

O-060-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3140407
BY BRAND PROTECTION LIMITED TO REGISTER THE TRADE MARK**

Mash It Up

IN CLASSES 9, 21 AND 25

AND

**THE OPPOSITION THERETO UNDER NO 406503
BY ABT MERCHANDISING LIMITED**

Background and pleadings

1. On 12 December 2015, Brand Protection Limited (“the applicant”) applied for the mark Mash It Up for goods in classes 9, 21 and 25.

2. The application was published for opposition purposes on 8 January 2016. ABT Merchandising Limited (“the opponent”) opposes the application in class 25, claiming that it offends sections 3(1)(a), (b) and (d) and 3(6) of the Trade Marks Act 1994 (“the Act”). The class 25 goods are:

Class 25: Clothing, footwear, headgear, casual clothing, hooded sweatshirts, jeans, printed T-shirts, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, long sleeve embroidered T-shirts, printed and embroidered sweatshirts, trousers, fleece pullovers, socks, skirts, shorts, scarves, gloves, underwear, Baseball shirts, Casual shirts, Denim shirts, Formal shirts, Open-necked shirts, Polo shirts, Printed t-shirts, Rugby shirts, Short-sleeve shirts, Sports shirts, T-shirts, Tee-shirts, Woven shirts, Hooded sweatshirts, Sweatshirts, Bandanas (neckerchiefs), Boots for sports, Clothing for sports, Shoes for sports wear, Sports caps, Sports clothing (other than golf gloves), Sports footwear, Sports garments (other than golf gloves), Sports headgear (other than helmets), Sports hosiery, Sports jackets, Sports jerseys, Sports jumpers, Sports shoes, Sports singlets, Sports socks, Sports sweaters, Sports uniforms (other than golf gloves or helmets), Sportswear, Sportswear (other than golf gloves or helmets), Studs for sports footwear, Aprons (clothing), Sun hats, Athletics vests, Babies' vests, Fishing vests, Rash vests, Vest tops, Vests, Wristbands (clothing), Wristbands (sweatbands), Bathing jackets, Jackets (clothing), Jackets for casual wear, Jackets for men, Jackets for women, Quilted jackets, Riding jackets, Shirt jackets, Stuff jackets (clothing), Unlined jackets, Weatherproof jackets, Wind jackets, Windproof jackets, Athletics shorts, Bermuda shorts, Boxer shorts, Denim shorts, Gym shorts, Shorts, Surf shorts, Surfing shorts, Swimming shorts, Trousers shorts, Tracksuits, Babies' pants (clothing), Babygrows, Baby Bibs, Baby Clothes, Bike pants, Long pants, Over pants, Pants (clothing), Short pants, Sweat pants, Track pants, Footless socks, Slipper socks, Socks, Articles of waterproof clothing, Waterproof babies' pants, Waterproof boots, Waterproof clothing, Waterproof headgear, Waterproof suits for motorcyclists, Bibs, not of paper, Clothing for gymnastics, Gym suits, Gymnastic shoes, Gymnastic suits, Gym wear, Articles of water-resistant clothing, Water repellent gloves for use by motor cyclists, Water-resistant clothing.

3. Sections 3(1)(a), (b), (d) and 3(6) state:

“3.— (1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c)
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practice of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

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

4. The claims are expressed as follows:

- 3(1)(a): The mark applied for is a statement that relates to a term (Mash Up) that is commonly used in the music industry for a song or composition created by blending two or more pre-recorded songs. The same term is commonly used in the graphic design and art world for an artistic composition created by blending or combining two or more designs relating to different trending subject matters. The mark is not capable of distinguishing goods or services of one undertaking from those of other undertakings.

- 3(1)(b): The mark consists of the term Mash Up which is a well-recognised term to signify an artistic composition created by blending or combining two or more designs relating to different trending subject matters. The word “It” between “Mash” and “up” simply signifies the act of producing a Mash Up.
- 3(1)(d): The mark consists of the terms Mash Up which is a well-recognised term to signify an artistic composition created by blending or combining two or more designs relating to different trending subject matters. The word “It” between “Mash” and “Up” simply signifies the act of producing a Mash Up.
- 3(6): The applicant’s core business appears to be in clothing and merchandise. A search on the UK register finds 51 pages of registrations and applications predominantly covering clothing in class 25. The opponent is aware of the applicant using its registrations to remove competing clothing companies’ listings from online sales platforms such as eBay and Amazon, causing damage to the sales and reputation of that company. The motivation of the applicant in this case is to prevent any clothing company from being able to use a well-recognised term to describe a particular style, design or artwork on clothing. This is easy to do with a registration because the online sales platforms like eBay and Amazon have very straightforward mechanisms to de-list items which are alleged to infringe a trade mark registration. The applicant is attempting, and in many cases, succeeding, to obtain registrations for simple statements, slogans and terms, unlawfully to prevent competition in the clothing and general merchandise industry where use of simple slogans, statements and terms are common.

5. The applicant filed a counterstatement in which it denies all the grounds of opposition. The counterstatement was signed by Andrew Scott, an officer/employee of the applicant. This is the only documentation from the applicant, which represents itself; it did not file evidence or any written submissions. The contents of the counterstatement are reproduced below, verbatim:

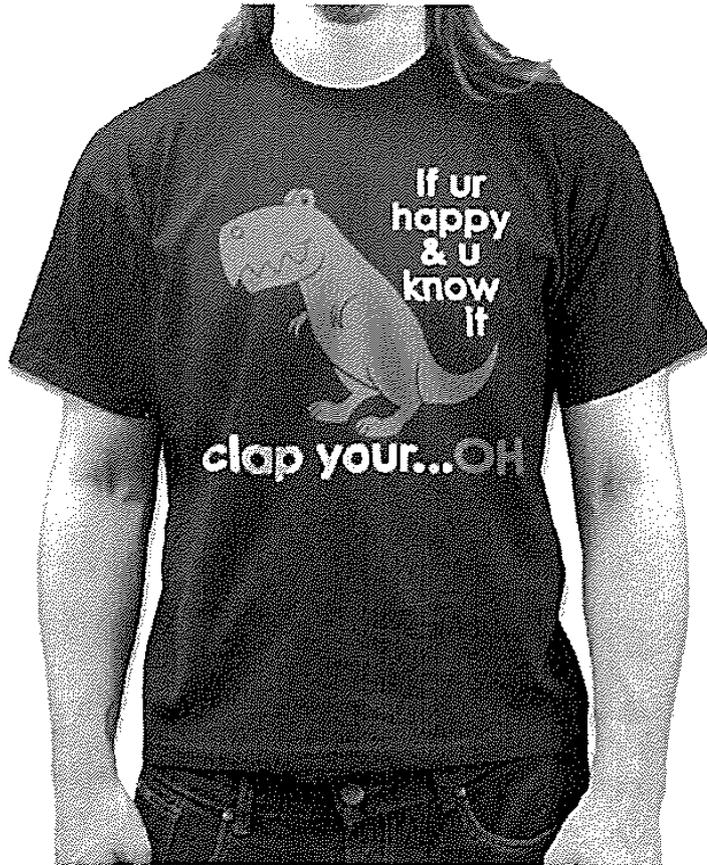
As a company, we are a builder and developer of brands - not merely a designer and printer of apparel and accessories. Our practices and methods are entirely distinct to any other company in the sector, as demonstrated by our 'Sex Weights & Protein Shakes' (SWPS) brand, which is registered not only in the UK but also Australia and the USA. SWPS boasts its own Facebook site and a strong following, dedicated online platform, advertising campaigns but most importantly premium-quality garments that are relabelled and professionally packaged. We adopt such methods to ensure that our products stand out in a saturated marketplace. We do not dispute the phrase 'Mash Up' has resonance in certain quarters - the mark we are applying for is 'Mash It Up', for which we have a series of garment designs that parody famous people, brands, films, TV series and characters in the form of graphical pastiches designed to amuse. This new brand is being reinforced in the same vein as SWPS with neck and sleeve labels, dedicated packaging and a Facebook platform to promote existing designs and generate potential ideas from the fan base. Clearly the name is inspired by the dictionary definition of 'mash-up', but in this sense is being achieved via graphical designs on clothing - our application is not about using the phrase 'Mash It Up' as a slogan on a t-shirt. As with other opposition cases lodged by the opponent, ABT Merchandising Limited, this is yet another attempt to secure some form of retribution following our company having reported ABT for infringement of the previously mentioned SWPS brand in 2015 (Mr Gerrard Manning threatened as much by email). It is our belief that the opponent is adopting a pernicious stance by simply opposing anything we attempt to register. Their claims and beliefs about our sister company's strategy are fanciful, false and based on mis-information. We're simply doing what hundreds of organisations do on a weekly basis - register their IP and trademarks to protect their work. One of the negatives about being a leader in this field is that other parties are very quick to copy the designs we develop. Ultimately, we are doing nothing unorthodox nor malicious by taking the appropriate steps to protect our ideas and investment.

6. The opponent filed evidence. Neither side chose to be heard or to file submissions in lieu of attendance at a hearing. I make this decision on the basis of the law and a careful reading of all the papers filed.

Evidence

7. The opponent's director, Bassam Karam, has filed a witness statement dated 19 September 2016. Mr Karam states that the opponent sells clothing bearing designs through online channels, such as eBay. The opponent's designs combine current trends, which he states are commonly known in the trade as 'mash-ups'. In 2015, Mr Karam was surprised to find that a number of the opponent's items of clothing had been delisted from eBay. He discovered that the artwork had been "taken and registered" by the applicant. Copies of the clothing and the relevant registrations are exhibited at ABT1. In each case, Mr Karam has provided the date on which the opponent's design was created, the date when it was first sold on eBay, and the dates of filing and registration of the applicant's alleged copy-cat UK trade marks. In each case, the opponent's eBay listing dates precede the applicant's trade mark application filing dates. Some examples are shown below:

ABT Merchandising design:

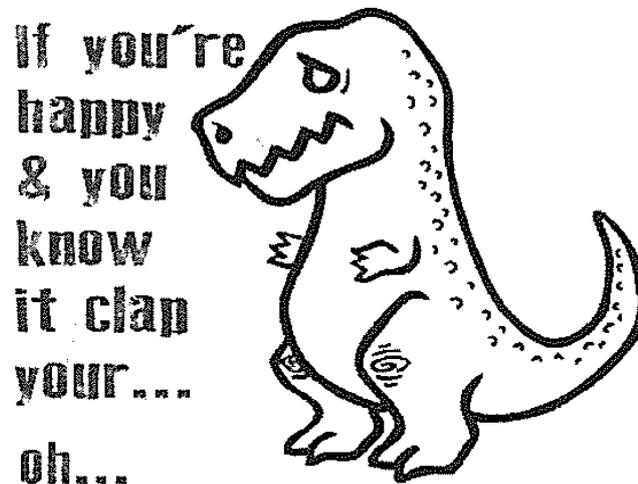


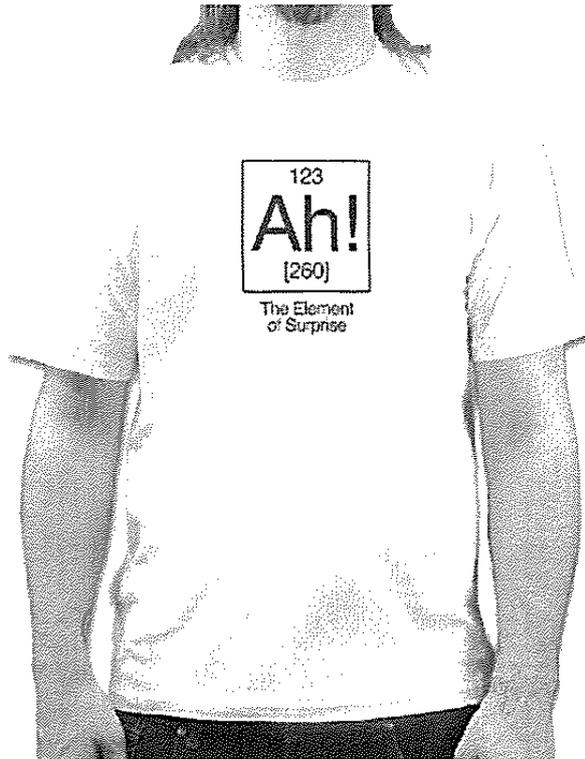
Created: March 18th 2014.

First sold on eBay : March 2014

Brand Protection registration:

UK00003068962 filed 18 August 2014, registered 21 November 2014



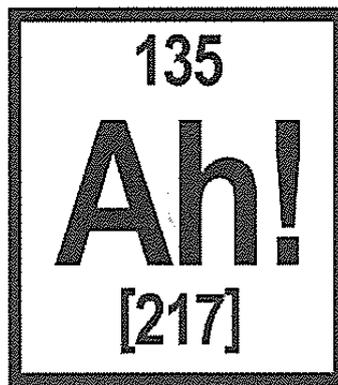


Created: 2nd October 2013

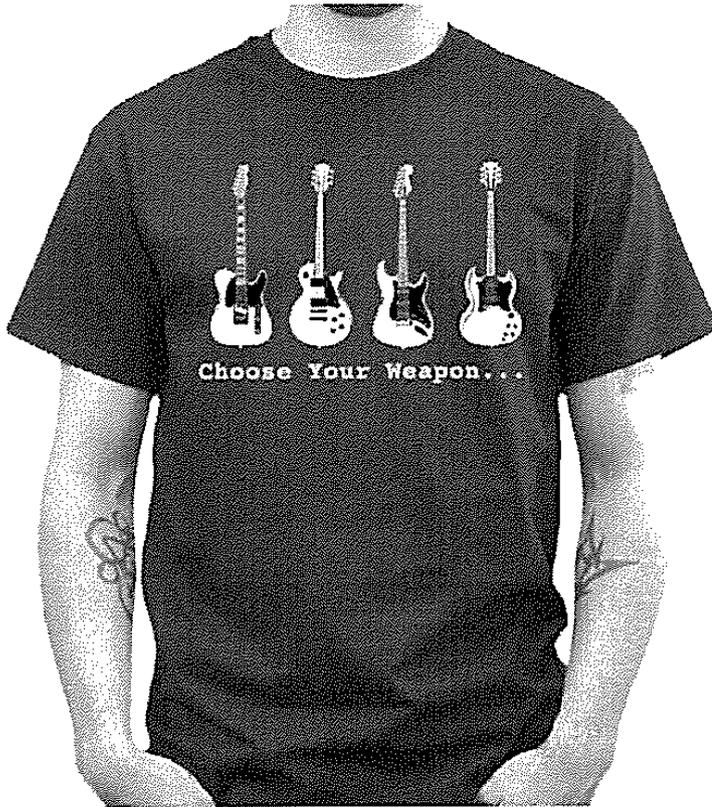
First sold on eBay : October 2013

Brand Protection registration:

UK00003069306 filed 20 August 2014, registered 21 November 2014



**The Element
of Surprise!**



Created: August 14th 2012

First sold on eBay : August 2012

Brand Protection registration:

UK00003137514 filed 6 November 2014, registered 13 March 2015



8. Mr Karam states that it was apparent to him that the applicant was deliberately taking the opponent's artwork, registering it as trade marks, and using the trade mark registrations to delist the opponent's goods in a deliberate attempt to cause damage to the opponent's business.

9. The opponent has also filed a witness statement from David Fry, who is a trade mark attorney and partner at Agile IP LLP, the opponent's professional representatives in these proceedings. The witness statement consists mainly of submissions, some of which expand upon the pleadings. I note that Mr Fry refers to section 3(1)(c) of the Act. This was not pleaded as a ground of opposition. I will not include the submissions in my summary of the evidence, but I bear them in mind and will refer to them as necessary.

10. The factual content of Mr Fry's evidence is that a "mash up" in the context of clothing designs refers to a blend of two or more pieces of artwork, each relating to different trending subject matter. There are no exhibits to Mr Fry's statement.

Decision

Section 3(1)(a) of the Act

11. Section 1(1) of the Act states:

"1.—(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging."

12. Strictly speaking, there is no need for me to decide whether this ground succeeds or fails. As Mr Geoffrey Hobbs Q.C., as The Appointed Person pointed out in *AD2000 Trade Mark*¹, s.3(1)(a) permits registration provided that the mark is

¹ [1997] RPC 168.

'capable' to the limited extent of "*not being incapable*" of distinguishing. Consequently, if I am satisfied that the mark complies with s.3(1)(b) and (d) of the Act, the 'incapable of distinguishing' objection under section 3(1)(a) is bound to fail. Alternatively, if any of the grounds under section 3(1)(b) or (d) succeed, the outcome under section 3(1)(a) becomes moot. However, for the sake of completeness, I set out here, briefly, why the ground fails, regardless of the grounds under section 3(1)(b) and (d) of the Act.

13. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), Arnold J said:

"44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4 , the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:

"80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services."

14. Article 4 of Regulation 207/2009 of 26 February 2009 on the Community trade mark (codified version) is the equivalent to section 1(1) of the Act, set out above. The mark is not incapable of distinguishing any goods. It follows from this authority that the ground of opposition under section 3(1)(a) must fail.

15. The ground under section 3(1)(a) fails.

Section 3(1)(d) of the Act

16. Section 3(1)(d) states:

“3.— (1) The following shall not be registered –

(a)

(b)

(c)

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practice of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

17. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

18. The opponent’s pleaded case under section 3(1)(d) is that the mark consists of the term Mash Up which is a well-recognised term to signify an artistic composition created by blending or combining two or more designs relating to different trending subject matters. The opponent claims that the word ‘It’ between ‘Mash’ and ‘Up’ simply signifies the act of producing a ‘mash up’.

19. The wording of section 3(1)(d) stipulates that the section applies when marks consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practice of the trade. The applicant claims that it is ‘mash up’ which is a recognised term. The mark consists of Mash It Up. The inclusion of IT changes ‘mash up’ (a noun) into an instruction. Therefore, this section of the Act cannot apply because the mark does not exist exclusively of the term which is said to be customary in the current language or in

the *bona fide* and established practice of the trade. Furthermore, the opponent has provided no evidence to support its claim. The section 3(1)(d) objection must fail because there is no evidence to show that the mark as a whole (exclusively) has (had already by the filing date) become customary in the current language or in the *bona fide* and established practice of the trade.

20. The ground under section 3(1)(d) fails.

Section 3(1)(b) of the Act

21. Section 3(1)(b) states:

“3.— (1) The following shall not be registered –

(a)

(b) trade marks which are devoid of any distinctive character,

(c)

(d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

22. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the

purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67)."

23. The pleaded case under this section of the Act is the same as for section 3(1)(d). There are no exhibits to support the pleading, or the statements of Mr Karam and Mr Fry to the effect that a mash-up, in clothing, refers to blending two or more pieces of artwork. As mentioned above, Mr Fry's witness statement contains submissions which expand upon the pleadings. He submits that the applicant's goods are the sort of media used by an undertaking to promote its business and so the mark will be taken as 'merely descriptive' of such goods (this is more the language of section 3(1)(c), which is not pleaded). He submits that the mark refers to the process of making a mash-up. Mr Fry goes on to make submissions about slogans and section 3(1)(b) of the Act. It appears that this is the crux of the objection: that the mark will be seen as a slogan and that the applicant's goods are the media which will carry the slogan. The opponent's case is that the average

consumer will see the mark as a promotional or banal statement rather than an indication of trade origin of the goods.

24. It would have been better to have included the claims made about the mark being a slogan in the pleadings, rather than use the evidence rounds to supplement the claims. However, I do not think that the applicant has suffered any disadvantage because it had the chance to file evidence and refute the claims made by Merrs Karam and Fry. The applicant did not file any evidence. Further, it is not fatal to the opponent's case that it has not filed any exhibits to show what 'mash up' means, for two reasons. Firstly, unlike for its section 3(1)(d) case in which the burden was on the opponent to show that the mark already had, at the date of filing, become customary in the current language or in the *bona fide* and established practice of the trade, the opponent is not required under section 3(1)(b) to show that a mark has already been used non-distinctively.

25. Secondly, the applicant's counterstatement makes an admission about the term 'mash up':

"We do not dispute the phrase 'Mash Up' has resonance in certain quarters – the mark we are applying for is 'Mash It Up', for which we have a series of garment designs that parody famous people, brands, films, TV series and characters in the form of graphical pastiches designed to amuse...Clearly the name is inspired by the dictionary definition of 'mash-up', but in this sense is being achieved via graphical designs on clothing – our application is not about using the phrase 'Mash It Up' as a slogan on a t-shirt."

26. The above extract from the counterstatement shows that the applicant acknowledges that its designs are graphical mash ups. I can accept the meaning of mash up as described by the opponent because it matches the meaning given by the applicant.

27. The applicant states that the application "is not about using the phrase 'Mash It Up' as a slogan on a t-shirt". The counterstatement says that it will be used on neck and sleeve labels. However, I must consider the various ways that a trade mark may

be used in relation to the goods (notional and fair use of the mark). This would include use on the garment, such as across the front, or on the back. That said, I must not confine my analysis to this 'worst case scenario'².

28. In BL O/353/10, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, upheld the refusal under section 3(1)(b) of an application for the mark BRING THE WORLD CLOSER, for telecommunications services:

"Taken as a whole, the expression looks and sounds like a statement about an advantage flowing from the use of the services on offer. I agree that the advantage and the methodology or mechanism by which it is delivered are not thereby explained. However, a narrative statement can be uninformative in relation to an aspect of the services to which it refers without necessarily or inevitably being apt to serve as an indication of trade origin. I think that is the position here.

The expression BRING THE WORLD CLOSER is caught by the exclusion from registration in section 3(1)(b) because it is liable to be perceived and remembered by the relevant average consumer as nothing more than an origin-neutral statement about the services concerned. It appears to me to involve no verbal manipulation or engineering of the kind which, in other cases, has been recognised as sufficient to turn explanatory phraseology into a sign possessed of a distinctive character."

29. Mash It Up is not an advertising slogan. The applicant has acknowledged that 'mash up' is meaningful and that it describes the graphic design concept it uses for its goods. It appears to be an expression in current culture which will be understood as an instruction or exhortation to mash [an unspecified] 'it' up. The 'it' is not explained. As in BRING THE WORLD CLOSER, Mash It Up strikes me as an uninformative narrative statement which is simply a modern expression of the freedom to be creative in respect of goods which are apt to carry graphic designs

² "The possibility that a trade mark may be used in a non-trade mark manner does not *per se* detract from its distinctive character"; Professor Ruth Annand, sitting as the Appointed Person in *THERE AIN'T NO F IN JUSTICE* BL O/094/08.

which are mash ups. It will not be perceived by the average consumer for the goods of the application as an indicator of trade origin.

30. The ground under section 3(1)(b) succeeds.

Section 3(6): bad faith

31. Section 3(6) of the Act states that:

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

32. In *Red Bull GmbH v Sun Mark Ltd & Anr* [2012] EWHC 1929 and [2012] EWHC 2046 (Ch) (“Sun Mark”) Arnold J summarised the general principles underpinning section 3(6) as follows:

“Bad faith: general principles

130 A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/ Article 3(2)(d) of the Directive/ Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131 First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132 Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2009] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La*

Mer Technology Inc v Laboratoires Goemar SA [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

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

134 Fourthly, bad faith includes not only dishonesty, but also “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined”: see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135 Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136 Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137 Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138 Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

“41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to

distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 48).”

33. As stated in the *Sun Mark* case, the relevant date is the date on which the application was made to register the trade mark, which in this case is 12 December 2015.

34. The applicant has filed no evidence going to the bad faith claim. Consequently, if the opponent has established a *prima facie* case of bad faith, the case will succeed because the applicant has not answered it³. The first question is, therefore, whether the opponent has presented a *prima facie* case of bad faith.

35. The opponent’s claim under section 3(6) appears to be that the applicant obtains registrations to remove competing clothing companies’ listings from online sales platforms. Mr Karam’s evidence focuses on the alleged copying of the opponent’s t-shirt artwork. This evidence does not appear to be relevant to the pleadings in the present case. Rather, the complaint is that the opponent produces garments which are the result of artwork ‘mash ups’ and the opponent is concerned that the applicant will have a statutory monopoly in a term which describes a particular style of clothing artwork, and therefore use its registration to remove from online listings third-party goods which are described in this manner.

36. This is not a fertile basis for a section 3(6) claim. Otherwise, section 3(6) would be a valid objection against every trade mark application which falls foul of section 3(1)(c) or (d) of the Act on the grounds that an applicant seeks a monopoly in a descriptive mark. Despite the applicant’s failure to file evidence, the ground fails because there is no *prima facie* case to answer.

37. The ground under section 3(6) fails.

³ See the decision of Mr David Kitchin Q.C. (as he then was) in *Ferrero SpA’s Trade Marks* [2004] RPC 29.

Outcome

38. The opposition succeeds under section 3(1)(b) of the Act. The mark will be refused for the class 25 goods and may proceed to registration for the goods in classes 9 and 21, which were not opposed.

Costs

39. The opponent has been successful and is entitled to a contribution towards its costs, based upon the published scale in Tribunal Practice Notice 4/2007. I have not made any award for the opponent's evidence and Mr Fry's submissions (filed as evidence) because it did not assist any of its grounds of opposition, which has been determined on the basis of the parties' pleadings. The breakdown is as follows:

Official fee	£200
Filing the opposition and considering the counterstatement	£300
Total	£500

40. I order Brand Protection Limited to pay ABT Merchandising Limited the sum of £500 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 14th day of February 2017



**Judi Pike
For the Registrar,
the Comptroller-General**