

O/0877/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003681452

BY TOTAL FAN TV LIMITED

FOR A TRADE MARK IN CLASSES 25, 35, 38 AND 41

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 430400

BY R L MEDIA LIMITED

AND IN THE MATTER OF APPLICATION NO. UK00003702708

FOR A TRADE MARK IN CLASSES 9, 18, 25 AND 28

AND APPLICATION NO. UK00003721834

FOR A TRADE MARK IN CLASSES 35, 38 AND 41

BY R L MEDIA LIMITED

AND IN THE MATTER OF OPPOSITIONS THERETO

UNDER NOS. 431018 AND 431019

BY TOTAL FAN TV LIMITED

BACKGROUND AND PLEADINGS

1. The crux of this dispute relates to the question of ownership of goodwill in relation to a social media channel previously known as Arsenal Fan TV (“the channel”).

2. The parties agree that the channel was established in October 2012. The idea for the channel came from Mr Robin Lyle, and he was joined in the venture by his business partner, Mr Tao Weitzer. Mr Lyle’s then wife, Ms Simone Davids-Lyle also claims to have been involved, although there is some dispute as to the extent of Ms Davids-Lyle’s involvement in the establishment of the channel, but nothing turns on this.

3. Mr Lyle was the ‘face’ of the channel. At this time, the channel operated under the name Arsenal Fan TV. A company called Total Fan TV Limited (“TFTL”) was incorporated on 6 November 2012,¹ which the parties agree was (at least to some extent) involved in the running of the channel. The parties dispute the extent and nature of TFTL’s role in the operation of the business.

4. Ultimately, the channel was successful. The main sources of income for the channel were advertising and a store through which fans could buy branded merchandise. In 2017, the marriage of Mr Lyle and Ms Davids-Lyle began to breakdown and disputes began to arise regarding the channel. In 2018, there were two key developments: 1) in August of that year there was a re-brand following a dispute with Arsenal Football Club (“Arsenal FC”) and 2) in September of that year a company called R L Media Limited (“RLM”) was incorporated by Mr Lyle. RLM then began to run the business of the channel, with Mr Lyle and Mr Weitzer continuing to produce the content. Following the re-brand, the channel operated under the following sign:

¹ Exhibit SDL1, page 1.



5. All three applications in issue, relate to the sign shown above. The details of the contested applications are as follows:

UKTM(A) no. 3681452 (“the 452 Mark”)

Filing date: 13 August 2021

Owner: TFTL

Opposed by: RLM on 21 January 2022

UKTM(A) no. 3702708 (“the 708 Mark”)

Filing date: 28 September 2021

Owner: RLM

Opposed by: TFTL on 14 February 2022

UKTM(A) no. 3721834 (“the 834 Mark”)

Filing date: 16 November 2021

Owner: RLM

Opposed by: TFTL on 14 February 2022

6. The goods and services to which the applications relate are set out in Annex 1 to this decision.

7. The opposition brought by RLM against the 452 Mark is based upon sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”). RLM claims to have been using a sign identical to the one shown in paragraph 4 above throughout the UK since at least 2018 in relation to a broad range of goods and services (as set out in Annex 2 to this decision). RLM claims that use of the 452 Mark would amount to passing off. RLM

also claims that TFTL had knowledge of RLM's use of the sign, and that the application is part of a blocking strategy and amounts to bad faith.

8. The oppositions brought by TFTL against the 708 and 834 Marks are based upon sections 5(1), 5(4)(a) and 3(6) of the Act. In relation to the opposition against the 708 Mark, TFTL also relies upon section 5(2)(a) of the Act. In relation to the section 5(4)(a) claim, TFTL claims to have been using the sign AFTV and the sign shown in paragraph 4 above throughout the UK since 2018 in relation to:

Clothing and hats.

Advertising and marketing services; broadcasting services, including podcasting services, internet broadcasting services, transmission of videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet; entertainment services, including entertainment services for sharing audio and video recordings, providing video entertainment via a website, entertainment services provided by online streams, sports entertainment services.

TFTL claims that use of the 708 and 834 Marks would amount to passing off.

9. TFTL also claims that Mr Lyle and Mr Weitzer, having been previously involved in TFTL, incorporated RLM and have since taken steps to divert revenue from TFTL to RLM. TFTL claims that the applications for the 708 and 834 Marks are part of an improper attempt to take the "AFTV" business from TFTL. Consequently, TFTL claims that the applications have been made in bad faith.

10. In relation to its section 5(1) and 5(2)(a) grounds, TFTL relies upon the 452 Mark. The opposition based upon these grounds is directed at the goods and services in bold and underlined (in relation to the section 5(1) grounds) and underlined (in relation to the section 5(2)(a) ground) in Annex 1 to this decision.

11. Both parties filed counterstatements denying the grounds of opposition.

12. Both parties filed evidence. A hearing took place before me on 10 May 2023, in person. TFTL was represented by Ms Alaina Newnes of Counsel, instructed by CMS Cameron McKenna Nabarro Olswang LLP and RLM was represented by Mr Stobbs of Stobbs IP. Both filed skeleton arguments in advance of the hearing.

EVIDENCE AND CROSS-EXAMINATION

13. RLM's evidence consists of:

- a. The witness statement of Mr Tao Weitzer dated 4 August 2022, which is accompanied by 12 exhibits. Mr Weitzer has been a director of both RLM and TFTL. He was also responsible for filming and editing content for the channel.
- b. The witness statement of Mr Robin Lloyd Lyle dated 4 August 2022, which is accompanied by 10 exhibits. Mr Lyle is a current director of RLM.

14. Both Mr Weitzer and Mr Lyle were cross-examined. I found them both to be sincere witnesses. I will refer back to the content of their evidence given under cross-examination where it is necessary to do so below.

15. TFTL's evidence consists of:

- a. The first witness statement of Ms Davids-Lyle dated 13 July 2022, which is accompanied by 1 exhibit. Ms Davids-Lyle is a director and shareholder of TFTL.
- b. The second witness statement of Ms Davids-Lyle dated 5 October 2022, which is accompanied by 1 exhibit.

16. RLM made two applications to file further evidence, which I refused. Both related to a family court judgment. At the time of the first application, that judgment had not been handed down and so could not be shared with this Tribunal. Without sight of the judgment, it was impossible to say whether it was material. By the time of the second

application, the judgment had been handed down and a copy was filed. The content of my letter refusing that application is set out in Annex 3 to this decision.

RELEVANCE OF EU LAW

17. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

PRELIMINARY ISSUE

18. Much of the evidence in this case relates to the question of ownership of shares in TFTL. It is an ongoing source of dispute between Mr Lyle and Ms Davids-Lyle as to who is the correct owner of those shares. For the avoidance of doubt, ownership of shares in a company has no bearing on the question of ownership of goodwill and it does not appear to have any relationship with the bad faith claims as pleaded. Consequently, this is not a matter that it would be appropriate for me to comment upon, and I will not address it any further.

THE OPPOSITION AGAINST THE 452 MARK

19. As the 452 Mark is relied upon by TFTL as part of their oppositions against the 708 and 834 Marks, I will begin by assessing the opposition to this mark first.

Section 5(4)(a)

20. Section 5(4)(a) states as follows:

“(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) [...]

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.”

21. 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.”

22. 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).”

23. The prima facie relevant date is the date of the application for the 452 Mark i.e. 13 August 2021. TFTL claims to have been using the sign since August 2018 (when the re-brand took place), which creates a second earlier relevant date.

24. It is not in dispute that the channel had generated goodwill. I also do not understand it to be in dispute that the logo shown in paragraph 4 above was distinctive of that goodwill. In any event, given that the channel had approximately 800,000 subscribers by September 2018 (only 1 month after the re-brand),² and a new name for a pre-existing business can acquire protection under the law of passing off as soon as that name becomes public, I consider that the AFTV logo was distinctive of the goodwill of the business at both relevant dates.³ The exact goods and services in respect of which each party claims goodwill differs, but the entirety of TFTL's claim falls within that claimed by RLM. Consequently, it appears that the parties are in agreement that there was goodwill in relation to (at least) the following:

Clothing and hats.

Advertising and marketing services; broadcasting services, including podcasting services, internet broadcasting services, transmission of videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet; entertainment services, including entertainment services for sharing audio and video recordings, providing video entertainment via a website, entertainment services provided by online streams, sports entertainment services.

25. As to ownership of goodwill, there is no suggestion by either party that there was any formal agreement in place; certainly, there is nothing in evidence before me.

26. RLM claims that it was always the intention that ownership of the goodwill (and other intellectual property rights) would remain with Mr Lyle and Mr Weitzer personally. Consequently, RLM claims that they were able to assign the goodwill to RLM upon its

² Exhibit SDL1, page 142.

³ *British Telecommunications Plc v One in a Million Ltd* [1999] FSR 1 CA (civil)

incorporation. Mr Lyle gave evidence that TFTL was only established for the purposes of opening a company bank account through which payments made/received in relation to the channel could be made, as Mr Lyle's credit rating at the time created problems for him in this regard. By contrast, TFTL claims to have been the undertaking responsible for operating the business and claims that any goodwill generated accrued to it, not Mr Lyle and Mr Weitzer personally.

27. In this regard, I note the following:

- a) A draft Terms and Conditions of Advertising document which relates to advertisements placed on the channel.⁴ These are described as having been "last updated: 2 February 2015". These state that it is TFTL which accepts such advertisements. In relation to payments, it states:

"9. [...] [TFTL] may change its rates at any time by publishing the modified rates. Any changes to the rates will take effect immediately. However, any changes to the applicable rates will not apply to any orders made prior to the date of such change.

10. All sums payable to TotalFanTV (TFTV) should be made in accordance with TFTV Financial Terms & Conditions which are: [...]" (my emphasis)

Mr Stobbs, rightly, submitted that this document does not make any reference to ownership of the intellectual property rights with which these proceedings are concerned. However, it does indicate that for those seeking to do business with the channel, it was TFTL with whom they would contract (rather than Mr Lyle or Mr Weitzer personally).

- b) A draft Share Purchase Deed between Mr Lyle, Ms Simone Davids-Lyle and a company called Ball Street Limited ("Ball Street").⁵ The parties agree that this

⁴ Exhibit SDL1, pages 16 to 21.

⁵ Exhibit SDL1, pages 25 to 52

was drafted in 2015, when a sale to Ball Street was contemplated. The “business” is defined as:

“The business carried on by the Company, namely the provision of digital media content for Arsenal Fan TV and 100% Chelsea, together with any additional channels, profiles, websites, apps, podcasts, radio stations and other digital media offerings that are owned by the Company. All associated revenue streams to include but not limited to the monetisation of content and merchandising, or any part of it.”

The “Company” is defined as TFTL.

I note that the definition of “Company’s Intellectual Property” refers to Schedule 5, which is blank. However, Schedule 4, which deals with warranties, states:

“All Intellectual Property Rights used, or held for use by the Company in connection with the Business are owned by the Company including (without limitation) those listed in Schedule 5 (Company’s Intellectual Property).”

The definition of “Intellectual Property Rights” includes goodwill.

Mr Lyle gave evidence that this was not a document that was ever executed and, one of the reasons for that, was that he did not want anyone else to acquire part of the channel (which he saw as being independent from TFTL). This was also supported by Mr Weitzer’s evidence under cross-examination. Further, I note that the Heads of Terms for that agreement states: “All key trade marks currently used by [TFTL] will be assigned to and maintained by [TFTL].”⁶ In light of the uncertainty surrounding the parties’ satisfaction with the content of this document given that it was not executed, I accept that that document is of limited assistance to TFTL.

⁶ Exhibit TW6

- c) An unsigned United Football Fans of Africa content agreement has been provided, which is dated 30 March 2017.⁷ It is TFTL which is named as the “Content Creator” and who is the named party to the agreement. Payment is described as being payable to TFTL.

- d) An email from someone acting as a business advisor for Mr Lyle dated 23 June 2017.⁸ The author appears to be discussing the potential for Mr Lyle to set up a new business, but notes that if Mr Lyle were to use any of the equipment owned by TFTL or wanted to take over any contracts from TFTL, then the latter would need to be purchased at market value and formal arrangements would need to be put in place.

The advisor does note that Mr Lyle is “effectively the company”.

He goes on to state that if TFTL were wound up, then a liquidator would be appointed and they would attempt to recover as much for the shareholders as possible. He states: “they will actively try and sell the assets of the company (e.g. the website, the use of the Arsenal Fan TV, the You Tube contract etc.)”.

He then goes on to discuss the possibility of Mr Lyle’s new business acquiring these assets from the liquidators.

- e) A letter dated 17 November 2017 sent by the representatives acting for TFTL and Mr Lyle in relation to the dispute with Arsenal Football Club stated as follows:⁹

“We act for Total Fan TV Limited. Please note that, despite your initial correspondence being addressed to Mr Robin Lyle (for whom we also act) the ArsenalFan TV service and business is in fact owned and operated by Total Fan TV Ltd.”

⁷ Exhibit SDL1, pages 53 to 57

⁸ Exhibit SDL1, pages 58 to 59

⁹ Exhibit SDL1, pages 61 to 65

- f) No documentary evidence listing Mr Lyle or Mr Weitzer personally as parties with whom any customers/businesses would need to contract in the context of the channel have been put forward.
- g) Domain name renewal fees relating to the channel were paid for by TFTL.¹⁰
- h) RLM acknowledges that TFTL was set up in order to receive payments made to the business.
- i) TFTL issued invoices to third parties for payment in relation to projects undertaken on the channel.¹¹
- j) TFTL received invoices from third parties for payments due in relation to the channel.¹²
- k) TFTL appears to have received the settlement payment resulting from the dispute with Arsenal FC.¹³

28. This evidence appears to me to support a prima facie case that it was TFTL to whom any goodwill accrued.

29. I note Mr Lyle's evidence under cross-examination that it was he who carried out negotiations for the deals done in relation to the channel (including the deal to which the document at point c) above relates). For example, he stated:

“[...] every deal that was done for AFTV. I would say practically every deal, was always done with me. I would be the person who would sit in the room, I would be the person who they would come to talk to, I would be the point of contact. [...] So like if I was not involved in a deal the deal would not happen probably because I am the person who is going to make the content for the deal.”

¹⁰ Exhibit SDL1, page 102.

¹¹ Exhibit SDL1, pages 99 to 101.

¹² Exhibit SDL1, page 112.

¹³ Exhibit SDL1, page 77.

30. Similarly, Mr Lyle claims that the AFTV logo was created for him personally, rather than TFTL. In this regard, Mr Lyle points to an email from the creator of the logo which states:¹⁴

“[...] all material done for AFTV I have done you now own, [...]”

31. There is also a letter from the same individual dated 22 July 2022 which states:

“In July 2018 I was commissioned by Robbie Lyle to design the brand identity for AFTV, see the attached logo.

This was done in good faith and all rights associated to the concept and artwork handed over to Robbie Lyle for future use.”

32. However, there is nothing in these documents which suggests that Mr Lyle was not acting on behalf of TFTL when he commissioned the logo in dispute or when he engaged in negotiations in relation to the channel. He was a director of TFTL at the time the logo was created. I do not consider that this evidence undermines the position as outlined in the above documentary evidence. This is because a company is a legal construct, and it requires individuals to carry out its business for it (usually employees or directors). Consequently, I accept Ms Newnes’ submission that the fact that Mr Lyle was attending meetings with potential customers and negotiating on behalf of the channel is not inconsistent with TFTL being the undertaking responsible for the running of the business and, therefore, being the entity to whom the goodwill accrued.

33. Mr Lyle points to the fact that he was named in the final settlement agreement with Arsenal FC. However, I note that TFTL was also a named party. Certainly, I agree with Ms Newnes that it is very persuasive that a legal representative acting on behalf of Mr Lyle confirmed in writing that it was not in fact Mr Lyle who owned and operated the channel, but TFTL. Mr Lyle seems to have accepted the benefit of the separation between a company and those running it when faced with a question of liability; but it is not possible to benefit from that separation without also accepting that the same is

¹⁴ Exhibit RL3

true in terms of the assets of the company. I also note that it was TFTL who was invoiced for the legal fees associated with this agreement.¹⁵

34. Mr Lyle relies upon the fact that he was heavily involved in financing the business in the early days. Whilst that may be the case, that does not, in my view, affect the question of ownership of goodwill. It is entirely possible for individuals/directors to loan money to a company on the basis that it will be paid back at some later point when the business is more successful, without gaining any claim of ownership to the company's assets. In any event, it is not clear how long Mr Lyle financed the company for and, certainly, both parties agree that once the channel had begun to generate more income, payments to cover the general running of the channel were paid out of the TFTL bank account.

35. Reference is made to the fact that Mr Weitzer owned the domain names used by the channel. It is certainly clear from the evidence that he purchased the domain names. However, I note that in an email from Mr Weitzer dated 3 February 2017, Mr Weitzer stated "all domain names are owned by Total Fan TV Ltd".¹⁶ Under cross-examination, Mr Weitzer explained that he said this because, in his mind, the channel and TFTL were one and the same:

"...when I am talking about the company Total Fan TV or Arsenal Fan TV, it was basically one and the same thing. One was set up to run things – we did all the filming, production, did all the stuff and Total Fan TV was set up to basically run our day-to-day books and accounts."

36. This dispute is not about ownership of domain names and, in any event, at some point TFTL took over responsibility for paying for the maintenance of those domain names, which is in line with a company that was conducting the business of the channel.

¹⁵ Exhibit SDL1, pages 66 to 70.

¹⁶ Exhibit SDL1, page 91

37. Mr Lyle points to the fact that the creation of the channel was his idea. However, there are no intellectual property rights in an idea; ownership of goodwill is a different issue to the question of who came up with the idea for the business. I do not consider that this assists RLM.

38. But what about viewers of the channel, who, as Mr Stobbs submitted, see Mr Lyle as the face of the channel? I note that various publications refer to Mr Lyle as the channel's "founder" and "presenter".¹⁷ I do not doubt that the success of the channel was, at least in part, related to Mr Lyle's popularity as its presenter. However, it seems to me that these were activities that he was undertaking on behalf of the company; he was promoting the channel that he had set up a company (being a separate legal entity) to run. I do not consider that this results in goodwill in the name of the channel attaching to Mr Lyle, rather than the company itself.

39. Ms Newnes directed me to the comments of Mr Geoffrey Hobbs KC in *Club Sail Trade Mark* [2010] RPC 32, in which he stated:

"Where, as here, there is a dispute as to whether and, if so, by whom rights of proprietorship have been held and exercised collectively in relation to the goodwill of a business with plural participants, it will usually be helpful for the decision taker to be provided with copies of the participants' business accounts and documentary evidence of the exercise of financial control in relation to relevant income and expenditure. By 'following the money' it ought to be possible to see where control over the operation of the business has actually been located."

40. "Following the money" in this case leads very clearly to TFTL. TFTL was the named party in contracts relating to the channel's income, it paid for the day to day expenses and it issued invoices to third parties for their services. RLM has not adduced sufficient evidence, in my view, to counter TFTL's evidence that this was the case. On balance, I find that it was in fact TFTL that was operating the day-to-day business and that it is to TFTL that any goodwill accrued up to at least September 2018 (when RLM was

¹⁷ Exhibit TW12

incorporated). As a result, RLM cannot have had an actionable passing off right at the August 2018 relevant date.

41. As Mr Stobbs noted at the hearing, that is not the end of the matter. It is important to consider whether the position would have been any different at the prima facie relevant date.¹⁸ By that point, RLM had effectively been trading for 3 years and operating the channel itself (to the exclusion of TFTL).

42. However, RLM was undoubtedly passing off when it first started using the mark in 2018, because at that time, it was TFTL who owned the goodwill. There is nothing in evidence before me to suggest that RLM has taken any steps to educate its customers that there was/is a difference between it and the previous operator of the channel; indeed, that would be contrary to Mr Lyle's position that he and the channel were one and the same. This is not, therefore, a case where the relevant public have come to understand, over a period of time, that there are two users of the same mark; for those users of the channel whose interest in it began prior to RLM's incorporation, they will believe that it is the very same channel that they are now dealing with that they have always dealt with. To them, there has been no change and there is no evidence before me to suggest that there has been. Consequently, I find that RLM has been misrepresenting itself as TFTL throughout the intervening 3-year period between its incorporation and the prima facie relevant date. As such, it cannot have acquired an actionable passing off right at the prima facie relevant date against TFTL. Consequently, I do not consider that the position was any different at the prima facie relevant date.

43. The opposition based upon section 5(4)(a) of the Act is dismissed.

Section 3(6)

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

¹⁸ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

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

45. 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:

“68. 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].”

46. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

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

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

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

48. The basis of RLM's bad faith case is that the intellectual property in the AFTV logo belonged to Mr Lyle and Mr Weitzer, who transferred their rights to RLM. RLM claims

that TFTL was aware of its rights in the logo applied for and that the application was made to block RLM's legitimate business and/or to divert business away from RLM.

49. Certainly, that is an objective which is capable of forming the basis of a bad faith claim. However, I have already found that the goodwill in the business belonged to TFTL and so any rights in the unregistered signs that were distinctive of that goodwill would have belonged to TFTL and not Mr Lyle, Mr Weitzer or RLM. As Mr Stobbs noted at the hearing, the 3(6) grounds in this case will follow the 5(4)(a) grounds. RLM has failed to establish a prima facie case.

50. The opposition based upon section 3(6) of the Act is dismissed.

THE OPPOSITIONS AGAINST THE 708 AND 834 MARKS

51. I will now turn to consider the oppositions against the 708 and the 834 Marks.

Section 5(4)(a)

52. I have set out the law relevant to my assessment under this section, above. I apply the same here.

The relevant date

53. The prima facie relevant date is the date of the applications in issue i.e. 28 September 2021 (for the 708 Mark) and 16 November 2021 (for the 834 Mark). There has been prior use of the sign dating back to the incorporation of RLM (11 September 2018).¹⁹

Goodwill

54. I have found that the goodwill in the channel was owned by TFTL, dating back to its incorporation in November 2012. As noted above, it is not in dispute that the sign

¹⁹ Exhibit TW10

relied upon was distinctive of that goodwill from the time of its first use in August 2018. As explained above, the parties are in agreement that there was a substantial goodwill in relation to (at least) the following goods and services:

Clothing and hats.

Advertising and marketing services; broadcasting services, including podcasting services, internet broadcasting services, transmission of videos, movies, pictures, images, text, photos, user-generated content, audio content, and information via the Internet; entertainment services, including entertainment services for sharing audio and video recordings, providing video entertainment via a website, entertainment services provided by online streams, sports entertainment services.

55. I note that from the date of RLM's incorporation, TFTL appears to have had limited involvement in the running of the channel; rather, it has been run by Mr Lyle and/or Mr Weitzer through RLM. TFTL's involvement in the running of the channel therefore ceased (or at least, reduced) towards the end of 2018, some 3 years prior to the prima facie relevant dates. TFTL would, in my view, have continued to have residual goodwill at the prima facie relevant dates, particularly given the popularity of the channel prior to RLM's incorporation and the limited time that had passed between these dates.

Misrepresentation

56. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] *R.P.C.* 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

57. *Halsbury's Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff 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 feature 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 successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot

be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (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 confusion or 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.”

58. The 708 and 834 Marks are plainly identical to the logo sign relied upon. As that represents TFTL’s best case, I will consider this ground based on the logo sign only. All of the services covered by the 834 Mark are plainly in the same or similar field of activity to those for which TFTL has goodwill. The position is not as clear cut in relation to the goods and services of the 708 Mark. I accept that, for the most part, they are within at least similar or connected fields of activity.

59. The absence of a common field of activity is not fatal; but it is an important and highly relevant consideration.²⁰ However, even where they are not obviously within the same field of activity, I bear in mind that RLM applied for its marks as an extension of the existing business; Mr Lyle believed that he owned the goodwill personally (and, by extension, that RLM is entitled to continue the business of the channel). He must, therefore, have seen some connection between the goods/services applied-for and the existing business; or, at the very least, some way in which the business could develop into those areas. Indeed, I note that RLM's counterstatement makes no attempt to draw a distinction between some goods and services (which it considers to be similar to those for which the channel had generated goodwill) and those for which it does not. I also bear in mind that the applied-for mark and the AFTV logo which is distinctive of TFTL's goodwill are identical. Consequently, it is far more likely that the relevant public will assume some economic connection between the undertakings using the signs, even where they are being used in more distant fields of activity. Taking all of this into account, I consider it likely that a substantial number of members of the public will be misled into thinking that the goods and services of RLM are the goods and services of TFTL, particularly given that RLM is itself purporting to be conducting the same business, without interruption under the same sign/marks and has done so throughout the 3 year period leading up to the prima facie relevant date.

Damage

60. In relation to those goods and services in the same, related or similar fields of activity to those for which TFTL has goodwill, damage through diversion of sales is easily foreseeable. In relation to those goods and services which are within different or more distant fields of activity, I consider it likely that damage could arise through lost licensing/franchise opportunities and/or loss of control of the quality of goods/services offered under their mark.

61. The opposition against the 834 and 708 Marks based upon section 5(4)(a) succeed in their entirety.

²⁰ *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

Section 5(1) and 5(2)(a)

62. I do not understand it to be in real dispute that if the 452 Mark survived the opposition brought by RLM then the 708 and 834 Marks would be successfully opposed under these grounds. I agree. In any event, these grounds of opposition are directed at a narrower proportion of the goods/services applied-for and do not take TFTL any further than its opposition under section 5(4)(a). Consequently, I will deal with these grounds no further.

Section 3(6)

63. I have set out the law in relation to this section above and I apply the same here.

64. At the hearing, Ms Newnes made submissions regarding a breach of fiduciary duty on the part of Mr Lyle and/or Mr Weitzer which, she said, was grounds in itself for a finding of bad faith. However, as Mr Stobbs correctly noted, this line of argument was not pleaded by TFTL and, consequently, I decline to consider it.

65. TFTL's pleaded case is that since November 2018, Mr Lyle and Mr Weitzer have been diverting income generated through the channel to RLM and that, despite TFTL being the owner of the goodwill in the business, RLM has filed the applications for the 708 and 834 Marks as part of an improper attempt to take the business of the channel from TFTL. Clearly, that is an objective for the purposes of which the contested applications could not properly be filed.

66. I bear in mind that, as Ms Newnes submitted, a claim of bad faith is not avoided simply by making an application in the name of a company.²¹ It appears that RLM (through Mr Lyle and Mr Weitzer) held a belief that TFTL did not own the goodwill in the business. Both Mr Lyle and Mr Weitzer were adamant in their stance on that under cross-examination. I have, of course, found that view to be incorrect. In my view, they held that belief despite the overwhelming information they had to the contrary. For example, the correspondence from Mr Lyle's own legal representative made it clear

²¹ *Joseph Yu v Liaoning Light Industrial Products Import and Export Corporation* BL O/013/05

that it was TFTL which owned the channel and associated business. Further, a business advisor acting for Mr Lyle confirmed that the channel was an asset that the liquidators would attempt to sell if TFTL was wound up. I note that RLM had itself been trading for 3 years prior to the relevant dates. However, it had been misrepresenting itself as TFTL during that time, a fact which should have been apparent in the circumstances. Whilst Mr Lyle may have believed that he and/or Mr Weitzer owned the goodwill at the relevant date, and this knowledge can be attributed to RLM, I must judge the position not by what RLM knew or thought it knew, but by what it should have known based upon the standards of reasonableness. In my view, RLM (through Mr Lyle and Mr Weitzer) should have known that the goodwill was held by TFTL and that its actions in attempting to file identical trade marks to the sign distinctive of TFTL's goodwill fell below the standards of acceptable commercial behaviour. This amounts to bad faith.

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

CONCLUSION

68. The opposition against UKTM(A) no. 3681452 fails in its entirety and the application may proceed to registration.

69. The opposition against UKTM(A) nos. 3702708 and 3721834 succeed in their entirety and the applications are refused.

COSTS

70. TFTL has been successful and is entitled to a contribution towards its costs. Costs in proceedings before the Registry are usually awarded on a contributory basis based upon the scale published in Tribunal Practice Notice 2/2016. However, TFTL seeks an award of costs off the usual scale.

71. The first reason for this request is that RLM can, it says, have had no bona fide belief that its applications were soundly based. For the reasons given above, I consider it likely that Mr Lyle and Mr Weitzer did in fact believe that they owned the goodwill

(albeit they were wrong in their belief and that belief is, somewhat, surprising given the advice they had received to the contrary). Consequently, I do not consider that this line of argument has any merits.

72. The second reason is that the parties have already been in dispute before the Registry in relation to a different application and a decision has already been handed down on 3 November 2021.²² That case concerned an application for the AFTV logo (identical to the mark in issue in these proceedings) filed by RLM. TFTL opposed the application based upon sections 5(4)(a) and 3(6) of the Act. The basis for the opposition was, for all intents and purposes, identical to the 5(4)(a) and 3(6) grounds pleaded in this case. The case was decided in favour of TFTL on both grounds. RLM's counterstatements in the opposition against the 452 Mark and the oppositions against the 708 and 834 Marks were all filed after that decision was handed down. Consequently, RLM knew the Hearing Officer's view on the legal position with regard to ownership of goodwill and bad faith. Oppositions do not give rise to an estoppel and so RLM was entitled to bring its cases anew. Its reason for attempting to run the same arguments again appears to be that it did not file evidence in the previous proceedings, whereas it did in these. However, it was open to RLM to file evidence in the previous proceedings and, in any event, its evidence has not taken it any further forward. Whilst I recognise that this position is likely to be frustrating for TFTL, as they have had to deal with effectively the same proceedings again, I do not consider RLM's actions to amount to an abuse of process. Consequently, I do not consider that there are sufficient grounds to justify an award of costs off the usual scale. However, I do consider it appropriate to make an award at the higher end of the scale due to the additional burden that TFTL has been put to by having to deal with, effectively, the same proceedings again.

73. In the circumstances, I award TFTL the sum of **£5,500**, calculated as follows:

Preparing a statement and considering RLM's statement (x3)	£1,500
Preparing evidence and considering RLM's evidence	£2,000

²² BI O/815/21

Preparing for and attending a hearing	£1,600
Official fees (x2)	£400
Total	£5,500

74. I therefore order R L Media Limited to pay Total Fan TV Limited the sum of £5,500. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of September 2023

S WILSON
For the Registrar

ANNEX 1

The application for the 452 Mark relates to the following goods and services:

Class 25

Clothing; Clothes; Tops [clothing]; Hoods [clothing]; Sports clothing; Outer clothing; Embroidered clothing; Hats.

Class 35

Advertising; Advertising and advertisement services; Online advertisements.

Class 38

Broadcasting; Broadcasting services; Broadcast services; Video broadcasting; Television broadcasting; Cable television broadcasting; Internet broadcasting services; Broadcasting of radio programs; Broadcasting of esports events; Data transmission and data broadcasting; Podcasting; Podcasting services; Transmission of podcasts; Transmission of video films; Video transmission services; Transmission of news; Transmission of videocasts; Transmission of webcasts; Transmission of digital information.

Class 41

Entertainment services; Online entertainment services; Audio entertainment services; Audio-visual display presentation services for entertainment purposes; Audio-visual display presentations; Entertainment services provided by on-line streams; Video entertainment services; Entertainment; Entertainment services for sharing audio and video recordings; Digital video, audio and multimedia entertainment publishing services.

The application for the 708 Mark relates to the following goods:

Class 9

Publications in electronic format; downloadable publications; downloadable electronic publications; online electronic publications downloadable from the Internet; publications in electronic form supplied online from databases or from facilities

provided on the Internet (including web sites); electronic magazines; multi-media recordings and publications; printed publications in electronically readable form; computer software and programs; computer games; downloadable software; downloadable software applications; computer software downloadable from the Internet; application software; application software for mobile communication devices; Video games software; Interactive video game programs; Instruction manuals in electronic format; Encoded identity cards; Downloadable interactive entertainment software; Computer software for use in providing multiple user access to a global computer information network; data recorded in electronic, optical or magnetic form; data carriers; data storage media; memory cards; audio and/or video recordings; downloadable and streamable audio and/or video recordings; pre-recorded videos, CDs, CDIs, CD-ROMs, discs, cassettes and other data carriers containing information recorded in magazine form; Computer peripheral devices; keyboards, mice (data processing), trackballs for moving the cursor and wireless electronic controls, all for use with electronic apparatus for consumers; Data processing equipment; Remote controls; Computer keyboards; audio headphones and headsets for use with computers and video gaming; Downloadable video recordings; computer game programs; game programs for arcade video game machines; video game controllers, namely remote controls, joysticks, interactively controlled floor pads, steering wheels for video games, headphones, keyboards and mice (data processing), all for use with computers and consoles for video game platforms; wireless mice (data processing) and remote controls for use with televisions, computers and set-top boxes (decoders); mouse pads; touch keys (touch pads); computer keyboard controllers; computer programs and software for use in conjunction with the provision of an interface (interface devices or interface programs for computers) between a computer and a peripheral apparatus; interactive user manuals sold as a units with the aforesaid goods; eyewear; glasses; spectacles; sunglasses; lenses; frames for spectacles and sunglasses; cases and boxes for spectacles and sunglasses; cords, straps and chains for spectacles and sunglasses; sports eyewear; eye protection wear for sports; glasses for sports; magnets; digital photograph frames; covers and cases for mobile phones, computers and personal electronic devices; parts and fittings for all the aforesaid goods.

Class 18

Trunks and travelling bags; rucksacks; backpacks; bags; beach bags; briefcases; card cases; garment cases for travel; handbags; holdalls; key cases; keyholders; purses; school bags; shopping bags; sports bags; suitcases; wallets; umbrellas, parasols and walking sticks; collars, leashes and clothing for animals; covers for animals; parts and fittings for all the aforesaid goods.

Class 25

Clothing, footwear, headgear; sports clothing; sports footwear; sports headgear; outerwear; swimwear; socks; underwear; football shirts; football boots and studs for football boots; football shorts; football socks; boots; shoes; caps; hats; beanie hats; baseball caps; garments for protecting clothing; football jerseys; shorts; gloves; training kit and shirts; coats; jackets; t-shirts; sweaters; tracksuits; pants; leggings; sleepwear; pyjamas; dressing gowns; trousers; jeans; replica football kits; clothing belts; parts and fittings for all the aforesaid goods.

Class 28

Toys; Games and playthings; gymnastic and sporting articles; board games; hand-held, self-contained games apparatus; computer game apparatus; footballs; balls; reduced sized goal posts; blocking dummies; protective padding for sports; shin pads; football gloves; miniature replica football kits; darts and flights therefor, balloons; coin/counter operated games; ordinary playing cards; games adapted for use with television receivers; models being toys; plastic models being toys; teddy bears; stuffed toy bears; puzzles; poker chips; indoor football tables; table football tables; decorations for Christmas trees; confetti; sponge hands in the nature of novelties; rattles; articles for playing golf; golf balls; golf tees; golf ball markers; golf bags; golf club covers; golf gloves; articles for playing darts; darts; sporting articles for use in playing snooker; snooker tables; pool tables; skis; surf boards; skateboards; snowboards; sleighs; sledges (playthings); slides [playthings]; roller skates; in-line skates; rackets; fishing tackle; dice; dominoes; marbles; dolls; action figure toys; soft toys; bathtub toys; inflatable toys; ride-on toys; toy vehicles; flying discs; kits of parts [sold complete] for constructing models; party novelties, namely streamers, crackers and paper hats; party novelty hats; costume masks; costumes being children's playthings; kites; skittles; exercise balls; gym balls; bags adapted for carrying sporting

articles and apparatus; goal posts; goal nets; posts and nets for sports; hurdles and ladders for use in athletics and fitness training; sports training apparatus; fitness training apparatus; body building apparatus; exercise apparatus; indoor fitness apparatus; fitness exercise machines; portable home gymnastic apparatus; sports equipment; bags adapted for carrying exercise equipment and balls; exercise weights; resistance weights; resistance bands; yoga equipment, namely yoga blocks, yoga straps and gym balls for yoga; Pilates equipment, namely exercise bands, resistance bands and Pilates toning balls; exercise machines; exercise balls equipped with interactive computer systems; exercise equipment equipped with interactive computer systems; Smart gym and exercise equipment; smart exercise balls; Smart gym and exercise equipment featuring computer hardware and software which tracks user performance; parts and fittings for all of the aforesaid goods.

The application for the 834 Mark relates to the following services:

Class 35

Advertising and marketing; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotional services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising; Advertising, marketing and promotion services; Marketing; Marketing, advertising and promotion services; Marketing, advertising, and promotional services; Promotion [advertising] of business; Promotion of goods and services for others; Promotion of sports competitions and events; Promotion services; Promotion, advertising and marketing of on-line websites.

Class 38

Telecommunications; communications services; broadcasting services; webcasting services; podcasting services; Audio broadcasting; Video broadcasting; Internet broadcasting services; Satellite broadcasting services relating to sporting events; Streaming of audio and video material via the

internet; broadcasting via the Internet and other computer and communication networks; electronic communications services; broadcasting services and provision of telecommunication access to video and audio content provided via a video-on-demand service via the internet; Audio, video and multimedia broadcasting via the Internet and other communications networks; broadcasting, transmission, reception and other dissemination of text, messages, information, data, sound and images; providing access to a multimedia content and video sharing portal; Provision of telecommunication access to video content provided via the Internet; Transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet; Providing user access to search engines; Provision of access to the internet for others; Communication by online blogs; Telecommunication services provided via platforms and portals on the Internet and other media; Provision of telecommunication access to video and audio content provided via an online video-on-demand service; Video-on-demand transmission services; Transmission of data, audio, video and multimedia files, including downloadable files and files streamed over a global computer network; receiving and exchanging of information, text, sounds, images, data and messages; communications by and/or between computers and computer terminals and computer networks; provision of access to computer databases in the fields of social networking and online communities; electronic display of information, text, images, messages and data; online communication services; chat room services; providing on-line chat rooms and interactive discussion forums; providing user access to portals on the Internet; providing user access to platforms on the Internet; provision of online forums for communication on topics of general interest; provision of online forums relating to education and entertainment, music, fashion, films, food, careers, women, travel, sports, adventure and lifestyle; provision of online community forums for uploading, posting, storing, displaying, sharing, watching, viewing, playing, editing, downloading, receiving, electronically transmitting or otherwise providing electronic media, multimedia content, audio and video content, movies, music, games, photos, images, pictures, graphics, text, messages, information, data, news and user-generated content via the Internet and other computer and communication networks; electronic

transmission of news and current affairs information; information, advisory and consultancy services relating to all of the aforesaid services .

Class 41

Entertainment agency services; Entertainment by IP-TV; Entertainment by film; Entertainment by means of radio; Entertainment by means of telephone; Entertainment by means of wireless television broadcasts; Entertainment in the form of television programmes (Services providing -); Entertainment in the nature of mobile phone television; Entertainment in the nature of soccer games; Entertainment services; Entertainment services for sharing audio and video recordings; Entertainment services in the form of television programmes; Entertainment services in the nature of interactive television programmes; Entertainment services in the nature of sporting events; Administration [organisation] of entertainment services; Arranging of entertainment shows; Conducting of entertainment activities; Education, entertainment and sport services; Education, entertainment and sports; Fan club services (entertainment); Film production for entertainment purposes; Information about entertainment and entertainment events provided via online networks and the Internet; Information relating to entertainment, provided on-line from a computer database or the internet; Interactive entertainment; Interviewing of contemporary figures for entertainment purposes; On-line entertainment; Online interactive entertainment; Organising of entertainment; Preparation of entertainment programmes for broadcasting; Providing entertainment information via a website; Providing video entertainment via a website; Provision of entertainment information; Provision of entertainment information via television, broadband, wireless and on-line services; Provision of entertainment information via the Internet; Provision of entertainment via podcast; Provision of information relating to entertainment online from a computer database of the Internet; Provision of on-line entertainment; Entertainment; Entertainment services provided by on-line streams; Entertainment services provided by television; Services for the production of entertainment in the form of video; Television and radio entertainment; Television entertainment; TV entertainment services; Video entertainment services; Entertainment in the nature of football games; Video recordings [not

downloadable] provided from the internet; Providing online videos, not downloadable; Entertainment provided via the internet; Entertainment services provided on-line from a computer database or the internet; Sporting results services; Sports and fitness; Sports entertainment services; Sports information services; Entertainment services relating to sport; Entertainment services relating to sporting events; Organisation of sports events in the field of football; Providing information about sporting activities; Providing information relating to sports; Providing sports entertainment via a website; Providing sports information; Providing sports news; Provision of information relating to sporting events; Provision of information relating to sports; Provision of information relating to sports persons; Provision of news relating to sport; Organising of football events; Provision of entertainment information via the Internet.

ANNEX 2

For the purposes of its opposition against the 452 Mark, TFTL claims to have used its sign in relation to the following goods and services:

Publications in electronic format; downloadable publications; downloadable electronic publications; online electronic publications downloadable from the Internet; publications in electronic form supplied online from databases or from facilities provided on the Internet (including web sites); electronic magazines; multi-media recordings and publications; printed publications in electronically recordable form; computer software and programs; computer games; downloadable software; downloadable software applications; computer software downloadable from the Internet; application software; application software for mobile communication devices; Video games software; Interactive video game programs; Instruction manuals in electronic format; Encoded identity cards; Downloadable interactive entertainment software; Computer software for use in providing multiple user access to a global computer information network; data recorded in electronic, optical or magnetic form; data carriers; data storage medial memory cards; audio and/or video recordings; downloadable and streamable audio and/or video recordings; pre-recorded videos, CDs, CDIs, CD-ROMs, discs, cassettes and other data carriers containing information recorded in magazine form; Computer peripheral devices; keyboards, mice (data processing), trackballs for moving the cursor and wireless electronic controls, all for use with electronic apparatus for consumers; Data processing equipment; Remote controls; Computer keyboards; audio headphones and headsets for use with computers and video gaming; Downloadable video recordings; computer game programs; game programs for arcade video game machines; video game controllers, namely remote controls, joysticks, interactively controlled floor pads, steering wheels for video games, headphones, keyboards and mice (data processing), all for use with computers and consoles for video game platforms; wireless mice (data processing) and remote controls for use with televisions, computers and set-top boxes (decoders); mouse pads; touch keys (touch pads); computer keyboard controllers; computer programs and software for use in conjunction with the provision of an interface (interface devices or interface programs for computers) between a computer and a peripheral apparatus; interactive user manuals sold as a units with the aforesaid

goods; eyewear; glasses; spectacles; lenses; frames for spectacles and sunglasses; cases and boxes for spectacles and sunglasses; cords, straps and chains for spectacles and sunglasses; sports eyewear; eye protection wear for sports; glasses for sports; magnets; digital photograph frames; covers and cases for mobile phones, computers and personal electronic devices; parts and fittings for all the aforesaid goods.

Trunks and travelling bags; rucksacks; backpacks; bags; beach bags; briefcases; card cases; garment cases for travel; handbags; holdalls; key cases; keyholders; purses; school bags; shopping bags; sports bags; suitcases; wallets; umbrellas, parasols and walking sticks; collars, leashes and clothing for animals; covers for animals; parts and fittings for all the aforesaid goods.

Clothing, footwear, headgear; sports clothing; sports footwear; sports headgear; outerwear; swimwear; socks; underwear; football shirts; football boots and studs for football boots; football shorts; football socks; boots; shoes; caps; hats; beanie hats; baseball caps; garments for protecting clothing; football jerseys; shorts; gloves; training kit and shirts; coats; jackets; t-shirts; sweaters; tracksuits; pants; leggings; sleepwear; pyjamas; dressing gowns; trousers; jeans; replica football kits; clothing belts; parts and fittings for all the aforesaid goods.

Toys; Games and playthings; gymnastic and sporting articles; board games; hand-held, self-contained games apparatus; computer game apparatus; footballs; balls; reduced sized goal posts; blocking dummies; protective padding for sports; shin pads; football gloves; miniature replica football kits; darts and flights therefor, balloons; coin/counter operated games; ordinary playing cards; games adapted for use with television receivers; models being toys; plastic models being toys; teddy bears; stuffed toy bears; puzzles; poker chips; indoor football tables; table football tables; decorations for Christmas trees; confetti; sponge hands in the nature of novelties; rattles; articles for playing golf; golf balls; golf tees; golf ball markers; golf bags; golf club covers; golf gloves; articles for playing darts; darts; sporting articles for use in playing snooker; snooker tables; pool tables; skis; surf boards; skateboards; snowboards; sleighs; sledges (playthings); slides [playthings]; roller skates; in-line skates; rackets; fishing tackle; dice; dominoes; marbles; dolls; action figure toys; soft

toys; bathtub toys; inflatable toys; ride-on toys; toy vehicles; flying discs; kits of parts [sold complete] for constructing models; party novelties, namely streamers, crackers and paper hats; party novelty hats; costume masks; costumes being children's playthings; kites; skittles; exercise balls; gym balls; bags adapted for carrying sporting articles and apparatus; goal posts; goal nets; posts and nets for sports; hurdles and ladders for use in athletics and fitness training; sports training apparatus; fitness training apparatus; body building apparatus; exercise apparatus; indoor fitness apparatus; fitness exercise machines; portable home gymnastic apparatus; sports equipment; bags adapted for carrying exercise equipment and balls; exercise weights; resistance weights; resistance bands; yoga equipment, namely yoga blocks, yoga straps and gym balls for yoga; Pilates equipment, namely exercise bands, resistance bands and Pilates toning balls; exercise machines; exercise balls equipped with interactive computer systems; exercise equipment equipped with interactive computer systems; smart gym and exercise equipment; smart exercise balls; Smart gym and exercise equipment featuring computer hardware and software which tracks user performance; parts and fittings for all of the aforesaid goods.

Advertising and marketing; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotional services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising; Advertising, marketing and promotion services; Marketing; Marketing, advertising and promotion services; Marketing, advertising and promotional services; Promotion [advertising] of business; Promotion of goods and services for others; Promotion of sports competitions and events; Promotion services; Promotion, advertising and marketing of on-line websites.

Telecommunications; communications services; broadcasting services; webcasting services; podcasting services; Audio broadcasting; Video broadcasting; Internet broadcasting services; Satellite broadcasting services relating to sporting events; Streaming of audio and video material via the internet; broadcasting via the Internet and other computer and communication networks; electronic communications services; broadcasting services and provision of telecommunication access to video

and audio content provided via a video-on-demand service via the internet; Audio, video and multimedia broadcasting via the Internet and other communications networks; broadcasting, transmission, reception and other dissemination of text, messages, information, data, sound and images; providing access to a multimedia content and video sharing portal; Provision of telecommunication access to video content provided via the Internet; Transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet; Providing user access to search engines; Provision of access to the internet for others; Communication by online blogs; Telecommunication services provided via platforms and portals on the Internet and other media; Provision of telecommunication access to video and audio content provided via an online video-on-demand service; Video-on-demand transmission services; Transmission of data, audio, video and multimedia files, including downloadable files and files streamed over a global computer network; receiving and exchanging of information, text, sounds, images, data and messages; communications by and/or between computers and computer terminals and computer networks; provision of access to computer databases in the fields of social networking and online communities; electronic display of information, text, images, messages and data; online communication services; chat room services; providing on-line chat rooms and interactive discussion forums; providing user access to portals on the Internet; providing user access to platforms on the Internet; provision of online forums for communication on topics of general interest; provision of online forums relating to education and entertainment, music, fashion, films, food, careers, women, travel, sports, adventure and lifestyle; provision of online community forums for uploading, posting, storing, displaying, sharing, watching, viewing, playing, editing, downloading, receiving, electronically transmitting or otherwise providing electronic media, multimedia content, audio and video content, movies, music, games, photos, images, pictures, graphics, text, messages, information, data, news and user-generated content via the Internet and other computer and communication networks; electronic transmission of news and current affairs information; information, advisory and consultancy services relating to all of the aforesaid services.

Entertainment agency services; Entertainment by IP-TV; Entertainment by film; Entertainment by means of radio; Entertainment by means of telephone; Entertainment by means of wireless television broadcasts; Entertainment in the form

of television programmes (Services providing -); Entertainment in the nature of mobile phone television; Entertainment in the nature of soccer games; Entertainment services; Entertainment services for sharing audio and video recordings; Entertainment services in the form of television programmes; Entertainment services in the nature of interactive television programmes; Entertainment services in the nature of sporting events; Administration [organisation] of entertainment services; Arranging of entertainment shows; Conducting of entertainment activities; Education, entertainment and sport services; Education, entertainment and sports; Fan club services (entertainment); Film production for entertainment purposes; Information about entertainment and entertainment events provided via online networks and the Internet; Information relating to entertainment, provided on-line from a computer database or the internet; Interactive entertainment; Interviewing of contemporary figures for entertainment purposes; On-line entertainment; Online interactive entertainment; Organising of entertainment; Preparation of entertainment programmes for broadcasting; Providing entertainment information via a website; Providing video entertainment via a website; Provision of entertainment information; Provision of entertainment information via television, broadband, wireless and on-line services; Provision of entertainment information via the Internet; Provision of entertainment via podcast; Provision of information relating to entertainment online from a computer database of the Internet; Provision of on-line entertainment; Entertainment; Entertainment services provided by on-line streams; Entertainment services provided by television; Services for the production of entertainment in the form of video; Television and radio entertainment; Television entertainment; TV entertainment services; Video entertainment services; Entertainment in the nature of football games; Video recordings [not downloadable] provided from the internet; Providing online videos, not downloadable; Entertainment provided via the internet; Entertainment services provided on-line from a computer database or the internet; Sporting results services; Sports and fitness; Sports entertainment services; Sports information services; Entertainment services relating to sport; Entertainment services relating to sporting events; Organisation of sports events in the field of football; Providing information about sporting activities; Providing information relating to sports; Providing sports entertainment via a website; Providing sports information; Providing sports news; Provision of information relating to sporting events; Provision of information relating to sports; Provision of information relating to sports persons;

Provision of news relating to sport; Organising of football events; Provision of entertainment information via the Internet.

ANNEX 3

Dear Sir or Madam,

I write further to the Case Management Conference (“CMC”) which took place before me on 17 April 2023. The purpose of the CMC was to discuss R L Media Limited’s (“RLM”) second request for a retrospective extension of time to file evidence. RLM sought permission to file as evidence in these proceedings a family court judgment in the divorce of Mr Robin Lyle (of RLM) and Ms Simone Davids-Lyle (of Total Fan TV Limited) (“TFT”).

On 30 March 2023, a preliminary view was issued refusing the request on the basis that it was not clear what relevance the judgment had. The same letter offered RLM the opportunity to request a CMC if it wished to challenge the preliminary view and noted as follows:

“If [RLM] requests a CMC, they should be prepared to:

- (1) Outline any authority for the fact that ownership of shares impacts upon ownership of goodwill; and
- (2) Explain how the transfer of shares discussed in the judgment relates to their bad faith claim as pleaded i.e. that Total Fan TV Limited (“TFT”) had prior knowledge of RLM’s alleged rights and that the purpose of filing the application was to block RLM’s legitimate business or divert business away from RLM.”

At the CMC, RLM was represented by Mr Stobbs, of Stobbs and TFT was represented by Mr Parrish, of CMC Cameron McKenna Nabarro Olswang LLP.

Mr Stobbs submitted that the application had been made promptly upon the handing down of the judgment. He also submitted that no prejudice would be caused to either party, as both had prior knowledge of the matters contained within the judgment (through their controlling minds, Ms Simone Davids-Lyle and Mr Lyle). I agree with

these points in principle, although I note that granting the extension is likely to increase costs for TFT, on the basis that they would have to be given an opportunity to respond.

Mr Stobbs submitted that the key question for me to decide in relation to RLM's application is the materiality of the evidence. I agree.

In this regard, I note that no reference is made in the judgment to who owns the marks/signs relied upon in these proceedings. There is reference made to the shareholding of the companies, but the ownership of shares in a company is entirely different to the ownership of goodwill. Mr Stobbs did not identify any authorities that would suggest otherwise. Mr Stobbs (in my view, rightly) accepted that the judgment was more relevant to the question of bad faith, than passing off. I can see nothing in the judgment that will have an impact upon the question of who owns the goodwill and, consequently, I do not consider the evidence to be material to the section 5(4)(a) ground.

Turning to the materiality of the evidence to the section 3(6) ground, there are two issues for RLM as I see it:

- 1) It appears from Mr Stobbs' submissions that they were seeking to rely on a pattern of behaviour on the part of Ms Davids-Lyle (and, by association, TFT) and that the transfer of shares referenced in the judgment was part of the pattern. However, this is not pleaded in their Form TM7 which simply states that TFT had prior knowledge of RLM's alleged rights and that the application was intended to block their use of their mark and/or divert business away. There is no reference in the Form TM7 to a transfer of shares.
- 2) Even if the pleading could cover the alleged pattern of behaviour, there is nothing in the judgment which actually confirms that there is anything wrong in the conduct of Ms Davids-Lyle. The judgment makes reference to allegations that both parties had been attempting to divert matrimonial assets and there is a reference to the amount paid for the shares appearing to fall below the valuation. However, as Mr Parrish submitted, no judgment is passed on these points as the judgment is focusing upon an appeal from a disclosure

application. Consequently, I do not consider that the judgment carries the weight that RLM suggests it does.

Taking all of this into account, **the application for a retrospective extension of time to file evidence is refused.**

Yours faithfully

Stephanie Wilson

Trade Marks Registry