

O/0872/23

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NUMBER 3366320
IN THE NAME OF GLOBAL TRADEMARK SERVICES LIMITED**

FOR THE TRADE MARK



IN CLASS 25

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NUMBER 503425 BY HENRIK LARSSON**

Background and pleadings

1. The trade mark which is the subject of these proceedings (shown on the front cover of this decision) was registered on 5 April 2019, in class 25.¹ The trade mark application was originally made by James Robbie Dear on 11 January 2019. Mr Dear subsequently assigned the mark to his company, Global Trademark Services Limited (“the proprietor”). The trade mark register records that the effective date of assignment was 28 October 2020, which is the date given by Mr Dear on the statutory assignment form, although the form itself was filed on 23 October 2020.²

2. On 11 November 2020, Henrik Larsson (“the applicant”) made an application to have the trade mark registration declared invalid. The applicant’s address on the statutory form was given as “c/o Signed Security”, at a location in Glasgow.³ The same address was given on the form for the applicant’s representative, Brian Hamill. Mr Hamill filled in the form, dated it and signed the statement of truth. The application form records that notice that the application would be made was given to the then proprietor, Mr Dear, on 14 October 2020.

3. The application was made on the basis of passing off, under sections 47(2)/5(4)(a) of the Trade Marks Act (“the Act”). The application was not served at this point because the pleadings were unclear and required amendment. There was also some degree of confusion within the Intellectual Property Office (“IPO”) as to the identity of the applicant; at first, it was erroneously thought to be Mr Hamill, but later correctly understood to be Mr Larsson. Mr Larsson’s name is clearly entered on the form as the applicant for cancellation, with Mr Hamill c/o Signed Security as his representative. I will say more about the relevance of Mr Hamill as the (initial) representative for the applicant later in this decision.

4. After procedural delays on the basis of a) the above; b) the defence and counterstatement being mislaid in the IPO’s incoming mail systems, and c) unclear pleadings in the counterstatement, Mr Hamill was replaced as the applicant’s

¹ The full list of goods and services is shown in Annexe 1 to this decision.

² Form TM16.

³ Form TM26(l). “Unit 6, Rosemount Business Park, 143 Charles Street, Glasgow G21 2QA”.

representative by Cloch Solicitors (“Cloch”) on 4 February 2022. At this point, the applicant made a request for security for costs on the grounds that, after Mr Dear was given notice that the application for cancellation would be made, he assigned the contested registration to a dormant company with no assets (the current proprietor). Following directions from the IPO’s Tribunal, Mr Dear undertook to be the personal guarantor for the proprietor in an email of 11 April 2022, should an adverse cost award be made. He confirmed this in an email of 4 May 2022. Neither party requested a case management conference (“CMC”) regarding the security for costs issue and the directions made.

5. Following the resolution of the security for costs issue, the applicant requested leave to amend his pleadings by email on 17 May 2022. A preliminary view was given by the Tribunal, permitting the applicant’s request.⁴ No CMC was requested to contest the preliminary view, which meant that it became final.⁵ The section 5(4)(a) pleading was amended by substitution of the wording given below, and pleadings under section 3(6) of the Act were added. The basis of the application for cancellation is therefore as follows:

i) section 5(4), relying on the signs HENRIK LARSSON and LARSSON having been used in the UK since at least July 1997 in relation to sport, film, television, sporting articles, clothing and memorabilia:

“Basis of case: the Cancellation Applicant has goodwill in his name/surname/sobriquet. The use of the Cancellation Applicant’s marks in relation to the goods covered by the contested registration could constitute a misrepresentation that the Registered Proprietor’s goods are connected with the Cancellation Applicant’s goodwill. The misrepresentation could cause damage to the Cancellation Applicant by means of confusion, tarnishment of reputation, or erosion of the distinctiveness of the Cancellation Applicant’s marks.”

⁴ On 10 June 2022.

⁵ A deadline was given for a CMC request to be made by 24 June 2022. The Tribunal gave a further opportunity for a CMC to be requested on 7 July 2022.

(ii) section 3(6):

“1. The Cancellation Applicant is a famous sportsman and TV personality. His name/surname/sobriquet ("HENRIK LARSSON" and "LARSSON") are well-known and identical or highly similar to the dominant textual element in the contested registration. The Cancellation Applicant did not give the applicant for registration permission to register his name/surname/sobriquet. The Cancellation Applicant received correspondence from Mr Dear (the controlling mind of the Registered Proprietor) around the filing of the contested registration inviting the Cancellation Applicant to pay to acquire rights afforded by the contested registration. Such conduct constitutes classic bad faith. The applicant for registration had no intention to use the mark in trade. The Registered Proprietor's 'block and squat' use of the registration provides a serious risk that the mechanism of trade mark registration will be brought into disrepute and, separately, falls short of the standards of reasonable practitioners in the field in question.

2. The contested registration covers possibly every item of clothing in class 25. The Registered Proprietor is a dormant company. As at the relevant date there could not have been a genuine intent to use the mark in trade for the specification applied for.

3. The Registered Proprietor is a dormant company but holds around nineteen trade marks registered in its name (ids 1502376 and 1527974) - around a dozen of which were filed after the contested registration. All such marks include dominant textual elements which are identical or highly similar to names/surnames/sobriquets of famous sportsmen. The registered proprietor is therefore stockpiling or hoarding trade marks, particularly of famous individuals. Thus, as at the relevant date, there was no genuine intent to use the contested mark or the filing of the application falls short of the standards of reasonable practitioners in the field in question.”

6. The applicant's email requesting leave to amend the pleadings also requested an order requiring the proprietor to disclose the following:

"1. Any consent he/it received to file to register or use the mark "LARSSON" or any colourable version thereof. The issue of Mr Larsson's consent is relevant to the first and third arguments under s. 3(6).

2. All correspondence in his/its possession or under its control with the Cancellation Applicant or his representatives directed at inviting the Cancellation Applicant to pay to acquire rights afforded by the contested registration. Such material relates to the issue of profiteering and is relevant to the first and third arguments under s. 3(6)."

7. The Tribunal directed that the disclosure request would be dealt with once an amended counterstatement had been filed, given the amendments to the applicant's pleadings.

8. The amended counterstatement was filed by Mr Dear, the proprietor's sole director, on 27 July 2022. It contained material which was irrelevant to the proceedings. The Tribunal directed the proprietor to remove the irrelevant material, as follows:⁶

- remove references to Mr Hamill;
- remove any attachments; and
- remove references to the IPO in the first 4 paragraphs of the counterstatement.

9. With regard to the attachments, Mr Dear had stated that he had attached 24 pages for the IPO but only 19 for the applicant due to elements being commercially sensitive. The Tribunal could not have accepted the attachments because a properly constituted confidentiality request had not been made and it was procedurally unfair to withhold material from the applicant. The Tribunal's letter

⁶ Letter dated 16 September 2022.

warned that the consequences of failing to comply with the direction would mean that the material would be struck out. The proprietor failed to comply with the directions. The Tribunal informed the proprietor that the material would be disregarded.⁷ The Tribunal also informed the proprietor that it would have the chance to file evidence after the applicant's turn to file evidence.

10. The proprietor claims that there can be no passing off because the applicant had provided no evidence of any significant sales and no goodwill in the UK. The proprietor states:⁸

“I have already laid out how my products will be sold but will repeat to confirm the process to demonstrate there will be no confusion in the minds of the consumer. I should also make it clear I will not be selling to the average consumer.

My company will hold all my UK based/focused trademarks in Global Trademark Services Limited who will lease the products to my other company Fasanta Fashion Limited for which I hold a series of different coloured trademarks UK00003629734. Fasanta Fashion trademark will be on all clothing as well the shield style trademarks. (I am enclosing a graphic for the IPO's viewing only as it is commercially sensitive). I will be targeting via online only “supporters of a Scottish football club” wording approved by the IPO during the Clark case UK00003591582.^[9] And as I am targeting a very specific group and not the average consumer these targeted consumers are far more aware where/who products come from. The targeted consumers will have to access a Fasanta Fashion website only to make a purchase and will be invoiced by Fasanta Fashion Limited. I have one other company Signed Security Limited which will operate in a similar manner with trademarks aimed at different market places.

⁷ Letter dated 6 October 2022.

⁸ Verbatim.

⁹ In fact, the Hearing Officer in the opposition proceedings against application 3591582 (CLARK) had already found that the said limitation was unacceptable, a decision which was held to be “entirely correct” by the Appointed Person, Mr Ian Purvis KC, in *C. & J. Clark International Limited v Global Trademark Services Limited*, BL O/992/22, at paragraph 5.

My original project was purely a charitable enterprise but as I was developing the project it became apparent if I produced high quality products there would be room for a profit also. So my project is now both charitable and commercial. Through the advice of my accountant I went to a specialist accountancy firm [name] who are exploring whether I should set up a charity or a trust as [name] are not convinced a charity is the correct vehicle. From the sale from every item an element of the monies will go in the prescribed vehicle for distribution to the players and or families and I have met with one of the families who are part of an even more specific grouping to tell them what I'm doing and how they will benefit from sales. The family has agreed that at the right time they will introduce me to the rest of the specific grouping. Most football clubs have a charity or trust of their own and any player and or family who do not wish to participate in my project those monies will go to the club's charity and or trust. This means with every sale of clothing some of the monies will go to a charitable cause.

I also cite IPO Hearing Officer's decision O/468/01 on King Cole.

Bad faith 3(6):

I have 19 trademarks most registered some currently going through the registration process, one of which is in my own name as I have not got around to moving it into GTS Ltd. I have applied for these trademarks in exactly the same manner and formats. When I first started this project I had absolutely no knowledge of the UPO's rules or processes and was highly reliant on IPO staff and even though they could not give specific advice they could give general guidance which was extremely helpful in helping me getting to grips with the processes and I will be forever grateful for the help and guidance given.

I cite the IPO Hearing Officer's ruling on the King Cole case O/468/01 where the Hearing Officer refused to take on the claim of Bad Faith due to the fact the accuser had no record of Goodwill. I would also remind the IPO I have in no way stopped Mr Larsson in using his own name, Henrik Larsson, nor do I

have ownership of the last name Larsson I only have rights to a figurative design. That the IPO operates on a first to file basis, in the UK there is no right to publicity. I also cite my full answer given above addressing Passing Off 5(4)(a) to be included in the claim of Bad Faith.”

11. With regard to the first paragraph in the quotation from the counterstatement, it is not clear to me where or when Mr Dear had already laid out how his products would be sold. This may be a reference to his applications for the composite marks HENRY and RONALDINHO, the subject of a decision by Mr Geoffrey Hobbs QC, sitting as the Appointed Person, BL O/264/22, paragraphs 19 and 67; to his application for the composite mark McNEILL, the subject of a decision by Mr Philip Harris, sitting as the Appointed Person, in *Peek & Cloppenburg KG v James Robbie Dear*, BL O/439/22, paragraph 84; and to his application for the composite mark CLARK, the subject of a decision by Mr Iain Purvis KC, sitting as the Appointed Person, in *C. & J. Clark International Limited v Global Trademark Services Limited*, BL O/992/22, paragraph 3.

12. The counterstatement then goes into detail about Mr Dear’s concerns about the status of Mr Hamill c/o Signed Security. This is not relevant to the substantive grounds, but I will say more about it later in this decision. The counterstatement continues:

“Since Mr Hammil initiated claims on my trademark UK00003366320 as long ago at January 2020 it has stifled my ability to move my business forward as it would be highly irresponsible to just charge ahead knowing this challenge was in train. If I had charged ahead and was trading if I lost the case I could be liable for revenues/profits so CA000503425 has effectively put a brake on my business moving forward. However, I cannot just blame Mr Hammil for the delay. During the 2 years and 6 months of harrassment by Mr Hammil and subsequently Cloch Solicitors there has been the small matter of COVID and the war in Ukraine. When I started this project there was an abundance of UK firms who could supply clothing in all colours and all brands. Today there is a worldwide shortage of supply with colours and brands being withdrawn, I enclose two articles about the worldwide supply shortages effecting even

some of the largest football companies in the world I enclose copies Exhibit 3 and Exhibit 4. I have recently found a Scottish firm who works with a Pakistan company who make their own clothing and can guarantee consistent supply of product and colours so I am quite keen to move my business forward.

When it comes to Bad Faith, I have followed all the correct rules and procedures of the IPO, I even submitted the trademark design (because it is shield shape) to the Lord Lyon and King of Arms, Garter Principal for approval which I achieved and acted on IPO guidance. I am enclosing my 3 company registrations from Companies House, copies enclosed as Exhibit 5.

You have a situation where I have followed all of the correct rules, laws and procedures being challenged by someone with no goodwill, no sales of their unregistered trademark where the opposer had not bothered to attempt to use the correct processes to register their trademark. And someone who filed for cancellation via an Agent using a company which did not exist at the time of filing CA000503425. Someone who has (so far) accused me of a copyright issue, passing off, non use and now passing off and bad faith. To me it is quite obvious if any Bad faith does exist where it sits and I most definitely do not believe I have acted in Bad Faith, all my figurative trademarks have been filed in a consistent manner and in accordance with the IPO rules and procedures. And I would remind the IPO that Cloch Solicitors very enthusiastically took over Agent responsibility for all aspects of the filing of CA000503425.”

13. Mr Dear has acted for the proprietor throughout these proceedings. The solicitor at Cloch Solicitors who has represented the applicant since that firm was appointed is Philip Hannay. Both parties filed evidence and submissions during the proceedings. Following the end of the evidence rounds, the applicant requested a substantive hearing. Both Mr Hannay and Mr Dear attended the hearing, which took place before me by videoconference on 6 July 2023. I make this decision after a careful reading of all the evidence, submissions, the large amount of correspondence, and after considering the submissions made at the hearing (and

afterwards). I will refer to material and submissions only where relevant and/or necessary.

The procedural background to the filing of evidence

14. Mr Hannay renewed the request for an order for disclosure on 21 October 2022, on the basis that there had been discussions between Mr Dear and the applicant (and his wife) about Mr Dear's proposal to use the applicant's name/marks. Mr Hannay pointed to a package of documents sent by Mr Dear on 19 October 2022 which included reference to correspondence from Mr Dear to the applicant as "Exhibit A". Mr Hannay said that it was his understanding that Mr Dear intended to rely upon the document in these proceedings. The labelling of the documents in the package is somewhat confusing, but I note that the likely document which fits this description was also included with what Mr Dear filed as intended evidence (prematurely) on 23 November 2022. It was also one of the documents attached to the amended counterstatement. The document which Mr Dear sent was a copy of part of a letter sent to him by Mr Hamill on 14 October 2020.¹⁰ The letter said that Mr Hamill understood that the Larssons had intimated to Mr Dear that Mr Hamill should deal with the issue of the trade mark and that the Larssons had asked that Mr Dear should not contact them again, and should direct any further contact to Mr Hamill. The Tribunal ordered disclosure by 6 December 2022, as follows:¹¹

"1. Any consent Mr Dear or the Registered Proprietor received to file to register or use the mark "LARSSON" or any colourable version thereof;

2. All correspondence, including emails, notes, letters and records (if any), in Mr Dear's or the Registered Proprietor's possession or under its control with the Cancellation Applicant or its representatives directed at inviting the cancellation applicant to pay to acquire rights afforded by the contested registration."

¹⁰ The date on which notice was given that the application would be made against the registration.

¹¹ On 7 November 2022, under rules 62(1)(a) and 62(2) of the Trade Marks Rules 2008 (as amended).

15. The letter stated that failure to comply with the disclosure order may affect the weight given to the proprietor's evidence. The proprietor was given the opportunity to request a CMC by 21 November 2022 if it disagreed with the order. No CMC was requested.

16. The proprietor did not comply with the disclosure order; nor did it make any reference to it, such as to state that no such documents were in its possession, or in existence.

17. The proprietor filed a "Statement of Use" form on 23 November 2022, which contained a statement of truth signed by Mr Dear. The form was accompanied by a document dated 21 November 2022, entitled "Witness Statement". It is not a witness statement. There is no statement of truth or identification of the witness and the source of their information. It ends:

"Kind Regards
Jim Dear"

18. The Tribunal wrote to the proprietor on 13 December 2022, explaining that the disclosure order had not been complied with and saying:

"Statement of Use

I acknowledge receipt of Mr Dear's filing of 23 November 2022, which consists of a 'Statement of Use' form. However, the statement of use is not relevant to this stage of proceedings, as the Proprietor's evidence timetable has not been set. The Statement of Use will therefore be placed on the file and considered, alongside any additional evidence from the proprietor, during their evidence period."

19. The letter also referred to the 'witness statement' in the following terms:

"Misrepresentation Witness statement

I now refer to the witness statement dated 21 November 2022, filed by the Proprietor to address the matter of misrepresentation.

I must advise you that your evidence is currently not in admissible format as provided for under rule 64 of the Trade Marks Rules 2008 (as amended). A witness statement should begin by identifying who is making the statement, including their name, address and the source of their information. A witness statement may also only be given in evidence if it includes a statement of truth. To verify a witness statement (for the purposes of this tribunal) the statement of truth is as follows: 'I believe that the facts stated in this witness statement are true'.

In addition, the document filed refers to exhibits A and A1, however these do not appear to have been received.

Further guidance on the appropriate format for a witness statement can be found on the IPO website at

<https://www.gov.uk/government/publications/filingevidence-about-an-application-or-in-tribunal-proceedings>.

Despite the witness statement being deficient as regards rule 64, its contents have nevertheless been examined. Bearing in mind that the original form TM26(I) was filed with a signed statement of truth by an individual, it is the Registrar's preliminary view that the registered proprietor has not made out a prima facie case that the original TM26(I) was filed without authority to act for the cancellation applicant. "C/O Signed Security" is an Address for Service and there is no requirement that it be a registered company. The application for invalidation will not be struck out because no valid evidence has been filed and, even if it was considered to be validly filed, it does not provide persuasive reasons.

If the registered proprietor disagrees, it must ask for a case management conference within seven days of the date of this letter, namely on or before 20 December 2022.

Written arguments on this matter will not be considered unless a single written

submission is filed in lieu of attendance at a case management conference and received within seven days of the date of this letter. If a case management conference is requested, it will take place before one of the Registrar's Hearing Officers."

20. No CMC was requested. The applicant's evidence was filed on 3 January 2023. A letter from the Tribunal dated 20 January 2023 acknowledged receipt of the applicant's evidence and also written submissions from the proprietor emailed on 11 January 2023. A posted copy of these were received by the Tribunal the following day, attached to which were several 'exhibits'. The Tribunal's letter stated (my italics):

"Proprietor's Evidence/Submissions

I acknowledge receipt of the Proprietor's written submissions, received on 11 January 2023. Although the period for the proprietor to file evidence had not been set, a copy of these have been added to the case file.

If the proprietor wishes for the exhibits filed on 12 January 2023 to be admitted into proceedings, these must also be refiled under the cover of a witness statement.

A period of two months from receipt of the opponent's [sic] evidence is allowed for the applicant [sic] to file this witness statement and submit any additional evidence and/or submissions, as appropriate. *This is the registered proprietor's opportunity to support its defence with evidence against the section 3(6) and section 5(a) [sic] grounds.*

The proprietor's evidence and/or submissions should therefore be received on or before **03 March 2023** and copied to the other party in accordance with Rule 64(6). Failure to do so will result in the evidence not being admitted into the proceedings.

The Registry has an overriding objective to ensure that proceedings are completed within a reasonable time. As a result, the Registry would expect the parties to adhere to the following timetable:

Filing of registered proprietor's evidence/submissions: 03 March 2023

If the registered proprietor files such evidence/submissions, the cancellation applicant will have until 03 April 2023 to indicate if it intends to file evidence in reply and, if it does, until 03 May 2023 to do so.

Upon the conclusion of the evidence rounds the parties will be asked if they wish to be heard on this matter.”

21. Further written submissions from the proprietor were received on 1 March 2023, but the exhibits had not been put into evidential format. The Tribunal repeated this information in a letter dated 21 March 2023:

“The official letter of 20 January 2023 provided a period for the proprietor to resubmit their exhibits filed on 12 January 2023 in the appropriate format under the cover of a witness statement. It was directed that failure to do so would result in the evidence not being admitted into the proceedings. Amendments were due to be filed on or before 03 March 2023, however no witness statement was received.

I acknowledge receipt of the Proprietor's filing of 01 March 2023, which has been placed on the file as written submissions and the Hearing Officer will decide what weight to give this when reaching a decision.

I also acknowledge receipt of an email copied to the Tribunal by the Proprietor on 07 February 2022, directed to the Companies House. It is not considered that this document has been filed as part of these proceedings, and therefore does not need to be responded to by the Cancellation Applicant.

The only document filed by the Proprietor that carries a statement of truth is the Statement of Use document filed by the proprietor on 23 November 2022. The Cancellation Applicant may therefore, if they wish to, file evidence in reply to this document.

The Cancellation Applicant now has until **03 April 2023** to indicate if it intends to file evidence in reply and, if it does, until **03 May 2023** to do so.

22. As set out by the Tribunal, the only evidence which the proprietor has filed and therefore the only evidence to which the applicant could reply was the Statement of Use form filed on 23 November 2022. The proprietor had ample opportunity to put its 'witness statement' and 'exhibits' dated 21 November 2022 and the 'exhibits' attached to its submissions of 1 March 2023 into proper evidential format but, for whatever reason, chose not to do so. At the hearing, Mr Dear made submissions about the alleged 'misrepresentation' of Mr Hamill/Mr Hannay. These were matters about which he had been directed to file a witness statement on 14 October 2022 and 7 November 2022 if he wished to pursue the matter. Non-evidential material was filed on 19 October 2022. The website link on to how to file evidence was included in the 7 November 2022 letter and an opportunity to request a CMC was given. No evidence was filed and no CMC was requested. The 'witness statement' of 21 November 2022 was then filed. For the reasons given above, that was not admitted into the proceedings.

23. Although Mr Dear had failed to pursue his complaint using the procedures directed by the Tribunal, at the hearing he nevertheless commenced to make submissions about the alleged 'misrepresentation'.¹² When I asked Mr Dear why he had not complied with the directions to file material in proper evidential format and/or to request a CMC, he replied:

"Because the IPO is a law unto itself and it is acting against my company and my trade marks. It has already been found, on two cases, to have acted illegally and outside its authority and this is a continuation of what has been going on."¹³

24. If Mr Dear really believes the IPO to be "a law unto itself", I set out here why he is mistaken.

¹² I allowed Mr Dear ten minutes at the hearing to make submissions about the alleged 'misrepresentation'.

¹³ A reference to the *ex parte HENRY* and *RONALDINHO* cases, as above.

25. In *Peek & Cloppenburg KG v James Robbie Dear*, the Appointed Person stated:

“...UK IPO is a properly constituted tribunal which does indeed apply the law and decide facts in the role of a court or judge.”

26. The statutory law applicable to these proceedings is the Trade Marks Act 1994 (as amended) and the Trade Marks Rules 2008 (as amended) (“the Rules”). The parts of these which are relevant to the filing of evidence are section 69 of the Act and rule 64 of the Rules, which state:

“69 Evidence before registrar

Provision may be made by rules—

(a) as to the giving of evidence in proceedings before the registrar under this Act by affidavit or statutory declaration;

(b)⁷⁹ conferring on the registrar the powers of an official referee of the Senior Courts or of the Court of Judicature as regards the examination of witnesses on oath and the discovery and production of documents; and

(c) applying in relation to the attendance of witnesses in proceedings before the registrar the rules applicable to the attendance of witnesses before such a referee.

⁷⁹ The Constitutional Reform Act 2005 (c.4)”

“Evidence in proceedings before the registrar; section 69

[Rule] 64.—(1) Subject to rule 62(2) and as follows, evidence filed in any proceedings under the Act or these Rules may be given—

(a) by witness statement, affidavit, statutory declaration; or

(b) in any other form which would be admissible as evidence in proceedings before the court.

(2) A witness statement may only be given in evidence if it includes a statement of truth.

(3) The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise.

(4) For the purposes of these Rules, a statement of truth—

(a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and

(b) shall be dated and signed by—

(i) in the case of a witness statement, the maker of the statement,

(ii) in any other case, the party or legal representative of such party.

(5) In these Rules, a witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

(6) Under these Rules, evidence shall only be considered filed when—

(a) it has been received by the registrar; and (b) it has been sent to all other parties to the proceedings.

Registrar to have power of an official referee; section 69

65. The registrar shall have the powers of an official referee of the Supreme Court as regards—

(a) the attendance of witnesses and their examination on oath; and

(b) the discovery and production of documents,

but the registrar shall have no power to punish summarily for contempt.”

27. Section 62 of the Act defines the registrar as the Comptroller-General of Patents, Designs and Trade Marks. The IPO is an operating name of the Patent Office, which is its legal title, as per rule 2(1). As set out on the IPO’s website, the IPO is the official UK government body responsible for intellectual property rights including patents, designs, trade marks and copyright.

28. It is therefore the case that the IPO, the Tribunal and its staff operate under statutory law. If what Mr Dear was referring to was his success on appeal before the Appointed Person in the *HENRY* and *RONALDINHO* cases (as some of his comments in various emails would indicate), then his belief that the IPO is “a law unto itself” is no less misplaced. As the Appointed Person in *Peek & Cloppenburg KG v James Robbie Dear* stated, “UK IPO is a properly constituted tribunal”. Like any tribunal, its decisions are appealable and can be overturned. The IPO is no more a “law unto itself” when overturned by an appellate body than any other UK tribunal or court.

29. The consequences of Mr Dear’s failures to follow the Tribunal’s directions are: (i) the only evidence he has filed is the Statement of Use form; and (ii) the ‘misrepresentation’ issue is a non-starter because Mr Dear failed to follow directions about filing evidence and requesting a CMC, and for other reasons, which I deal with later in this decision.

30. In his written submissions of 15 June 2023, Mr Dear says “I have no idea what charges my trademark is facing” and “I have no idea what the IPO has accepted as evidence on my behalf due to the poor communications by the IPO”.

31. Firstly, the amended grounds of invalidation, sections 3(6) and 5(4)(a) of the Act, have both been denied in the counterstatement, reproduced earlier in this decision. Secondly, Mr Dear wrote to the Tribunal on 26 October 2022 (after the evidence timetable had been set), asking when he would have the opportunity to defend himself against the grounds pleaded. He did not say that he did not know what case had been brought against his trade mark and he specifically referred to the allegations of bad faith and passing off. Thirdly, it ought to have been clear to Mr Dear from the Tribunal’s letters of 13 December 2022, 20 January 2023 and 21 March 2023 what had and had not been accepted as the proprietor’s evidence. Furthermore, the Tribunal wrote to both parties on 19 May 2023, after the applicant’s evidence-in-reply had been filed, saying:

“The official letter of 21 March 2023 directed that the Cancellation Applicant had until 03 April 2023 to indicate if it intended to file evidence in reply and, if it does, until 03 May 2023 to do so.

I acknowledge receipt of Mr Dear’s email of 21 March 2023 regarding witness statements, however, as stated in the official letter of 21 March 2023, I can confirm that the only document filed by the Proprietor that carries a statement of truth is the Statement of Use document filed on 23 November 2022.

On 22 March 2023 the Cancellation Applicant confirmed their intention to file evidence in reply.

On 24 April 2023, the Cancellation Applicant filed evidence in reply. You should have received a copy of this evidence. The evidence rounds are now concluded.

Below is a list of all the evidence or submissions that have been filed by both parties in these proceedings.

Applicants evidence and/or submissions

Witness statement

Philip Hannay
Henrik Larsson

Exhibits

PAH01 – PAH10
HL01 – HL03

Written submissions of 03 January 2023

Registered Proprietors evidence and/or submissions

Statement of Use of 23 November 2022

Written submissions of 11 January 2023

Written submissions of 01 March 2023

Applicants evidence and/or submissions in reply

Witness Statement

2nd Witness Statement of Philip Hannay

Exhibits

CA-PAH-10”

32. The reference to Mr Dear’s email of 21 March 2023 regarding witness statements was because he emailed the same day as he received the Tribunal’s letter of 21 March 2023, reproduced above in this decision, saying:

“I relied on my original 2 Witness Statements already filed. I told you that in my reply on the 3rd.

Unless of course you have lost more documents. Please acknowledge Witness Statements have been filed.”

The only reply on “the 3rd” that I can see comprises correspondence sent on 3 January 2023. There were two letters sent on that date to the Tribunal’s caseworker to complain about them and the IPO; and an email to say that Mr Dear would be billing the IPO £1500. I can see in the letter that Mr Dear says:

“On the Witness Statement and Disclosure of Documents. Disclosure of Documents first, I have no idea what you are talking about. You will need to clarify what documents and if they are a demand from Mr Hannay of Cloch solicitors I will not be responding and the IPO needs to stop taking instructions from Mr Hannay on CA000503425. I have written to you separately again seeking clarification as to what documents you are talking about.

On the Witness Statement and CA000503425 more generally. Since CA000503425 was filed via a TM26(I) in November 12 2021 I have been claiming misrepresentation which the IPO has been very determined to ignore. And recent events have made it how clear the IPO is determined to avoid misrepresentation at all costs.

In your letter dated 7 November 2022 you finally (5 days from exactly one year since the filing of CA000503425) gave instructions of how to file around misrepresentation through a Witness Statement and you provided a link as seen in the letter in Exhibit E. In the link you provided there was only one pro forma form Statement of Use to be completed which I did and included my Witness Statement with the heading “CA000503425 FAO [Name] Knowingly Misrepresented Filing by Mr Hammil and continued by Mr Hannay of Cloch Solicitors” Exhibits F and G.”

33. I have set out above the procedural background to the disclosure request and the disclosure order made. In its letter of 20 January 2023, the Tribunal said:

“Disclosure

The official letter of 13 December 2023 provided both parties with the opportunity to request a case management conference on the matter of disclosure, however no such request was made. The matter is therefore considered closed”.

34. The disclosure order was clear. It set a deadline for compliance, that the evidence must be in the form of a witness statement, and provided a deadline for requesting a CMC in the event that the proprietor wished to contest the order.

Litigants-in-person have a responsibility to observe directions and deadlines, just the same as represented parties, as observed in *Kevin Hickey v DO-IT s.r.o.* by Mr Phillip Johnson, sitting as the Appointed Person:¹⁴

“Duty of the Registrar towards litigants in person

9. There are, and have always been, many unrepresented persons who apply to register trade marks, oppose applications or otherwise act in relation to proceedings before the Registry. In recent years, the number of litigants in person appearing before the higher courts has increased substantially, which has led those courts to consider how to ensure fairness between the parties where one (or both) may have little or no idea of how the legal system works.

10. In *Tinkler v Elliot* [2012] EWCA Civ 1289, the Court of Appeal considered whether the judge below was right to have set aside a judgment following an application by a litigant in person. Maurice Kay LJ gave judgment on behalf of the Court where at paragraph 32 he stated:

“I accept that there may be facts and circumstances in relation to a litigant in person which may go to an assessment of promptness but, in my judgment, they will only operate close to the margins. An opponent of a litigant in person is entitled to assume finality without expecting excessive indulgence to be extended to the litigant in person. It seems to me that, on any view, the fact that a litigant in person “did not really understand” or “did not appreciate” the procedural courses open to him for months does not entitle him to extra indulgence. Even if one factors in Mr Elliott’s health problems, the evidence shows that between April and July 2010 he was active in this litigation. The fact that, if properly advised, he would or might have made a different application then cannot avail him now. That would be to take sensitivity to the difficulties faced by a litigant in person too far. In my judgment, this is where Sharp J went wrong. She regarded this to be “a special case on its facts” but it could only be considered such if one goes too far in making

¹⁴ BL O/173/17.

allowances for a litigant in person. For these reasons, I do not consider that it was open to her to find the promptness requirement satisfied.”

11. In *Denton v TH White* [2014] EWCA Civ 906, [2014] 1 WLR 3926, Lord Dyson MR and Vos LJ in a joint judgment make a related point at paragraph 40: Litigation cannot be conducted efficiently and at proportionate cost without (a) fostering a culture of compliance with rules, practice directions and court orders, and (b) cooperation between the parties and their lawyers. This applies as much to litigation undertaken by litigants in person as it does to others....”

35. The Appointed Person went on to say that the same applies to proceedings before the registrar, a point also made by Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Robert Bosch GmbH v Roman Khan*, BL O/399/15.

36. Even if Mr Dear had not appreciated the importance of the disclosure order and the offer of a CMC, it appears from his letter of 3 January 2023 that he would not have complied with it anyway.

37. The last point made by Mr Dear on 3 January 2023 was addressed by the Tribunal in its letter of 13 December 2022, reproduced above, to which his correspondence replies. The Tribunal could not have made it any clearer (several times) that the only material filed by the proprietor in evidential format was the Statement of Use form. I will proceed on that basis and on the basis of what was stated in the counterstatement because this was signed with a statement of truth by Mr Dear. The counterstatement would be considered as evidence in the courts.¹⁵ One of the attachments to the counterstatement prompted the request for disclosure: the letter to Mr Dear from Mr Hamill. The remainder of the attachments are irrelevant to the issues in these proceedings. In any event, they cannot be considered because it is not clear which of them Mr Dear withheld from the

¹⁵ See the decision of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Soundunit Limited v Korval Inc.*, BL O/468/12, at paragraph 37: “The registered proprietor is right, that, by Rule 64 of the Trade Marks Rules 2008, in any proceedings under the Act, evidence may be given, inter alia, “in any other form which would be admissible as evidence in proceedings before the court”. Before the High Court a pleading verified by a statement of truth may be admitted as evidence (see CPR Rule 32).”

applicant, without a properly made confidentiality request. The only attachment to the counterstatement which can be referred to is the letter which prompted the disclosure request.

The applicant's evidence

38. The applicant's evidence comes from Mr Hannay and Mr Larsson, who filed witness statements dated 3 January 2023 and 24 February 2023, respectively. Mr Hannay filed a second witness statement dated 24 April 2023, in reply to that of Mr Dear/the proprietor. Some of it is not relevant to the grounds of invalidation, but I will refer to it when considering costs.

39. Mr Hannay states that the information in the statement comes from his own knowledge, Government records or from the internet. He believes the information to be true and accurate to the best of his knowledge and belief.

40. Exhibit CA-PAH-07 is an undated screen print from a website called Perfect Memorabilia:

Select your currency: GBP



OFFICIAL HENRIK LARSSON COLLECTION AT PM PRESENTS "THE UEFA SHIRT"

★★★★★ 5.0 (4 reviews) Ask a question

Store / Larsson Official



3 people
Looking at this product right now

SKU 00081

£325.00

Exclusive

Price incl. VAT (€54.17)

An iconic shirt for an iconic player...

Choose Your Shirt Font:

- UEFA Font
- SPL Font

Add to Bag

Product Details

When setting out to create a memorabilia range with Henrik we try to take a fans eye view of certain aspects of the career. So whilst the end result of this campaign didn't end in the customary trophy win for Henrik we couldn't leave it out and we are proud to present our UEFA Cup edition shirt.

Using name and number sets sourced from the original factory that produced them in 2002 we have added them to our original Henrik Larsson memorabilia shirt to produce a shirt we are proud of. The shirt is completed by our unique Henrik Larsson official memorabilia sleeve badge.

If anything captured what the football club means to the fans and what the fans mean to the football club then perhaps this was it. The final match would ultimately not go Celtics way - despite two goals from the King of



41. I note that the "Product Details" wording says:

"When setting out to create a memorabilia range with Henrik we try to take a fans eye view of certain aspects of the career. So whilst the end result of this campaign didn't end in the customary trophy win for Henrik we couldn't leave it out and we are proud to present out UEFA Cup edition shirt.

Using name and number sets sourced from the original factory that produced them in 2002 we have added them to our original Henrik Larsson memorabilia shirt to produce a shirt we are proud of. The shirt is completed by our unique Henrik Larsson official memorabilia sleeve badge."

42. Mr Hannay states that the shirt in the image features green and white stripes and that the badge on the sleeve features LARSSON and an image like that of the

contested mark, in reverse. He states that the third and fourth thumbnails show the footballer Henrik Larsson (the applicant) signing what appears to be the football shirt which is shown as for sale for £325.00. I cannot make out the detail of the badge from the representation filed (even enlarged) or the third and fourth thumbnails.

43. Exhibits CA-PAH-08 and CA-PAH-09 comprise press articles about the applicant. The first of these exhibits is a Sky Sports article entitled “Bhoys To Offer Larsson New Deal”. The article itself is undated, but the content refers to the renewal of a sports contract to play professional football for Celtic Football Club in Glasgow, set to expire in 2003. The article says:

“CELTIC want to sign star striker Henrik Larsson on an extended contract even though his current contract does not expire until 2003.

Bhoys boss Martin O’Neill is keen to tie up the player so that he finishes his career at Celtic Park.

“We are so pleased with Larsson that we want him to stay to finish his career here,” said O/Neill.

The Scottish League leaders are likely to offer the Swedish international a salary of £30,000 per week, making him one of the best paid players in the UK.

Larsson has hit 83 goals in 122 matches for the club and has been rumoured to interest a number of English clubs.

The new contract could put an end to the rumours and keep the inspirational striker in the Scottish Premier League.”

44. The second of the exhibits is a copy of an article in *The Sun* newspaper, published on 17 May 2018, the year prior to the filing of the contested trade mark application. I note that a photograph of the applicant appears at the start of the article:



45. The article says:

“HEN PARTY How old is Henrik Larsson, what is his net worth and when did he retire from football?

Former Celtic and Barcelona star will be at this summer’s World Cup in Russia as a pundit for ITV

Swedish legend Henrik Larsson is going to the World Cup.

The former Barcelona and Celtic striker has been snapped up by ITV [sic] to be a pundit on their coverage from Russia this summer.

Larsson netted 174 goals in 221 games during his time in Scotland and played in three World Cups.

How old is Henrik Larsson?

THE SWEDISH striker was born in Helsingborg in 1971. Beginning his career with local club Hogaborg, he impressed for Feyenoord before getting his big break at Celtic.

Larsson was a cult hero at Celtic Park and spent seven years firing in goals for the Hoops.

He is currently 46 years old.

What is his net worth?

Over a 25-year career Larsson amassed a personal wealth estimated to be into seven figures.

His exact net worth is not known, but he was one of the best-paid stars in Europe during his time at Barcelona.

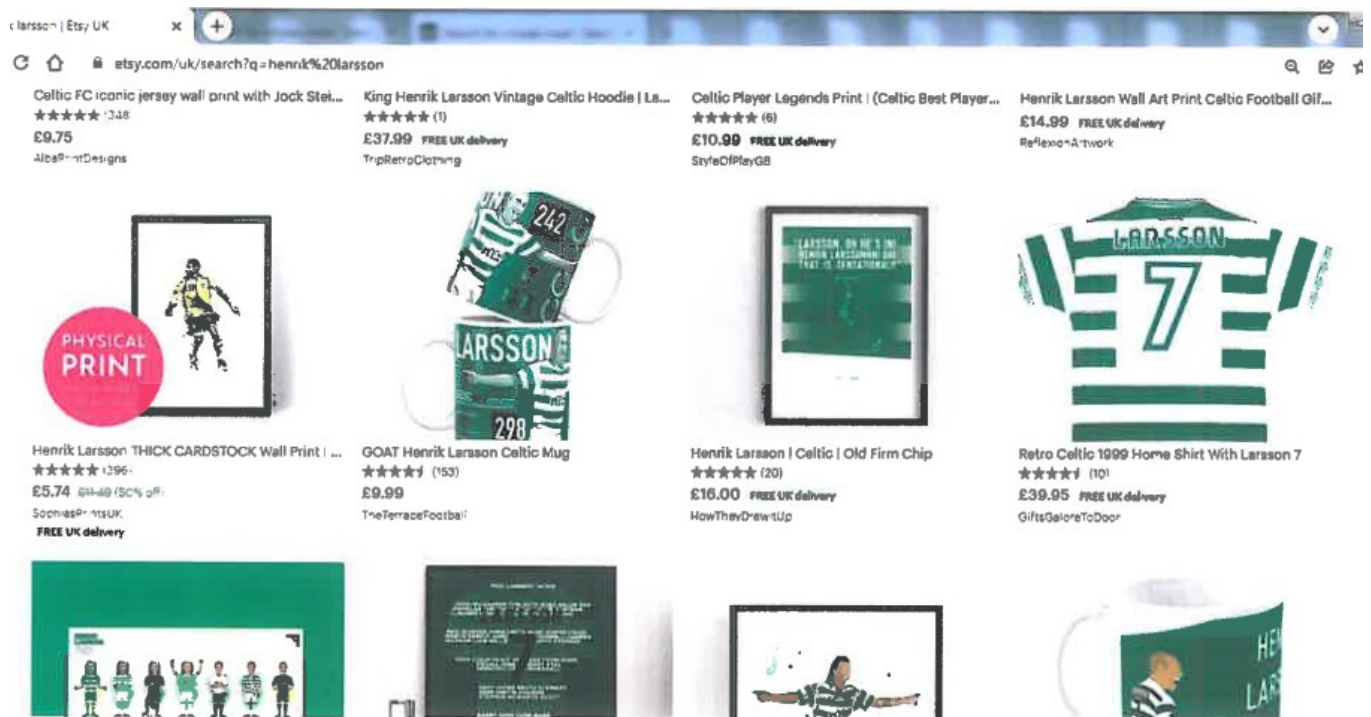
When did he retire from football?

THE SWEDE hung up his boots three times in internationals – first in 2004, after the World Cup, then finally in 2008.

After a brief spell with Manchester United he returned to Helsingborg where he eventually retired in 2009.”

46. The final exhibit adduced by Mr Hannay’s first witness statement is CA-PAH-10, which comprises a number of screenshots from the websites etsy.com and redbubble.com. It is difficult to see the full date on which some of the prints were accessed and printed, but all date from 2022.

47. The screenshots show various items such as pictures, mugs, posters, coasters, mobile phone cases, a magnet, a cushion and t-shirts; for example:



2/5/22, 10:35 AM

Henrik Larsson Gifts & Merchandise | Redbubble



Henrik Larsson Jersey Magnet
By slawisa
£6.63



2/5/22, 10:35 AM

Henrik Larsson Gifts & Merchandise | Redbubble

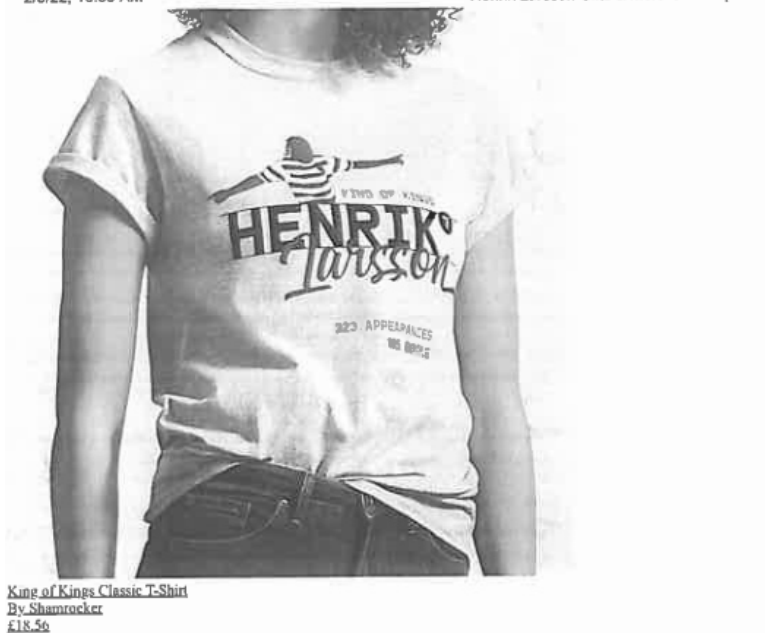


Celtic Henrik Larsson Poster
By coollike
£15.57



Tags:

henrik larsson, celtic, henrik larsson, larsson, celtic fc, celtic fc, hail hail, paradise



King of Kings Classic T-Shirt
By Shamrock
£18.56

48. The applicant has also adduced published information about himself, as exhibits to his own witness statement. Exhibits HL-01 and HL-02 comprise prints from IMDb and Wikipedia of biographical information about “Henrik Larsson”. Mr Larsson states that the contents “fairly accurately, though not comprehensively, reflect the highlights of my career as a professional footballer.”

49. I note the following from the IMDb evidence:

- Mr Larsson played for Celtic FC from 1997 until 2004, winning the Scottish League in 1997/1998, 2000/2001, 2001/2002 and 2003/2004;
- he scored 242 goals in 315 games for Celtic FC (the figures are different to those reported in *The Sun*);
- he signed for Barcelona FC in 2004;
- in September 2004 he played against Celtic FC in the Champions League competition and scored the last goal without celebration because it was against his old club (Celtic-Barcelona 1-3);
- he played in the 1994, 2002 and 2006 World Cups, and in the 2000 and 2004 Euro Cup competition;
- he was in the Barcelona team that won the Champions League in 2006;
- he scored a goal for Sweden against England in the 2006 World Cup;

- he played for Manchester United FC from January to March 2007;

50. I note the following from the Wikipedia evidence:

- Mr Larsson is “[o]ften regarded as the greatest foreign import in Scottish football history”;
- he was signed for Celtic in 1997 for £650,000.
- he scored 53 goals in 2000/2001 and won the European Golden Shoe;
- his 242 goals in 313 matches saw Celtic fans nickname him *The King of Kings*;
- he won 2 league titles and the 2005/2006 Champions League at Barcelona FC;
- he scored 37 goals in 106 international matches;
- he is the all-time leading goal scorer in the UEFA European League/UEFA Cup;
- in the early 2000s, Rangers FC’s manager, Dick Advocaat, said “Larsson is one of the best strikers in Europe, maybe the world”;
- on the announcement of his departure from Barcelona FC, Ronaldinho said “With Henrik leaving us at the end of the season this club is losing a great scorer, no question. But I am also losing a great friend. Henrik was my idol and now that I am playing next to him it is fantastic”;
- in relation to his loan to Manchester United FC in early 2007 and his decision to return to his Swedish club, Manchester United’s then manager, Alex Ferguson, said “He’s been fantastic for us, his professionalism, his attitude, everything he’s done has been excellent...We would love him to stay but, obviously, he has made his promise to his family and Helsingborg and I think we should respect that – but I would have done anything to keep him.” Manchester United won the Premier League two months after Mr Larsson left the club.

51. Mr Larsson refers to the contested mark and states that it depicts his name or sobriquet, his silhouette and refers to his career at Celtic FC. He says that if the mark was used for the goods covered by the registration, UK consumers would

mistake the mark as signifying that the goods were his or that there was some sort of economic link between him and the goods. He states:

“For, other than as I am about to explain, I do not know Global Trademark Services Limited or its sole director James Robbie Dear, and I have never knowingly or willingly given consent to either Global Trademark Services Limited or James Robbie Dear to use or register my name(s), trade mark(s), logo, sobriquet, likeness, photograph, voice, silhouette (both real life and as in any recording) and any other product of my professional football career, or any part thereof. In fact, Mr Dear approached me a few years ago explaining his intention to exploit my name (only) and offered me a percentage of the sales if I agreed. I did not agree. I believe that this was after he had filed for registration of the contested mark (UK00003366320).

For the avoidance of doubt, it is my intention to continue to commercially exploit my name(s), trade mark(s), logo, sobriquet, likeness, photograph, voice, silhouette (both real life and as in any recording) and all other products of my professional career, or any part thereof, in the United Kingdom. Mr Brian Hamill is currently assisting with the same. In that regard, I believe that UK00003366320 is blocking or unfairly hindering my ability to protect and exploit my name, sobriquet, likeness and silhouette, especially in terms of my career at Celtic Football Club”.

The proprietor’s evidence

52. The Statement of Use form which Mr Dear filed on 23 November 2022 (prior to the applicant’s deadline for filing evidence and prior to the proprietor being invited to file evidence by the Tribunal) states the following:

“The trademark has yet to be used as an opposition started very quickly in the trademark’s registration still within 5 years. With COVID and the Ukraine war it is has made it very difficult to obtain consistent, quality supply of clothing and colours. This has now been sourced via a Scottish Company who use a Pakistan supplier and work is ongoing to produce clothing and launch is not

approximately 6 months away. This trademark is part of a series of trademarks all in the same design (currently 13, 1 of them registered in my own name) all aimed the supporters of the same football club.”

53. Mr Dear goes on to state in the form that:

“I have been talking to my target market for 4 years to make sure my designs logo and clothing is in line with expectations. The business will also have a strong charitable element where part of the sales incomes to former football players and or their families. I am in discussion with [name] Solicitors about the correct legal vehicle for distribution of the monies and talked to one of the families of one of my trademarks and they have accepted what I’m doing and promised to introduce me to families of 12 of my trademarks.”

54. The final part of the form states:

“The Opposition CA000503425 was originally filed by Mr Brian Hammil c/o Signed Security and taken over by Mr Hannay of Cloch Solicitors who combined have fraudulently misrepresented themselves. I have reported the misrepresentation to the PIPCU (Police Intellectual Property Crime Unit) and Cloch Solicitors to the SLCC (Scottish Legal Complaints Commissioner). CA000503425 is now 2 years old and for 9 months prior Mr Hammil harassed my trademark causing delays. There is a challenge over the name company Signed Security which has been ongoing for around 1 year. As with the constant changing of charges within CA000503424 by both Mr Hammil and Mr Hannay, Mr Hannay only recently changed the nature of the claimed trading company to being a company who sells to private clients. As you will see from the evidence enclosed this is not logical to previous claims.”

55. In its written submissions, the applicant makes reference to a decision before the Company Names Tribunal, *Brian Hamill & Perfect Memorabilia Limited v Signed Security Limited* BL O/0160/23.¹⁶ The applicants (claimants) in those proceedings

¹⁶ [Decision on Signed Security Limited - GOV.UK \(www.gov.uk\)](https://www.gov.uk/government/cases/decision-on-signed-security-limited)

were Mr Hamill and Perfect Memorabilia Limited. They were represented by Mr Hannay (of Cloch). The primary respondent was Signed Security Limited, a company incorporated by Mr Dear on 16 March 2021. Mr Dear represented his company. The applicants sought a change to the primary respondent's name under section 69(1) of the Companies Act 2006, relying on reputation and/or goodwill attaching to the name "Signed Security". The applicants filed evidence to meet the initial burden of proving such a reputation/goodwill. Their application for a change of the contested company name failed because the adjudicators found that the evidence was insufficient to prove the relevant reputation and/or goodwill. They had not overcome the initial evidential burden and therefore there was no need for the adjudicators to consider the defences (which included good faith) relied upon by the primary respondent, on behalf of which Mr Dear filed evidence.

56. The applicant submits the following was said by Mr Dear in evidence, dated 26 August 2022, filed in the Company Names proceedings:

- "Global Trademark Services Limited is the arm of my business which owns the trade marks in the UK. Fasanta Fashion Limited is the business entity through which I intend to sell the merchandise online. As part of my expansion into the European market, I also wanted to incorporate another company to hold the registrations for some of my trade marks relating to footballers and their clubs in Europe so, in March 2021, Signed Security Limited was set up to do this."
- "Over the past few years, I have designed and registered a number of trade marks which relate to former professional footballers and their football clubs. I develop these trade marks with the intention of selling merchandise featuring the trade marks to football fans and donating some of the proceeds to the players or their families."

57. None of this was filed as evidence in the present proceedings.

58. In *AXA v Agate Systems Limited*, BL O/1141/22, the opponent did not file evidence in the trade mark opposition proceedings, but referred to the evidence of reputation which it had filed in previous Company Names Tribunal proceedings, to which the trade mark applicant had not been a party. Mr Daniel Alexander KC, sitting as the Appointed Person, said:

“27. AXA submits that the concepts of ‘reputation’ and ‘enhanced distinctive character’ are closely related (it says that they “overlap” including because the evidence for such is likely to be the same or similar) and it refers to *Sabel v Puma* (C-251/95) [1997] ECR 1-1691 and the observation of the Court of Appeal in *Maier v Asos* [2015] FSR 20, quoting *Intel v CPM* (C-252/07) [2009] RPC 15 to the effect that “A trade mark with a reputation necessarily has distinctive character, at the very least acquired through use” (*Maier v Asos* at paragraph [125]).

28. AXA therefore contends that the hearing officer was wrong in paragraph [27] of the decision to dismiss AXA’s claim of enhanced distinctiveness as “unfounded”. AXA says that this was procedurally wrong and wrong in fact and the hearing officer should have taken account of the statement of facts (as opposed to the findings) in the CNT decision. AXA contends that this approach does not violate the rule in *Hollington v. Hewthorn*.

29. Agate points out that the test for reputation in CNT [Company Names Tribunal] proceedings is not necessarily the same as the test for enhanced distinctiveness under the 1994 Act and that the hearing officer had ample basis for ignoring this earlier decision.

30. It is not in dispute that the relevant legal principles as to reliance on material from another decision were summarised in *JSC BTA Bank v Ablyazov* [2018] EWHC 1368 (Comm) at [19]:

i) This Court cannot rely upon a bare finding of a prior Court in a matter in which Mr Khrapunov was not a party or privy: *Hollington v Hewthorn & Co Ltd* [1943] KB 587 . [...]

ii) However, this Court can take into account the substance of the underlying evidence as set out in prior judgments (such as the contents of documents or the evidence of witnesses), giving this such weight as is appropriate (and on the basis that it is entirely open to Mr Khrapunov to challenge that evidence and adduce other evidence): *Rogers v Hoyle* [2013] EWHC 1409 (QB) at [115]-[117] ; [2014] EWCA Civ 257 at [54] and [99]; and *JSC A Bank v Ablyazov and another* [2016] EWHC 3071 (Comm) at [24].”

31. AXA says that the hearing officer should however have taken into account the substance of the underlying evidence referred to in the CNT Decision, giving it such weight as it thought appropriate rather than not taking it into account at all. AXA argues that the reasons he gave for not doing so were unsound. Those reasons were given at paragraph [27] of the decision and may be summarised as follows:

- (i) He was not aware of the issues in the CNT Decision and they appeared to be different to the issues raised by the Opposition.
- (ii) The evidence relied upon in the CNT Decision had not been filed in the Opposition proceedings.
- (iii) Agate had not had the opportunity to reply to or challenge the evidence relied on in the CNT Decision.

32. Agate contends that AXA is in effect trying inappropriately to rely on the evaluation in the CNT Decision by the back door and that in any event the weight to be given to this decision is small.

Evaluation

33. In my view, there is some substance in AXA’s submissions in this respect but the impact is very limited.

34. First, it is not clear that the hearing officer had fully taken on board the fact that AXA was not relying on the findings of the CNT Decision but only the facts as recorded in it and therefore may have regarded the result of decision as inadmissible rather than evaluating the weight to be given to the summary of the evidence contained in it in accordance with the JSC approach. This is not surprising since the argument does not seem to have been advanced in the same way. However, the general principle in proceedings before the Registry is that a factual matter such as enhanced distinctives must be proved by evidence in the proceedings themselves rather than by way of reliance on a statement of facts recited in another decision.

35. Second, in the light of the submissions on JSC at the appeal, the hearing officer would have been justified in attributing some weight to the summary of facts in that decision, in view of the special circumstances that the Axate had the opportunity to contest the reputation of the work AXA for insurance services and had not done so (either in pleading or otherwise) at an earlier stage. In particular, the hearing officer would have been justified, in the light of the procedural history, including the point made in Agate's response, in evaluating likelihood of confusion on the basis that there was a reputation in a part of the AXA Mark (namely the AXA word element) in respect of insurance services. To that limited extent, the hearing officer's decision fell into error in not giving any effect to the fact that there was no contest to the reputation of AXA for (mainly) insurance services. However, I do not think he can be criticised for this since the argument and authorities before him seem to have been different from those presented to me."

59. The evidence for the primary respondent in the Company Names Tribunal proceedings was given by Mr Dear. As director of the company defending the claim, Mr Dear was the controlling mind in those proceedings and, for the same reason, is the controlling mind of the proprietor defending the claims in the present trade mark proceedings. The witness was the same in both sets of proceedings: Mr Dear. He referred to his business plans for his trade marks in the evidence he filed in the Company Names Tribunal proceedings. He says in his written submissions of 15 June 2023, filed in the present proceedings, that the Company Names Tribunal

proceedings are “closely linked” to the present proceedings. The present applicant’s submissions were filed at the same time as its evidence in chief, to which the proprietor/Mr Dear had the opportunity to reply, or to object, or to challenge. For all these reasons, I consider that the submissions referring to Mr Dear’s underlying evidence in the Company Names Tribunal proceedings may be given weight.

Decision

Section 5(4)(a) of the Act

60. 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.”

61. 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.”

62. Section 5(4)(a) of the Act has application in invalidation actions through section 47, the relevant parts of which state:

“47(2) [...] 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.”

63. The three elements which the applicant must show are well known. 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)."

64. 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.”

65. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“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.”

66. As this is a case where there is no evidence that the contested mark has been used, it is the date on which the application for the contested registration was made which is the relevant date for the purposes of section 5(4)(a) of the Act: 11 January 2019.¹⁷ The applicant must show that he had sufficient goodwill at this date to bring the claim.

67. There is no evidence that the applicant had traded in any goods by the relevant date, so there is no accrual of goodwill in the conventional sense through selling sporting articles, clothing and memorabilia. The Henrik Larsson UEFA football shirt sold by Perfect Memorabilia, which appears to be an entity linked to the applicant

¹⁷ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander QC, sitting as the Appointed Person.

from the wording in the screenshot (reproduced above), is undated. In any event, the law of passing off does not protect goodwill of trivial extent.¹⁸

68. Earlier in this decision, I reproduced extracts from Exhibit CA-PAH-10, which are listings on Etsy and Redbubble of goods. These listings belong to various third parties. In his witness statement, Mr Hannay explains the exhibit in the following way:

“The Cancellation Applicant’s LARSSON mark and his image features regularly and widely on goods offered for sale in the UK. There is now produced and shown to me marked Exhibit CA-PAH-10 examples of products offered for sale on the UK Etsy and Redbubble websites.”

69. At the hearing, Mr Hannay clarified that the purpose of the exhibit was to show “the strength and breadth” of the applicant’s reputation, not that these were goods sold by the applicant.

70. Apart from clothing, sporting articles and memorabilia, the other areas of trade in relation to which goodwill is claimed are sport, film and television. It is claimed that the applicant has goodwill in his name, surname or sobriquet and “that the use of the Cancellation Applicant’s marks in relation to the goods covered by the contested registration could constitute a misrepresentation that the Registered Proprietor’s goods are connected with the Cancellation Applicant’s goodwill. The misrepresentation could cause damage to the Cancellation Applicant by means of confusion, tarnishment of reputation, or erosion of the distinctiveness of the Cancellation Applicant’s marks.”

71. I regard the reference to “the use of the Cancellation Applicant’s marks in relation to the goods covered by the contested registration could constitute a misrepresentation that the Registered Proprietor’s goods are connected with the Cancellation Applicant’s goodwill” as a poorly worded claim that the use of the

¹⁸ See for example, *Hart v Relentless Records* [2002] EWHC 1984 (Ch) and *Smart Planet Technologies, Inc. v Rajinda Sharma*, BL O/304/20.

contested mark in relation to the goods covered by the contested registration would constitute misrepresentation.

72. Mr Dear states in the counterstatement that “the IPO operates on a first to file basis, in the UK there is no right to publicity”, citing the registrar’s decision in *Andrew Cole Enterprises Limited v Joe Cole*.¹⁹ That was a decision dated 25 October 2001. Since then, the law has developed. In *Irvine v Talksport Ltd* [2003] F.S.R. 35, the Court of Appeal approved Laddie J.’s analysis that the tort of passing off was wide enough to cover false endorsement. In *Wadlow on the Law of Passing-Off 6th Ed.*, Professor Wadlow explains at [3-70] (footnote omitted):

“The definition of “trader” for the purposes of the law of passing-off is quite wide enough to embrace those who make their living in entertainment, the performing arts, professional sport, writing and the like. The issue of the locus standi of such claimants has arisen in two main contexts: ownership of pen names or stage names, and merchandising and endorsement. In *Irvine v Talksport* the professional motor racing driver Eddie Irvine obtained damages of £25,000 (increased from £2,000 at first instance) for the use of his photograph in a promotional mailshot in a way which implied that he endorsed the defendants’ radio station. [...]”

73. The applicant’s claim in relation to sport, film and television is wide enough to include a claim to false endorsement if it were to be established that the applicant had goodwill in relation to LARSSON and/or HENRIK LARSSON at the relevant date.

74. I have set out above the facts about the applicant’s professional football career. It is clear to me from the evidence that he was a prolific goal-scorer and well-known for that in the UK, not least because of the years he spent as a striker in the Scottish Premier League, for Celtic FC. He played in three World Cups, the European Championships and the Champions League, all sporting events covered by the UK press and television channels. The 2002 World Cup and the 2000 European

¹⁹ BL O/468/01.

Championships, when he played for Sweden, took place while he was a Celtic FC player. The 2004 Champions League competition, when he played for Barcelona FC, took place in the year he left Celtic FC: during the competition, he scored against his old club Celtic FC at their home ground.

75. In the year prior to the relevant date, the applicant was a pundit for ITV during its coverage of the World Cup in the summer of 2018. Three things strike me about this fact. Firstly, ITV was (and is) a major UK television channel. Secondly, it is a notorious fact that the popularity and public profile in the UK of the World Cup when it is taking place is immense. Thirdly, this was eight months (or less) prior to the filing of the contested mark. The applicant would have been seen on ITV, during programmes with huge UK viewing figures, talking about football and displaying his experience and knowledge of playing football. The applicant was hired by ITV to be a pundit because of his fame and experience gained through his time as a striker for top-flight clubs such as Celtic FC, Barcelona FC and Manchester United FC.

76. This is not evidence of goodwill in relation to film and television. However, it is evidence of goodwill in relation to sport: specifically, football. Recalling that goodwill is “the attractive force which brings in custom”, the evidence shows that over his professional footballing career and afterwards, the applicant benefitted from his good name and reputation as a top footballer. It was as a result of this “attractive force” that the applicant gained the custom of various top-flight football clubs and of ITV. At the relevant date, his appearance on ITV, talking about football and analysing the performance of international footballers would still have been fresh, the World Cup having been staged only a few months prior to the relevant date. Even without the punditry job, the applicant’s career history leaves me in no doubt that his fame and the attractive force would have been current at the relevant date amongst members of the public in the UK who were interested in football. The fact that he was engaged as a pundit by ITV some nine years after he retired as a player adds weight to the continued currency of his goodwill and reputation in the summer of 2018.

77. In *Irvine v Talksport Ltd* Parker L.J. stated that:

“31. In his first judgment, Laddie J, after setting out the relevant facts, turned first to a submission made by Mr Hicks that the cause of action in passing off does not cover a case where the claimant is represented as having ‘endorsed’ a particular product or service unless it can also be shown that the claimant and the defendant shared a common field of activity or that the ‘endorsement’ will, at least in the short term, result in some financial loss to the claimant.

32. Having conducted what is, if I may respectfully say so, an impressive analysis of the historical development of the tort of passing off, the judge rejected Mr Hicks' submission, concluding (in paragraph 38 of his judgment) that it is not necessary for a claimant who has been falsely represented as endorsing a particular product or service to establish these additional facts in order to recover substantial damages in passing off. The judge continued:

‘Of course there is still a need to demonstrate a misrepresentation because it is that misrepresentation which enables the defendant to make use or take advantage of the claimant's reputation.’

33. In paragraph 46 of his judgment, the judge said this:

‘It follows from the views expressed above that there is nothing which prevents an action for passing off succeeding in a false endorsement case. However, in order to succeed, the burden on the claimant includes a need to prove at least two, interrelated, facts. First, that at the time of the acts complained of he had a significant reputation or goodwill. Second, that the actions of the defendant gave rise to a false message which would be understood by a not insignificant section of his market that his goods have been endorsed, recommended or are approved of by the claimant..... .’ ”

78. I find that, at the relevant date, the applicant had a significant goodwill (and reputation) in HENRIK LARSSON and LARSSON in relation to the sport of football. The material filed on behalf of the proprietor appears to accept that fact; for example:

- One of the attachments to Mr Dear’s ‘witness statement’ of 21 November 2022 is the letter before action from Mr Hamill referring to Mr Dear having contacted the applicant. This contact was the subject of the disclosure order. Mr Dear has remained silent about his actions in contacting the applicant. He has not denied it happened. There is an inference that there was an attractive force pertaining to the applicant for Mr Dear to have contacted him about the trade mark application/registration.
- Mr Dear says in the ‘witness statement’ of 21 November 2022 that “[if] a company, any company had permission to sell a Henrik Larsson HL 7 unregistered trademark they would be shouting it from the rooftops and trying to promote through every possible media channel.”

79. Even if the applicant’s goodwill is not accepted by the proprietor, I find that the applicant has demonstrated sufficiently in evidence that he had the requisite goodwill at the relevant date to bring the claim. The success of the claim still depends on actionable misrepresentation, and damage. Damage does not yet have to have taken place; as is common in disputes before the registrar, the anticipation of damage should the contested mark be used is relevant (known as *quia timet*).²⁰

80. I return to *Wadlow* (footnotes omitted):

“7-219 It is settled law that there is no free-standing right for a celebrity (or anyone else for that matter) to control the use of his or her name or image by another. The principal authority in the general law is now the decision of the House of Lords in *Douglas v Hello!* So far as merchandising and endorsement are concerned, the relevant law was conveniently summarised by Kitchin LJ in the *Rihanna* case, *Fenty v Arcadia*:

“I ... begin by setting out some basic principles. There is in English law no ‘image right’ or ‘character right’ which allows a celebrity to control the use of his or her name or image. Thus, in *Douglas v Hello!*, two

²⁰ *Draper v Trist and Trisbestos Brake Linings Ltd* [1939] 56 RPC 429 and *Litecoin Foundation Limited v Inshallah Limited and ors* [2021] EWHC 1998 (Ch).

well-known film actors, Michael Douglas and Catherine Zeta-Jones, sought to prevent the publication and use of unauthorised photographs taken surreptitiously at their wedding. Lord Hoffmann (with whom Baroness Hale of Richmond and Lord Brown of Eaton-under-Heywood agreed) said at [124]:

‘There is in my opinion no question of creating an “image right” or any other unorthodox form of intellectual property. The information in this case was capable of being protected, not because it concerned the Douglases’ image any more than because it concerned their private life, but simply because it was information of commercial value over which the Douglases had sufficient control to enable them to impose an obligation of confidence.’

Similarly, Lord Nicholls of Birkenhead explained at [253]:

‘Publication of wedding photographs in “Hello!” was not, of itself, improper exploitation of the reputation, name or likeness of the Douglases such as may be protected in some circumstances in the US... . Nor did “Hello!’s” publication of pictures of this event constitute “character merchandising” or, still less, a case of “false endorsement” as discussed by Laddie J in *Irvine v Talksport* Thus it is unnecessary to consider how far English law has developed, or should develop, in these fields.’

Lord Walker of Gestingthorpe put it this way at [285]:

‘Their claims come close to claims to a “character right” protecting a celebrity’s name and image such as has consistently been rejected in English law: see *Elvis Presley Trade Marks* ... , and also Brooke LJ in the interlocutory appeal in this case The present limits of the law of passing off as a

protection of a celebrity complaining of “false endorsement” were thoroughly reviewed by Laddie J in *Irvine v Talksport*”

Lord Walker continued at [293]:

‘Although the position is different in other jurisdictions, under English law it is not possible for a celebrity to claim a monopoly in his or her image, as if it were a trademark or brand. Nor can anyone (whether celebrity or nonentity) complain simply of being photographed. ...’

A celebrity seeking to control the use of his or her image must therefore rely upon some other cause of action such as breach of contract, breach of confidence, infringement of copyright or, as in this case, passing off. However, as Mr Hobbs has properly reminded us, the law of passing off is not designed to protect a person against fair competition. Nor does it protect a person against the sale by others of the same goods or even copied goods. What it protects is goodwill and it prevents one person passing off his goods or services as those of another.”

7-220 A person who can be described as a trader has a cause of action for passing-off if he suffers damage to the goodwill in a business carried on by him from a material and damaging misrepresentation, express or implied, that he has endorsed another business or its products. As always in passing-off, the terms “business” and “trader” are very widely defined and would include artists, all kinds of performers, professional sportsmen and the like. All these have goodwill in relation to their paid professional performances, and those who have an income from merchandising or endorsement have goodwill in relation to those activities as well. However, there is in principle no remedy in passing-off for a private individual in his capacity as such, whether famous or unknown. Nor is there any remedy for even the most famous public figure unless the use by the defendant of his name, image or personal attributes is

calculated to deceive in a material sense. Passing-off, at least in English law, does not provide rights of privacy or publicity.”

81. In relation to the *Irvine* case, Professor Wadlow notes at [7-253], that the claimant, Eddie Irvine, had ample goodwill and reputation both as a racing driver and through his companies which provided endorsements. At [7-254], Professor Wadlow notes:

“Turning to the element of misrepresentation, it was conceded that the claimant could not succeed merely on proof of use of his image for commercial purposes. The question was whether a significant proportion of those to whom the brochure was sent would think that Mr Irvine had endorsed or recommended “TalkSport”. This was answered in favour of the claimant. The argument that the photograph would not be recognised (except by enthusiasts) was dismissed for several reasons: Eddie Irvine was at that time the most successful and most widely publicised British Formula 1 driver; his face had frequently appeared in print and on television, and not only in sports coverage; it was well known that he drove for Ferrari, whose distinctive racing clothing he was pictured wearing; and the promotion was timed to correspond to the British Grand Prix. He would be identified by sight by a significant part of the general public, and by an even larger proportion of those professionally involved in the business of endorsement by sporting personalities, including the target audience for the “Talksport” promotion. There was evidence of a recipient who drew precisely this conclusion, and the acknowledged objectives of the promotion were entirely consistent with it having this effect, even if unintentionally.”

82. A factor in *Irvine* was that Eddie Irvine was in the business of providing endorsements as well as being a racing driver. There is no evidence in the present case that the applicant had provided endorsements prior to the relevant date, although (as I have found) there is plenty of evidence of his goodwill as a football player. *Irvine* was highly fact dependent, as was *Fenty v Arcadia* which involved the fact that the claimant, Rihanna, had previously collaborated in clothing with the

defendant, and the image used on the clothing resembled the cover of an album she had recently released.²¹

83. *Wadlow* says at [7-256]:

“Despite the general reluctance of English courts to entertain passing-off actions in respect of merchandising in the past, it has been recognised that there is a difference between real and fictitious characters in that the former really can give or withhold their approval, and reliance on that approval or endorsement by the public is more readily to be inferred. The unauthorised use of the name or picture of a real person is therefore very much more likely to result in an implied but material misrepresentation than with fictitious characters, especially if the person is qualified to recommend the goods or business in question:

“The business of what he [Counsel for the licensees] calls character merchandising has become very well known in our present times and everyone who has a character, whether real or fictional, to exploit, does so by the grant of licences to people who wish to use the name of the real or fictional character. I think one must leave real persons out of it because, when one deals with a real person one has a person with real qualities and, therefore, his endorsement or the use of his name may undoubtedly suggest, or may suggest in proper circumstances, an endorsement which may or may not exist. ...”

[Walton J in *Tavener Rutledge v Trexapalm Ltd* [1977] R.P.C. 275.]

[...]

“[7-259] Consistently with *Irvine v Talksport*, it is now suggested that there are three relevant situations which have to be distinguished. In English law, damage to goodwill is still the gist of the action and a misrepresentation which causes no damage is not actionable. If a professional sportsman or

²¹ [2015] F.S.R. 14.

entertainer already has a substantial income from granting endorsements or similar kinds of licence, then he has a goodwill in relation to his business as a licensor or endorser, as well as that in relation to the sporting or entertainment activities from which his fame and popularity originally derive. In this case, unauthorised use of his name or likeness in such a way as to imply endorsement will rightly be taken to have deprived him of the royalty he would otherwise have received, whether or not he would actually have endorsed the defendant in fact and whether or not the defendant competes with any existing or prospective endorsee. If the defendant's goods or services, or the nature of the implied connection, are such as to debase the claimant's reputation, then that is a further head of damage, though not one which is essential in its own right. On the other hand, if the claimant's only relevant trading activity consists of his professional sporting or artistic performances then it is probably illegitimate to rely on loss of purely hypothetical licensing income as a head of damage, and the damage which is the gist of the action must be sought elsewhere. Finally, if the celebrity cannot be said to be a trader with goodwill in any relevant sense, then the action must fail."

84. There is no evidence in the present case that the applicant had provided endorsements or obtained licensing income prior to the relevant date. However, in the present case, the applicant is qualified to recommend at least goods which are football shirts and other clothing worn to play football or to display fans' affiliation to a player or club. There is a connection, or at least the fields of activity are not very much removed, between football and football clothing. In particular, football shirts are worn ubiquitously as fashion items, as well as on the pitch.

85. Turning to the contested mark itself, one of Mr Dear's submissions is that Larsson is a common surname.²² He says that there are 672 companies named Larsson registered at Companies House. Apart from there being no evidence of that, I have my doubts that Larsson is a common surname in the UK. Even if it is a

²² Submissions dated 12 January 2023.

common surname in the UK, that is only the beginning and is far from the end of the matter.

86. The contested mark contains LARSSON across the top, a dominant and distinctive component of the mark as a whole and for which the applicant has substantial goodwill for being a footballer. The name LARSSON and the graphic elements are contained within a shield-like outline. Mr Dear refutes the applicant's claim that the silhouette is the applicant in celebratory pose after scoring a goal. He has filed, although not in evidential form, prints from the internet of other footballers (for example, Sir David Beckham) in the same or very similar pose. Although this is not evidence, it is unsurprising that other footballers adopt the same celebration pose: anyone who has watched a football match (at any level) will have seen goal scorers celebrate by running with their arms outstretched, index fingers pointed outwards. Therefore, whilst this may not be categorically a silhouette of the applicant celebrating a goal, in combination with the name of the applicant who is a famous footballer and a shield-like device reminiscent of a club emblem, the whole creates the idea of the applicant in celebratory pose as a footballer.²³

87. The applicant is famous for having played for a Scottish Premier League football club. In the counterstatement, Mr Dear (for the proprietor) states:

“The business will also have a string [sic] charitable element where part of the sales incomes to former football players and or their families. I am in discussion with [name] Solicitors about the correct legal vehicle for distribution of the monies and talked to one of the families of one of my trademarks and they have accepted what I'm doing and promised to introduce me to families of 12 of my trademarks.”

88. It is not credible that the contested mark contains a 'common surname' which is either coincidental to or not meant to refer to the applicant, who played for a Scottish club. I also do not accept that the inclusion of LARSSON in the mark was coincidental because Mr Dear has attached to his counterstatement the letter before

²³ The image of the applicant in *The Sun* article shows him in this celebratory pose.

action which clearly refers to his having made contact with the applicant about the contested mark to make an offer, as described by Mr Larsson in his witness statement. It was for Mr Dear either to refute this or to comply with the disclosure order. He has been entirely silent about the contact. Silence in these circumstances leads to the direct inference that the application was made with the intention of referring to the applicant. There would be little point in the mark referring to the applicant unless it attached itself to the attractive force which would move fans of football, of Celtic FC and of the applicant to buy the goods covered by the contested mark.

89. In *Planetart LLC and anor v Photobox Limited and anor*, Mr Daniel Alexander QC, sitting as a Deputy Judge of the High Court of England and Wales said:²⁴

“79. The Claimants place some emphasis on the Defendants’ intention in this case which can on occasion be an important factor in a passing off claim. If a defendant has deliberately sought to take the benefit of a claimant’s goodwill for himself the court will not *“be astute to say that he cannot succeed in doing that which he is straining every nerve to do”* (see *Slazenger & Sons v Feltham & Co* (1889) 6 R.P.C. 130 at p.538 per Lindley LJ).”

90. I note that the Esty and Redbubble evidence shows some images on products (reproduced above) which are not dissimilar to the contested mark. The images are decorative, not trade mark use. Although after the relevant date, the images show the popular use of the applicant’s name and images associated with him as decoration on image-carrying goods, to be bought as a ‘badge of allegiance’ to him. It is possible that this is how the contested mark is intended to be used. If so, such use might be seen merely as decoration on image-carrying goods, not trade mark use, a matter which has its own legal ramifications in relation to a registered trade mark. However, this ground for invalidation has been brought against a registered trade mark, the essential function of which is to distinguish the goods of one undertaking from others. The issue is therefore not one of selling scarves or replica football shirts which bear an image and the name of the applicant, but that of a

²⁴ [2020] EWHC 713 (Ch).

registered trade mark, which is a trade monopoly and negative right that can be used to prevent the use of infringing signs and/or prevent the registration of the same. This means that the registered proprietor cannot deny that the contested mark (as a whole) will be used to designate the goods of a particular undertaking, not simply as decoration.

91. The mark is not simply a picture of a football shirt with a player's name on it, such as Mr Larsson might have worn when he played for Celtic. Rather, it is shield-like badge or device bearing his name and profile on a coloured background. The background calls to mind green-stripes-on-white, which are the colours associated with football shirts worn by Celtic players. This is not the sort of sign consumers would expect to be used by just any trader in replica football gear. Many football fans might believe that football goods bearing this mark are marketed by, or are endorsed by, Celtic Football Club. However, given that Mr Larsson has not played for Celtic for many years, and because the focus of the mark is on Larsson the player, a substantial number of fans are likely to believe that the goods are being marketed by him, or with his consent. Therefore, in relation to football-related and other leisure and sporting goods, there is misrepresentation. This is because a substantial number of the public will buy the goods in the belief that the applicant has marketed, endorsed, recommended or approved of the goods. It is no answer to say that the goods will only be sold to a discerning public who are supporters of a Scottish football club and who know where the goods come from.²⁵ Firstly, it is impossible to limit the specification of goods in such a way, as per the appeal in *C. & J. Clark International Limited v Global Trademark Services Limited*. Secondly, it would be very hard to limit the public this way in practice, despite Mr Dear stating in the counterstatement that the targeted group of consumers would only buy from another of his websites. That would mean preventing anyone who is not a supporter of the Scottish football club from accessing and purchasing from the website.

²⁵ The actual club is not named by Mr Dear in these proceedings, although I note that the Appointed Person makes reference to Celtic FC in *C. & J. Clark International Limited v Global Trademark Services Limited*: "I should say that the mark applied for is one of a set of trade marks which Mr Dear has applied for through GTM, each one representing a player from the Glasgow Celtic football team which won the European Cup in 1967 (known as the 'Lisbon Lions'). John Clark played centre back in this team. Mr Dear says the purpose of the trade marks is at least partly to raise money for the players or their families. None of this is of course relevant to the legal issues I have to decide but it puts the application into context."

Thirdly, trade mark registrations are property items which can be bought and sold, with another owner adopting an entirely different marketing strategy and business model (which would also be open to the present proprietor). Fourthly, what is to stop supporters of a Scottish football club believing that the applicant has endorsed, recommended or approved of the goods when the applicant himself played for a Scottish Premier League football club?

92. In my view, the intention to target the supporters of a Scottish football club adds force to the finding (i) that goodwill under Larsson is implicitly accepted; and (ii) that the proprietor's intention was, and is, to benefit from the goodwill and reputation of the applicant, a famous past player at a Scottish football club. Damage would follow as a direct consequence of the misrepresentation; for instance by injurious association and the loss of control over the applicant's goodwill and reputation. Any adverse publicity about goods sold under the mark, such as their quality, their cost, or even whether the proportion of the price given to charity is enough, is liable to affect the applicant's goodwill, including in his later role as a respected TV pundit.²⁶

“To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of ways. The quality of the goods I sell; the kind of business I do; the credit or otherwise which I might enjoy. All those things may immensely injure the other man, who is assumed wrongly to be associated with me.”

93. In *Irvine*, Laddie J said at [2368]:

‘But goodwill will be protected even if there is no immediate damage in the above sense. For example, it has long been recognised that a defendant cannot avoid a finding of passing off by showing that his goods or services are of as good or better quality than the claimant's. In such a case, although the defendant may not damage the goodwill as such, what he does is damage the value of the goodwill to the claimant because, instead of benefiting from exclusive rights to his property, the latter now finds that someone else is

²⁶ *Ewing v Buttercup Margarine Company, Limited*, [1917] 34 R.P.C. 232

squatting on it. It is for the owner of goodwill to maintain, raise or lower the quality of his reputation or decide who, if anyone, can use it alongside him. The ability to do that is compromised if another can use the reputation or goodwill without his permission and as he likes. Thus Fortnum and Mason is no more entitled to use the name FW Woolworth than FW Woolworth is entitled to use the name Fortnum and Mason ...' 'The law will vindicate the claimant's exclusive right to the reputation or goodwill. It will not allow others so to use goodwill as to reduce, blur or diminish its exclusivity.'"

94. Given Mr Dear's explanations in the counterstatement about the charitable intentions behind his series of trade marks, including this one, I do not think his subjective intention was to cause deception. However, the objective effect of the contested mark is the same: it will misrepresent the goods as being connected with the applicant. The public will be moved to buy the proprietor's goods because of the reference to the applicant, who has substantial goodwill as a footballer, in the belief that the applicant has marketed, endorsed, recommended or approved of the goods. Damage will follow as explained above.

95. Since the proprietor/Mr Dear's position is that he intended (and intends) to market his goods to Scottish football fans, who may well follow other sports, there is a reasonable inference that Mr Dear considers that the goodwill associated with the applicant can be exploited for all the goods in the specification, except in relation to goods which are clearly far-removed from the area of goodwill, such as 'ballet shoes'. I find that the ground under section 5(4)(a) succeeds in relation to goods which are worn whilst playing or training for football; replica kit/merchandise; goods which are football-related, sport-related or are leisurewear; or terms encompassing the aforesaid goods:

After ski boots; Aikido suits; Aikido uniforms; Aloha shirts; American football bibs; American football pants; American football shirts; American football shorts; American football socks; Anglers' shoes; Ankle boots; Ankle socks; Anklets [socks]; Anoraks; Anoraks [parkas]; Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Après-ski boots; Apres-ski shoes; Aqua shoes; Arm warmers [clothing]; Articles of clothing; Articles of clothing made of hides; Articles of clothing made of

leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Athletic clothing; Athletic footwear; Athletic shoes; Athletic tights; Athletic uniforms; Athletics footwear; Athletics hose; Athletics shoes; Athletics vests; Babies' clothing; Babies' outerclothing; Babies' pants [clothing]; Babies' pants [underwear]; Babies' undergarments; Baby bibs [not of paper]; Baby bodysuits; Baby boots; Baby bottoms; Baby clothes; Baby layettes for clothing; Baby pants; Baby sandals; Baby tops; Balaclavas; Bandanas; Bandanas [neckerchiefs]; Bandannas; Bandeaux [clothing]; Baseball caps; Baseball caps and hats; Baseball hats; Baseball shoes; Baseball uniforms; Baselayer bottoms; Baselayer tops; Basketball shoes; Basketball sneakers; Bath robes; Bath sandals; Bath slippers; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear; Beach hats; Beach robes; Beach shoes; Beach wraps; Beachwear; Beanie hats; Beanies; Bed socks; Belts [clothing]; Belts for clothing; Belts made from imitation leather; Belts made of leather; Belts made out of cloth; Belts (Money -) [clothing]; Belts of textile; Berets; Bermuda shorts; Bib overalls for hunting; Bib shorts; Bib tights; Bibs, not of paper; Bibs, sleeved, not of paper; Bikinis; Blazers; Blouses; Blouson jackets; Blousons; Blue jeans; Board shorts; Boardshorts; Bobble hats; Bodies [clothing]; Bodies [underclothing]; Body warmers; Bomber jackets; Bootees (woollen baby shoes); Booties; Boots; Boots for motorcycling; Boots for sport; Boots for sports; Boots (Ski -); Bottoms [clothing]; Bow ties; Bowling shoes; Bowties; Boxer briefs; Boxer shorts; Boxing shoes; Boxing shorts; Boy shorts [underwear]; Boys' clothing; Bralettes; Bras; Brassieres; Breeches; Breeches for wear; Briefs; Briefs [underwear]; Bucket caps; Bucket hats; Bushjackets; Button down shirts; Button-front aloha shirts; Cagoules; Camouflage gloves; Camouflage jackets; Camouflage pants; Camouflage shirts; Camouflage vests; Canvas shoes; Cap peaks; Cap visors; Capelets; Capes; Capes (clothing); Caps; Caps being headwear; Caps [headwear]; Caps with visors; Car coats; Cardigans; Cargo pants; Cashmere clothing; Cashmere scarves; Casual clothing; Casual footwear; Casual jackets; Casual shirts; Casual trousers; Casual wear; Casualwear; Chemise tops; Chemises; Chemisettes; Children's clothing; Childrens' clothing; Children's footwear; Children's headwear; Children's outerclothing; Children's wear; Chino pants; Cleats for attachment to sports shoes; Climbing boots; Climbing boots [mountaineering boots]; Climbing footwear; Cloaks; Clogs; Cloth

bibs; Clothes; Clothes for sport; Clothes for sports; Clothing; Clothing containing slimming substances; Clothing for babies; Clothing for children; Clothing for cycling; Clothing for cyclists; Clothing for fishermen; Clothing for gymnastics; Clothing for horse-riding [other than riding hats]; Clothing for infants; Clothing for leisure wear; Clothing for martial arts; Clothing for men, women and children; Clothing for skiing; Clothing for sports; Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing layettes; Clothing made of imitation leather; Clothing made of leather; Clothing of imitations of leather; Clothing of leather; Coats; Coats for men; Coats for women; Coats made of cotton; Coats of denim; Coats (Top -); Collared shirts; Combative sports uniforms; Combinations [clothing]; Corduroy pants; Corduroy shirts; Corduroy trousers; Cotton coats; Coveralls; Coverups; Cover-ups; Cowls [clothing]; Cravates; Cravats; Crew neck sweaters; Crop tops; Culotte skirts; Culottes; Cycling caps; Cycling Gloves; Cycling pants; Cycling shoes; Cycling shorts; Cycling tops; Cyclists' clothing; Deck shoes; Deck-shoes; Denim coats; Denim jackets; Denim jeans; Denim pants; Denims [clothing]; Desert boots; Down jackets; Down vests; Drawers as clothing; Drawers [clothing]; Dresses; Dresses for infants and toddlers; Dresses made from skins; Dressing gowns; Driving gloves; Driving shoes; Dry suits; Duffel coats; Duffle coats; Dungarees; Ear muffs; Ear muffs [clothing]; Ear warmers; Earbands; Earmuffs; Embroidered clothing; Espadrilles; Esparto shoes or sandals; Esparto shoes or sandals; Exercise wear; Fabric belts; Fabric belts [clothing]; Fake fur hats; Fashion hats; Figure skating clothing; Fingerless gloves; Fingerless gloves as clothing; Fishermen's jackets; Fishing boots; Fishing clothing; Fishing footwear; Fishing headwear; Fishing jackets; Fishing shirts; Fishing smocks; Fishing vests; Fishing waders; Fitted swimming costumes with bra cups; Fittings of metal for boots and shoes; Fittings of metal for footwear; Flat caps; Flat shoes; Fleece jackets; Fleece pullovers; Fleece shorts; Fleece tops; Fleece vests; Fleeces; Flip-flops; Flip-flops for use as footwear; Flying suits; Foot volleyball shoes; Football boots; Football boots (Studs for -); Football jerseys; Football shirts; Football shoes; Footless socks; Footless tights; Footmuffs, not electrically heated; Footwear; Footwear [excluding orthopedic footwear]; Footwear (Fittings of metal for -); Footwear for men; Footwear for men and women; Footwear for snowboarding; Footwear for sport; Footwear for sports; Footwear for track and field athletics; Footwear for use in sport; Footwear for women; Footwear made of vinyl; Footwear not for sports; Foundation garments; Functional underwear; Gabardines; Gabardines

[clothing]; Galoshes; Garments for protecting clothing; Gilets; girls' clothing; Gloves; Gloves as clothing; Gloves [clothing]; Gloves for apparel; Gloves for cyclists; Gloves including those made of skin, hide or fur; Gloves with conductive fingertips that may be worn while using handheld electronic touch screen devices; Golf caps; Golf clothing, other than gloves; Golf footwear; Golf pants, shirts and skirts; Golf shirts; Golf shoes; Golf shorts; Golf skirts; Golf trousers; Goloshes; Gym boots; Gym shorts; Gym suits; Gymnastic shoes; Gymshoes; Gymwear; Half-boots; Halter tops; Handball shoes; Handwarmers [clothing]; Hats; Head bands; Head scarves; Head sweatbands; Head wear; Headbands; Headbands against sweating; Headbands [clothing]; Headbands for clothing; Headgear; Headgear for wear; Headscarfs; Headscarves; Headwear; Hiking boots; Hiking shoes; Hockey shoes; Hooded pullovers; Hooded sweat shirts; Hooded sweatshirts; Hooded tops; Hoodies; Hoods; Hoods [clothing]; Horse-riding boots; Horse-riding pants; Hosiery; Hunting boot bags; Hunting boots; Hunting jackets; Hunting pants; Hunting shirts; Hunting vests; Imitation leather dresses; Infant clothing; Infant wear; Infants' boots; Infants' clothing; Infants' footwear; Infants' shoes; Infants' trousers; Infantwear; Jackets; Jackets being sports clothing; Jackets [clothing];Jackets (Stuff -) [clothing]; Jeans; Jerkins; Jerseys; Jerseys [clothing]; Jockstraps [underwear]; Jodhpurs; Jogging bottoms; Jogging bottoms [clothing]; Jogging outfits; Jogging pants; Jogging sets [clothing];Jogging shoes; Jogging suits; Jogging tops; Judo suits; Judo uniforms; Jump Suits; Jumper dresses; Jumper suits; Jumpers; Jumpers [pullovers]; Jumpers [sweaters]; Jumpsuits; Karate suits; Karate uniforms; Kendo outfits; Knee warmers [clothing]; Knee-high stockings; Knickers; Knit jackets; Knit shirts; Knit tops; Knitted baby shoes; Knitted caps; Knitted clothing; Knitted gloves; Knitted tops; Knitted underwear; Knitwear; Knitwear [clothing]; Lace boots; Ladies' boots; Ladies' clothing; Ladies' dresses; Ladies' footwear; Ladies' outerclothing; Ladies' sandals; Ladies' suits; Ladies' underwear; Ladies wear; Layette; Layette [clothing]; Leather belts [clothing]; Leather clothing; Leather (Clothing of -); Leather (Clothing of imitations of -); Leather coats; Leather dresses; Leather garments; Leather headwear; Leather jackets; Leather pants; Leather shoes; Leather slippers; Leather suits; Leather waistcoats; Leg warmers; Leggings [leg warmers]; Leggings [trousers]; Legwarmers; Leg-warmers; Leisure clothing; Leisure footwear; Leisure shoes; Leisure suits; Leisure wear; Leisurewear; Leotards; Light-reflecting coats; Light-reflecting jackets; Linen clothing; Lingerie; Long jackets; Long johns; Long sleeve pullovers; Long

sleeved vests; Long underwear; Long-sleeved shirts; Lounge pants; Loungewear; Lounging robes; Mackintoshes; Maillots; Maillots [hosiery]; Martial arts uniforms; Maternity bands; Maternity clothing; Maternity dresses; Maternity leggings; Maternity lingerie; Maternity pants; Maternity shirts; Maternity shorts; Maternity sleepwear; Maternity smocks; Maternity tops; Maternity underwear; Maternity wear; Men's and women's jackets, coats, trousers, vests; Men's clothing; Men's sandals; Men's socks; Men's suits; Men's underwear; Menswear; Millinery; Miniskirts; Mittens; Mitts [clothing]; Moccasins; Mock turtleneck shirts; Mock turtleneck sweaters; Mock turtlenecks; Moisture-wicking sports bras; Moisture-wicking sports pants; Moisture-wicking sports shirts; Money belts [clothing]; Monokinis; Motorcycle gloves; Motorcycle jackets; Motorcycle rain suits; Motorcycle riding suits; Motorcyclist boots; Motorcyclists' clothing; Motorcyclists' clothing of leather; Motorists' clothing; Mountaineering boots; Mountaineering shoes; Mufflers; Mufflers as neck scarves; Mufflers [clothing]; Mufflers [neck scarves]; Muffs; Muffs [clothing]; Neck scarfs [mufflers]; Neck scarves; Neck scarves [mufflers]; Neck tubes; Neck warmers; Neckbands; Neckerchiefs; Neckerchieves; Neckties; Neckwear; Night gowns; Night shirts; Nightdresses; Nightgowns; Nighties; Nightshirts; Nightwear; Non-slip socks; One-piece clothing for infants and toddlers; One-piece playsuits; One-piece suits; Open-necked shirts; Outer clothing; Outerclotthing; Outerclotthing for boys; Outerclotthing for girls; Outerclotthing for men; Outerwear; Overcoats; Overshirts; Overshoes; Overtrousers; Over-trousers; Padded jackets; Padded pants for athletic use; Padded shirts for athletic use; Padded shorts for athletic use; Pajama bottoms; Pajamas; Pajamas (Am.); Panties; Pants; Pants (Am.); Pantsuits; Panty hose; Pantyhose; Parkas; Pea coats; Peaked caps; Peaked headwear; Peaks (Cap -); Pedal pushers; Pinafore dresses; Pinafores; Pique shirts; Pirate pants; Plastic baby bibs; Plastic slippers; Play suits; Playsuits [clothing]; Pleated skirts; Plimsolls; Polar fleece jackets; Polo boots; Polo knit tops; Polo neck jumpers; Polo shirts; Polo sweaters; Ponchos; Pram suits; Printed t-shirts; Pullovers; Pumps [footwear]; Puttees; Puttees; Pyjamas; Pyjamas [from tricot only]; Quilted jackets [clothing]; Quilted vests; Rain boots; Rain coats; Rain hats; Rain jackets; Rain ponchos; Rain shoes; Rain slickers; Rain suits; Rain trousers; Rain wear; Raincoats; Rainproof clothing; Rainproof jackets; Rainshoes; Rainwear; Ramie shirts; Rash guards; Ready-made clothing; Ready-to-wear clothing; Referees uniforms; Replica football kits; Reversible jackets; Riding boots; Riding gloves; Riding Gloves; Riding jackets;

Riding shoes; Riding trousers; Robes; Robes (Bath -); Roll necks [clothing]; Roller shoes; Romper suits; Rompers; Rubber fishing boots; Rubber shoes; Rubbers [footwear]; Rugby boots; Rugby jerseys; Rugby shirts; Rugby shoes; Rugby shorts; Rugby tops; Running shoes; Running Suits; Running vests; Safari jackets; Sailing wet weather clothing; Sailor suits; Salopettes; Sandal-clogs; Sandals; Sandals and beach shoes; Sarongs; Scarfs; Scarves; Scrimmage vests; Sheepskin coats; Sheepskin jackets; Shell jackets; Shell suits; Shift dresses; Shirt-jacs; Shirts; Shirts; Shirts for suits; Shoes; Shoes for casual wear; Shoes for foot volleyball; Shoes for infants; Shoes for leisurewear; Shoes with hook and pile fastening tapes; Short sets [clothing]; Short trousers; Shortalls; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved T-shirts; Shrugs; Silk clothing; Silk scarves; Silk ties; Singlets; Skating outfits; Ski and snowboard shoes and parts thereof; Ski balaclavas; Ski boot bags; Ski boots; Ski gloves; Ski hats; Ski jackets; Ski pants; Ski suits; Ski suits for competition; Ski trousers; Ski wear; Skiing shoes; Skirt suits; Skirts; Skorts; Skull caps; Slacks; Sleep pants; Sleep shirts; Sleeping garments; Sleepsuits; Sleepwear; Sleeved jackets; Sleeveless jackets; Sleeveless jerseys; Sleeveless pullovers; Sliding shorts; Slip-on shoes; Slipovers; Slipovers [clothing]; Slipper socks; Slippers; Slippers made of leather; Small hats; Snap crotch shirts for infants and toddlers; Sneakers; Sneakers [footwear]; Snoods [scarves]; Snow boarding suits; Snow boots; Snow pants; Snow suits; Snowboard boots; Snowboard gloves; Snowboard jackets; Snowboard mittens; Snowboard shoes; Snowboard trousers; Snowsuits; Soccer bibs; Soccer boots; Soccer shirts; Soccer shoes; Socks; Socks and stockings; Socks for infants and toddlers; Socks for men; Spiked running shoes; Sport coats; Sport shirts; Sport shoes; Sport stockings; Sports bibs; Sports [Boots for -]; Sports bras; Sports caps; Sports caps and hats; Sports clothing; Sports clothing [other than golf gloves]; Sports footwear; Sports garments; Sports headgear [other than helmets]; Sports jackets; Sports jerseys; Sports jerseys and breeches for sports; Sports over uniforms; Sports overuniforms; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports shoes; Sports singlets; Sports socks; Sports vests; Sports wear; Sportswear; Stockings; Stockings [sweat-absorbent]; Stockings (Sweat-absorbent -); Stretch pants; Studs for football boots; Stuff jackets; Stuff jackets [clothing]; Suede jackets; Suit coats; Suits; Suits (Bathing -); Suits made of leather; Suits of leather; Sun hats; Sun visors; Sun visors [headwear]; Sundresses; Sunsuits; Surf wear; Surfwear; Sweat bands; Sweat bands for the head; Sweat

bands for the wrist; Sweat bottoms; Sweat jackets; Sweat pants; Sweat shirts; Sweat shorts; Sweat suits; Sweat-absorbent socks; Sweat-absorbent stockings; Sweat-absorbent underclothing; Sweat-absorbent underclothing [underwear]; Sweat-absorbent underwear; Sweatbands; Sweaters; Sweatjackets; Sweatpants; Sweatshirts; Sweatshorts; Sweatsuits; Swim briefs; Swim caps; Swim shorts; Swim suits; Swim trunks; Swim wear for children; Swim wear for gentlemen and ladies; Swimming caps; Swimming caps [bathing caps];Swimming costumes; Swimming suits; Swimming trunks; Swimsuits; Swimwear; Tabards; Taekwondo suits; Taekwondo uniforms; Tank tops; Tankinis; Tank-tops; Tee-shirts; Tennis dresses; Tennis pullovers; Tennis shirts; Tennis shoes; Tennis shorts; Tennis skirts; Tennis socks; Tennis sweatbands; Tennis wear; Thermal clothing; Thermal headgear; Thermal socks; Thermal underwear; Thermally insulated clothing; Thong sandals; Thongs; Ties; Ties [clothing]; Tights; Top coats; Topcoats; Tops; Tops [clothing]; Track and field shoes; Track jackets; Track pants; Track suits; Tracksuit bottoms; Tracksuit tops; Tracksuits; Traction attachments for footwear; Trainers; Trainers [footwear]; Training shoes; Training suits; Trekking boots; Trench coats; Trenchcoats; Triathlon clothing; Trouser socks; Trousers; Trousers for children; Trousers for sweating; Trousers of leather; Trousers shorts; Trunks; Trunks (Bathing -); Trunks [underwear]; T-shirts; Tube tops; Tunics; Turtleneck pullovers; Turtleneck shirts; Turtleneck sweaters; Turtleneck tops; Turtlenecks; Twin sets; Umpires uniforms; Under garments; Under shirts; Underclothes; Underclothing; Underclothing (Anti-sweat -); Underclothing for women; Undergarments; Underpants; Underpants for babies; Undershirts; Underwear; Underwear (Anti-sweat -); Underwear for women; Uniforms; Unitards; Vest tops; Vests; Vests (Fishing -); Visors; Visors being headwear; Visors [clothing]; Visors [headwear];V-neck sweaters; Volleyball jerseys; Volleyball shoes; Waders; Waist belts; Waistcoats; Waistcoats [vests]; Walking boots; Walking breeches; Walking shoes; Walking shorts; Warm up suits; Warm-up jackets; Warm-up pants; Warm-up suits; Warm-up tops; Water socks; Waterpolo caps; Waterproof boots; Waterproof boots for fishing; Waterproof capes; Waterproof clothing; Waterproof jackets; Waterproof outerclothing; Waterproof pants; Waterproof shoes; Waterproof suits for motorcyclists; Waterproof trousers; Water-resistant clothing; Waterskiing suits; Weather resistant outer clothing; Weatherproof clothing; Weatherproof jackets; Weatherproof pants; Wellington boots; Wellingtons; Wet suits; Wet suits for surfing; Wet suits for water-skiing; Wet suits for water-skiing and sub-

aqua; Wet suits for windsurfing; Wetsuit gloves; Wetsuits; Wetsuits for surface watersports; Wetsuits for surfing; Wetsuits for water-skiing; Wind coats; Wind jackets; Wind pants; Wind resistant jackets; Wind suits; Wind vests; Windcheaters; Wind-jackets; Windproof clothing; Windproof jackets; Wind-resistant jackets; Wind-resistant vests; Windshirts; Winter boots; Winter coats; Winter gloves; Women's clothing; Women's foldable slippers; Womens' outerclothing; Women's shoes; Women's suits; Womens' underclothing; Womens' undergarments; Women's underwear; Woolen clothing; Woollen socks; Woollen tights; Woolly hats; Woven clothing; Woven shirts; Wrist bands; Wrist warmers; Wristbands; Wristbands [clothing]; Yoga bottoms; Yoga pants; Yoga shirts; Yoga shoes.

96. The section 5(4)(a) ground succeeds against all the goods listed in the previous paragraph.

Section 3(6) of the Act

97. Section 3(6) of the Act states:

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

98. Section 3(6) of the Act has application in invalidation actions through section 47, the relevant part of which states:

“47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). [...]

99. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724,

Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“67. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs

from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]".

100. It is necessary to ascertain what the applicant for the trade mark knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

101. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). It is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*.

102. The caselaw shows that the initial evidential burden falls upon the applicant for cancellation: he must present evidence from which a rebuttable presumption of lack of good faith can be drawn. If he does that, then the burden shifts to the proprietor to rebut the allegation. The applicant for the mark was Mr Dear, who has given evidence for the proprietor. He is clearly well-placed to do so.

103. There are three legs to the bad faith allegation as pleaded, to which I will refer in the following abbreviated way for convenience, although of course I bear in mind the ground as pleaded in full:

- (i) no intention to use in relation to the wide specification;
- (ii) no intention to use – stockpiling; and

(iii) no intention to use - opportunistic blocking/squatting.

No intention to use: 'wide specification'

104. The full pleading is:

“The contested registration covers possibly every item of clothing in class 25. The Registered Proprietor is a dormant company. As at the relevant date there could not have been a genuine intent to use the mark in trade for the specification applied for.”

105. The applicant claims that the registration covers possibly every item of clothing in class 25. At the hearing, Mr Hannay said he had been able to count the terms in the specification (using his computer) and they number 3,500. The applicant claims that the proprietor is a dormant company and there could not have been a genuine intention to use the mark for the specification applied for.

106. The registered specification is a very long alphabetical list of goods, shown in Annexe 1 to this decision. There are a variety of unusual terms included, and a disparate array of clothing types. For example, as well as 'albs' and 'zori, the registration covers bikinis, waist strings for kimonos, and fisherman's jackets.

107. Whether it is bad faith to apply for a trade mark without any intention to use it in relation to the specified goods and services but with the intention of using it as a 'legal weapon' was considered in *Sky v Skykick*, CJEU, Case C-371/18, EU:C:2020:45 (“*Sky CJEU*”) and *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 (“*Sky CA*”). That aspect of the Court of Appeal's judgment was appealed and a decision from the Supreme Court is awaited. At present, the law appears to be as follows:

- a) Applying to register a trade mark without an intention to use it is not bad faith *per se*. Therefore, it is not necessary for the trade mark applicant to be using, or have plans to use, the mark in relation to all the goods/services covered by the specification: *Sky CJEU*.

- b) The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that applicant had no economic activity corresponding to the goods and services referred to in that application: *Sky CJEU*.
- c) However, where the trade mark application is filed without an intention to use it in relation to the specified goods and services, and there is no rationale for the application under trade mark law, it may constitute bad faith. Such bad faith may be established where there are objective, relevant and consistent indications showing that the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: *Sky CJEU*.
- d) A trade mark may be applied for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky CJEU*.
- e) It is not possible for there to be bad faith in respect of an entire category of goods or services where there was an intention to use the mark in relation to some goods or services within that category (*Sky CJEU*; *Sky CA*).
- f) Each category of goods and services must be considered separately, taking into account legitimate use and factors such as an applicant's reputation, brand recognition and expansion which might justify a wide specification: *Sky CA*.

108. In *Equisafety Ltd v Battle, Hayward And Bower, Ltd & Anor*, [2021] EWHC 3296 (IPEC), although it was admitted that the registration included certain goods in respect of which the claimant had no intention to use the mark, there was insufficient evidence to show that the application had been made in bad faith. The judge pointed out that the registration included some goods in classes 9 and 18 in relation to which

the claimant was using the mark, as well as classes it “may well want to move into” (at [38]). The judge said:

“39. Even if the application was made in bad faith in so far as it related to goods such as bicycle helmets and Fences (Electrified), it is clear from *Skykick* (see for example, at [108]-[109]), that that would not invalidate the application insofar as it related to goods such as the reflective products that [the claimant] was selling at the time. As [the claimant’s] infringement claim is based on that latter type of goods, the bad faith argument does not assist [the defendant].

40. I should say that, even as regards goods such as bicycle helmets and Fences (Electrified), it does not seem to me that the evidence is sufficient for me to conclude that the application was made in bad faith. As these goods were outside the scope of [the defendant’s] activities, it does not appear that [the claimant’s] motivation was to undermine [the defendant’s] position. So, the allegation becomes simply one of too broad a specification of goods which is not sufficient to found a bad faith claim (see *SkyKick* at [67(13)] and [77]).”

109. The proprietor/Mr Dear has not directly addressed the wide specification allegation. There is no reference to it in his evidence and there was no reference to it at the hearing. However, he makes a reference to a non-use attack in his counterstatement. I will say more about this later in the decision, but it suffices at this point to record that I consider his (mistaken) reference to a non-use attack was to refute the allegation that he had no intention to use the mark in relation to the goods applied for. This is consistent with his ‘Statement of Use’ form in which he explains the problems he had encountered in getting clothing to market. He refers in the counterstatement to part of the proceeds from the clothing sales going to the players of the Scottish football club, or to their families. There is a clear statement that he intended to use the contested mark in relation to clothing.

110. The applicant’s evidence about this aspect of the bad faith claim does not take matters any further forward than the bare pleading. There is nothing about it in Mr

Hannay's evidence, nor in Mr Larsson's evidence. The quotations from the Company Names Tribunal evidence do not go to the point.

111. The facts of this case are different to those in *Sky*, whereby *Sky* was engaged in multiple oppositions based upon its registrations for wide specifications. Point (e) in the summary of *Sky CA* says that it is not possible for there to be bad faith in respect of an entire category of goods or services where there was an intention to use the mark in relation to some goods or services within that category. Mr Dear's 'Statement of Use' and the counterstatement show that he did have such an intention when he applied for the contested mark: he states that the clothing was aimed at supporters of a Scottish football club. In relation to the applicant's pleading about dormancy of the proprietor, I make two points. Firstly, Mr Dear, not the proprietor, was the applicant at the relevant date. Secondly, point (b) of the *Sky CA* summary says that bad faith cannot be presumed on the basis of the mere finding that the applicant had no economic activity at the relevant date.

112. As the law currently stands, in relation to this aspect of the bad faith claim, there is no evidence from which a rebuttable presumption of lack of good faith can be drawn, and therefore the burden does not shift to the proprietor. The mere breadth of the specification is insufficient to give rise to a *prima facie* case of bad faith on the basis of the above case law. However, this aspect of the law, as decided by the Court of Appeal in *Sky CA*, has been appealed to the Supreme Court, which recently heard submissions on the point from the parties to those proceedings and from the registrar. As judgment is awaited, I will make no formal finding about this aspect of the section 3(6) ground until the judgment from the Supreme Court has been handed down and the parties in the present proceedings have had the opportunity to make submissions about what it means for the specification which is currently registered. I will issue a separate decision giving my formal finding at that point.

No intention to use: 'stockpiling'

113. The full pleading is:

“3. The Registered Proprietor is a dormant company but holds around nineteen trade marks registered in its name (ids 1502376 and 1527974) - around a dozen of which were filed after the contested registration. All such marks include dominant textual elements which are identical or highly similar to names/surnames/sobriquets of famous sportsmen. The registered proprietor is therefore stockpiling or hoarding trade marks, particularly of famous individuals. Thus, as at the relevant date, there was no genuine intent to use the contested mark or the filing of the application falls short of the standards of reasonable practitioners in the field in question.”

114. I can deal with this relatively briefly. ‘Stockpiling’ refers to speculative, opportunistic trade mark filings, made without the intention that they be used in accordance with their essential function.²⁷ Mr Dear has maintained throughout these proceedings, and in the Company Names Tribunal proceedings, that he intends to use his trade marks, including the present contested mark, “with the intention of selling merchandise featuring the trade marks to football fans and donating some of the proceeds to the players or their families”.²⁸ This is not stockpiling or hoarding. The final part of the last sentence of the pleading (my emphasis) says “or the filing of the application falls short of the standards of reasonable practitioners in the field in question”. That is not a sufficiently specific pleading. This part of the section 3(6) ground fails.

²⁷ See, for example, *Kinder Trade Marks O/279/03* [2004] R.P.C. 29 at [23] and *Trump International Limited v DTTM Operations LLC, the Comptroller General of Patents, Designs and Trade marks intervening* [2019] EWHC 769 (Ch).

²⁸ Evidence in the Company Names Tribunal proceedings, 26 August 2022.

No intention to use: 'opportunistic blocking/squatting'

115. The full pleading is:

“1. The Cancellation Applicant is a famous sportsman and TV personality. His name/surname/sobriquet ("HENRIK LARSSON" and "LARSSON") are well-known and identical or highly similar to the dominant textual element in the contested registration. The Cancellation Applicant did not give the applicant for registration permission to register his name/surname/sobriquet. The Cancellation Applicant received correspondence from Mr Dear (the controlling mind of the Registered Proprietor) around the filing of the contested registration inviting the Cancellation Applicant to pay to acquire rights afforded by the contested registration. Such conduct constitutes classic bad faith. The applicant for registration had no intention to use the mark in trade. The Registered Proprietor's 'block and squat' use of the registration provides a serious risk that the mechanism of trade mark registration will be brought into disrepute and, separately, falls short of the standards of reasonable practitioners in the field in question.”

116. In the middle of this pleading is the reference to Mr Dear having contacted the applicant around the time of filing of the contested registration, inviting the applicant to pay to acquire rights afforded by the contested registration, which is claimed as “classic bad faith”. This alleged contact, which was not disputed or referred to in the counterstatement, gave rise to the applicant’s disclosure request and the subsequent disclosure order from the Tribunal. As already mentioned in this decision, the proprietor did not comply with the disclosure request.

117. The cancellation applicant’s written submissions of 3 January 2023 said:

“22. It is submitted that the case under s. 5(4)(a) also constitutes bad faith. However, under s. 3(6), the Cancellation Applicant's statement of grounds highlights three further claims:

(i) Free-riding against consent/ 'block and squat';

- (ii) Specification too wide and premature; and
- (iii) Stockpiling/hoarding.”

118. It is my view that the pleadings are cast wider in these written submissions than they were in the amendment to pleadings made on 17 May 2022. Firstly, there is the ‘submission’ that the section 5(4)(a) ground also constitutes bad faith, without that having a) been pleaded, and b) explained. Secondly, there is the two-pronged attack at point (i). As pleaded, the claim reads as an allegation of blocking and squatting. It does not read as two claims in one paragraph. The amended pleadings filed on 17 May 2022 were divided into three paragraphs, not four. In the applicant’s skeleton argument, the goal posts shifted again. This time there were four headings for bad faith:

“Classic bad faith

37. The Applicant has testified [tab 13/WS/p. 2, para. 4] that no consent was given for the filing of the Larsson Mark (which is linked to the Applicant) and that Mr Dear filed the Larsson Mark in the hope of extracting some value from the Applicant. Mr Dear failed to comply with the Registry’s disclosure order to provide contemporaneous material around the Relevant Date. The intent to exploit the Applicant is admitted in Mr Dear’s witness statement for case APP3786 [at ¶12] (above).

Free-riding / blocking

38. Spurned by the Applicant, Mr Dear fabricated a change of business plan in order to free-ride on the Applicant’s reputation, interfering with the Applicant’s commercial plans and commercial relationships (for example, with Brian Hamill/Perfect Memorabilia Limited).

Too wide / pre-mature

39. As at the Relevant Date, on the balance of probabilities, Mr Dear, then [age] (now [age]), and employed by [name], was not genuinely ready and did

not have the resource to use the Larsson Mark for the full range of some 3,500 different goods applied for.

Stockpiling / hoarding

40. The Larsson Mark is one of many marks registered and not used by the Proprietor. As noted, Mr Dear “*plans to file for hundreds more trademarks*” [tab 22/submissions/p. 1, para. 3, line 3]. These marks in the main all related to actual footballers and their clubs. A fact admitted by Mr Dear.¹⁰

10 Mr Dear's witness statement for case APP3786 [at \2],[The Company Names Tribunal proceedings].”

119. The pleadings as articulated in the request for amendment filed on 17 May 2022 were the pleadings served upon the proprietor. These were what the proprietor was entitled to regard as the case it had to answer if it chose to file an amended defence (which it did). Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said in *Demon Ale Trade Mark* [2000] R.P.C. 345, at 357:

“Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focussed statement of the grounds upon which they intend to maintain that the tribunal should or should not do what it has been asked to do.”

120. It is unfair to add further claims without making an application to do so which can be objected to by the proprietor if it wishes. Additional pleadings should not be made in submissions and certainly not just prior to a hearing without a proper application for permission to amend. This is particularly important when the proprietor is a litigant in person.

121. The pleadings for this section of the bad faith claim, which was the applicant's first paragraph of three in his amended pleadings filed on 17 May 2022, is about 'blocking and squatting'. That is the context of the reference to Mr Dear having contacted the Larssons. I will assess the claim on this basis.

122. The applicant points to Mr Dear's statement of 26 August 2022 in the Company Names Tribunal proceedings:

"Over the past few years, I have designed and registered a number of trade marks which relate to former professional footballers and their football clubs. I develop these trade marks with the intention of selling merchandise featuring the trade marks to football fans and donating some of the proceeds to the players or their families."

123. This reflects what Mr Dear said in the counterstatement and his 'Statement of Use' form in the present proceedings:

"My original project was purely a charitable enterprise but as I was developing the project it became apparent if I produced high quality products there would be room for a profit also. So my project is now both charitable and commercial. ... From the sale from every item an element of the monies will go in the prescribed vehicle for distribution to the players and or families and I have met with one of the families who are part of an even more specific grouping to tell them what I'm doing and how they will benefit from sales. The family has agreed that at the right time they will introduce me to the rest of the specific grouping. Most football clubs have a charity or trust of their own and any player and or family who do not wish to participate in my project those monies will go to the club's charity and or trust. This means with every sale of clothing some of the monies will go to a charitable cause."²⁹

"I have been talking to my target market for 4 years to make sure my designs logo and clothing is in line with expectations. The business will also have a strong charitable element where part of the sales incomes to former football players and or their families. I am in discussion with [name] Solicitors about the correct legal vehicle for distribution of the monies and talked to one of the

²⁹ Counterstatement.

families of one of my trademarks and they have accepted what I'm doing and promised to introduce me to families of 12 of my trademarks."³⁰

124. In the *Henry/Ronaldinho* appeal hearing before the Appointed Person, Mr Dear gave an explanation for choosing the marks which relate to former professional footballers and their football clubs. He said:³¹

"It started off as a charitable project. I was seeking a vehicle to get monies to the players who I consider to be superior players to the modern day player, but they were very poorly remunerated in their days. Some of them are left in quite hard financial situations. I have met with one of the Lisbon Lions families [a reference to the Celtic team of 1967, which he explains was the first British team to win the European cup], explained exactly what it is I am doing and that they would expect to receive monies from the sales of the garments that I am going to sell..."³²

125. None of this has been filed as evidence in these proceedings; possibly as a misunderstanding on Mr Dear's part because he went on to say, in the context of a possible future *inter partes* (contested) case such as the present that:

"This information is with the IPO through other contested trade marks, other application where I have made my – I have not hidden what it is I am trying to do at any stage. In fact, with one of the cases I have submitted my business case to the IPO so that they know exactly – I even showed them how I produced the silhouette figures".³³

126. It is probable that it was this explanation, given at the appeal hearing which took place prior to the filing of the amended counterstatement in the present proceedings, to which Mr Dear was referring in his counterstatement when he said "I

³⁰ Statement of Use form.

³¹ Transcript, pages 50 to 51.

³² The Appointed Person made reference to the Lisbon Lions in another of Mr Dear's cases, *C. & J. Clark International Limited v Global Trademark Services Limited*, BL O/992/22, for a green and white shield mark incorporating CLARK. The Appointed Person referred to John Clark as playing centre back in the Lisbon Lions team.

³³ Transcript, pages 52 to 53.

have already laid out how my products will be sold, but will repeat to confirm the process to demonstrate there will be no confusion in the minds of the consumer.”

127. I do not place reliance on what Mr Dear said at the appeal hearing because neither he nor the applicant (nor Mr Hannay) has filed it as evidence in these proceedings; nor was Mr Dear under oath. However, I am satisfied that there are no inconsistencies between what he said then (18 February 2022) and what he has said in the present proceedings, and in the Company Names Tribunal proceedings (the latter relied upon by the applicant, as discussed earlier in this decision). Mr Dear had an intention to use the trade mark when he filed the application, to sell merchandise to the supporters of a Scottish football club.

128. That is not blocking and squatting. Furthermore, the applicant’s pleaded claim regarding the contact made by Mr Dear to the Larssons is inconsistent with what Mr Larsson himself states in his evidence. The pleaded claim is:

“The Cancellation Applicant received correspondence from Mr Dear (the controlling mind of the Registered Proprietor) around the filing of the contested registration inviting the Cancellation Applicant to pay to acquire rights afforded by the contested registration.”

129. Mr Larsson stated:

“In fact, Mr Dear approached me a few years ago explaining his intention to exploit my name (only) and offered me a percentage of the sales if I agreed. I did not agree. I believe that this was after he had filed for registration of the contested mark (UK00003366320).”

130. Mr Larsson says nothing about being invited to pay to acquire rights afforded by the registration (the opposite seems to be the case). Although it is true that negative inferences could be made about the failure to comply with the disclosure order in relation to the bad faith claim, I am doubtful that the silence makes any difference. This is because of the particular way in which this leg of the bad faith claim has been pleaded and the absence of evidence from Mr Larsson that he was

asked to pay to use the mark or his name. It is a claim to blocking and squatting, which is the type of trade mark opportunism which was the issue in *Trump International Limited v DTTM Operations LLC* [2019] EWHC 769 (Ch); and in *Paper Stacked Limited v CKL Holdings NV* (“Alexander Trade Mark”).³⁴ The evidence filed by the applicant does not put up a rebuttable case of a lack of good faith on that basis. If I am wrong about that, then I consider that the proprietor has rebutted it in the counterstatement, in the ‘Statement of Use’ and in the Company Names Tribunal proceedings evidence to which the applicant has referred in submissions and skeleton argument. There was no intention to block and squat. The section 3(6) ground fails on this pleaded basis.

Outcome

131. The section 5(4)(a) ground partially succeeds in relation to the goods listed in paragraph 96 of this decision. **Under section 47(6) of the Act, the registration is deemed never to have been made in relation to the goods listed in paragraph 96.** The registration remains valid for goods not listed in paragraph 96, which are set out in Annexe 2 to this decision. However, this is subject to the outcome of the separate section 3(6) decision to which I refer below.

132. Two of the three pleaded bases for the section 3(6) ground have failed. My decision in relation to the third basis, that there was no intention to use the mark in relation to all the goods (‘wide specification’), is suspended under rule 62(1)(f) of the Rules pending the judgment of the Supreme Court in the appeal against *Sky CA*.

Costs

133. Costs are normally awarded to a successful party on the basis of the published scale.³⁵ The scale aims to award costs on a contributory rather than a compensatory basis. This is because the registrar operates an accessible low-cost tribunal with predictable costs. However, the registrar’s practice makes it clear that costs may be awarded on a compensatory basis if a party behaves unreasonably.

³⁴ [2019] EWHC 769 (Ch); and BL O/036/13, Mr Geoffrey Hobbs QC, sitting as the Appointed Person.

³⁵ The scale applicable to these proceedings was published in Tribunal Practice Notice 2/2016.

134. At the conclusion of the hearing, Mr Hannay requested off-scale costs because he considered the proprietor/Mr Dear to have engaged in unreasonable behaviour. Mr Dear also requested costs off the scale. In written submissions dated 15 June 2023, confirmed at the hearing, Mr Dear submits that the proprietor should be awarded £5,000 for the toll taken on him and his time and expense dealing with the matter. Mr Dear also requested that the IPO declare the application for invalidation a sham and vexatious filing, in which case he requests actual costs of £4,655,000, based on lost business for the last six months. This is calculated at the target market being 3.1 million people, with about 5% purchasing 77,500 garments at £60 each.

135. Section 68 of the Act and Rule 67 of the Trade Mark Rules 2008 give the registrar a wide discretion to award costs. As Anthony Watson Q.C. stated in *Rizla Ltd.'s Application*³⁶ when considering a very similar provision under the Patents Act 1977: “The wording of section 107 could not in my view be clearer and confers on the Comptroller a very wide discretion with no fetter other than the overriding one that he must act judicially.”

136. Although the courts have endorsed the registrar’s power to award compensatory costs in cases of unreasonable behaviour, it does not follow that compensatory costs must be awarded whenever there is any unreasonable behaviour. As stated in *Rizla’s Application*, the question is whether “the behaviour in question constituted such exceptional circumstances that a standard award of costs would be unreasonable.”

137. Part of this decision is final, and appealable: the section 5(4)(a) outcome, and the outcome on two of the three pleaded bases for the section 3(6) ground. There is, as yet, no final outcome to the third basis for the section 3(6) ground (the wide specification claim). However, that is not a bar to considering whether costs off the scale is warranted, even against the party who is ultimately successful, in whole or in part.

³⁶ [1993] RPC 365 at 377.

138. I consider Mr Dear's behaviour in these proceedings to constitute exceptional circumstances and that the applicant is entitled to off-scale costs, despite only partial success under section 5(4)(a) and whatever the eventual outcome of the separated aspect of the section 3(6) claim. The large volume of correspondence in these proceedings fills over four lever arch files. That, in my experience as a hearing officer in this Tribunal, is exceptional for a single set of proceedings. The volume of correspondence, in itself, is not the reason why I consider off-scale costs to be warranted. It is the nature of the correspondence, the overwhelming majority of which has been generated by or because of Mr Dear. It seems to me that it is the Tribunal which has borne the brunt of the drain on resources (time and money) in dealing with the copious amount and disorderly nature of the correspondence (frequently disrespectful in tone). However, each and every email, letter and document had to be read by the applicant's representatives and a decision made as to whether a response was required or a deadline was to be met or monitored. This will have increased costs for the applicant far beyond what is envisaged by the scale.

139. Rather than give details of every matter in the correspondence which has contributed to unreasonable behaviour, I will give some of the most time-consuming examples. One of these concerned an issue which Mr Dear described as "misrepresentation", referred to in paragraph 22 of this decision. Since misrepresentation is an ingredient in passing off, for clarity I will call the issue 'authority to act', since this is what Mr Dear's complaint was (and is): that neither Mr Hamill or Cloch Solicitors/Mr Hannay had or has authority to act for the applicant, Henrik Larsson. Of all the substantive and many procedural issues in these proceedings, this issue has caused the most correspondence.

140. As said earlier in this decision, Mr Larsson was originally represented by Mr Hamill. The details on the front page of the original statutory application form, the TM26(I), looked like this:

“Please find enclosed email from Mr Brian Hamill.

I am extremely obliged to Mr Hamill for proving my points on deflection, obfuscation and confusion.

Mr Hamill first filed his TM26(I) on October/ November 2020.

I registered SC692378 to prove Signed Security Limited did not exist at the time of Mr Hamill's TM26(I) filing and I registered my company March 2021.

The rest of his ramblings are just more obfuscation, misdirection and confusion. If Signed Security Limited did not exist at the time of his filing then it possible Mr Hamill has admitted to misrepresentation. I will leave this for others, including the IPO, to decide.”

143. There followed a period of a few months in which the proprietor’s defence and counterstatement, which had been filed on time, could not be located within the IPO. Once that was done, and they had been admitted into the proceedings, Mr Dear repeated his complaint about authority to act in emails to the Tribunal on 23 and 28 November 2021. These were not copied to the applicant’s representative. A letter which was copied to Mr Hamill was sent to the Tribunal on 8 December 2021, which included the following:

“I now turn to some of Mr Hamill’s behaviours I feel the IPO should be aware of and are relevant to this case. Mr Hamill is not of Signed Security never was, I registered the company Signed Security to prove he is not associated with this company and therefore has misrepresented himself.

[...]

I do not believe Mr Larsson would be aware that Mr Hamill filed the form with the IPO as Mr Hamill of Signed Security. If Mr Larsson is aware then this moves from Misrepresentation to Conspiracy to Misrepresent. Through this document I make Mr Hamill aware any sales figures supplied I will forward onto HMRC.”

144. The Tribunal responded on 23 December 2021, stating that:

“No evidence is required by the Tribunal to prove Mr Hamill represents the cancellation applicant. Mr Hamill has signed a declaration stating that he is the representative therefore, the Tribunal has no reason to challenge this.”

145. Mr Dear followed this by sending an email to the Tribunal on 23 December 2021, two emails on 24 December 2021, two emails on 26 December 2021, and one email on 27 December 2021 dealing with several matters, none of which were copied to the applicant's representative. In relation to the authority to act issue, the emails included the following:

- 24 December 2021 (8am)

"I have been asking for clarification on whether has provided evidence that he is actually representing Mr Larsson. Which you clearly have withheld from me, how did he provide such proof? He has misrepresented himself on his cancellation form, how was his proof provided did the IPO accept it signed Mr Hamill of Signed Security? Or some other entity?"

- 26 December 2021 (5.30pm)

"There is a serious problem within your most recent reply. In declaring you have a written assurance from Mr Hamill you are directly contracting a recent letter where the IPO declared it has had no contact between the IPO and Mr Hamill that I have not been copied on.

I have been asking from the start of this fiasco if Mr Hamill has provided proof he does indeed represent Mr Larsson. Your recent letter means I have not been given all the necessary information to defend myself properly. And denying this contact in a previous letter could lead a person to believe that the IPO is working in concert with Mr Hamill.

This is now a very serious matter and the IPO better assess the situation and how it intends to remedy the situation. You allowed a person who misrepresented him on his submission to then after a considerable period change his accusations from Copyright to Passing Off. To consistently not reply to the request has Mr Hamill provided the IPO any proof of representation of Mr Larsson what form was that proof provided, did Mr Hamill confirm as part of Signed Security a company he has no connection to? Or did the IPO allow Mr Hamill to provide this proof under a different entity? Thus accepting Mr Hamill's submissions under multiple identities and to not provide this evidence to myself."

146. In stating that Mr Hamill had signed a declaration, the Tribunal was referring to his having signed the declaration on the TM26(I), with a statement of truth. The Tribunal, of course, had not contacted the applicant without copying the proprietor. Following a reply from the Tribunal on 12 January 2022, in which the Tribunal stated that the administrative complaints procedure could not be used to address the issue and that Mr Dear must ask for a hearing, Mr Dear sent the following email on 13 January 2022, not copied to the applicant's representative:

“You in concert with someone who has misrepresented themselves. I am meeting with my solicitor on Friday. I am going to discuss calling the Series Fraud Office. I don't know if this is my next step.

I really feel like I have stepped into some bizarre twilight zone.

I note that you have refused to answer my questions about the IPO's misrepresentation to me. How did Mr Hamill confirm his link was it with Mr Larsson to the IPO, was it through the fictional Signed Security or another entity?

It is like being in some bizarre twilight zone where I have no idea how to proceed. Your answers are a disgrace and provide no clarity whatsoever.

Am man misrepresented himself on his application and you are accepting this false application. I have been raising this matter since 2020 and to date the IPO has refused to address, don't tell me to raise it yet again it has been raised time and time again with no response.

I will be back in touch after meeting with my solicitor.”

147. Three hours later, another email was sent in the same vein, and another the following day. None of these were copied to the applicant's representative. This, in itself, is unreasonable behaviour. In its letter of 9 March 2022, which dealt with security for costs, the Tribunal said:

“Please note that the parties are required to assist the Tribunal to deal with cases promptly, efficiently and fairly, in ways which are proportionate to the complexity of the issues and which enable an appropriate share of the Tribunal's resources to be allocated. The parties have copied the Tribunal into a considerable amount of correspondence which has taken place between them. This places a disproportionate burden upon the Tribunal's resources and unnecessarily complicates the proceedings. The parties are directed to refrain from copying the Tribunal into correspondence between them. The parties must, however, copy to each other any correspondence which directly addresses the Tribunal. Furthermore, the parties are only to write to the Tribunal in response to an action required by the Tribunal; for example, in response to a required amendment or to meet a deadline to file evidence.”

148. The authority to act issue was raised again by Mr Dear in an email dated 11 March 2022 referring again to Mr Hamill having entered his details “in the name of company Signed Security” on the original form TM26(I). A similar email was sent on 15 March 2022, making allegations about Cloch, who had by now been appointed as the applicant’s representative, and implying that the IPO had not acted impartially by giving assistance regarding the TM26(I).³⁷ The latter was repeated on 22 March 2022, after the Tribunal had sent a letter on 16 March 2022 stating that it would reply in relation to the issues which were relevant.

149. Mr Dear raised the authority to act issue in a further email of 8 May 2022, in which, amongst other statements, he opined that it was very unusual to allow amendments to pleadings rather than the “normal procedure of being asked to resubmit”. (Of course, amendments to pleadings are not unusual, and parties are not required to complete an entirely new form.) Included in the email was a statement that the applicant had provided no evidence of sales (it had not been asked to file evidence at this point) and that “If the IPO does have evidence of “significant sales” then this evidence has not been provided to myself again in violation of any fair play or due process”. These are just two examples of Mr Dear’s lack of understanding about the Tribunal’s procedures, the Act, the Rules and published practice directions, which have complicated these proceedings and driven up costs unnecessarily. It was at this juncture that the applicant’s representatives wrote to the Tribunal (on 9 May 2022) to point out that Mr Dear was ignoring the Tribunal’s directions about voluminous correspondence. Mr Dear’s response was that he blamed the applicant and the IPO for causing the correspondence (email 9 May 2022).

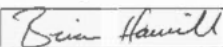
150. The Tribunal wrote to the parties on 13 May 2022 in a seven-page letter, dealing with several issues, including those mentioned in the previous paragraph. The matter of authority to act was addressed:

³⁷ There are numerous emails throughout these proceedings which accuse the IPO of acting impartially; it appears, each time, as a result of Mr Dear’s misunderstandings about processes and what was being said or directed by the Tribunal.

“7. Mr Dear, for the registered proprietor, has, on several occasions, raised his concerns that the original representative who filed Form TM26(I), Brian Hamill, did not have the authority to act for the cancellation applicant, Henrik Larsson. The official letter of 23 December 2021 said the following (emphasis added):

“It is noted in your email of 23 November 2021 you queried the legal representation of the cancellation applicant. No evidence is required by the Tribunal to prove Mr Hamill represents the cancellation applicant. Mr Hamill has signed a declaration stating that he is the representative therefore, the Tribunal has no reason to challenge this.”

8. The “declaration” is the statement of truth which Mr Hamill signed on Form TM26(I) which was served on the registered proprietor on 5 May 2021:

7 Declaration	I believe that the facts stated in this form and the attached statement of grounds are true.
Signature	
Name (BLOCK CAPITALS)	BRIAN HAMILL
Date	09 NOV 2020
Number of sheets attached to this form:	<input type="checkbox"/>

9. There was no other documentation regarding authority to act for Henrik Larsson required by the IPO nor filed at the IPO. The IPO has not withheld any confirmation or documentation regarding this matter from the registered proprietor or from Mr Dear. Mr Dear has seen exactly the same documentation that the IPO has seen. The IPO does not look behind representatives’ details in the thousands of application and tribunal disputes filed every year for trade marks, patents and designs. Evidence of authority to act is not required, there being a statement of truth which must be signed; on the contrary, there would have to be cogent evidence that a person or firm does not have authority to act before the matter would be investigated. That is not the case here. No evidence has been filed that the original representative (or the new one, Cloch Solicitors) did not have Henrik Larsson’s authority to act. **This matter is closed.**”

151. Notwithstanding the said closure of the matter by the Tribunal, Mr Dear raised it again in a letter dated 29 September 2022. On 6 October 2002, the Tribunal informed Mr Dear that the letter had been placed on the official file, at the same time as serving the Form TM8 and setting the evidence timetable. Mr Dear sent an email to the Tribunal on the same day, saying:

“I give you fair warning to not remove Mr Hammil from the proceedings. And you need to confirm that Mr Hannay and Cloch Solicitors has taken over full responsibility for the filing of CA000503425, potential fraudulent misrepresentations et al.”

152. This caused the applicant’s representative to write to the Tribunal (copied to Mr Dear) on 14 October 2022, pointing out the difference between a registered company name and a trading name. On the same day, the Tribunal wrote to the parties, referring to section 82 of the Act and Rule 60 of the Rules, and stating:

“Before the IPO would consider a matter of fraudulent misrepresentation, the matter would need to be cogent and coherent evidence [sic] from the accuser in the form of a witness statement and supporting exhibits would have to be filed.”

153. Mr Dear responded, also on the same day, to say that he was gathering evidence for the IPO and the police. On 20 October 2022, Mr Dear said in two emails to the Tribunal that if the issue was not resolved, he would report the IPO to the police. As I said at paragraph 22 of this decision, Mr Dear ignored the Tribunal’s directions on 14 October 2022 and 7 November 2022 to file evidence if he wished to take the matter any further. He filed non-evidential material on 19 October 2022, causing the Tribunal’s letter on 7 November 2022, which also stated that the cancellation application would not be struck out. The website link on to how to file evidence was included in the 7 November 2022 letter and an opportunity to request a CMC by 21 November 2022 was given. No evidence was filed and no CMC was requested. Non-evidential material was filed dated 21 November 2022, called a witness statement, but with no statement of truth. The Tribunal wrote to the parties on 13 December 2022 about a number of matters, including:

“I now refer to the witness statement dated 21 November 2022, filed by the Proprietor to address the matter of misrepresentation.

I must advise you that your evidence is currently not in admissible format as provided for under rule 64 of the Trade Marks Rules 2008 (as amended). A witness statement should begin by identifying who is making the statement, including their name, address and the source of their information. A witness statement may also only be given in evidence if it includes a statement of truth. To verify a witness statement (for the purposes of this tribunal) the statement of truth is as follows: ‘I believe that the facts stated in this witness statement are true’.

In addition, the document filed refers to exhibits A and A1, however these do not appear to have been received.

Further guidance on the appropriate format for a witness statement can be found on the IPO website at <https://www.gov.uk/government/publications/filingevidence-about-an-application-or-in-tribunal-proceedings>.

Despite the witness statement being deficient as regards rule 64, its contents have nevertheless been examined. Bearing in mind that the original form TM26(I) was filed with a signed statement of truth by an individual, it is the Registrar’s preliminary view that the registered proprietor has not made out a *prima facie* case that the original TM26(I) was filed without authority to act for the cancellation applicant. “C/O Signed Security” is an Address for Service and there is no requirement that it be a registered company. The application for invalidation will not be struck out because no valid evidence has been filed and, even if it was considered to be validly filed, it does not provide persuasive reasons.

If the registered proprietor disagrees, it must ask for a case management conference within seven days of the date of this letter, namely on or before 20 December 2022.

Written arguments on this matter will not be considered unless a single written submission is filed in lieu of attendance at a case management conference and received within seven days of the date of this letter. If a case management conference is requested, it will take place before one of the Registrar's Hearing Officers."

154. No case management conference was requested. Following two further emails from Mr Dear on 13 December 2022, another letter from the Tribunal, dated 19 December 2022, reiterated the points made, and stated that if no case management conference was requested, the matter would be closed. In particular, the letter stated at the beginning:

"The purpose of this letter is to point out that all of the issues you raise in those emails [the two emails of 13 December 2022] have already been dealt with by the Tribunal."

155. The letter went on to say:

"Witness statement about misrepresentation

4. You state that you did not file a statement of use, yet the evidence you sent to the Tribunal on 23 November 2022 included a form headed "Statement of Use" in which you refer to the registered proprietor's trade mark not having yet been used. You state that you filed a Witness Statement on Misrepresentation. That was addressed in the Tribunal's letter of 13 December 2022 as being deficient in format. Furthermore, the Tribunal's letter of 13 December 2022 gave a preliminary view that the evidence (despite its deficiencies) had been examined and that it did not raise a prima facie case that Mr Hamill had no authority to act when he filed the TM26(I) on behalf of the cancellation applicant. You were given until 20 December 2022 to request a CMC if you wished to contest the preliminary view. In the

absence of a CMC request or written submissions in lieu of a CMC request received by 20 December 2022, no further comment will be made about this matter, as set out in the Tribunal's letter of 13 December 2022.

[...]

Future conduct

7. As you will note, all of the issues you raise have already been dealt with in previous correspondence from the Tribunal. Your repeated emails about issues already dealt with is placing an unacceptable burden upon the Tribunal and is contrary to the Tribunal's overriding objective, as articulated in Tribunal Practice Notice 2/2011:

Deal with cases promptly, efficiently and fairly

Deal with cases in ways which are proportionate to the complexity of the issues

Give cases an appropriate share of the Tribunal's resources

Save expense

Under rule 62(1)(a) of the Trade Marks Rules 2008 (as amended), the Tribunal will no longer answer correspondence about matters which it has already answered and/or about which it has made directions and for which any CMC/hearing dates have passed."

156. Mr Dear sent a further email two days later, on 21 December 2022, complaining about the IPO, and a letter dated 3 January 2023 which again raised the authority to act issue.

157. On 21 February 2023, the Company Names Adjudicators issued their decision to which both parties have referred, and to which I referred earlier in this decision. The complaint against Mr Dear's company name, Signed Security Limited, by Brian Hamill and Perfect Memorabilia Limited under section 69(1) of the Companies Act 2006, failed because the applicants failed to show that they had sufficient reputation or goodwill in the name Signed Security. That was the end of the matter. However,

it is notable that the adjudicators saw fit to make the following (obiter) comments (footnote omitted):

“35. In summary, we conclude that the applicants do not have the requisite goodwill/reputation as required by section 69(1)(a) and section 69(7).

36. In light of this finding, it is not necessary that we consider whether the names are sufficiently similar, nor the respondents’ defences. However, we feel compelled to make some comments regarding Mr Dear’s motivations in incorporating the primary respondent.

37. The evidence illustrates that, whilst the applicants have failed to demonstrate that any goodwill/reputation attaches to the name “Signed Security”, it does support a view that, nonetheless, the applicants have a legitimate interest in the name. It does not appear to be disputed by Mr Dear that the genesis of the name was with Mr Hamill. The applicants provided a letter from Mr Dear (on behalf of the proprietor of the Larsson trade mark, Global Trademark Services Limited) that was provided in the trade mark cancellation proceedings, and it shines light on Mr Dear’s motivation:

“...Mr Hamill is not of Signed Security never was, I registered the company Signed Security to prove he is not associated with this company and therefore has misrepresented himself.

... I do not believe Mr Larsson would be aware that Mr Hamill filed the form with the IPO as Mr Hamill of Signed Security. If Mr Larsson is aware then this moves from Misrepresentation to Conspiracy to Misrepresent...”

38. These comments appear to illustrate a number of misconceptions on the part of Mr Dear, namely that:

- Mr Hamill reference to “Signed Security” is a reference to a registered company (the “misrepresentation” that he was referring). This has never been the claim of Mr Hamill, but rather that it is a

trading name, being a sign not necessarily requiring registration of any kind;

- Mr Hamill or PML have no right to use the name “Signed Security”. Contrary to Mr Dear strongly held belief, there is no basis for such a claim. It is permissible for a company or other legal entity to choose a trading name subject to not offending under trade mark law of the law of passing off, neither of which are in play here
- incorporating the name “Signed Security Limited “proves” that Mr Hamill is not associated with name and that he was misrepresenting himself. This is not the case and neither does it prevent Mr Hamill from using it as a trading name. The first time Mr Dear came across the name “Signed Security” was when it was used by Mr Hamill. There is no evidence whatsoever that Mr Hamill was misrepresenting himself. He clearly has an interest in the name as evidenced by the fact that he appears to have “coined” the name and used it in an address for service on an official document. The absence of a proven goodwill/reputation associated with the name does not change that. The name appeared to have been unknown and of no interest to Mr Dear before he became aware of its very limited use by Mr Hamill

39. Taking all these points into account, it is clear to us that the contested company name in these proceedings was incorporated solely as a misguided act. However, despite this, the applicants have failed to demonstrate that they have the requisite goodwill or reputation identified by the name “Signed Security” and, therefore, their application fails.”

158. Here, the adjudicators laid out the very point that the Tribunal in these proceedings had made: there is no requirement that Signed Security be a registered company. “C/O Signed Security” is an Address for Service.

159. Despite these comments from the Company Names Adjudicators, Mr Dear persisted in raising the issue, including at the substantive hearing before me. I have referred earlier in this decision to Mr Dear’s answer to my question at the hearing as

to why he had not filed proper evidence about the issue and why he had not sought a case management conference.

160. Standing back and reviewing all the correspondence just on this one issue leaves me in no doubt that the applicant is entitled to off-scale costs, whatever the eventual outcome of these proceedings. However, the persistently chaotic correspondence and the choices made by Mr Dear in either ignoring what the Tribunal has explained, or directed, or not seeking a case management conference, have not been confined to this one issue.³⁸ On the one hand Mr Dear says that he is a lay litigant, but on the other he said in an email to Cloch dated 25 February 2022, which he forwarded to the Tribunal, that he had talked to three IP solicitor firms but had concluded that he has at least as much IP knowledge as they do, so will continue to manage all his IP work himself. That was Mr Dear's choice; however, his repeated confusion about the law has caused extra work for the applicant because of the volumes of correspondence generated to deal with his confusion. Examples are:

- Following the Company Names Adjudicator decision, Mr Dear emailed the Tribunal on 15 March 2023 to say that it had been found that Signed Security had no goodwill and therefore he would expect the present proceedings to be concluded. The applicants in that case and in the present proceedings are completely different entities: Henrik Larsson is the applicant in these proceedings. It is Mr Larsson who needs to demonstrate goodwill.
- At the conclusion of the evidence rounds, as is standard procedure, the Tribunal invited the parties either to request a hearing on the substantive issues or to file written submissions in lieu of a hearing, for a decision from the papers. The cancellation applicant requested a hearing. Mr Dear emailed the Tribunal on two occasions to state that Mr Hannay should not be allowed to have a hearing, despite the Tribunal responding, twice, that the effect of rule 63 is that parties have a right to be heard. That issue generated four letters, and directly concerned the applicant's basic rights to a fair trial.

³⁸ For example, failure to comply with the directed amendments to the counterstatement and the directed disclosure order.

- Repeatedly claiming that the applicant had alleged non-use of the mark, confusing this with the no intention to use aspects of the section 3(6) ground. Following two emails on 14 June 2022 from Mr Dear, the Tribunal sought to explain the difference in its letter of 7 July 2022:

“6. The registered proprietor’s two emails of 14 June 2022 refer to the cancellation applicant making a challenge of non-use and that this cannot be done because a proprietor has five years from the date on which its mark is registered to commence use. That is correct in so far as section 46 of the Act is concerned. The ground which the cancellation applicant seeks to add to its invalidation application is based upon intention to use at the date of application, not what has been done in the five years after registration: see the decision in *Viva Technologies Ltd v Viva Media GmbH*, BL O/418/17:

“The applicant merely asserts that its intention to use the mark cannot be challenged until the mark has been registered for 5 years. However, as the opponent’s representative points out, that is not the case if it has shown that, contrary to the declaration made on the form of application, the applicant had no bona fide intention to use the trade mark at the date of filing the application.”

A ground under section 3(6) of the Act can be brought at any time (and by any party): see the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in BL O/036/17 *Paper Stacked Limited v CKL Holdings NV*.”

Mr Dear’s letter of 12 July 2022 said that he had “not had a reply to the point on 5 years is non negotiable in any circumstances for non use and I asked for a review of the IPO’s decision to accept a non use filing with my trademark.” The Tribunal responded on 14 July 2022 informing Mr Dear that the case had been reviewed and it had answered his point about non-use in its letter of 7

July 2022. The letter said that if he wished to argue the point, he would need to request a case management conference with a Hearing Officer. No case management conference was requested. He raised the point again in an email on 13 December 2022, as well as other points which had already been answered by the Tribunal, prompting its letter of 19 December 2022 from which I have already quoted above:

“Bad faith, passing off and ‘non-use’

5. You say “As to the extra documents, the IPO has not addressed my query as to why the IPO acting as a self appointed agent is ignoring Mr Hannay’s last claim of Non Use why the IPO decided by their own accord to settle on Bad Faith and Passing Off”.

6. The Tribunal gave a preliminary view to allow the application by the cancellation applicant to add a bad faith (section 3(6)) ground in its letter of 10 June 2022 and amendment of the section 5(4)(a) ground (passing off). You were allowed until 24 June 2022 to request a CMC if you wished to contest that preliminary view. In a follow-up letter dated 7 July 2022, responding to your questions, the Tribunal allowed you a further period of time until 11 July 2022 to request a CMC. No CMC was requested. That same letter explained the difference between a claim under section 3(6) and a claim that a mark has not been put to genuine use (a non-use claim). If, however, you are referring to the cancellation applicant’s ‘non-use’, that is a matter for the cancellation applicant to address in its evidence which is due on 13 January 2022. The matter of the addition of section 3(6) and the amended section 5(4)(a) ground is closed.”

This issue caused seven items of correspondence. Despite the Tribunal’s explanations and quotations from caselaw, Mr Dear then raised it again in submissions received on 12 January 2023.

- In an email of 29 July 2022, Mr Dear said that he hadn’t had sight of the passing off and bad faith allegations and that the last allegation was non-use:

he said he “would hope that the IPO hasn’t taken it upon themselves to cobble together the dual charge of Passing Off and Bad Faith for Cloch Solicitors’ based on previous Cloch Solicitors accusations on Cloch Solicitors behalf?” As detailed elsewhere in this decision, the applicant (via Cloch) made a formal request, copied to Mr Dear, on 17 May 2022 to amend its section 5(4)(a) ground and to add section 3(6) as a ground. Mr Dear replied to this the following day, referring to both grounds. The Tribunal gave a preliminary view to allow the amended grounds on 10 June 2022.

- The Tribunal’s letter of 11 December 2020 stated that ownership of the contested mark was now recorded as Global Trademark Services Ltd following Mr Dear’s assignment and directed the new proprietor to confirm that it had had sight of any forms filed and that it was aware of and accepted liability for costs. This is standard procedure when new parties become involved in ongoing proceedings before the Tribunal. On 14 December 2020, Mr Dear emailed to say he may not be inclined to accept the transfer. On 19 January 2021, the Tribunal explained that the present proprietor was the recorded owner of the contested mark, prompting Mr Dear to reply:

“Who authorised Global Trademark Services Limited to be associated with this? The original cancellation form was made to James Robbie Dear. James Robbie Dear and Global Trademark Services Ltd are 2 separate legal entities. Under what authority has the cancellation form been transferred from 1 legal entity to another?”

The Tribunal explained, once again, on 12 February 2021 that the recorded proprietor was Global Trademark Services Ltd and that the application had to be served upon the recorded proprietor. Mr Dear did not appear to accept this in a further email of 13 February 2021, in which he said he “reserved the right to take on the claim” and that a new application form to the present proprietor may have to be filed, but that he would await the outcome of new deadlines. This standard procedure caused five pieces of correspondence instead of two. It is an example of Mr Dear’s apparent lack of confidence in the Tribunal’s processes causing more correspondence than necessary; a Tribunal which deals with thousands of sets of proceedings every year.

161. On 6 December 2022, Mr Dear emailed to complain about his treatment by the IPO, also saying:

“In my last reply I said I would start sending this email on the hour every hour and charging the IPO for my time as the IPO is not being ISO9001 compliant in responding to my correspondence. I withdraw as I simply don't have time to do such a thing. However, I will send this email every day and bill the IPO £250.00 per email per day and send the bill once a week until the answers are given. The IPO cannot keep taking up my time re-writing for replies I should have already had answers to in compliance with ISO9001.”

162. Similar emails were received on 13 December 2022 and 3 January 2023. Following the latter, the Tribunal wrote on 20 January 2023, dealing with a number of points, also saying:

“You are asked to note that the volume and nature of correspondence from you is likely to be escalating the cancellation applicant's costs; this may be factored into any final cost award at the conclusion of these proceedings.”

163. Mr Dear replied on the same date to say that if the IPO refused to pay his bills he would take the IPO to the small claims court. All of this correspondence would have been reviewed by the cancellation applicant's representatives.

164. The cancellation applicant's representative, Mr Hannay, confirmed on 22 March 2023 that the applicant wished to file evidence in reply. This prompted Mr Dear to send to Mr Hannay a letter dated 26 March 2023, which he copied to the Tribunal, demanding that Mr Hannay drop the present case or he would report Mr Hannay and Cloch to the Scottish Law Complaints Commission for filing sham and vexatious litigation. Mr Hannay's second witness statement was filed on 24 April 2024.³⁹ It dealt with some issues about the substantive grounds and concluded with the following:

³⁹ Witness statement dated 24 April 2023.

“The allegations of fraudulent misrepresentation are strictly denied. The claims regarding reports to authority are false. I have received no correspondence from the PIPCU [Police Intellectual Property Crime Unit]. Moreover, in terms of the SLCC [Scottish Legal Complaints Commission] conform to professional regulations I am duty bound to verify and respond to such complaints as and when made. There is now produced and shown to me marked exhibit CA-PAH-10 example emails from the SLCC dated 23 November 2022 (16.31), 07 December 2022 (15.33) and 28 March 2023 (14.40) confirming in each case that no such complaint has been made.”

165. Mr Dear replied the same day to say he had a SLCC case number and he had a phone appointment the following day with Police Force Scotland.

166. At least part of the applicant’s evidence in reply concerned allegations of complaints made to the SLCC about Mr Hannay and evidence to show that, as of 24 April 2023, no such complaints had been received by the SLCC. In his oral submissions at the hearing before me on 6 July 2023, Mr Hannay said that Mr Dear had made repeated and continual allegations of contacting his professional regulator, prompting him to include the issue in the evidence in reply. After each allegation, Mr Hannay had contacted the SLCC and also his insurers. The day after the hearing, on 7 July 2023, Mr Dear emailed the Tribunal, copying Mr Hannay, saying:

“could I have a copy of the transcript with the Hearing Officer Judith Pike yesterday. I need a copy for my files and to send to the police given Mr Hannay filed his Witness Statement purporting to show sales of MR Henrik Larsson had to admit they had no connection with Mr Henrik Larsson whatsoever. The police will be interested in this admission by Mr Hannay.

In the last section of the Hearing Mr Hannay took the opportunity to besmirch and damage my reputation by claiming I have never contacted the SLCC and cast doubt on my contact with the police. I am enclosing proof that Mr Hannay attempted yesterday to mislead the Hearing Officer.”

167. Attached to the email was a photograph of a police incident card, with the date the incident was reported showing as 27 June 2023, and a letter to Mr Dear from the

SLCC referring to Mr Dear's complaint about Mr Hannay. This was dated 17 May 2023. The complaint was dismissed.

168. This prompted Mr Hannay to point out, in response on 7 July 2023, that these documents were dated after he filed his second witness statement. At the time he made his witness statement, he had received no information regarding complaints made about him.

169. The matter did not end there. The Tribunal responded the same day to say that a copy of the transcript would be sent to the parties and that I did not expect to receive any more material or correspondence beyond that which I had directed at the hearing.⁴⁰ Mr Dear responded six minutes later with "Always good to hear that the IPO has no interest in improper conduct. I'll let the police deal with it." The following day (8 July 2023) he said in an email:

"Further to my email reply yesterday. I am not prepared to just leave matters to the police.

Mr Hannay misled the Hearing Officer by making two false representations about me and my company.

To mislead a Hearing Officer is a serious matter. What are the procedures for registering a complaint over Mr Hannay's conduct? Mr Hannay throws in these false representations at the Hearing stage where I have no right of reply.

I have provided the IPO with evidence that Mr Hannay made false statements about me and my conduct."

170. The Tribunal replied on 12 July 2023 providing an IPO website link for complaints, which caused Mr Dear to reply the same day:

"I'd really appreciate being listened to. I did not complain about the IPO process but about Mr Hannay of Cloch Solicitors using the section of the Hearing where I cannot respond to make further untruthful statements about me in order to try and influence the Hearing Officer. I am asking how to complain about Mr Hannay's conduct during the Hearing. It cannot be right,

⁴⁰ I directed regularisation of Mr Larsson's witness statement and for Mr Hannay to send to Mr Dear a copy of *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19 to which he referred at the hearing, but not in his skeleton arguments.

fair, equitable for one party to make false representations about the other party during the Hearing with the offended party no right of recourse [sic].

Or does the IPO encourage false representations and sees nothing wrong with a party deliberately misleading the Hearing Officer?"

171. There were, therefore, seven pieces of correspondence after the hearing concerning complaints about Mr Hannay, in addition to the content of the applicant's evidence in reply about the issue.

172. All of the above constitutes unreasonable behaviour and has greatly extended the timescale and costs of the proceedings. Even if the applicant was not required to respond to all points, the applicant would have had to keep up with the volume and disorderly nature of the correspondence, monitoring the Tribunal's responses, in order to ensure that his own position was not compromised and mistakes made at his expense. For example, the applicant asked before filing evidence in reply what documents from the proprietor the Tribunal considered to be evidence. That is not usually necessary because in the vast majority of cases it is clear what is evidence. The more correspondence proliferates, particularly with confused and irrelevant content, the higher the chances are of procedural irregularities occurring. The applicant is entitled to an award of costs off the scale. Under rule 62(1)(a), the applicant is directed to file a schedule of costs within twenty-one days of the date of this decision, copied to the registered proprietor/Mr Dear, who will then have twenty-one days to file any submissions in response. The schedule should provide a breakdown of costs so that I can assess, and Mr Dear can understand/challenge, the reasonableness of time spent on particular activities. The breakdown should include an estimate (at least) of the number of hours spent on various stages and/or issues that have arisen, and should also include the time spent preparing the required breakdown. I will then issue a supplementary decision with the final cost award, giving my reasons.

Separation of proceedings

173. The section 3(6) 'wide specification' ground is suspended under rule 62(1)(f) of the Rules. Under rule 62(1)(h), I direct that the section 3(6) 'wide specification' part

of the proceedings is dealt with as separate proceedings. I will issue a separate decision covering the section 3(6) 'wide specification' ground after the Supreme Court hands down its judgment in the *Sky CA* appeal, having first given the parties an opportunity to make submissions about the effect on these proceedings of the Supreme Court's judgment. That decision will have its own appeal period.

Status of this decision

174. This decision is not yet final. The appeal period for this decision insofar as it relates to the section 5(4)(a) ground, the section 3(6) 'stockpiling', and the section 3(6) 'blocking/squatting' grounds will run from the date of issue of the supplementary costs decision. The appeal period for the supplementary costs decision will commence upon the same date.

Dated this 14th day of September 2023

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

Annexe 1: the list of goods of the contested registration (as represented on the register)

Adhesive bras;After ski boots;Aikido suits;Aikido uniforms;Albs;Aloha shirts;American football bibs;American football pants;American football shirts;American football shorts;American football socks;Anglers' shoes;Ankle boots;Ankle socks;Anklets [socks];Anoraks;Anoraks [parkas];Anti-perspirant socks;Anti-sweat underclothing;Anti-sweat underwear;Après-ski boots;Après-ski shoes;Aprons;Aprons [clothing];Aqua shoes;Arm warmers [clothing];Army boots;Articles of clothing;Articles of clothing for theatrical use;Articles of clothing made of hides;Articles of clothing made of leather;Articles of outer clothing;Articles of sports clothing;Articles of underclothing;Ascots;Ascots (ties);Athletic clothing;Athletic footwear;Athletic shoes;Athletic tights;Athletic uniforms;Athletics footwear;Athletics hose;Athletics shoes;Athletics vests;Babies' clothing;Babies' outerclothing;Babies' pants [clothing];Babies' pants [underwear];Babies' undergarments;Babushkas;Baby bibs [not of paper];Baby bodysuits;Baby boots;Baby bottoms;Baby clothes;Baby doll pyjamas;Baby layettes for clothing;Baby pants;Baby sandals;Baby tops;BalACLAVAS;Ball gowns;Ballet shoes;Ballet slippers;Ballet suits;Ballroom dancing shoes;Bandanas;Bandanas [neckerchiefs];Bandannas;Bandeaux [clothing];Barber smocks;Baseball caps;Baseball caps and hats;Baseball hats;Baseball shoes;Baseball uniforms;Baselayer bottoms;Baselayer tops;Basic upper garment of Korean traditional clothes [Jeogori];Basketball shoes;Basketball sneakers;Bath robes;Bath sandals;Bath slippers;Bathing caps;Bathing costumes;Bathing costumes for women;Bathing drawers;Bathing suit cover-ups;Bathing suits;Bathing suits for men;Bathing trunks;Bathrobes;Beach clothes;Beach clothing;Beach cover-ups;Beach footwear;Beach hats;Beach robes;Beach shoes;Beach wraps;Beachwear;Beanie hats;Beanies;Bed jackets;Bed socks;Belts [clothing];Belts for clothing;Belts made from imitation leather;Belts made of leather;Belts made out of cloth;Belts (Money -) [clothing];Belts of textile;Berets;Bermuda shorts;Bib overalls for hunting;Bib shorts;Bib tights;Bibs, not of paper;Bibs, sleeved, not of paper;Bikinis;Blazers;Bloomers;Blouses;Blouson jackets;Blousons;Blue jeans;Board shorts;Boardshorts;Boas;Boas [clothing];Boas [necklets];Boaters;Bobble hats;Bodices;Bodices [lingerie];Bodies [clothing];Bodies [underclothing];Body linen [garments];Body stockings;Body suits;Body warmers;Bodysuits;Boiler suits;Boleros;Bolo ties;Bolo ties with precious metal tips; Bomber jackets; Bonnets;Bonnets [headwear];Boot cuffs;Boot uppers;Bootees (woollen baby shoes);Booties;Boots;Boots for motorcycling;Boots for sport;Boots for sports;Boots (Ski -);Bottoms [clothing];Bow ties;Bowling shoes;Bowties;Boxer briefs;Boxer shorts;Boxing shoes;Boxing shorts;Boy shorts [underwear];Boys' clothing;Bra straps;Bra straps [parts of clothing];Braces as suspenders;Braces for clothing;Braces for clothing [suspenders];Braces [suspenders]; Bralettes; Bras; Brassieres; Breeches;Breeches for wear;Bridal garters;Bridal gowns;Bridesmaid dresses;Bridesmaids wear;Briefs;Briefs [underwear];Bucket caps;Bucket hats;Burnouses;Bushjackets;Bustiers;Bustle holder bands for obi (obiage);Bustles for obi-knots (obiage-shin);Button down shirts;Button-front aloha shirts;Caftans;Cagoules;Camiknickers;Camisoles;Camouflage gloves;Camouflage jackets;Camouflage pants;Camouflage shirts;Camouflage vests;Canvas shoes;Cap peaks;Cap visors;Capelets;Capes;Capes (clothing);Caps;Caps being headwear;Caps [headwear];Caps (Shower -);Caps with visors; Car coats; Cardigans;Cargo pants;Cashmere clothing;Cashmere scarves; Cassocks;Casual

clothing;Casual footwear;Casual jackets;Casual shirts;Casual trousers;Casual wear;Casualwear;Chadors;Chaps; Chaps (clothing); Chasubles;Chefs' hats;Chefs' whites;Chemise tops; Chemises; Chemisettes; Cheongsams (Chinese gowns);Children's clothing;Childrens' clothing;Children's footwear;Children's headwear;Children's outerclothing;Children's wear;Chino pants;Choir robes;Christening gowns;Christening robes;Cleats for attachment to sports shoes;Climbing boots;Climbing boots [mountaineering boots];Climbing footwear;Cloaks;Clogs;Cloth bibs;Cloth bibs for adult diners;Clothes;Clothes for sport;Clothes for sports;Clothing;Clothing containing slimming substances;Clothing for babies;Clothing for children;Clothing for cycling;Clothing for cyclists;Clothing for fishermen;Clothing for gymnastics;Clothing for horse-riding [other than riding hats];Clothing for infants;Clothing for leisure wear;Clothing for martial arts;Clothing for men, women and children;Clothing for skiing;Clothing for sports;Clothing for wear in judo practices;Clothing for wear in wrestling games;Clothing layettes;Clothing made of fur;Clothing made of imitation leather;Clothing made of leather;Clothing of imitations of leather;Clothing of leather;Coats;Coats for men;Coats for women;Coats made of cotton;Coats of denim;Coats (Top -);Cocktail dresses;Collar guards for protecting clothing collars;Collar liners for protecting clothing collars;Collar protectors;Collared shirts;Collars;Collars [clothing];Collars for dresses;Combative sports uniforms;Combinations [clothing];Corduroy pants;Corduroy shirts;Corduroy trousers;Corselets;Corsets;Corsets [clothing, foundation garments];Corsets [foundation clothing];Corsets [underclothing];Costumes;Costumes for use in children's dress up play;Costumes for use in role-playing games;Costumes (Masquerade -);Cotton coats;Coveralls;Coverups;Cover-ups;Cowls [clothing];Cravates;Cravats;Crew neck sweaters;Crinolines;Crop tops;Cuffs;Culotte skirts;Culottes;Cummerbunds;Cycling caps;Cycling Gloves;Cycling pants;Cycling shoes;Cycling shorts;Cycling tops;Cyclists' clothing;Dance clothing;Dance costumes;Dance shoes;Dance slippers;Deck shoes;Deck-shoes;Denim coats;Denim jackets;Denim jeans;Denim pants;Denims [clothing];Desert boots;Detachable collars;Detachable neckpieces for kimonos (haneri);Dinner jackets;Dinner suits;Disposable slippers;Disposable underwear;Donkey jackets;Down jackets;Down vests;Drawers as clothing;Drawers [clothing];Dress pants;Dress shields;Dress shirts;Dress shoes;Dress suits;Dresses;Dresses for evening wear;Dresses for infants and toddlers;Dresses made from skins;Dressing gowns;Driving gloves;Driving shoes;Dry suits;Duffel coats;Duffle coats;Dungarees;Dust coats;Ear muffs;Ear muffs [clothing];Ear warmers;Earbands;Earmuffs;Embossed heels of rubber or of plastic materials;Embossed soles of rubber or of plastic materials; Embroidered clothing;Espadrilles;Esparto shoes or sandals;Esparto shoes or sandals;Evening coats;Evening dresses;Evening gowns;Evening suits;Evening wear;Exercise wear;Eye masks;Fabric belts;Fabric belts [clothing];Fake fur hats;Fancy dress costumes;Fascinator hats;Fashion hats;Fedoras;Fezzes;Figure skating clothing;Fingerless gloves;Fingerless gloves as clothing;Fishermen's jackets;Fishing boots;Fishing clothing;Fishing footwear;Fishing headwear;Fishing jackets;Fishing shirts;Fishing smocks;Fishing vests;Fishing waders;Fitted swimming costumes with bra cups;Fittings of metal for boots and shoes;Fittings of metal for footwear;Flat caps;Flat shoes;Fleece jackets;Fleece pullovers;Fleece shorts;Fleece tops;Fleece vests;Fleeces;Flip-flops;Flip-flops for use as footwear;Flying suits;Foam pedicure slippers;Folk costumes;Foot volleyball shoes;Football boots;Football boots (Studs for -);Football jerseys;Football shirts;Football shoes;Footless socks;Footless tights;Footmuffs, not electrically heated;Footwear;Footwear [excluding orthopedic

footwear];Footwear (Fittings of metal for -);Footwear for men;Footwear for men and women;Footwear for snowboarding;Footwear for sport;Footwear for sports;Footwear for track and field athletics;Footwear for use in sport;Footwear for women;Footwear made of vinyl;Footwear made of wood;Footwear (Non-slipping devices for -);Footwear not for sports;Footwear soles;Footwear (Tips for -);Footwear uppers;Footwear (Welts for -);Formal evening wear; Formal wear; Formalwear;Foulards [clothing articles];Foundation garments;Frames (Hat -) [skeletons];Frock coats;Full-length kimonos (nagaji);Functional underwear;Fur cloaks;Fur coats;Fur coats and jackets;Fur hats;Fur jackets;Fur muffs;Fur stoles;Furs [clothing];Gabardines;Gabardines [clothing]; Gaiter straps; Gaiters;Galoshes;Garments for protecting clothing;Garrison caps;Garter belts;Garters;Gauchos;Gilets;Girdles;Girdles [corsets];Girls' clothing;Gloves;Gloves as clothing;Gloves [clothing];Gloves for apparel;Gloves for cyclists;Gloves including those made of skin, hide or fur;Gloves with conductive fingertips that may be worn while using handheld electronic touch screen devices;Golf caps;Golf clothing, other than gloves;Golf footwear;Golf pants, shirts and skirts;Golf shirts;Golf shoes;Golf shorts;Golf skirts;Golf trousers;Goloshes;Gowns;Gowns for doctors;Greatcoats;G-strings;Guernseys;Gussets for bathing suits [parts of clothing];Gussets for footlets [parts of clothing];Gussets for leotards [parts of clothing];Gussets for stockings [parts of clothing];Gussets for tights [parts of clothing];Gussets for underwear [parts of clothing];Gussets [parts of clothing];Gym boots;Gym shorts;Gym suits;Gymnastic shoes;Gymshoes;Gymwear;Hairdressing capes;Half-boots;Halloween costumes;Halter tops;Handball shoes;Handwarmers [clothing];Haneri [detachable neckpieces for kimonos];Hat frames [skeletons];Hats;Hats (Paper -) [clothing];Head bands;Head scarves;Head sweatbands;Head wear;Headbands;Headbands against sweating;Headbands [clothing];Headbands for clothing;Headdresses [veils];Headgear;Headgear for wear; Headscarfs; Headscarves; Headshawls; Headsquares;Headwear;Heavy coats;Heavy jackets;Heel inserts;Heel pieces for shoes;Heel pieces for stockings;Heel protectors for shoes;Heelpieces for footwear;Heelpieces for stockings;Heels;Hidden heel shoes;High rain clogs (ashida);High-heeled shoes;Hijabs;Hiking boots;Hiking shoes;Hockey shoes;Hooded pullovers;Hooded sweat shirts;Hooded sweatshirts; Hooded tops; Hoodies; Hoods;Hoods [clothing];Horse-riding boots;Horse-riding pants;Hosiery;House coats;Housecoats;Hunting boot bags;Hunting boots;Hunting jackets;Hunting pants;Hunting shirts;Hunting vests;Imitation leather dresses;Infant clothing;Infant wear;Infants' boots;Infants' clothing;Infants' footwear;Infants' shoes;Infants' trousers;Infantwear;Inner socks for footwear;Inner soles;Innersocks;Insoles;Insoles for footwear;Insoles for shoes and boots;Insoles [for shoes and boots];Intermediate soles;Jacket liners;Jackets;Jackets being sports clothing;Jackets [clothing];Jackets (Stuff -) [clothing];Japanese footwear of rice straw (waraji);Japanese kimonos;Japanese sleeping robes (nemaki);Japanese sleeping robes [nemaki];Japanese split-toed work footwear (jikatabi);Japanese style clogs and sandals;Japanese style sandals of felt;Japanese style sandals of leather;Japanese style sandals (zori);Japanese style socks (tabi);Japanese style socks (tabi covers);Japanese style wooden clogs (geta);Japanese toe-strap sandals (asaura-zori);Japanese traditional clothing;Jeans;Jerkens;Jerseys;Jerseys [clothing];Jockstraps [underwear];Jodhpurs;Jogging bottoms;Jogging bottoms [clothing];Jogging outfits;Jogging pants;Jogging sets [clothing];Jogging shoes;Jogging suits;Jogging tops;Judo suits;Judo uniforms;Jump Suits;Jumper dresses;Jumper suits;Jumpers;Jumpers [pullovers];Jumpers [sweaters];

Jumpsuits;Kaftans;Karate suits;Karate uniforms;Kendo outfits;Kerchiefs;Kerchiefs [clothing];Khakis;Khimars;Kilts;Kimonos;Knee warmers [clothing];Knee-high stockings;Knickerbockers;Knickers;Knit jackets;Knit shirts;Knit tops;Knitted baby shoes;Knitted caps;Knitted clothing;Knitted gloves;Knitted tops;Knitted underwear;Knitwear;Knitwear [clothing];Knot caps;Korean outer jackets worn over basic garment [Magoja];Korean topcoats [Durumagi];Korean traditional women's waistcoats [Baeja];Laboratory coats;Lace boots;Ladies' boots;Ladies' clothing;Ladies' dresses;Ladies' footwear;Ladies' outerclothing;Ladies' sandals;Ladies' suits;Ladies' underwear;Ladies wear;Layettes;Layettes [clothing];Leather belts [clothing];Leather clothing;Leather (Clothing of -);Leather (Clothing of imitations of -);Leather coats;Leather dresses;Leather garments;Leather headwear;Leather jackets;Leather pants;Leather shoes;Leather slippers;Leather suits;Leather waistcoats;Leg warmers;Leggings [leg warmers];Leggings [trousers];Legwarmers;Leg-warmers;Leisure clothing;Leisure footwear;Leisure shoes;Leisure suits;Leisure wear;Leisurewear;Leotards;Light-reflecting coats;Light-reflecting jackets;Linen (Body -) [garments];Linen clothing;Lingerie;Linings (Ready-made -) [parts of clothing];Liveries;Long jackets;Long johns;Long sleeve pullovers;Long sleeved vests;Long underwear;Long-sleeved shirts;Lounge pants;Loungewear;Lounging robes;Low wooden clogs (hiyori-geta);Low wooden clogs (koma-geta);Low wooden clogs [koma-geta]; Lumberjackets; Mackintoshes; Maillots;Maillots [hosiery];Maniples;Mankinis;Mantillas;Mantles;Martial arts uniforms;Masks (Sleep -);Masquerade costumes;Maternity bands;Maternity clothing;Maternity dresses;Maternity leggings;Maternity lingerie;Maternity pants;Maternity shirts;Maternity shorts;Maternity sleepwear;Maternity smocks;Maternity tops;Maternity underwear;Maternity wear;Men's and women's jackets, coats, trousers, vests;Men's clothing;Men's dress socks;Men's sandals;Men's socks;Men's suits;Men's underwear;Menswear;Metal fittings for Japanese style wooden clogs;Military boots;Millinery;Miniskirts;Mitters [hats];Mitres [hats];Mittens;Mitts [clothing];Moccasins;Mock turtleneck shirts;Mock turtleneck sweaters;Mock turtlenecks;Moisture-wicking sports bras;Moisture-wicking sports pants;Moisture-wicking sports shirts;Money belts [clothing];Monokinis;Morning coats;Motorcycle gloves;Motorcycle jackets;Motorcycle rain suits;Motorcycle riding suits;Motorcyclist boots;Motorcyclists' clothing;Motorcyclists' clothing of leather;Motorists' clothing;Mountaineering boots;Mountaineering shoes;Mufflers;Mufflers as neck scarves;Mufflers [clothing];Mufflers [neck scarves];Muffs;Muffs [clothing];Mukluks;Mules;Muumuus;Nappy pants [clothing];Neck scarfs [mufflers];Neck scarves;Neck scarves [mufflers];Neck tubes; Neck warmers; Neckbands; Neckerchiefs; Neckerchieves; Neckties; Neckwear; Negligees;Night gowns; Night shirts; Nightcaps; Nightdresses; Nightgowns; Nighties; Nightshirts;Nightwear;Nipple pasties;Niqabs;Non-slip socks;Non-slipping devices for footwear;Nurse dresses;Nurse overalls;Nurse pants;Nurses' uniforms;Nursing shoes;Oilskins [clothing];One-piece clothing for infants and toddlers;One-piece playsuits;One-piece suits;Open-necked shirts;Outer clothing;Outer soles;Outerclothing;Outerclothing for boys;Outerclothing for girls;Outerclothing for men;Outerwear;Overalls;Overalls for infants and toddlers; Overcoats; Overshirts; Overshoes;Overtrousers;Over-trousers;Padded jackets;Padded pants for athletic use; Padded shirts for athletic use;Padded shorts for athletic use; Pajama bottoms;Pajamas;Pajamas (Am.);Pantaloons;Pantie-girdles;Panties;Pants;Pants (Am.);Pantsuits;Panty hose;Pantyhose;Paper aprons;Paper clothing;Paper hats [clothing];Paper hats for use as clothing items;Paper hats for wear by chefs;Paper

hats for wear by nurses; Pareos; Pareus; Parkas; Party hats [clothing]; Pea coats; Peaked caps; Peaked headwear; Peaks (Cap -); Pedal pushers; Pedicure sandals; Pedicure slippers; Peignoirs; Pelerines; Pelisses; Petticoats; Petti-pants; Pinafore dresses; Pinafores; Pique shirts; Pirate pants; Plastic aprons; Plastic baby bibs; Plastic slippers; Platform shoes; Play suits; Playsuits [clothing]; Pleated skirts; Pleated skirts for formal kimonos (hakama); Plimsolls; Plus fours; Plush clothing; Pocket kerchiefs; Pocket squares; Pocket squares [clothing]; Pockets for clothing; Polar fleece jackets; Polo boots; Polo knit tops; Polo neck jumpers; Polo shirts; Polo sweaters; Ponchos; Pop socks; Pram suits; Printed t-shirts; Protective metal members for shoes and boots; Pullovers; Pullstraps for shoes and boots; Pumps [footwear]; Puttees; Puttees and gaiters; Pyjamas; Pyjamas [from tricot only]; Quilted jackets [clothing]; Quilted vests; Rain boots; Rain coats; Rain hats; Rain jackets; Rain ponchos; Rain shoes; Rain slickers; Rain suits; Rain trousers; Rain wear; Raincoats; Rainproof clothing; Rainproof jackets; Rainshoes; Rainwear; Ramie shirts; Rash guards; Ready-made clothing; Ready-made linings [parts of clothing]; Ready-to-wear clothing; Referees uniforms; Religious garments; Removable collars; Replica football kits; Reversible jackets; Riding boots; Riding gloves; Riding Gloves; Riding jackets; Riding shoes; Riding trousers; Robes; Robes (Bath -); Roll necks [clothing]; Roller shoes; Romper suits; Rompers; Ruanas; Rubber fishing boots; Rubber shoes; Rubber soles for jikatabi; Rubbers [footwear]; Rugby boots; Rugby jerseys; Rugby shirts; Rugby shoes; Rugby shorts; Rugby tops; Running shoes; Running Suits; Running vests; Russian felted boots (Valenki); Sabots; Safari jackets; Sailing wet weather clothing; Sailor suits; Salopettes; Sandal-clogs; Sandals; Sandals and beach shoes; Sarees; Saris; Sarongs; Sash bands for kimono (obi); Sashes for wear; Scarfs; Scarves; School uniforms; Scrimmage vests; Sedge hats (suge-gasa); Serapes; Shampoo capes; Shapewear; Shawls; Shawls and headscarves; Shawls and stoles; Shawls [from tricot only]; Sheepskin coats; Sheepskin jackets; Shell jackets; Shell suits; Shields (Dress -); Shift dresses; Shirt fronts; Shirt yokes; Shirt-jacs; Shirts; Shirts and slips; Shirts for suits; Shoe covers, other than for medical purposes; Shoe inserts for non-orthopedic purposes; Shoe soles; Shoe soles for repair; Shoe straps; Shoe uppers; Shoes; Shoes for casual wear; Shoes for foot volleyball; Shoes for infants; Shoes for leisurewear; Shoes soles for repair; Shoes with hook and pile fastening tapes; Short overcoat for kimono (haori); Short petticoats; Short sets [clothing]; Short trousers; Shortalls; Shorts; Shorts [clothing]; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved T-shirts; Shoulder scarves; Shoulder straps for clothing; Shoulder wraps; Shoulder wraps [clothing]; Shoulder wraps for clothing; Shower caps; Shrugs; Silk clothing; Silk scarves; Silk ties; Singlets; Skating outfits; Ski and snowboard shoes and parts thereof; Ski balaclavas; Ski boot bags; Ski boots; Ski gloves; Ski hats; Ski jackets; Ski pants; Ski suits; Ski suits for competition; Ski trousers; Ski wear; Skiing shoes; Skirt suits; Skirts; Skorts; Skull caps; Slacks; Sleep masks; Sleep pants; Sleep shirts; Sleeping garments; Sleepsuits; Sleepwear; Sleeved jackets; Sleeveless jackets; Sleeveless jerseys; Sleeveless pullovers; Sliding shorts; Slip-on shoes; Slipovers; Slipovers [clothing]; Slipper socks; Slipper soles; Slippers; Slippers made of leather; Slips; Slips [clothing]; Slips [underclothing]; Slips [undergarments]; Small hats; Smocks; Smoking jackets; Snap crotch shirts for infants and toddlers; Sneakers; Sneakers [footwear]; Snoods [scarves]; Snow boarding suits; Snow boots; Snow pants; Snow suits; Snowboard boots; Snowboard gloves; Snowboard jackets; Snowboard mittens; Snowboard shoes; Snowboard trousers; Snowsuits; Soccer bibs; Soccer boots; Soccer shirts; Soccer shoes; Sock suspenders; Socks; Socks and stockings;

Socks for infants and toddlers;Socks for men;Soles for footwear;Soles for japanese style sandals;Soles [Inner];Spats;Spiked running shoes;Sport coats;Sport shirts;Sport shoes;Sport stockings;Sports bibs;Sports [Boots for -];Sports bras;Sports caps;Sports caps and hats;Sports clothing;Sports clothing [other than golf gloves];Sports footwear;Sports garments;Sports headgear [other than helmets];Sports jackets;Sports jerseys;Sports jerseys and breeches for sports;Sports over uniforms;Sports overuniforms;Sports pants;Sports shirts;Sports shirts with short sleeves;Sports shoes;Sports singlets;Sports socks;Sports vests;Sports wear;Sportswear;Stiffeners for boots;Stiffeners for shoes; Stocking suspenders;Stockings;Stockings (Heel pieces for -);Stockings [sweat-absorbent];Stockings (Sweat-absorbent -);Stoles;Stoles (Fur -);Strapless bras;Strapless brassieres;Straps (Gaiter -);Stretch pants;String fasteners for haori (haori-himo);Studs for football boots;Stuff jackets;Stuff jackets [clothing];Suede jackets;Suit coats;Suits;Suits (Bathing -);Suits made of leather;Suits of leather;Sun hats;Sun visors;Sun visors [headwear];Sundresses;Sunsuits; Surf wear;Surfwear;Suspender belts;Suspender belts for men;Suspender belts for women;Suspenders;Suspenders [braces];Swaddling clothes;Sweat bands;Sweat bands for the head;Sweat bands for the wrist;Sweat bottoms;Sweat jackets;Sweat pants;Sweat shirts;Sweat shorts;Sweat suits;Sweat-absorbent socks;Sweat-absorbent stockings;Sweat-absorbent underclothing;Sweat-absorbent underclothing [underwear];Sweat-absorbent underwear; Sweatbands; Sweaters; Sweatjackets; Sweatpants;Sweatshirts;Sweatshorts;Sweatsuits;Swim briefs;Swim caps;Swim shorts;Swim suits;Swim trunks;Swim wear for children;Swim wear for gentlemen and ladies;Swimming caps;Swimming caps [bathing caps]; Swimming costumes; Swimming suits;Swimming trunks;Swimsuits;Swimwear;Synthetic fur stoles;Tabards;Taekwondo suits;Taekwondo uniforms;Tail coats;Tam o'shanters;Tams;Tank tops;Tankinis;Tank-tops;Tap pants;Tap shoes;Tartan kilts;Teddies;Teddies [underclothing];Teddies [undergarments];Tee-shirts;Tennis dresses;Tennis pullovers;Tennis shirts;Tennis shoes;Tennis shorts;Tennis skirts;Tennis socks;Tennis sweatbands;Tennis wear;Theatrical costumes;Thermal clothing;Thermal headgear;Thermal socks;Thermal underwear;Thermally insulated clothing;Thobes;Thong sandals;Thongs;Three piece suits [clothing];Ties;Ties [clothing];Tightening-up strings for kimonos (datejime);Tights;Tips for footwear;Toe boxes;Toe socks;Toe straps for Japanese style sandals [zori];Toe straps for Japanese style wooden clogs;Toe straps for zori [Japanese style sandals];Togas;Tongues for shoes and boots;Top coats; Top hats; Topcoats; Tops;Tops [clothing];Toques [hats];Track and field shoes;Track jackets;Track pants;Track suits;Tracksuit bottoms;Tracksuit tops;Tracksuits;Traction attachments for footwear;Trainers;Trainers [footwear];Training shoes;Training suits;Trekking boots;Trench coats;Trenchcoats;Trews;Triathlon clothing;Trousers;Trousers for children;Trousers for sweating;Trousers of leather;Trousers shorts;Trunks;Trunks (Bathing -);Trunks [underwear];T-shirts;Tube tops;Tunics;Turbans;Turtleneck pullovers;Turtleneck shirts;Turtleneck sweaters;Turtleneck tops;Turtlenecks;Tutus;Tuxedo belts;Tuxedos;Twin sets;Umpires uniforms;Under garments;Under shirts;Underarm gussets [parts of clothing];Underclothes;Underclothing;Underclothing (Anti-sweat -);Underclothing for women;Undergarments;Underpants;Underpants for babies;Undershirts;Undershirts for kimonos (juban);Undershirts for kimonos (koshimaki);Undershirts for kimonos [koshimaki];Underskirts;Underwear;Underwear (Anti-sweat -);Underwear for women;Uniforms;Uniforms for commercial use;Uniforms for nurses;Union

suits;Unitards;Uppers (Footwear -);Uppers for Japanese style sandals;Uppers of woven rattan for Japanese style sandals;Ushankas [fur hats];Valenki [felted boots];Veils;Veils [clothing];Vest tops;Vests;Vests (Fishing -);Vests for use in barber shops and salons;Visors;Visors being headwear;Visors [clothing];Visors [hatmaking];Visors [headwear];V-neck sweaters;Volleyball jerseys;Volleyball shoes;Waders;Waist belts;Waist cinchers;Waist strings for kimonos (koshihimo);Waistbands;Waistcoats;Waistcoats [vests];Walking boots;Walking breeches;Walking shoes;Walking shorts;Warm up suits;Warm-up jackets;Warm-up pants;Warm-up suits;Warm-up tops;Water socks;Waterpolo caps;Waterproof boots;Waterproof boots for fishing;Waterproof capes;Waterproof clothing;Waterproof jackets;Waterproof outerclothing;Waterproof pants;Waterproof shoes;Waterproof suits for motorcyclists;Waterproof trousers;Water-resistant clothing;Waterskiing suits;Weather resistant outer clothing;Weatherproof clothing;Weatherproof jackets;Weatherproof pants;Wedding dresses;Wedding gowns;Wellington boots;Wellingtons;Welts for footwear;Wet suits;Wet suits for surfing;Wet suits for water-skiing;Wet suits for water-skiing and sub-aqua;Wet suits for windsurfing;Wetsuit gloves;Wetsuits;Wetsuits for surface watersports;Wetsuits for surfing;Wetsuits for water-skiing;White coats for hospital use;Wimples;Wind coats;Wind jackets;Wind pants;Wind resistant jackets;Wind suits;Wind vests;Windcheaters;Wind-jackets;Windproof clothing;Windproof jackets;Wind-resistant jackets;Wind-resistant vests;Windshirts;Winter boots;Winter coats;Winter gloves;Women's ceremonial dresses;Women's clothing;Women's foldable slippers;Womens' outerclothing;Women's shoes;Women's suits;Womens' underclothing;Womens' undergarments;Women's underwear;Wooden bodies for Japanese style clogs;Wooden main bodies of Japanese style wooden clogs;Wooden shoes;Wooden shoes [footwear];Wooden supports of Japanese style wooden clogs;Woolen clothing;Woollen socks;Woollen tights;Woolly hats;Work boots;Work clothes;Work overalls;Work shoes;Working overalls;Woven clothing;Woven shirts;Wrap belts for kimonos (datemaki);Wraps [clothing];Wrist bands;Wrist warmers;Wristbands;Wristbands [clothing];Yashmaghs;Yashmaks;Yoga bottoms;Yoga pants;Yoga shirts;Yoga shoes;Yokes (Shirt -);Zoot suits;Zori.

Annexe 2: the list of goods which remain valid (subject to the outcome of the separate section 3(6) decision)

Adhesive bras; Albs; Aprons; Aprons [clothing]; Army boots; Articles of clothing for theatrical use; Ascots; Ascots (ties); Babushkas; Baby doll pyjamas; Ball gowns; Ballet shoes; Ballet slippers; Ballet suits; Ballroom dancing shoes; Barber smocks; Basic upper garment of Korean traditional clothes [Jeogori]; Bed jackets; Bloomers; Boas; Boas [clothing]; Boas [necklets]; Boaters; Bodices; Bodices [lingerie]; Body linen [garments]; Body stockings; Body suits; Bodysuits; Boiler suits; Boleros; Bolo ties; Bolo ties with precious metal tips; Bonnets; Bonnets [headwear]; Boot cuffs; Boot uppers; Bra straps; Bra straps [parts of clothing]; Braces as suspenders; Braces for clothing; Braces for clothing [suspenders]; Braces [suspenders]; Bridal garters; Bridal gowns; Bridesmaid dresses; Bridesmaids wear; Burnouses; Bustiers; Bustle holder bands for obi (obiage); Bustles for obi-knots (obiage-shin); Caftans; Camiknickers; Camisoles; Caps (Shower -); Cassocks; Chadors; Chaps; Chaps (clothing); Chasubles; Chefs' hats; Chefs' whites; Cheongsams (Chinese gowns); Choir robes; Christening gowns; Christening robes; Cloth bibs for adult diners; Clothing made of fur; Cocktail dresses; Collar guards for protecting clothing collars; Collar liners for protecting clothing collars; Collar protectors; Collars; Collars [clothing]; Collars for dresses; Corselets; Corsets; Corsets [clothing, foundation garments]; Corsets [foundation clothing]; Corsets [underclothing]; Costumes; Costumes for use in children's dress up play; Costumes for use in role-playing games; Costumes (Masquerade -); Crinolines; Cuffs; Cummerbunds; Dance clothing; Dance costumes; Dance shoes; Dance slippers; Detachable collars; Detachable neckpieces for kimonos (haneri); Dinner jackets; Dinner suits; Disposable slippers; Disposable underwear; Donkey jackets; Dress pants; Dress shields; Dress shirts; Dress shoes; Dress suits; Dresses for evening wear; Dust coats; Embossed heels of rubber or of plastic materials; Embossed soles of rubber or of plastic materials; Evening coats; Evening dresses; Evening gowns; Evening suits; Evening wear; Eye masks; Fancy dress costumes; Fascinator hats; Fedoras; Fezzes; Foam pedicure slippers; Folk costumes; Footwear made of wood; Footwear (Non-slipping devices for -); Footwear soles; Footwear (Tips for -); Footwear uppers; Footwear (Welts for -); Formal evening wear; Formal wear; Formalwear; Foulards [clothing articles]; Frames (Hat -) [skeletons]; Frock coats; Full-length kimonos (nagagi); Fur cloaks; Fur coats; Fur coats and jackets; Fur hats; Fur jackets; Fur muffs; Fur stoles; Furs [clothing]; Gaiter straps; Gaiters; Garrison caps; Garter belts; Garters; Gauchos; Girdles; Girdles [corsets]; Gowns; Gowns for doctors; Greatcoats; G-strings; Guernseys; Gussets for bathing suits [parts of clothing]; Gussets for footlets [parts of clothing]; Gussets for leotards [parts of clothing]; Gussets for stockings [parts of clothing]; Gussets for tights [parts of clothing]; Gussets for underwear [parts of clothing]; Gussets [parts of clothing]; Hairdressing capes; Halloween costumes; Haneri [detachable neckpieces for kimonos]; Hat frames [skeletons]; Hats (Paper -) [clothing]; Headdresses [veils]; Headshawls; Headsquares; Heavy coats; Heavy jackets; Heel inserts; Heel pieces for shoes; Heel pieces for stockings; Heel protectors for shoes; Heelpieces for footwear; Heelpieces for stockings; Heels; Hidden heel shoes; High rain clogs (ashida); High-heeled shoes; Hijabs; House coats; Housecoats; Inner socks for footwear; Inner soles; Innersocks; Insoles; Insoles for footwear; Insoles for shoes and boots; Insoles [for shoes and boots]; Intermediate soles; Jacket liners; Japanese footwear of rice straw (waraji); Japanese kimonos; Japanese sleeping robes (nemaki); Japanese sleeping

robes [nemaki]; Japanese split-toed work footwear (jikatobi); Japanese style clogs and sandals; Japanese style sandals of felt; Japanese style sandals of leather; Japanese style sandals (zori); Japanese style socks (tabi); Japanese style socks (tabi covers); Japanese style wooden clogs (geta); Japanese toe-strap sandals (asaura-zori); Japanese traditional clothing; Kaftans; Kerchiefs; Kerchiefs [clothing]; Khakis; Khimars; Kilts; Kimonos; Knickerbockers; Knot caps; Korean outer jackets worn over basic garment [Magoja]; Korean topcoats [Durumagi]; Korean traditional women's waistcoats [Baeja]; Laboratory coats; Linen (Body -) [garments]; Linings (Ready-made -) [parts of clothing]; Liveries; Low wooden clogs (hiyori-geta); Low wooden clogs (koma-geta); Low wooden clogs [koma-geta]; Lumberjackets; Maniples; Mankinis; Mantillas; Mantles; Masks (Sleep -); Masquerade costumes; Men's dress socks; Metal fittings for Japanese style wooden clogs; Military boots; Miters [hats]; Mitres [hats]; Morning coats; Mukluks; Mules; Muumuus; Nappy pants [clothing]; Negligees; Nightcaps; Nipple pasties; Niqabs; Non-slipping devices for footwear; Nurse dresses; Nurse overalls; Nurse pants; Nurses' uniforms; Nursing shoes; Oilskins [clothing]; Overalls; Overalls for infants and toddlers; Pantaloons; Pantie-girdles; Paper aprons; Paper clothing; Paper hats [clothing]; Paper hats for use as clothing items; Paper hats for wear by chefs; Paper hats for wear by nurses; Pareos; Pareus; Party hats [clothing]; Pedicure sandals; Pedicure slippers; Peignoirs; Pelerines; Pelisses; Petticoats; Petti-pants; Plastic aprons; Platform shoes; Pleated skirts for formal kimonos (hakama); Plus fours; Plush clothing; Pocket kerchiefs; Pocket squares; Pocket squares [clothing]; Pockets for clothing; Pop socks; Protective metal members for shoes and boots; Pullstraps for shoes and boots; gaiters; Ready-made linings [parts of clothing]; Religious garments; Removable collars; Ruanas; Rubber soles for jikatobi; Russian felted boots (Valenki); Sabots; Sarees; Saris; Sash bands for kimono (obi); Sashes for wear; School uniforms; Sedge hats (suge-gasa); Serapes; Shampoo capes; Shapewear; Shawls; Shawls; Shawls and stoles; Shawls [from tricot only]; Shields (Dress -); Shirt fronts; Shirt yokes; Shoe covers, other than for medical purposes; Shoe inserts for non-orthopedic purposes; Shoe soles; Shoe soles for repair; Shoe straps; Shoe uppers; Shoes soles for repair; Short overcoat for kimono (haori); Short petticoats; Shoulder scarves; Shoulder straps for clothing; Shoulder wraps; Shoulder wraps [clothing]; Shoulder wraps for clothing; Shower caps; Sleep masks; Slipper soles; slips; Slips; Slips [clothing]; Slips [underclothing]; Slips [undergarments]; Smocks; Smoking jackets; Sock suspenders; Soles for footwear; Soles for Japanese style sandals; Soles [Inner]; Spats; Stiffeners for boots; Stiffeners for shoes; Stocking suspenders; Stockings (Heel pieces for -); Stoles; Stoles (Fur -); Strapless bras; Strapless brassieres; Straps (Gaiter -); String fasteners for haori (haori-himo); Suspenders; Suspenders for men; Suspenders for women; Suspenders; Suspenders [braces]; Swaddling clothes; Synthetic fur stoles; Tail coats; Tam o'shanters; Tams; Tap pants; Tap shoes; Tartan kilts; Teddies; Teddies [underclothing]; Teddies [undergarments]; Theatrical costumes; Thobes; Three piece suits [clothing]; Tightening-up strings for kimonos (datejime); Tips for footwear; Toe boxes; Toe socks; Toe straps for Japanese style sandals [zori]; Toe straps for Japanese style wooden clogs; Toe straps for zori [Japanese style sandals]; Togas; Tongues for shoes and boots; Top hats; Toques [hats]; Trews; Trouser straps; Turbans; Tutus; Tuxedo belts; Tuxedos; Underarm gussets [parts of clothing]; Undershirts for kimonos (juban); Undershirts for kimonos (koshimaki); Undershirts for kimonos [koshimaki]; Underskirts; Uniforms for commercial use; Uniforms for nurses; Union suits; Uppers (Footwear -); Uppers for Japanese style sandals; Uppers of

woven rattan for Japanese style sandals; Ushankas [fur hats]; Valenki [felted boots]; Veils; Veils [clothing]; Vests for use in barber shops and salons; Visors [hatmaking]; Waist cinchers; Waist strings for kimonos (koshihimo); Waistbands; Wedding dresses; Wedding gowns; Welts for footwear; White coats for hospital use; Wimples; Women's ceremonial dresses; Wooden bodies for Japanese style clogs; Wooden main bodies of Japanese style wooden clogs; Wooden shoes; Wooden shoes [footwear]; Wooden supports of Japanese style wooden clogs; Work boots; Work clothes; Work overalls; Work shoes; Working overalls; Wrap belts for kimonos (datemaki); Wraps [clothing]; Yashmaghs; Yashmaks; Yokes (Shirt -); Zoot suits; Zori.