O/0531/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00004042626

BY TAOUFIK MATHLOUTHI

TO REGISTER THE TRADE MARK:

Mecca Cola

IN CLASS 32

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 449000

BY MONSIEUR MILOUDI SELIM

AND

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001795639

DESIGNATING THE UK

BY MONSIEUR MILOUDI SELIM

MECCA COLA

IN CLASS 32

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 450016

BY TAOUFIK MATHLOUTHI

BACKGROUND AND PLEADINGS

1. This decision involves cross-consolidated proceedings wherein Taoufik Mathlouthi ("TM") and Monsieur Miloudi Selim ("MMS") brought actions against one another. I will summarise the relevant proceedings below, beginning with MMS' opposition on the basis that it was brought first.

MMS' opposition

2. On 23 April 2024, TM applied to register the **Mecca Cola** word mark ("**626 Mark**") shown on the cover page of this decision in the UK. The application was published for opposition purposes on 17 May 2024, and TM seeks registration for the following goods:

Class 32	Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; drink other than alcoholic beverages.

3. The application was fully opposed by MMS on 7 August 2024, based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 ("the Act"). Under both sections, MMS relies upon the following mark:

MECCA COLA

International registration no. WO000001795639
International registration and UK designation date 15 May 2024
Priority date 30 November 2023.
("639 IR")
Relying upon all of the goods for which it is registered, namely:

Class 32	Beers; mineral waters (beverages); carbonated waters; fruit-based beverages; fruit juices; syrups for beverages; preparations for making

non-alcoholic beverages; lemonades; fruit nectars; soda water; non-alcoholic aperitifs.

4. Under section 5(1), MMS claims that the marks and the goods are identical. Under section 5(2)(a), MMS claims that there is a likelihood of confusion because the marks are identical and the goods are identical or highly similar.

5. TM filed a counterstatement denying the claims made. TM also requested proof of use of MMS' **639 IR**. However, since the **639 IR** has not completed its registration process more than five years before the relevant date (the filing date of the **626 Mark**), the use provisions at section 6A of the Act do not apply. Accordingly, MMS may rely upon all of the goods it has identified without demonstrating that it has used the IR.

<u>TM's opposition</u>

6. MMS' International trade mark 1795639 ("**639 IR**") consists of the **MECCA COLA** sign. The IR is registered with effect from 15 May 2024. With effect from the same date, MMS designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The mark also claims priority from 30 November 2023 based on a trade mark registered in France (No. 5010702). MMS seeks protection for the IR in relation to the goods contained in paragraph 3 above.

7. The request to protect the IR was published on 27 September 2024. On 4 October 2024, TM fully opposed the protection of the IR in the UK based upon sections 5(2)(b), 5(4)(a) and 3(6) of the Act. Under section 5(2)(b), TM relies upon the following mark:

Comparable UK trade mark (EU) registration no. UK00902958973[1]
Filing date 18 November 2002; Registration date 22 January 2004.
(“973 Mark”)
Relying upon some of the goods for which the mark is registered, namely:

Class 32 Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

8. Under section 5(2)(b), TM claims that there is a likelihood of confusion because the marks are visually, phonetically and conceptually similar to a high degree, and the goods are identical or highly similar.

9. Under section 5(4)(a), TM relies upon its **MECCA COLA** sign which it claims to have used throughout the UK since 2002 for non-alcoholic drinks. TM claims that use of MMS’ mark on all of its goods would be contrary to the law of passing off.

10. Under section 3(6), TM claims that MMS has “no intention of using the mark and has filed the application to prevent [TM] from securing protection after [TM] mistakenly allowed an earlier registration to lapse”. TM also claims that the “application has been filed in the knowledge that [MMS] is not entitled to the trade mark” and therefore this behaviour “falls below the standard of acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area of trade”.

11. MMS filed a counterstatement denying the claims made and subject TM’s **973 Mark** to proof of use.

12. MMS is represented by Venner Shipley LLP and TM is represented by Sonder & Clay. MMS filed documentation in relation to its **639 IR** priority date and TM filed

[1] Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

evidence in chief. Neither party requested a hearing, however, both parties filed submissions in lieu. This decision is taken following a careful perusal of the papers.

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. 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 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.

EVIDENCE

14. MMS filed evidence to substantiate its claim of priority for its **639 IR**, based on the French trade mark No. 5010702. This included a document from the INPI (the Institut National de la Propriété Industrielle which is the national trade mark registry of France). The evidence confirms that the registration date for the French mark 5010702 MECCA COLA is 30 November 2023 and the applicant/holder is identified as Selim Miloudi.

15. TM's evidence consists of a witness statement in his own name, dated 27 January 2025. TM is the Director and Shareholder of MCE Distribution Ltd and Mecca Cola World Group Ltd Hong Kong. TM's statement is accompanied by 15 exhibits (TM1-TM15).

16. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

MY APPROACH TO THE OPPOSITIONS

17. TM's opposition against MMS' **639 IR** could have an impact on MMS' opposition, in that the level of success (if any) will determine what goods MMS can rely upon in

its opposition against TM's **626 Mark**. However, if MMS' **639 IR** is successfully opposed in full, it will not constitute as an earlier mark for the purpose of its opposition against TM's **626 Mark**, and MMS' opposition would consequently fall away.

DECISION

TM's opposition

Sections 5(2)(b)

18. Section 5(2)(b) reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

19. TM's **973 Mark** qualifies as an earlier mark in accordance with section 6(1)(a) of the Act as its filing date is earlier than the priority date of MMS' **639 IR**.

20. As TM's **973 Mark** has completed its registration process more than five years before the priority date of MMS' **639 IR**, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

21. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

22. Section 6A of the Act states:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

23. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of TM's **973 Mark** is the five years ending on the priority date of MMS' **639 IR**, i.e. 1 December 2018 to 30 November 2023.

24. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use of TM's **973 Mark** within the EU is relevant for the part of the relevant period which falls prior to IP Completion Day (31 December 2020). After that date, only use in the UK will be relevant.

25. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v*

Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*

at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

Evidence of use

26. As highlighted above, TM is the Director and Shareholder of two companies; MCE Distribution Ltd and Mecca Cola World Group Ltd Hong Kong. He confirms that MCE Distribution Ltd was previously called MECCA COLA EUROPE LTD between 3 May 2016 and 12 November 2024, as confirmed by the Companies House extract contained in **exhibit TM1**. This exhibit also states that the company is located in Liverpool, which is supported by the accountant's letter contained in **exhibit TM4** which says that the company "actively engages in both domestic and international trade", with their primary office located in Liverpool "serving as the central hub for its operations".[2]

27. In his witness statement, TM confirms that both companies have been selling beverages under the MECCA COLA name around the world since 2002,[3] however, MCE Distribution Ltd is the specific legal entity which manages the production, distribution and sale of beverages. TM also states that the bottling plants for its MECCA COLA products are located in Spain and its ingredients come from Italy.[4]

28. In **exhibit TM5**, I have been provided with a presentation called MECCA COLA which TM confirms "has been given to investors". I note that the front page of the presentation is as follows:

MECCACOLA
#BEDIFFERENT

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[2] The letter also confirms the MCE appointed its accountant in 2016. I note that in MMS' submissions in lieu, they state that **exhibit TM4** is hearsay, that the document has not been submitted as part of the witness statement, nor does it contain a statement of truth. On this basis, they requested it be disregarded. However, the exhibit clearly accompanies a witness statement which does indeed contain a statement of truth. I also bear in mind that as per Supreme Court in *TUI v Griffiths* [2023] UKSC 48, MMS did not request cross-examination of TM's witness statement or **exhibit TM4** when it was filed, nor did it file evidence in response querying the evidence. On this basis, I dismiss MMS' request that **exhibit TM4** be disregarded.

[3] This is supported by the information contained in a printout from Wikipedia contained in **exhibit TM2**. The Wikipedia platform allows entries to be updated by the public and therefore, this information should be approached with a certain degree of caution, though MMS has cast no doubt on the reliability of the Wikipedia account.

[4] Whilst I have been provided with invoices, certifications and correspondence with TM's Italian supplier of ingredients, contained in **exhibit TM8**, this has no relevance or bearing on the proceedings.

29. I have not been provided with any information such as how many EU or UK investors would have seen the presentation, or when they would have seen it, though I note that it contains information on page 18 regarding the value of the carbonated soft drinks market in 2015, with a *forecast* for sales volumes in 2017. In my view, the presentation is likely to amount to internal use of the mark (rather than external use that would be seen by customers). Nevertheless, I note that the presentation provides some background on the MECCA COLA brand, for example:

a) It is the "first halal certified soft drinks brand in the world".
b) Mecca Cola was launched in France in 2002.
c) In 2007, Mecca Cola reached the volume of 1.5 billion liters in a single year.
d) In 2008, there was a decline in business due to "political pressures, legal battles and global recession".
e) However, Mecca Cola relaunched its brand in 2015.
f) Mecca Cola is a "huge global brand being distributed in over 60 countries with an estimated value of $2bn+ at its peak".
g) It also enjoys "extensive global media coverage and attracted attention at the highest levels".

30. The presentation also includes ideas for strategic growth, its marketing and brand evolution, proposals for investment, as well as the following product portfolio of its goods that clearly use MECCA COLA mark on their labels or in their description:

31. TM states that **exhibit TM6** contains invoices from the Spanish bottling company for the production and transport of beverages bearing the MECCA COLA brand.[5] I note that 6 invoices are dated between 19 October 2023 and 30 November 2023, with the remaining invoices dated after the relevant period. The 6 invoices from the relevant period clearly contains the wording "MECCA COLA" in their description. I also note that whilst they list the details for "MECCA COLA EUROPE LTD" and their Liverpool address, the invoices are clearly addressed to be shipped to STA Charles-Perpignan, Saint Denis, Marseille, Barcelona and Sydney (Australia).

32. TM also provides a selection of 33 invoices which he states were issued by MCE Distribution Ltd for the export of MECCA COLA beverage products, contained in **exhibit TM7**. I note the following from this exhibit:

a) 22 of the invoices are dated after the relevant period (from 20 December 2023 onwards).[6] 21 invoices are from MECCA COLA EUROPE LTD (who are located at a Liverpool address). 1 invoice is from Mecca Cola World Group Ltd Hong Kong. The invoices amount to sums often in the tens of thousands of euros, and are addressed to the Republic of Mauritius, Jordan, France, Denmark and the Netherlands.
b) There are 2 invoices from MECCA COLA EUROPE LTD, addressed to the UK (Liverpool and Keighley (West Yorkshire)) dated 9 January 2024 and 24 May 2024. The invoice amounts are above €9,000. However, they are again dated after the relevant period.
c) There is 1 invoice from Mecca Cola World Group Ltd Hong Kong, addressed to the UK (BD21 3BW), dated 1 September 2024, which again, is after the relevant period.
d) 8 of the invoices are dated within the relevant period, from 3 April 2021 to 31 October 2023. These invoices are from MECCA COLA EUROPE LTD, showing invoice sums in the tens of thousands of euros. One invoice is addressed to the

[5] **Exhibit TM6** contains the witness statement of Rosario de Zayas Rueda who is a qualified translator serving Morningside Translations. He confirms that he is familiar with the English and Spanish languages and has been asked to translate the invoices contained in **exhibit TM6**. The statement is dated 24 February 2025.
[6] Whilst the invoice dates are arranged as, for example, "2023/12/20", from my understanding this is the date 20 December 2023.

"SULTANAE of OMAN", 2 invoices are addressed to Italy, 4 invoices are addressed to Mauritius, and 1 invoice is addressed to Perpignan (France).

33. In his witness statement, TM states that **exhibit TM15** contains "a selection of invoices for the sale of and promotion of the MECCA COLA product in the United Kingdom". I note that the exhibit contains 10 invoices which use the same "MECCACOLA" mark used on the front page of the presentation contained in **exhibit TM5** (as shown in paragraph 28 above). The invoices are clearly addressed to customers based in Hull, Smethwick, London and Wembley, and the invoice amounts for the Mecca Cola goods vary between £4.50 to £992.39. The total turnover generated from the invoices amounts to £2,681.79. However, the invoices are dated between 1 July 2016 and 7 December 2016. I also note that the name and location of the company producing the invoices is shown as follows:

34. Under the payments section of the invoices, it also makes it clear to pay the account name "Kilbury & Alton Trading Ltd". However, TM does not explain how this company relates to himself.

35. **Exhibit TM9** contains a selection of press articles, the majority of which are dated between 3 January 2003 to 13 April 2016 and therefore fall before the relevant period. One article is dated 15 September 2018, which is over 2 months before the start of the relevant period, and was posted on "GULF NEWS".[7] However, I note that this article does not cast any light forward onto the relevant period, i.e. it does not provide me with any information in regard to TM's activities which could have continued into the

[7] I note that this is a .com website which therefore can be accessed worldwide and does not specifically pertain to the UK.

relevant period. It only mentions that “Zamzam Cola” is opening a bottling plant in the Dubai investment park. “Zamzam Cola” is neither of the aforementioned companies that TM owns, and there is nothing else within his witness statement (nor the remaining evidence) to suggest that “Zamzam Cola” is owned by TM[8] and there is no mention of the words “Mecca Cola” within the GULF NEWS article.

36. While I have been provided with screenshots of MCE’s website in **exhibit TM3**, I note that all of the screenshots are undated. I have also been provided with undated screenshots from the “MECCA COLA UK” Facebook page, with some of the posts showing low engagement, only generating between 1 to 16 likes. The screenshots from the “MeccaColaWorldGroup” X page and the “meccacolauk” Instagram page are also undated, with the Instagram page only showing 2 posts. On the basis that all of the screenshots are undated, I am unable to ascertain how many followers the opponent had before the relevant date.

37. TM has provided a schedule of trade mark registrations for a variety of territories in **exhibits TM12** and **TM13**. However, this does not assist me on the basis that while TM may own these marks, this does not, in itself, show use of the marks, in the relevant period and territories (EU and UK) in respect of the goods for which TM’s **973 Mark** is registered.

38. Lastly, TM provides 4 published studies in relation to MECCA COLA. However, all of these are from 2003, 2007 and 2008, and therefore clearly fall before the relevant period.

Assessment of genuine use

39. I note that the above evidence shows use of the words MECCA COLA or the slightly stylised MECCACOLA wording contained in exhibits **TM5** and **TM15**.[9] I shall proceed by giving TM its best case and accepting that the use of both of these signs is genuine use of TM’s **973 Mark** on the basis that the distinctive character of the **973**

[8] However, I note that the Wikipedia evidence suggests that Zamzam Cola is an earlier competitor of Mecca Cola.
[9] As shown in paragraph 28 above.

Mark lies is the wording "MECCA COLA" which is clearly visible and continues to indicate origin.[10]

40. I will now consider whether the evidence shows that TM's **973 Mark** satisfies the requirements for genuine use. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[11] As indicated in the case law cited above, use does not need to be quantitively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" in the relevant territory and period.

41. In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use.......... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

[10] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, paras 31-35
[11] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

42. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:
>
> > [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.
>
> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

43. The case law summarised in the passage from *easygroup* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's Application*, BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

44. TM's evidence clearly contains a sufficient number of deficiencies. The **973 Mark** is registered under TM's name, although I note that the majority of the evidence does not show use of the **973 Mark** by TM himself. However, at paragraphs 1 to 5 of his statement, TM states that he is the director and owner of 2 registered companies, and that these companies have been selling "beverages under the MECCA COLA name around the world". While this may indeed be the case, TM has not provided any evidence, for example, in the form of licencing agreements, to show that both of these companies had permission to trade under TM's **973 Mark**. On this basis, I conclude that TM has failed to establish any use of its earlier mark, and consequently, section 5(2)(b) falls at the first hurdle.

45. Nevertheless, even if I was prepared to accept that both of these companies had permission to use TM's **973 Mark**, I do not consider that the evidence is sufficient enough to establish genuine use of it in the relevant period and territories.

46. Where proof of use is required, it is typical to see evidence such as turnover figures, broken down by year, and by the types of products sold. However, as noted

by MMS in its submissions in lieu, I have not been provided with such figures, nor have I been provided with overall turnover made between 2018 to 2023.

47. While the internal presentation values the brand, that being; "an estimated value of $2bn+ at its peak", firstly, I do not know when the brand was at its peak, and secondly, the value was given after highlighting that it is a "huge global brand" distributed in over 60 countries, and therefore, it is unlikely that this value only pertains to the EU and UK. I also note that the presentation is undated.

48. I have been provided with invoice evidence, but the majority of the invoices fall after the relevant period. For the 6 invoices from the Spanish bottling company that are dated within the relevant period, that being between 19 October 2023 and 30 November 2023, they were all addressed to countries outside of the UK. As noted above, after IP completion day (31 December 2020) only use in the UK is relevant. In regard to the export invoices, only 3 invoices were addressed to the UK and these fell after the relevant period. In regard to the 8 invoices dated within the relevant period, which were addressed to Oman, Italy, Mauritius and Perpignan (France), these were also dated after IP completion date (2021 and 2023), and on this basis, again, are not relevant.[12] The sales generated from the 10 UK invoices contained in **exhibit TM15** amount to £2,681.79. However, all of these invoices are dated between July 2016 and December 2016 and therefore fall before the relevant period. As noted above, these invoices also appear to pertain to a company called "Kilbury & Alton Trading Ltd". TM does not confirm how this company is connected to himself or if they were granted a license to use the mark.

49. Providing evidence of turnover and invoices from the relevant period and territories is plainly information which should have been available and relatively easy to provide. It is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by TM is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, as highlighted above, there is very little evidence of other activity in this case. The third party articles are all dated before the

[12] I also note that Oman is outside of the EU, and therefore, even if this invoice did fall before IP completion day, it would not have been relevant.

relevant period and I have no other evidence of marketing aside from the undated presentation, which was used before investors, which in any event is likely to amount to internal use. As noted by MMS in its submissions in lieu, I have not been provided with any marketing expenditure. The website screenshots and social media evidence is undated. Whilst some of the social media posts show engagement, I note that it is very low. Lastly, the published studies provided by TM are also dated significantly before the relevant period.

50. Therefore, taking all of the evidence as a whole, including the absence of any information regarding sales made during the relevant period, combined with no dated screenshots of TM's goods being offered for sale on its website, and the lack of marketing figures and evidence of promotional material distributed in the relevant period, leads me to find that TM's evidence is insufficiently solid in showing that its **973 Mark** has been genuinely used in the relevant territories, during the relevant period, in respect of any of its registered goods.

51. The consequence of my finding is that TM's **973 Mark** may not be relied upon under section 5(2)(b) in these proceedings. As the **973 Mark** is the only registered earlier right being relied upon by TM in these proceedings, the section 5(2)(b) claim fails.

Section 5(4)(a)

52. Section 5(4)(a) of the Act states as follows:

> "5(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”.

53. Subsection (4A) of section 5 of the Act 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.”

54. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

55. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-

410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

56. MMS has not provided any dated evidence of use of its mark. On this basis, I have only the prima facie relevant date to consider i.e. the priority date of the **639 IR**, being the 30 November 2023.

Goodwill

57. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> "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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start."

58. 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 that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by BALI Trade Mark [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 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."

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

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

60. Under section 5(4)(a), I am able to consider all of the evidence which is dated before 30 November 2023 that pertains to use in the UK. However, the aforementioned deficiencies with TM's evidence still stand.

61. All of the evidence provided by TM shows that sales of MECCA COLA were made through the companies MCE Distribution Ltd (previously known as MECCA COLA EUROPE LTD) and Mecca Cola World Group Ltd Hong Kong. While in his witness statement, TM confirms that he is the director of both of these companies, I have not been provided with any exhibited evidence to confirm this relationship, nor have I been, for example, provided with any form of licensing agreement to show that these companies had permission to trade under his MECCA COLA sign, and what the position would be with regard to ownership of the goodwill arising from any use. On this basis, I find that the section 5(4)(a) case fails as I have not been provided with any evidence proving the existence of any protectable level of goodwill in TM and his sign at the relevant date.

62. For the sake of completeness, in regard to the UK invoices exhibited at **TM15**, as shown in the screenshot contained in paragraph 33 above, the invoices appear to be in the name of the company "Kilbury & Alton Trading Ltd" based in Birmingham. The payment section of the invoices also indicates that payments should be made to "Kilbury & Alton Trading Ltd". In his witness statement, TM does not provide any narrative evidence confirming how "Kilbury & Alton Trading Ltd" is related to him or his companies (based in Liverpool and Hong Kong), nor have I been provided with, for example, a license agreement to show that this third-party company was allowed to use TM's mark on his behalf, and that any goodwill generated by them would remain with TM. Paragraph 15 of his statement simply states that: "*Produced and shown to me now marked Exhibit TM 15 are a selection of invoices for the sale of and promotion of the MECCA COLA product in the United Kingdom*." On this basis, I find that these invoices also cannot be used to prove the existence of any protectable level of goodwill in TM and his sign at the relevant date.

63. Taking all of the above into account, the opposition based upon section 5(4)(a) fails.

Section 3(6)

64. 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."

65. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] 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)."

66. According to *Alexander Trade Mark*, BL O/036/18, 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?

67. It is also necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *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).

68. The case law states that the relevant date for assessing whether an application to register a trade mark in the UK was made in bad faith is "the date the application for registration was made". Therefore, whilst I note that MMS' IR has a priority date of 30 November 2023, the complaint of bad faith in the present case is to be assessed at the date on which MMS sought trade mark protection in the UK, that being 15 May 2024.

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

69. In its Form TM7, TM claims that MMS "has no intention of using the mark and has filed the application to prevent [TM] from securing protection after they mistakenly allowed an earlier registration to lapse" covering the UK. In his witness statement, TM confirms that he owned a MECCA COLA registration in France and the EU, and as he failed to renew the registration in "good time", he attempted to re-register the marks,

but discovered the applications filed by MMS. There are in no doubt circumstances in which failure to secure ongoing trade mark protection of rights in the UK is simply a matter of “tough luck”. Trade marks are territorial and the registration process operates on a first to file basis. However, TM’s narrative in support of its claim of bad faith includes the following details:

a) TM states that MMS contacted TM to request a meeting, evidence of which is exhibited in **TM14**. This exhibit contains the witness statement of Hugh T. Robinson dated 20 February 2025, a qualified professional translator. His evidence is a translation of a WhatsApp message dated 30 April 2024, which says: “Good evening Mr. MATHLOUTHI, this is Mr. MILOUDI. Could we have a call? Regards”. It also shows that a missed voice call was made on 5 May 2024.

b) At paragraph 20 of his statement, TM states that he “subsequently” met with MMS along with Mr Enis Guennouni who is the South of France distributor for his 2 companies. He states that:

    a. “At this meeting, [MMS] admitted that he knew the MECCA COLA brand belonged to me, but he had realised that I had not renewed some registrations and decided to register for himself. He then requested that I produce and market products under the MECCA COLA name for him and pay him a licence fee.”

Was that objective for the purposes of which the contested mark could not be properly filed?

70. I bear in mind that the filing of a mark with the knowledge that the opponent owns it, in isolation, may not be compelling because mere knowledge of another party’s use of a mark (either in the UK or elsewhere) does not establish bad faith.[13] However, TM claim is more than bare knowledge. It is that MMS, having prior knowledge of TM’s

[13] *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker Case* C-320/12 and *Lindt, Koton* (paragraph 55).

interest in the mark (warranting a meeting at the request of MMS), sought protection of trade mark for the same goods in the UK, with no intention to use it, to gain a commercial benefit to negotiate payment of a licence fee from TM. This behaviour could be the basis of a bad faith objection, if proven. Therefore, the key question is whether TM has satisfied the burden of proving the existence of MMS' intention which is inconsistent with honest practices.

Was it established that the contested mark was filed in pursuit of that objective?

71. The only exhibited evidence filed in support of its bad faith claim is the translated WhatsApp message contained in **TM14**. In regard to this exhibit, in its submissions in lieu, MMS submits that:

> "This WhatsApp message is clearly dated 30 April 2024 (and thus outside of the Relevant Period). It is unclear why this document has been submitted. It confirms that [MMS] sent a message to [TM] to suggest a telephone call; nothing more."

72. However, the exhibit does show that MMS approached TM 15 days before its **639 IR** was registered and designated the UK, that being the relevant date.

73. In regard to the section 3(6) claim, in its submissions in lieu MMS states that:

> "[MMS] further submits that the claim brought under Section 3(6) of the Act alleging that [MMS] acted in bad faith is wholly unsubstantiated. No evidence has been filed in support of this serious allegation. Its inclusion appears to be a tactical manoeuvre rather than one grounded in fact or law. In the absence of cogent and compelling evidence, this claim must be dismissed outright. It is well-established that bad faith is a serious allegation that must be distinctly pleaded and properly evidenced; [TM] has done neither."

74. In *Maya Appliances Pvt. Ltd v Prapaharan Sivaratnam*, BL O/0052/25, Iain Purvis KC, sitting as the Appointed Person, noted that:

> "27. <u>**It is obviously wrong to expect a [claimant of bad faith] to be able to give direct evidence of the motivation of someone who has adopted their mark**</u>. All they can reasonably be expected to do in the vast majority of cases is to make inferences from the objective facts and invite the other party to respond to this. If they establish a prima facie case consistent with bad faith, then in the absence of a response from the other party the [claim] should succeed." **(My emphasis)**

75. In the present case, TM has provided evidence to show that they had an active, ongoing and legitimate business interest in the MECCA COLA mark. **Exhibits TM12** and **TM13** show that TM owns multiple MECCA COLA marks in a range of jurisdictions, including the UK, and the presentation provided by TM, whilst internal, does show that TM had continued seeking investment into the MECCA COLA brand that was launched in 2002 (seemingly by TM), with an "estimated value of $2bn+ at its peak". This use of the brand by TM was also clearly known by MMS as they approached TM, registered the **639 IR** knowing that TM's previous registration had lapsed, and requested that TM produce and market products under the MECCA COLA name and pay a licence fee to MMS.

76. While MMS claims that there is an *absence of cogent and compelling evidence*, in its submissions in lieu, I note that MMS does not challenge the narrative evidence contained in TM's witness statement. TM's account includes a degree of detail and appears entirely plausible in view of TM's evidenced interests in the MECCA COLA trade mark. MMS does not provide any reasoning as to why they reached out on WhatsApp or wanted a call with TM. MMS also does not deny that a meeting happened between the parties. More importantly, MMS does not deny the account made by TM in his witness statement as to what happened during the meeting between the parties, nor does MMS provide an alternative of what was discussed, nor any account of its own interest in the mark or its intention to use. I therefore find that MMS has clearly not denied that they knew the MECCA COLA mark belonged to TM, and that they took advantage of the lapse in registration to file for its own MECCA COLA mark, in order to gain a commercial benefit by making TM pay MMS a licence fee in order to produce and market products in which TM appears to have a fundamental commercial interest.

77. Taking all of the above evidence into account, I have a plausible and tolerably clear account from TM, which has not been challenged or rebutted. I therefore find that MMS' behaviour falls below acceptable standards of honest commercial practice, and that the application was made, as the case law puts it, "not with the aim of engaging fairly in competition but the with intention of undermining, in a manner inconsistent with honest practices, the interests of a third party", that being TM. I am satisfied that the only motivation for the filing of the IR application was an illegitimate one. MMS has filed no evidence to rebut TM's prima facie case and consequently, I consider that MMS' **639 IR** was filed in bad faith.

78. The application based upon section 3(6) of the Act succeeds in its entirety.

CONCLUSION

79. On the basis that TM's opposition based upon section 3(6) is fully successful, the **WO0000001795639** is refused in its entirety.

80. MMS' **WO0000001795639** therefore cannot be relied upon as an earlier mark for the purposes of its opposition of TM's **UK00004042626**.

81. As MMS does not rely upon any other mark, and there is no other basis for the opposition, MMS' opposition under section 5(1) and 5(2)(a) must fail. Therefore, TM's **UK00004042626** mark may proceed to registration for all of the goods applied for, listed in paragraph 2 of this decision.

COSTS

82. TM has been successful in both defending MMS' opposition and in its own opposition to MMS' mark, and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award TM the sum of £1,700 as a contribution towards the costs of the proceedings.

83. The sum is calculated as follows:

Filing a Notice of opposition and Considering MMS' counterstatement	£250
Considering MMS' Notice of opposition and preparing a counterstatement	£250
Preparing and filing evidence	£650
Preparing and filing written submissions in lieu	£350
Official Fee	£200
Total	**£1,700**

84. I therefore order Monsieur Miloudi Selim to pay Taoufik Mathlouthi the sum of £1,700. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of June 2026

L FAYTER

For the Registrar