O/0554/26

TRADE MARKS ACT 1994

<u>CONSOLIDATED PROCEEDINGS</u>

IN THE MATTER OF

CANCELLATION NO. 506918
BROUGHT BY INDOOR SPORT SERVICES LIMITED
AGAINST TRADE MARK REGISTRATION NO. UK00003806715
IN THE NAME OF RIVAL STRENGTH LTD

AND

CANCELLATION NO. 507497
BROUGHT BY RIVAL STRENGTH LTD
AGAINST TRADE MARK REGISTRATION NO. UK00003991343
IN THE NAME OF INDOOR SPORT SERVICES LIMITED

AND

CANCELLATION NO. 507506
BROUGHT BY RIVAL STRENGTH LTD
AGAINST TRADE MARK REGISTRATION NO. UK00003991338
IN THE NAME OF INDOOR SPORT SERVICES LIMITED

AND

CANCELLATION NO. 507498
BROUGHT BY RIVAL STRENGTH LTD
AGAINST TRADE MARK REGISTRATION NO. UK00003991202
IN THE NAME OF INDOOR SPORT SERVICES LIMITED

BACKGROUND AND PLEADINGS

1. These proceedings involve four consolidated invalidity actions between RIVAL STRENGTH LTD ("Rival") and INDOOR SPORT SERVICES LIMITED ("Indoor").

2. The registered trade marks that are subject to the applications for invalidity are set out below:

UK00003806715 ("Rival's trade mark")

RIVAL
STRENGTH

Filing date: 06 July 2022
Registration date: 11 November 2022

The mark is registered for the following goods:

Class 28: *Gym balls; Gym balls for yoga; Sports equipment; Gym chalk for improving hand grip in sports activities; Sleds [recreational equipment]; Sporting articles and equipment; Manually operated exercise equipment; none of the aforesaid goods being boxing equipment or boxing accessories, or for use in relation to boxing.*

UK00003991343 ("Indoor's trade mark 1")

RIVAL
SERIES

RIVAL
SERIES

RIVAL
SERIES

(series of 3)

Filing date: 13 December 2023

Registration date: 15 March 2024

The mark is registered for the following goods and services:

Class 20: *Storage racks for physical fitness equipment; storage racks for exercise weights; storage racks; storage units (furniture); hanging storage racks; mobile storage racks.*

Class 25: *Clothing, footwear, headgear; t-shirts; sweatshirts; athletic shoes; clothing for fitness training.*

Class 27: *Gymnasium exercise mats; Floor coverings [mats] for use in sporting activities; exercise mats.*

Class 28: *Sporting articles and equipment; gymnastic articles and equipment; sports training apparatus; body-training apparatus; pullup bar; kettlebells; barbells; exercise weights; resistance bands; climbing ropes for gymnastic purposes; jump ropes; bumper plates; plyo boxes; games and playthings; gymnastic and sporting articles not included in other classes; fitness apparatus; wrist and ankle weights for exercise; dumb-bells [for weight lifting]; weight plates; weight training apparatus [other than for medical use]; weight benches; belts for weightlifting; grip balls in the nature of rubber ball for hand exercise; skipping ropes; grips for the handles of sporting articles; benches for gymnastic use; rings for gymnastics; exercise balls, weightlifting plates, weightlifting bars, weightlifting benches, weightlifting stands and supports, gymnastic suspension straps, elastic resistance bands, medicine balls, step boxes, jump boxes, stability balls, weight vests, squat stands, weightlifting racks, cable racks, power racks; resistance training machines, paralettes, foam rollers, hurdles, agility ladders, exercise ropes, track sleds; sports training apparatus, namely, rowing machines, running machines, treadmills, stationary exercise bicycles; back support for weightlifters.*

Class 35: *Retail services and on-line retail services connected with storage racks, storage units (furniture), hanging storage racks, mobile storage racks, storage racks for physical fitness equipment, storage racks for exercise weights; Retail services and on-line retail services connected with sporting articles and equipment, gymnastic apparatus and equipment, body rehabilitation apparatus, body-training apparatus, body-building apparatus, body toner apparatus [exercise] and exercise apparatus and equipment.*

UK00003991338 ("Indoor's trade mark 2")

("series of 3")

Filing date: 13 December 2023

Registration date: 15 March 2024

The specification for which this mark is registered is the same as that of Indoor's trade mark 1.

UK00003991202 ("Indoor's trade mark 3")

AF RIVAL SERIES

Filing date: 13 December 2023

Registration date: 15 March 2024

The specification for which this mark is registered is the same as that of Indoor's trade mark 1.

<u>Indoor’s application for a declaration of invalidity against Rival’s trade mark UK00003806715 based on Section 5(4)(a) of the Act.</u>

3. On 18 January 2024, Indoor applied to have Rival’s trade mark UK00003806715 declared invalid under the provisions of Section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). This ground may be relied upon in invalidation proceedings by virtue of Section 47 of the Act. The application is directed against all of the goods for which Rival’s mark stands registered. This is on the basis of Indoor’s alleged earlier rights in the following signs:

Rival Series

AF RIVAL SERIES

4. Indoor claims to have used the signs throughout the UK since 2018 in respect of identical goods and services to those registered under Indoor’s trade mark 1 as outlined above. As such, Indoor claims to have acquired goodwill in its business under the signs, and that use of Rival’s trade mark would be a misrepresentation to the public and result in damage to the aforementioned goodwill.

5. Rival filed a counterstatement denying the claims made and requesting Indoor to provide proof of the same.

<u>Rival’s applications for a declaration of invalidity against Indoor’s trade marks UK00003991343, UK00003991338 and UK00003991202 based on Sections 5(2)(b), 5(3) and 5(4)(a) of the Act.</u>

6. On 28 June 2024, Rival applied to have Indoor’s trade marks UK00003991343, UK00003991338 and UK00003991202 declared invalid under the provisions of Section 47 of the Act. The applications are directed against all of the goods and

services for which Indoor's marks stand registered. This is on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

7. Under Section 5(2)(b) and 5(3), Rival relies upon its earlier trade mark no. UK00003806715 and the goods covered by the same. This is the trade mark that is subject to the application for a declaration of invalidity filed by Indoor (which is based on one single ground, namely that of passing off).

8. Under Section 5(2)(b), Rival claims that the marks are similar and the goods and services are identical or similar leading to a likelihood of confusion.

9. Under Section 5(3), Rival claims to have a reputation for its earlier mark in relation to all the goods for which it is registered having used it since November 2020. It claims that its reputation and the similarity between the marks would cause the relevant public to perceive a link between the undertakings, and that use of Indoor's marks would take unfair advantage of, or be detrimental to, the distinctive character or reputation of its earlier mark.

10. By virtue of its earlier filing date, the trade mark relied upon by Rival is an "earlier mark" in accordance with Section 6 of the Act. As Rival's earlier mark has not been registered for more than five years when the applications for a declaration of invalidity were filed, it is not subject to the use conditions under Section 47(1A) of the Act. Consequently, Rival may rely upon all of the goods it has identified without demonstrating that it has used the mark. However, this is subject to the invalidity filed by Indoor being rejected (in its entirety or in part) and to Rival's earlier trade mark remaining registered (in its entirety or in part) for the goods relied upon.

11. Lastly, under Section 5(4)(a), Rival relies upon the following signs:

RIVAL STRENGTH

RIVAL

12. Save for the underlined terms (which are not relied upon under the 'RIVAL' sign), Rival claims to have used these unregistered signs since November 2020 throughout the UK in relation to the following goods and services:

> *Clothing; storage racks and units; gym balls; gym balls for yoga; sporting articles and equipment; sports equipment; gymnastic articles and equipment; sports training apparatus; body-training apparatus; pullup bar; kettlebells; barbells; exercise weights; resistance bands; jump ropes; bumper plates; plyo boxes; gymnastic and sporting articles not included in other classes; fitness apparatus; dumb-bells [for weight lifting); weight plates; weight training apparatus [other than for medical use]; weight benches; grip balls in the nature of rubber ball for hand exercise; skipping ropes; grips for the handles of sporting articles; exercise balls, weightlifting plates, weightlifting bars, weightlifting benches, weightlifting stands and supports, gymnastic suspension straps, elastic resistance bands, medicine balls, step boxes, jump boxes, stability balls, weight vests, squat stands, weightlifting racks, cable racks, power racks; resistance training machines, foam rollers, hurdles, agility ladders, exercise ropes, track sleds; sports training apparatus, namely, rowing machines, running machines, treadmills, stationary exercise bicycles; back support for weightlifters; gym chalk for improving hand grip in sports activities; Sleds [recreational equipment]; Manually operated exercise equipment; gym mats and exercise mats; retail and on line retail services relating to the aforesaid goods; gym design services.*

14. Rival claims to have acquired goodwill in its business under the signs, and that use of Indoor's trade marks would be a misrepresentation to the public that would result in damage to the aforementioned goodwill.

15. Indoor filed a defence and counterstatement in each invalidity, denying Rival's claims. Although Indoor ticked the box "Yes" to the question about proof of use, as I

have explained earlier in this decision, Rival’s earlier mark is not subject to proof of use.

16. In view of the relationship between each of the above cases, on 20 August 2024 the Registrar directed under Rule 62(1)(g) of the Trade Marks Rules 2008 that they be consolidated.

HEARING AND REPRESENTATION

17. Indoor is represented by Adamson Jones, and Rival is represented by Fry Heath & Spence LLP. A hearing took place before me, by video conference, on 4 March 2026. Indoor was represented by David Gwilliam of Adamson Jones and Rival was represented by Benet Brandreth KC instructed by Fry Heath & Spence LLP.

Relevance of EU Law

18. 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

19. Both parties filed evidence in these consolidated proceedings.

20. Indoor’s evidence came in the form of two witness statements, one which was filed as evidence-in-chief by Max Wilson dated 29 April 2024 and accompanied by 8 exhibits (MW01-EXH MW08) and one which was filed as evidence-in-reply by Guy George De-Vere Wilson dated 20 October 2024 and accompanied by 3 exhibits (GW01-EXH GW03). Mr Max Wilson and Mr Guy George De-Vere Wilson are both Directors of Indoor. Their evidence is aimed at supporting Indoor’s claim for passing off.

21. Rival's evidence came in the form of three witness statements, two from Samuel Alexander Hurman dated 1 July 2024 and 21 October 2024 and accompanied by 21 and 26 exhibits respectively (EXH SAH1-SAH21 and EXH SAH22- SAH48), and one from Anthony Youngs dated 21 October 2024. Mr Hurman is the director of Rival. The purpose of Mr Hurman's first witness statement (which was filed as evidence-in-chief) is to demonstrate use of Rival's earlier mark and unregistered signs in order to support Rival's claims based on Sections 5(3) and 5(4)(a). In addition to this, Mr Hurman filed his second witness statement as evidence-in-reply, commenting on the evidence provided by Mr Max Wilson's on behalf of Indoor. Mr Hurman's second witness statement also integrates his earlier evidence providing further and updated information.

22. Mr Youngs is the Director and owner of Black Bear Fitness Limited, a third-party company which is not involved in these proceedings. His evidence merely confirms that his company is a reseller of Rival's equipment and refers to an instance of confusion.

23. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

24. As it will be recalled, the ability of Rival to rely on its earlier trade mark in the invalidity actions against Indoor's trade mark registrations depends on the outcome of Indoor's application to invalidate Rival's earlier mark. As Mr Brandreth correctly observed at the hearing, there is a cascade with all Rival's invalidity actions flowing from the validity of its earlier mark. Hence, I shall start with Indoor's application to invalidate Rival's earlier mark which is based on Section 5(4)(a).

ADMISSIONS MADE AT THE HEARING

25. At the hearing both parties agreed that the crux of the issue here is whether Indoor had sufficient goodwill to sustain its passing off action against Rival's earlier trade

mark at the relevant date. Further, both parties agreed that if actionable goodwill is established, misrepresentation and damage will follow.

26. Mr Brandreth also agreed that if Rival's earlier mark survives Indoor's invalidity action, and Rival's invalidities against Indoor's trade marks succeed on the Section 5(2)(b) ground, I do not need to go into the details of Rival's claims under Sections 5(3) and 5(4)(a). However, at the end of the hearing both Mr Brandreth and Ms Walker also agreed that if the invalidity against Rival fails, Rival's invalidities should succeed in full, based on the Section 5(2)(b) ground. I am very grateful for those concessions which enabled me to issue this decision quicker than would otherwise have been the case.

27. With these concessions in mind, I now turn to the decision.

DECISION

INDOOR'S APPLICATION FOR INVALIDITY AGAINST RIVAL'S REGISTRATION NO. UK00003806715 BASED ON SECTION 5(4)(A).

28. 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."

29. 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."

30. The relevant parts of Section 47 state:

"47. (1) […]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) […]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[…]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

31. 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)."

32. 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."

<u>The relevant date for Section 5(4)(a)</u>

33. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC (now KC), as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, 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.' "

34. Rival applied to register the mark subject to Indoor's invalidity action on 06 July 2022. Absent earlier use of the mark under attack, the relevant date would be 06 July 2022. However, Rival also claims to have used its mark since November 2020 (i.e. nearly two years prior to the date of the application for registration of 06 July 2022), whereas Indoor claims to have used its earlier unregistered signs since 2018. Hence, depending on the evidence filed, I might need to consider what the position would have been prior 06 July 2022, i.e. at the start of the behaviour complained about, which, if established, would be November 2020 based on Rival's pleadings.

Goodwill

35. The meaning of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) as follows:

> "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."

36. 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 of 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; 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."

37. 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."

38. Goodwill must be more than trivial in extent. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

> "62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

39. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (now KC), 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."

40. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

"The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi's witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of "reCUP" ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca's Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in

this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

41. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, *"very limited",* the claimant's goodwill was found to be sufficient to entitle it to restrain the defendant's trade under LUMOS.[1]

42. I now turn to the evidence.

43. As Mr Brandreth correctly observed at the hearing (and as I have anticipated earlier in this decision), the central issue in this dispute is whether, at the relevant date, Indoor

[1] *See also: Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); (COA)

had sufficient goodwill associated with the signs relied upon that predates the use by Rival.

44. Mr Brandreth's position on this point is that, taken at its highest, Indoor's evidence is incoherent and implausible and shows brief and minimal use which is insufficient to sustain Rival's claim for passing off. In this connection, Mr Brandreth submitted that what emerges from the evidence is that Indoors made some preliminary internal considerations of the use of the signs relied upon in 2017 and early 2018 that were not, ultimately, followed up and that Internet searches conducted by Rival have revealed no external use by Indoor of the signs relied upon before the relevant date.

45. In particular, Mr Brandreth's main criticism of Indoor's evidence is that the turnover figures provided are global figures, and do not relate specifically to goods marketed under the signs in relation to which Indoor claims to have acquired an actionable goodwill. In his skeleton argument, Mr Brandreth then set outs various criticisms of Indoor's evidence, under subcategories identifying the main uses claimed in evidence, including the invoices, the website, the user manuals, the online advertising, the marketing emails, and the social media. These points were expanded upon later in Mr Brandreth's oral submissions. In particular, Mr Brandreth argued that Indoor's evidence mainly shows a preliminary consideration by Indoor to use the sign Rival in a select set of products that never progressed, and that only much later and long after the use by Rival of its earlier mark in relation to a vast range of products (i.e. in December 2020), Indoor launched a completely different product, 'The Squat Rack' under the sign Rival. Prior to this, Mr Brandreth argued, Indoor made no public use of the sign Rival. Lastly, Mr Brandreth pointed out that part of the evidence filed by Indoor relates to use of a different sign, i.e. Faster.

46. Conversely, Ms Walker did not spend much time dealing with Indoor's evidence in her skeleton argument, simply stating that Indoor's position is that *"[Indoor] will argue that, as of December 2020, the totality of the evidence submitted in these proceedings establishes the existence of goodwill within the meaning of Section 5(4)(a) TMA as a result of its trading activities in connection with the Rival Series Marks"* and that when making these arguments, she would refer to the relevant authorities, including *Stannard v Reay* [1967] RC 589 and *Lumos v Sweet Squared* [2012] EWPCC 22, both

of which apply the principle that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off. At paragraphs 6 and 7 of her skeleton arguments, Ms Walker also accepted that the relevant date for the purpose of these proceedings is December 2020 stating as follows:

> *"We note from the witness statement of Samual Human (SAH), the Director of [Rival], that the company began trading in December 2020 (SAH Witness Statement 1, [4]).*
>
> *Accordingly, simply for the sake of procedural economy and without making any admission, Party A will take December 2020 as the relevant date".*

47. In her oral submissions, Ms Walker added that Indoor's goodwill had started to be accrued by 2018 and reiterated that December 2020 is the relevant date for assessing whether Indoor had actionable goodwill to sustain its claim for passing off.

48. I should pause here to say that taking December 2020 as the relevant date is a concession, notwithstanding Ms Walker added the caveat "*simply for the sake of procedural economy and without making any admission"*. I say this because Ms Walker's statement that Indoor will take December 2020 as the relevant date means that it is an agreed point between the parties and I can use it as a basis for my decision. Further, whatever the outcome that follows from taking December 2020 as the relevant date, at this stage Indoor would not be permitted to resile from or qualify its admission since it was given at the end of the proceedings. Lastly, I do not think it would be fair to Rival to take a later date as the relevant date, because I would need to take the step of unilaterally departing from Indoor's position (and unilaterally withdrawing its concession).

49. It follows that since the matter about December 2020 being the relevant date has been conceded, it is an agreed point between the parties, and I do not need to trouble myself about it. Accordingly, I will use it as a basis for my decision.[2]

---

[2] O/0096/25 BEAK

50. In her oral submissions, Ms Walker stated that Indoor's annual sales exceed those concerned in both *Stannard* and *Lumos*. She also argued that the selection of invoices exhibited at MW01 (which relate to the sales of goods under the sign AF Rivals Series) show a geographical spread throughout the UK and Ireland. She also observed that of the invoices documented in MW01 there are 21 invoices of 22 items, totalling £2,922.65 that took place over 2 years. She also referred to the evidence about the re-design of the website and the design of the logo which, she said date back to late 2017/early 2018 when the preparations began.

51. On the issue of the sales and invoices, Mr Brandreth pointed out that in his witness statement, Mr Max Wilson asserts that there has been use of the Rival signs since early 2018 for a wide range of goods and services - from storage units (furniture) in class 20, to exercise mats in class 27, to rings for gymnastics in class 28, to retail services connected with, among other things, body rehabilitation apparatus. That is correct. In fact, paragraphs 6 and 7 of Mr Max Wilson's witness statement are as follows:

> *"6. My Company trades as AGAIN FASTER throughout the United Kingdom and Europe and has done since as early as 2012. We started using the RIVAL SERIES marks on our goods, in relation to our services and across our manuals, brochures, marketing and promotional materials from early 2018 with preparations to begin using the marks starting internally in late 2017.*
>
> *7. The RIVAL SERIES marks are used on or in relation to the following goods and services:*
>
> ***Class 20** - Storage racks; storage units (furniture); hanging storage racks; mobile storage racks; storage racks for physical fitness equipment; storage racks for exercise weights.*
>
> ***Class 27** - Gymnasium exercise mats; Floor coverings [mats] for use in sporting activities; exercise mats.*

Class 28 *- Sporting articles and equipment; gymnastic articles and equipment; sports training apparatus; body-training apparatus; pullup bar; kettlebells; barbells; exercise weights; resistance bands; climbing ropes for gymnastic purposes; jump ropes; bumper plates; plyo boxes; games and playthings; gymnastic and sporting articles not included in other classes; fitness apparatus; wrist and ankle weights for exercise; dumb-bells [for weight lifting]; weight plates; weight training apparatus [other than for medical use]; weight benches; belts for weightlifting; grip balls in the nature of rubber ball for hand exercise; skipping ropes; grips for the handles of sporting articles; benches for gymnastic use; rings for gymnastics; exercise balls, weightlifting plates, weightlifting bars, weightlifting benches, weightlifting stands and supports, gymnastic suspension straps, elastic resistance bands, medicine balls, step boxes, jump boxes, stability balls, weight vests, squat stands, weightlifting racks, cable racks, power racks; resistance training machines, paralettes, foam rollers, hurdles, agility ladders, exercise ropes, track sleds; sports training apparatus, namely, rowing machines, running machines, treadmills, stationary exercise bicycles; back support for weightlifters.*

Class 35 *- Retail services and on-line retail services connected with storage racks, storage units (furniture), hanging storage racks, mobile storage racks, storage racks for physical fitness equipment, storage racks for exercise weights; Retail services and on-line retail services connected with sporting articles and equipment, gymnastic apparatus and equipment, body rehabilitation apparatus, body-training apparatus, body-building apparatus, body toner apparatus [exercise] and exercise apparatus and equipment."*

52. This evidence also reveals a significant point, namely that Indoor trades as 'AGAIN FASTER' (which appears to be Indoor's main brand), that it has done so since as early as 2012, and that the brand 'RIVAL' (which is the brand relied upon in these proceedings) was adopted much later in late in early 2018.

53. In the following paragraph Mr Max Wilson states:

"8. Approximate sales of my company's goods in classes 20, 27 & 28 before the date of the Contested Registration of the Proprietor in the years 2017, 2018, 2019, 2020, 2021 and up to 5 July 2022 were as follows:

54. And provides the following table:

Year	**Sales (£)**
2017	1,427,538.00
2018	1,261,926.00
2019	1,293,142.00
2020	3,223,085.00
2021	1,848,530.00
2022 (up to 05/07/22)	238,104.00

55. Admittedly, Mr Max Wilson did not say that the numbers provided are global sales figures, neither did he say that they include goods sold under brands other than the 'RIVAL SERIES' signs relied upon in these proceedings. Indeed, having set the scene by explaining that the 'RIVAL SERIES' signs are used on or in relation to a range of goods and services, one would expect that specific figures are provided to support such claims. However, facts cannot be proven by way of suppositions. This is all of the more so in circumstances whereby (a) the evidence is challenged, like it is in the present case, and (b) the supposition I am required to make is inconsistent with the evidence taken as a whole.

56. I say this because the table provided include a significant figure from the year **2017** which is nearly £1,5million and cannot possibly relate to, or include, goods and services marketed under the brand 'RIVAL' or 'RIVAL SERIES'. This is because Mr Max Wilson says that Indoor started using the 'RIVAL SERIES' marks on their goods and services and across their promotional materials **from early 2018; in this connection, since Mr Max Wilson also says that the use in late 2017 was internal, it could not have generated any sales**. This specific point about the sales figures including sales from 2017 (i.e. prior to the launch of the brand 'RIVAL' by Indoor) and the conclusion that the sales figures provided must necessarily include sales of goods and services sold under different brands (because the brand 'RIVAL' was launched in 2018 and, consequently, could not have generated any sale in 2017) was not specifically raised by Mr Hurman when he challenged Indoor's evidence in his witness

statement. Instead, the extent of Mr Hurman's challenge was that the sales figures given by Mr Max Wilson do not tally with Companies House's records and with the figures given by Indoor in a previous opposition and, as such, are not credible. He stated (my emphasis):

> *"In Mr Wilson's Statement at paragraph 8 he gives sales figures. No source is given for these figures and we cannot reconcile them with any other public figures such as those on Companies House accounts. Nor to those given for sales under and by reference to their AgainFaster sign in case [O/0635/23] at paragraph [24] for equivalent goods, and yet are considerably lower: for example in that case it is reported that Mr Wilson's evidence was that his company had made sales in the UK for goods in classes 20, 27 and 28 in 2018 of £78,900; the figure given in paragraph 8 is £1,261,926. <u>Even if they are correct, I understand them to be total sales for his company in all countries and not to relate solely to products sold under the signs 'RIVAL SERIES', 'AF RIVAL SERIES' and' AR RIVAL SERIES' in the UK Up to 5 July 2022.</u> I say that for two reasons. First, on the basis that I have looked at the published accounts for Mr Wilson's company at Companies House and they are consistent with these being total sales figures. (Because they have only filed Total Exemption Accounts, which do not include sales figures, I cannot correlate these directly to the sales figures given in paragraph 8. However, it is clear from the figures in the accounts that these must be total sales. For example, the company gives total assets less current liabilities for 2017 as £1,240,632 as against a sales figure in paragraph 8 of £1,427,538.00. Second, because Mr Wilson says these are figures related to all the goods in classes 20, 27 and 28, whereas it is clear from the other material that the 'RIVAL SERIES' was only ever intended to be used in relation to a small selection of specific goods as I discuss below. Attached Marked 'Exhibit SAHS' is a copy of case [O/0635/23] and a copy of the company accounts of- Indoor Sports Services Limited 2017."*

57. Although this was a different challenge from the observation I have made above about the sales figures including those relating to 2017, the same point was made by Mr Hurman, i.e. that the figures provided do not to relate solely to products sold under the sign 'RIVAL'. In this connection, I agree with Mr Brandreth, that Indoor did not

address this point when filing evidence in reply which was given by Mr De-Vere-Wilson who stated as follows:

> *"16. In paragraph 9 Mr Hurman refers to an alleged discrepancy in the sales figures provided by my Company under paragraph 8 of Mr Max Wilson's Witness Statement. I must emphatically and categorically deny Mr Hurman's inference to the effect the sales figures have been reported incorrectly or that these figures are inconsistent. The financial statements were prepared and delivered in accordance to the provisions applicable to companies subject to small companies regime as well as HMRC rules. In any event Mr Hurman' claims are not material to the issue in hand, so they should be disregarded for the purposes of the current proceedings."*

58. As it can be seen, Mr De-Vere-Wilson only stated that the annual sales figures are correct and consistent, whilst denying the relevance of the challenge. Notably, he did not say that the annual sales figures relate solely to products sold under the signs 'RIVAL' in the UK which was the main point in dispute.

59. Accordingly, I conclude that the sales figures provided in the table above cannot be sales figures for goods and services marketed under the 'RIVAL SERIES' signs which are relied upon by Indoor in these proceedings. Further, even if it is possible that these figures include turnover generated under the 'RIVAL SERIES' brand after the brand was launched in 2018, as Mr Brandreth correctly pointed out, there is no granular information which would show what proportion of the sales relate to goods and services marketed under the brand 'RIVAL SERIES' or how they should be broken down by product.

60. This mean that the only sales figures which I can certainly conclude relate to the 'RIVAL SERIES' signs are those I can extrapolate from the invoices.[3] Although the invoices exhibited range from 2018 until 5 July 2023, bearing in mind Indoor's concession about the relevant date, I can take into account only those up to December 2020. Further, I have read the invoices in conjunction with Indoor's evidence about the

[3] Exhibit MW01

product codes which show the product type referred to by the product code on the invoices.

61. Mr Brandreth did a very helpful job by going through the invoices and identifying the number of items which relate to the sign ‘Rival’ (as shown in the description of goods on the invoices). In his skeleton argument, he stated that *“as brand uses of RIVAL, it is minuscule - 9 items refer to RIVAL in 2018, 11 in 2019, 6 in 2020, 10 in 2021, and 5 in 2022”*. Bearing in mind that the relevant date is December 2020, the 15 items sold in 2021 and 2022 cannot count towards goodwill. This leaves a total of 26 items sold prior to the relevant date. They are as follows:

Invoice (date)	Goods	Total
12/02/2020	1 x Again Faster® Rival Speed Sled	£62.50
14/05/2020	1 x Again Faster® Rival Parallette Set	£83.33
30/06/2020	1 x Again Faster® Rival Speed Sled	£100
24/07/2020	1 x Again Faster® Rival Parallette Set	£83.33
25/09/2020	1 x Again Faster® Rival Parallette Set	£83.33
12/11/2020	1 x Again Faster® Rival Parallette Set	£83.33
14/02/2018	1 x Parallettes Rival Series	£100
23/04/2018	1 x Home Pull Up Bar Rival Series	£100
24/05/2018	1 x Dog Sled - Rival Series	£247.50
01/06/2018	1 x Dog Sled - Rival Series	£247.50
17/07/2018	1 x Parallettes Rival Series	£65

31/07/2018	1 x Parallettes Rival Series	£83.37
15/08/2018	1 x Home Pull Up Bar Rival Series	£100
24/09/2018	1 x Dog Sled - Rival Series	£275
29/11/2018	1 x Parallettes Rival Series	£83.37
12/02/2019	1 x Parallettes Rival Series	£83.37
5/03/2019	1 x Parallettes Rival Series	£83.37
16/04/2019	1 x Home Pull Up Bar - Rival Series	£100
13/05/2019	1 x Again Faster® Rival Speed Sled	£50
13/06/2019	1 x Again Faster® Rival Pull-up Bar	£100
10/07/2019	1 x Again Faster® Rival Pull-up Bar	£100
29/07/2019	2 x Parrallettes - Rival Series	£180
25/09/2019	1 x Again Faster® Rival Parallette Set	£83.33
11/10/2019	1 x Again Faster® Rival Speed Sled 1 x Again Faster® Rival Speed Sled	£50 £50
29/11/209	1 x Again Faster® Rival Speed Sled	£50
6/12/2019	1 x Again Faster® Rival Speed Sled	£50

62. My total of 6 items for 2020 matches that calculated by Mr Brandreth. The value of those 6 items is £495.82. Likewise, I have calculated 9 invoices for 2018 for a total value of £1,301.74 for 9 items. For the sake of completeness, I should say that there are two additional invoices in 2018[4] which contain the description of the goods as "GHD - Glute Ham Developer Riva". I have not included those goods in my calculation because (a) although there are the letters 'RIVA' at the end of the product description, that is not the same as 'RIVAL' and (b) neither the product code nor the description of the goods for these goods match any of the product codes exhibited at MW02 (the product code for those goods is 50-976 which is not in the list of the RIVAL products). Lastly, there are a total of 11 invoices for the year 2019, for a total of £980.07 and 13 items sold.[5] Accordingly, the sum for the invoices dated prior to the relevant date is £2,777.63 for a total of 28 items sold.

63. The rest of the evidence consists of some marketing material, including copies of pages from a 2018 product manual, and a few social media posts. However, it is not clear how many catalogues were distributed or how many viewers the social media posts received. Finally, Mr Wilson states that he exhibits a marketing email[6] which was sent to approximately 30,000 customers on Indoor's mailing list on 31 August 2018. First, there is no evidence as to whom those customers were. Second, the only evidence of sales immediately after 31 August 2018 are 3 invoices dated 24 September 2018, 29 November 2018 and 5 December 2018 which suggest that the email did not have much of an impact in any event.

64. That is the totality of the evidence filed on behalf of Indoor.

65. The onus is on Indoor to establish that, at the relevant date of December 2020, it had sufficient goodwill in the sign relied upon that it could prevent the use (and registration) of Rival's trade mark under the law of passing-off. Regarding the test for goodwill, without suggesting that it is more onerous in an invalidity than in an opposition, in *Dixy Fried Chickens (Euro) Ltd, Re* [2003] EWHC 2902 (Ch) Mr Justice Laddie, significantly, noted that before one can invalidate a registration based on

[4] Invoices dated 27/07/2018 and 5/12/2018
[5] Of the 13 items I counted are two more than put forward by Mr Brandreth, which ultimately explains why I say 28 here but Mr Brandreth says 26. However, this slightly discrepancy makes no material difference to the outcome.
[6] MW07

Section 5(4)(a), it must properly substantiate the claim to goodwill with relevant credible evidence. He stated:

> "Once registered, a trade mark is presumed to be valid. It is for this respondent to prove otherwise. When a s. 5(4)(a) attack is being run, the attacker must prove on a balance of probabilities that the use of the mark can be prevented by an action for passing off. As Pumfrey J explained in *REEF Trade* Mark [2002] RPC 19, the Registrar is entitled to receive sufficient evidence at least to raise a prima facie case that the attacker's reputation extends to the goods comprised in the specification of goods for the registered mark. He also said:
>
> > "Thus evidence will include evidence from the trade as to reputation; evidence as to the manner in which goods are traded or the services supplied; and so on." (para 27)
>
> In other words, mere assertion is not enough. Before one can invalidate a registration and thereby deprive a trader of his exclusive rights, one must produce relevant credible evidence of sufficient weight. This is the same as the requirement for a "genuine and properly substantiated likelihood of confusion" referred to in WILD CHILD Trade Mark [1998] RPC 455."

66. These are cancellations based on the ability to prevent the use of a presumed validly registered trade mark through the law of passing-off. By the relevant date, Indoor had sold £2,777.63 worth of items of gym equipment with a total of 28 items sold with no evidence of repeat customers. This is, by any means, a very tiny amount, both in terms of value but also in terms of number of units sold. Whilst Indoor might have sold more goods, I have no way of quantifying it – hence, the only evidence of sufficient weight that I can take into account is that from the invoices. There is no indication of marketing spend. The length of use is also relevant to establishing recognition by the public, and in this case, there is only a relatively short period of prior use of about 2 years with very little sales.

67. Although in *Lumos* goodwill was established on the basis of what was considered a very limited number of customers and small sales, the goods were high-end skin

products which were originally sold at £120 per bottle, and there was evidence that the products were being used in 20 aesthetic clinics, and in 21 beauty salons. Further, there was evidence that the goods were targeted at a small part of the total skincare market, namely a niche described as "anti-ageing serums" and the judge found that a very modest goodwill had been generated in the LUMOS mark in relation to skincare products, and that such goodwill related to a particular niche within that market.

68. Indeed, the size of the market for the goods concerned is a relevant consideration. This is because the sales volumes must be considered not only in absolute terms but also in the context of the relevant industry, i.e. in terms of what proportion of the relevant market is occupied by the sign. Further, the smaller the market for the goods, the more likely it is that slighter trading activities may suffice than for goods which target larger markets. This approach was confirmed in *Smart Planet Technologies,* where it was concluded that the sale of 40,000 cups was insufficient to achieve a protectable goodwill because it was a tiny share of the relevant market:

> "38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.
> […]
> 40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off."

69. In this case, Mr Hurman filed evidence that the annual value of gym equipment goods in the UK is £800 million. As Mr Brandreth stated in his skeleton argument, the

value of the goods sold by Indoor prior to the relevant date (being less than £3,000) vanishes entirely against this figure. Further, even in the context of the sales figures provided by Indoor, as Mr Brandreth stated, the goods sold under the 'RIVAL' sign represent a minuscule proportion of Indoor's total sales, which Mr Brandreth calculated as approximately 0.08% (2018), 0.097% (2019) 0.018% (2020) of the total activity of Indoor itself. For the sake of completeness, I should add that even if I were to look at Indoor's position at the later relevant date of 06 July 2022, there are only an additional dozen or so invoices which refer to 'RIVAL' in 2021 and 2022 (up to 6 July 2022) for a total of further approximately £1,000.[7] This would still represent a tiny amount in terms of value and number of goods sold, and I find it to be so small that is almost at the vanishing point.

70. At the hearing Ms Walker suggested that the market share is not relevant and that what is relevant is that *"it has been shown that Indoor has made sales with the mark".* She also said that the goodwill shown is not trivial.

71. Conversely, Mr Brandreth made the submission that whilst goodwill might not be trivial in absolute terms, the damage that Indoor must suffer as a result of a misrepresentation must be more than trivial. Mr Brandreth's submission is, indeed, in line with what Mr Thomas Mitcheson QC (now KC), as the Appointed Person, stated in *Smart Planet Technologies*, i.e. that for a passing off claim to be successful, the claimant must establish 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.

72. Taking all of the above into account, my conclusion is that given the very little amount of sales Indoor has established, and the absent of evidence about any promotional investment, Indoor has not proven that there was a sufficient goodwill in its earlier signs to cause a substantial damage on the basis of the misrepresentation relied upon.

[7] Invoices for 2021: (1) 13.01.201: Again Faster® Rival Parallette Set £100; (2) 19.02.2021: Again Faster® Rival Parallette Set £100; (3) 4.03.2021: Again Faster® Rival Speed Sled £95; (4) 2.06.2021: Again Faster® Rival Speed Sled £100; (5) 29.07.2021: Again Faster® Rival Speed Sled £170; (6) 13.09.2021: Again Faster® Rival Speed Sled £160; (7) 8.11.2021: Again Faster® Rival Speed Sled £50; (8) 7.12.2021: Again Faster® Rival Speed Sled £50; (9) Invoices for 2022: (1) 11.02.2022: Again Faster® Rival Speed Sled £80; (2) 21.03.2022: Again Faster® Rival Speed Sled £100; (3) 19.04.2022: Again Faster® Rival Speed Sled £80.

73. Accordingly, Indoor's invalidity fails at the first hurdle. Since Rival's trade mark remains registered, Rival can rely on it in its invalidity against Indoor's trade marks registrations.

Rival's applications for a declaration of invalidity against Indoor's trade marks UK00003991343, UK00003991338 and UK00003991202 based on Sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

74. At the hearing it was agreed that since it was common ground that the signs and the goods are sufficiently similar to cause misrepresentation (had Indoor established sufficient goodwill to sustain its action for passing off) and since the Section 5(2)(b) is based on same trade marks and the same/similar goods and services, I would take the approach that if Rival's mark remains registered, because Indoor failed to establish sufficient goodwill, the invalidity actions against Indoor's trade marks will succeed on the basis of Section 5(2)(b) and I do not need to deal with the other grounds under Section 5(3) and 5(4)(a).

75. Accordingly, Rival's applications for a declaration of invalidity against Indoor's trade marks UK00003991343, UK00003991338 and UK00003991202 based on Sections 5(2)(b) are all successful in their entirety.

OUTCOME

76. Indoor's application for a declaration of invalidity against Rival's trade mark UK00003806715 fails. Rival's trade mark will remain on the register.

77. Rival's applications for a declaration of invalidity against Indoor's trade marks UK00003991343, UK00003991338 and UK00003991202 based on Sections 5(2)(b) are all successful meaning that they will be treated as if they were never registered in the first place.

COSTS

78. Rival has been successful in all four consolidated proceedings and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award Rival the sum of £3,300 calculated as follows:

Preparing invalidity applications	£600
Defending invalidity application	£300
Filing evidence and considering the other party's evidence	£1,000
Attending a hearing	£800
Official fees	£600
Total	£3,300

79. I therefore order Indoor Sport Services Limited to pay Rival Strength Ltd the sum of £3,300. 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 30th day of June 2026

TERESA PINTO
For the Registrar