the new website address was. There was also no evidence, from the rubric printed on the box itself, to indicate if Excellence Games Limited or FB's own name or any other business name was being used in the promotion and sale of the product.

89. Also in her first witness statement, FB stated that she received 1200 games from Cartamundi, in February 2022, following the agreement reached with DL in January

2022. She also stated that she has spent £6000 promoting the games at various trade fairs and by arrangement with several book stores.[47] She exhibited a number of invoices paid by her which she states were in pursuit of promoting and selling the games.[48] These invoices are screenshots of transactions and have only a day and month date format with no years indicated. Within the same exhibit there are several images taken from social media posts, using the handle **Excellence_boardgame,** showing FB demonstrating the board games. The posts are not dated by year either, but I have presumed them to be posted at some point in 2022, i.e. after Cartamundi delivered the games in February 2022. FB has not given any indication of how many board games have actually been sold or what the turnover has been from any sales. There is no indication from FB as to the reach of the audience, i.e. the numbers of people or businesses from the UK who attended any of the trade shows she was present at. The social media screenshot at page 95 of the exhibit shows two posts receiving 213 and 135 views respectively which in my view indicates a modest number of interactions. However I accept that even if the above information was presented, it may have been of limited relevance as it appears that all of this activity took place after the relevant date. In short, the evidence provided is insufficient to prove that at the relevant date FB had established the goodwill necessary to overcome the first hurdle required under section 5(4)(a).

90. The opposition brought under section 5(4)(a) fails.

Sections 5(2)(b) & 5(3)

91. I believe these grounds can be dealt with quite swiftly. I have already considered the evidence on the copyright issues and found that DL owns the copyright to the contested mark, therefore FB cannot rely on her earlier mark and as a consequence these grounds fail.

Conclusion in relation to opposition nos. 432838, 432840, 433489 & 433490

92. FB's claim against DL succeeds only under section 3(6) but fails under all other grounds.

[47] FB's first witness statement, paragraphs 6-9.
[48] Exhibit FB39.

Overall conclusion

93. As all of the opposition proceedings have been successful to some degree, then subject to any appeal of this decision, none of the applications can proceed to registration.

Next steps

94. Trowers & Hamlins LLP on behalf of DL, emailed the Tribunal in advance of the hearing on 1 December 2025 with regard to costs. It stated that due to the complex nature of the proceedings, it was proposed that it may be more appropriate for me to issue the substantive decision first and defer the costs element into a separate decision once submissions had been sought from both sides. For her part, FB filed her costs proforma and associated documents on 1 December 2025, reflecting both the periods for which she was professional represented and subsequently self-represented.

95. I agreed at the hearing that I would take the approach advocated by Trowers & Hamlins LLP. Therefore I will not set an appeal period for the substantive decision at this point but instead will invite DL to file submissions on costs within two months of the date of this decision and thereafter invite FB to respond strictly on the costs submission. Once submissions have been received, I will consider the costs and issue a separate supplementary decision. Once that decision is issued then I will set an appeal period for this substantive decision.

Dated this 21st day of April 2026

June Ralph
For the Registrar
The Comptroller-General