

O/0901/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3978460

IN THE NAME OF STACEY O'CONNOR

FOR THE FOLLOWING TRADE MARK:

Colt Security

IN CLASS 13

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 507231

BY DROPNET LTD

BACKGROUND AND PLEADINGS

1. Stacey O'Connor ("the proprietor") is the registered proprietor of trade mark number 3978460, **Colt Security** ("the proprietor's mark"). The proprietor's mark was filed on 12 November 2023 and became registered on 16 February 2024. It stands registered for *personal self defence sprays* in class 13.

2. On 12 April 2024, DropNet Ltd ("the applicant") made an application for a declaration of invalidity in respect of the proprietor's mark pursuant to section 47 of the Trade Marks Act 1994 ("the Act"). The application is based upon sections 5(2)(a), 5(3), 5(4)(a) and 3(6) of the Act.

3. For the purposes of its claims under sections 5(2)(a) and 5(3), the applicant relies upon its trade mark registration number 3640370, **Colt Security** ("the applicant's mark"). The applicant's mark was filed on 12 May 2021 and became registered on 3 December 2021. It stands registered for the following goods, all of which are relied upon by the applicant:

Class 9: Alarms; electric alarms; baby alarms; security alarms; acoustic alarms; whistle alarms; pool alarms; alarm panels; central alarms; alarm installations; smoke alarms; fire alarms; alarms (fire -); alarm systems; personal alarms; sound alarms; alarm sensors; alarm bells; gas alarms; theft alarms; burglar alarms; electronic burglar alarms; smoke alarm testers; natural gas alarms; personal alarm apparatus; personal security alarms; alarm signalling receivers; acoustic sound alarms; bells (alarm -), electric; alarm signalling transmitters; radio alarm clocks; anti-intrusion alarms; alarm monitoring systems; acoustic [sound] alarms; alarm central units; alarm bells, electric; electric alarm bells; alarm sensors for refrigerators; gas leak alarm systems; keypads for security alarms; electronic anti-theft alarms; water leakage detection alarms; electric alarms for smoke; alarms and warning equipment; electric alarms for fire; security software; secure microprocessors; security cameras; automatic security barriers;

electronic security tags; holographic security apparatus; security warning apparatus; security surveillance robots; handheld security wands; security control apparatus; security surveillance apparatus; access security apparatus (automatic -); security tapes (adhesive -) [encoded]; access security apparatus (electric -); security apparatus for elevators; security tokens [encryption devices]; downloadable computer security software; hand-held security wands; security tapes (adhesive -) [magnetic]; control panels for security alarms; secure digital (SD) card readers; utility, security and cryptography software; secure terminals for electronic transactions; electronic personal alarm devices.

4. In its statement of grounds, the applicant contends that the competing marks are identical and that the parties' goods are similar. On this basis, the applicant submits that there is a likelihood of confusion and requests that the proprietor's mark be declared invalid under section 5(2)(a).

5. Under section 5(3), the applicant claims that its mark enjoys a reputation in respect of all the goods listed above. It submits that use of the proprietor's mark, without due cause, would take unfair advantage of, and/or be detrimental to, the repute and distinctive character of its mark. The applicant also argues that the relevant public would mistakenly believe there is an economic connection between the users of the competing marks.

6. Under section 5(4)(a), the applicant claims that it has goodwill in its business in relation to which it has used the sign **COLT SECURITY** throughout the UK since 2021. The applicant claims that the sign has been used in respect of *alarm, safety alarm and pepper spray*. The applicant submits that use of the proprietor's mark would be contrary to the law of passing off.

7. As for section 3(6), the applicant contends that the proprietor's mark was filed in bad faith. In this regard, the applicant claims that the proprietor knowingly and intentionally sought to unfairly benefit from the reputation and goodwill associated with the applicant's mark; the proprietor is said to have obtained her registration with

complete knowledge of the applicant's mark with the intention of unfairly competing, exploiting the applicant's market presence, and disrupting its business operations. The applicant argues that this is demonstrated through the proprietor's swift reporting of its Amazon listings without any legitimate use of her mark.

8. The proprietor filed a counterstatement, denying the grounds of invalidity. In respect of all the applicant's claims under section 5, the proprietor's position is that the parties' goods are sufficiently different. The proprietor also denies that there were any malicious intentions behind applying to register her mark and submits that the application was filed in good faith.

9. Only the applicant filed evidence. The proprietor filed written submissions during the evidence rounds. A hearing was requested and held before me, by video conference, on 25 September 2025. The applicant was represented by its Director, Mashiullah Hafezjee.¹ The proprietor was represented by her Business Manager, Atuba Shahid.

EVIDENCE AND SUBMISSIONS

10. The applicant's evidence is given in a witness statement from Mr Hafezjee, dated 8 August 2024, together with eight exhibits (MH1-MH8). Mr Hafezjee has been the applicant's Director since 2021. His evidence largely goes to the use made of the applicant's mark/sign, though he also provides evidence regarding reports made by the proprietor on Amazon.

11. The proprietor filed written submissions dated 10 October 2024.

12. I have taken all the evidence and submissions (including those made orally at the hearing) into account in reaching my decision and will refer to them below where necessary.

¹ Mr Hafezjee was assisted at various points in the hearing by his colleagues, Marta and Victor.

DECISION

13. Sections 5(2)(a), 5(3), 5(4)(a) and 3(6) of the Act have application in invalidation proceedings because of the provisions of section 47 of the Act, which reads as follows:

“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).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

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

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(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.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

[...]

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

[...]

(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.”

14. The applicant’s mark qualifies as an ‘earlier trade mark’ pursuant to section 6(1)(a) of the Act. As it had not completed its registration process five years or more before the date on which the application for a declaration of invalidity was filed, it is not subject to the use provisions set out above. Consequently, the applicant may rely upon all its class 9 goods for the purposes of its claims under sections 5(2)(a) and 5(3), without having to establish genuine use.

Preliminary remarks

15. I note that, within her counterstatement, the proprietor highlighted that the respective goods are in different classes. Moreover, she argued that the potential for confusion is “*speculative and unsubstantiated*” because the parties operate in “*vastly different market segments*”. The same arguments were made in her written submissions. I must point out that these points will, as a matter of law, have no bearing on the outcome of this decision. As section 60A of the Act makes clear, whether goods are in the same or different classes is not decisive in determining whether they are similar or dissimilar. Furthermore, the applicant’s mark had not been registered for five years at the filing date of the proprietor’s mark, meaning that the former is entitled to protection against a likelihood of confusion with the latter based upon its notional use for all the goods listed in the register. As Laddie J explained in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41:

“22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer’s use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place”.

16. Furthermore, it is necessary to consider all the circumstances in which the proprietor’s mark might be used.² My assessments must take into account the goods in the specification of the proprietor’s mark and whether there is any potential conflict

² *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

with the goods in the specification of the applicant's mark. Any differences between the actual goods provided by the parties, or the particular segments of the market they target, are not relevant unless those differences are apparent from the parties' marks.

17. I also note that, at the hearing, Ms Shahid submitted that *“the IPO’s own expert [...] examined both marks and concluded that they operate in separate classes with no sufficient similarity to cause confusion”*. This appears to be a reference to the fact that the IPO’s examination team did not notify the applicant of the proprietor’s application during its examination, as explained in the Tribunal’s correspondence dated 4 June 2024. Whilst this is noted, the initial search conducted during the examination of an application is undertaken to identify potentially conflicting marks and is not an exhaustive search of the register. Ultimately, I am not bound by it. The fact that the applicant was not notified of the proprietor’s application during the examination process (and any reasons for that) will have no bearing on the outcome of this decision. I must conduct my own assessment, taking into account all the relevant factors.

18. Finally, in her skeleton argument, the proprietor repeatedly highlighted that the applicant did not oppose her mark during the opposition period and argued that this ought to be taken as an acceptance that there is no conflict between the marks. A similar line of argument was advanced by Ms Shahid at the hearing. I do not agree. A party may choose not to oppose an application for a variety of commercial or strategic reasons. They may not even be aware of the application. It is not open to me to infer the reasons for a party’s decision to oppose or not oppose an application. The Act provides for both opposition and invalidity proceedings. A party should not be prejudiced in invalidity proceedings by the mere fact that it did not oppose the application during the opposition period.

Section 5(2)(a)

Legislation and case law

19. Sections 5(2)(a) and 5A of the Act read as follows:

“5(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, [...]

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

20. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Identity of the marks

21. At the hearing, Ms Shahid conceded on behalf of the proprietor that the competing marks are identical. Clearly, that is the case: the competing marks both consist of the words ‘Colt Security’.

Comparison of goods

22. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23, that:³

“In assessing the similarity of the goods or services concerned, [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

23. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the relevant factors identified by Jacob J (as he then was) for assessing similarity also included the users of the goods and the trade channels through which they reach the market.

24. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that ‘complementary’ means:

³ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

25. For the purposes of the comparison, I will consider the applicant's *personal alarms*. I agree with Ms Shahid that these goods differ in nature from *personal self defence sprays*. In my view, the respective goods also have different methods of use. It is my understanding that the proprietor's goods are sprays which are dispensed from a canister or other container. Conversely, the applicant's goods include personal safety alarms, which comprise small, portable devices which are activated to produce a loud noise. As the respective goods are not important or indispensable to one another, they are not complementary. However, I agree with the applicant to the extent that there is an overlap in intended purpose. This is because both may be used for self-defence. In addition, the respective goods may share users, as consumers of self-defence sprays may also purchase personal safety alarms. To my mind, there is a degree of competition between the respective goods. This is on the basis that a consumer looking for products for self-defence could reasonably purchase a personal safety alarm over a self-defence spray, or vice versa. I also agree with Mr Hafezjee that the goods are likely to reach the market through overlapping trade channels, but not because they may both be sold through Amazon. An extremely wide range of disparate goods are sold through such platforms, meaning that it would be inappropriate to conclude that there is an overlap in trade channels solely on that basis. Nevertheless, it is my view that an undertaking specialising in self-defence products, such as the proprietor's sprays, may also offer personal safety alarms. Taking all of the above factors into account, I find that there is a medium degree of similarity between the respective goods.

Average consumer

26. As the authorities indicate, I must determine who the average consumer is for the parties' goods and how they are likely to be selected. The average consumer is

deemed to be reasonably well informed, observant and circumspect.⁴ In *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, Arnold LJ explained that:⁵

- (i) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (ii) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (iii) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (iv) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (v) The average consumer's level of attention varies according to the category of goods or services in question; and
- (vi) The average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

⁴ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited* [2014] EWHC 439 (Ch)

⁵ Approved by the Supreme Court in *Iconix* (cited above).

27. The average consumer of the goods at issue is likely to be a member of the general public. The frequency with which the goods are purchased is likely to vary, although they are unlikely to be purchased particularly regularly. The cost of the goods may also vary but, overall, they are likely to be relatively inexpensive. As the goods concern the user's safety and self-defence, the purchasing process is unlikely to be merely casual. When selecting the parties' goods, the average consumer may consider factors such as ease of use, reliability, size, portability and effectiveness. Taking these factors into account, I find that the average consumer will demonstrate a medium level of attention during the purchasing process. The goods are likely to be purchased in retail outlets, and their online equivalents, wherein they will be selected after being viewed on shelves, displays, or in images on websites. Consequently, the purchasing process is likely to be predominantly visual in nature. However, I do not discount aural considerations entirely, as the average consumer may wish to discuss such products with a sales assistant prior to purchase.

Distinctive character of the earlier mark

28. In *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

29. Registered trade marks possess varying degrees of inherent distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion: the more distinctive the earlier mark, the greater the likelihood of confusion.

30. The applicant’s mark is in word-only format and consists of the words ‘Colt Security’. The word ‘colt’ is a dictionary word with a number of meanings, including a young, male horse; an awkward or inexperienced young person; and a member of a junior sports team.⁶ In my view, the average consumer is likely to be aware of at least one of these meanings. Whichever particular meaning is attributed to it, it is this word in which the distinctiveness of the mark lies. It is a dictionary word which has no descriptive or allusive qualities. The word ‘Security’ is descriptive or strongly allusive of the kind and/or intended purpose of the goods relied upon (and which formed the basis for similarity with the proprietor’s goods); it does not increase the distinctiveness of the mark over and above that provided by the word ‘Colt’. Overall, I find that the applicant’s mark possesses a medium level of inherent distinctive character.

31. Evidence has been filed and I must now consider whether, at the relevant date of 12 November 2023, the distinctive character of the applicant’s mark had been enhanced through use.

32. In his statement, Mr Hafezjee says that the applicant has been providing “*security-related goods under Class 9*” since 2021. These are said to have become “*best sellers*” on various e-commerce platforms. Mr Hafezjee says that this includes being recognised as an ‘Amazon Choice’ product, said to signify a high level of customer satisfaction and robust sales performance. In support, Mr Hafezjee provides copies of

⁶ <https://www.collinsdictionary.com/dictionary/english/colt>

the applicant's sales records. Insofar as they are relevant to the present assessment, they comprise the following:

(i) Printouts from the applicant's Amazon account, showing an order on 2 December 2022 for a multipack of 'Colt Security' products which included a panic alarm (£19.95).⁷ The order was placed through Amazon.co.uk;

(ii) Printouts from the applicant's Amazon account, showing orders on 26 July 2023 and 5 August 2023 for multipacks of 'Colt Security' products which included a panic alarm (£17.95 and £19.95, respectively).⁸ The order was placed through Amazon.co.uk;

(iii) Printouts from the applicant's Amazon account, showing 5,787 orders of a multipack of 'Colt Security' products which included a panic alarm (£17.95).⁹ The orders were placed through Amazon.co.uk between 7 March 2021 and 3 March 2024. 200 of the orders shown were after the relevant date. Those from before the relevant date were placed in August 2022, September 2022, June 2023 and October 2023. A small number were cancelled or refunded;

(iv) Printouts from the applicant's Amazon account, showing 1,107 orders of a 'Colt Security' multipack which included a panic alarm (£19.95).¹⁰ The orders were placed through Amazon.co.uk between 7 March 2021 and 3 March 2024. 100 of the orders shown were after the relevant date. Those from before the relevant date were placed in August 2022 and September, October and November 2023. A small number of the orders were cancelled or refunded.

33. Mr Hafezjee also says that a search for 'COLT SECURITY' on Google prominently displays the applicant's products, which he says is indicative of strong brand recognition and market presence. In this regard, and insofar as is relevant to the present assessment, he provides printouts of Google search results for the term "*colt*

⁷ Exhibit MH1

⁸ Exhibit MH2

⁹ Exhibit MH3

¹⁰ Exhibit MH4

security alarm [...]".¹¹ However, this is dated 8 August 2024, i.e. after the relevant date. As such, it cannot be relied upon as showing the position at the relevant date.

34. Whilst Mr Hafezjee has provided other evidence, none of it relates to the goods relied upon under this ground. Therefore, it will not be discussed at this stage.

35. Based upon the above, it is clear that the applicant traded in panic alarms (which fall within *personal alarms*) before the relevant date. Given that they were conducted through Amazon.co.uk, I accept that the sales shown in evidence were to customers in this jurisdiction. Moreover, since Amazon is a nationwide trading platform, the sales were likely to have been throughout the UK. However, the sales records indicate that fewer than 7,000 units of relevant goods were sold before the relevant date. This is a modest level of business which is not indicative of intensive use of the applicant's mark. Nor is the evidence indicative of longstanding use of the applicant's mark; the earliest order was placed in August 2022, only around 15 months before the relevant date. The evidence also has several key deficiencies. For example, no turnover figures or market share information has been provided.¹² Moreover, there is no evidence regarding any amounts spent by the applicant on promoting its mark in the UK. There is also no evidence of any promotional activities being conducted before the relevant date. In light of all this, I find that the evidence falls a long way short of establishing that the distinctive character of the applicant's mark had been enhanced at the relevant date.¹³

Likelihood of confusion

36. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree

¹¹ Exhibit MH8

¹² Although turnover figures were included in the applicant's skeleton argument, these were not in Mr Hafezjee's witness statement. At the hearing, I did not receive an adequate explanation of how the figures had been calculated or unambiguous confirmation that they were based on matters which were in evidence. I do not, therefore, consider it appropriate to take them into account.

¹³ For the sake of completeness, I confirm that my finding would have been the same even if I had taken the turnover figures into account. The turnover totalled only around £420,000, which was not broken down by reference to the different products sold under the mark.

of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the applicant's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

38. Earlier in this decision, I concluded as follows:

- (i) The competing marks are identical;
- (ii) The parties' goods are similar to a medium degree;
- (iii) The average consumer is a member of the general public, who will demonstrate a medium level of attention;
- (iv) The purchasing process is predominantly visual in nature, though aural considerations have not been excluded;
- (v) The applicant's mark possesses a medium level of inherent distinctive character, which has not been enhanced through use.

39. In consideration of all the above factors, I find that there is a likelihood of direct confusion. Taking into account the principles of interdependency and imperfect recollection, it is my view that the identity of the competing marks, the medium level of distinctive character of the applicant's mark and the medium degree of similarity

between the parties' goods will result in the average consumer, paying a medium level of attention, mistaking one mark for the other.

Conclusion

40. The applicant's claim under section 5(2)(a) is successful.

Section 5(3)

Legislation and case law

41. Section 5(3) of the Act states:

“(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

42. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

43. The relevant case law can be found in the following judgments of the CJEU: *General Motors*, Case C-375/97, *Intel*, Case C-252/07, *Adidas-Salomon*, Case C-408/01, *L'Oréal v Bellure*, Case C-487/07, *Marks and Spencer v Interflora*, Case C-323/09, and *Environmental Manufacturing LLP v OHIM*, Case C-383/12 P. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas-Salomon, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure*).

44. The conditions of section 5(3) are cumulative. Firstly, the applicant must show that its mark is identical or similar to the proprietor's mark.¹⁴ Secondly, the applicant must show that its mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Thirdly, the applicant must establish that the public will make a link between the marks, in the sense of its mark being brought to mind by the proprietor's mark. Finally, assuming the foregoing conditions have been met, section 5(3) requires that one or more types of damage claimed by the applicant will occur. It is not necessary for the purposes of section 5(3) that the goods are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

45. The relevant date for the assessment under this ground is the filing date of the proprietor's mark, namely 12 November 2023.

¹⁴ Given my finding at paragraph 21, this condition is clearly satisfied.

Reputation

46. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

47. I have already found that the evidence is not sufficient for the purposes of establishing that the distinctive character of the applicant’s mark had been enhanced by the relevant date. Whilst I acknowledge that reputation and enhanced distinctive character are different, the nature, factors, and evidence used to prove them are the same.¹⁵ For the same reasons as given at paragraph 35, I am not satisfied that the evidence demonstrates that the applicant’s mark had a reputation in the UK at the relevant date. Without a qualifying reputation, this ground must fail.

¹⁵ *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

Conclusion

48. The applicant's claim under section 5(3) is dismissed.

Section 5(4)(a)

Legislation and case law

49. Section 5(4)(a) of the Act 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,

[...]

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.”

50. 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.”

51. 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).”

52. As there is no evidence that the proprietor’s mark was used before its filing date, the relevant date for assessing this ground is the filing date of the proprietor’s mark, namely 12 November 2023.¹⁶

Goodwill

53. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

“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.”

¹⁶ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, paragraph 43

54. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J (as he then was) stated that:

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

55. In *Smart Planet Technologies, Inc. v Rajinda Sharma*, BL O/304/20, Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31. After reviewing these authorities, Mr Mitcheson concluded that:

“[...] a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

56. Under the present ground, the applicant relies upon *alarm, safety alarm and pepper spray*. I have already assessed the evidence in respect of the applicant's alarms and found that it was not sufficient in the context of reputation and enhanced distinctive character. Nevertheless, that does not preclude a finding of goodwill since a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill may be small.¹⁷ Reputation and goodwill are subject to different tests, with the latter typically having a lower threshold than the former.¹⁸

57. Whilst the limitations with the evidence remain, it does clearly show that the applicant sold panic alarms under the sign 'COLT SECURITY' to customers in the UK before the relevant date. The evidence does not display every order represented by the headline totals.¹⁹ Moreover, a small number of orders were cancelled or refunded, and a proportion of them occurred after the relevant date. However, Mr Hafezjee's unchallenged narrative evidence is that each record pertains to a single product (with a unique 'SKU' number). This is consistent with the documentary evidence, in particular, the order filters shown in each record. The evidence shows around 6,500 orders for panic alarms before the relevant date. This represents a modest level of trade. It was also conducted over a 15-month period, which is not indicative of longstanding trade. Nevertheless, sales were regular, with orders in August 2022, September 2022, December 2022, June 2023, July 2023, August 2023, September 2023, October 2023 and November 2023. Some of the orders also appear to have been placed on a "*Subscribe & Save*" basis, suggesting some repeat custom. In my view, the facts of this case can be distinguished from those in *Smart Planet Technologies* (cited above). In that case, 10 invoices had been issued to two customers in the UK, representing the sale of around 40,000 paper cups (in the context of a market in the UK of around 2.5 billion cups per annum). On the balance of all the evidence, I am satisfied that the applicant's business in personal safety alarms had a small, but more than trivial, goodwill at the relevant date. I am also satisfied that the sign 'COLT SECURITY' was distinctive of that goodwill.

¹⁷ See, for instance, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

¹⁸ *Seeley International Pty Ltd v Shenzhen TCL New Technology Co., Ltd*, BL O/0350/26, paragraph 72

¹⁹ For example, not all 5,787 orders appear to be included in Exhibit MH3.

58. In respect of pepper spray, the sales records provided by Mr Hafezjee include the following:

(i) Printouts from the applicant's Amazon account, showing 8,944 orders of a two-pack of 'Colt Security' self-defence sprays (£17.99) through Amazon.co.uk between 1 March 2021 and 2 March 2024.²⁰ 300 of the orders shown were from after the relevant date. Those from before the relevant date were placed in October and December 2022. A small number of orders were cancelled or refunded;

(ii) Printouts from the applicant's Amazon account, showing 10,000+ orders of a 'Colt Security' self-defence spray (£9.95) through Amazon.co.uk between 1 March 2021 and 2 March 2024.²¹ 100 of the orders shown were after the relevant date. Those from before the relevant date were placed in July, August and October 2023. Again, a small number were cancelled or refunded;

(iii) Printouts from the applicant's Amazon account, showing two orders for a 'Colt Security' self-defence spray.²² The orders were placed through Amazon.co.uk on 19 August 2022 and 4 October 2023;

(iv) Printouts from the applicant's Amazon account, showing an order for a 'Colt Security' self-defence spray on 19 August 2022.²³ The order was placed through Amazon.co.uk.

59. Mr Hafezjee has also provided evidence of customer reviews in respect of such goods, which comprises the following:

(i) Feedback for a 'Colt Security' self-defence spray product from verified purchasers.²⁴ The feedback appears positive, though none of it is dated.

²⁰ Exhibit MH1

²¹ Exhibit MH2

²² Exhibit MH3

²³ Exhibit MH4

²⁴ Exhibit MH5

Although there are labels such as “*Past month*” and “*More than a year ago*”, I cannot determine with any degree of certainty when the feedback was given;

(ii) A printout from securityguards.org.uk, showing a security guard posting about a ‘Colt Security’ self-defence spray.²⁵ The post received 256 views. It is not dated. It contains an indication “1y”, which may mean that it was posted a year prior to it being obtained. However, I cannot determine with any degree of certainty when this was;

(iii) A printout from X (formerly Twitter), showing a user posting an image of a ‘Colt Security’ personal security spray.²⁶ The post is dated 15 January 2023. The image shows that the product was ‘Amazon’s Choice’ for “pepper spray” at that time. It seems as though the user was a UK purchaser, given that they comment on what is legal in the UK along with “*we need them*”. The post had over 50,000 views;

(iv) Still images of two videos on YouTube which featured ‘Colt Security’ personal security sprays.²⁷ The quality is poor, but it appears that the accounts had around 400 or so subscribers each. The videos appear to have had 17 likes and one like, respectively. Neither the videos nor any comments are dated. Links to the videos have been included in the evidence, but it is not for me to conduct independent research.

60. Finally, I note that the evidence from Google includes search results for the terms “*colt security [...] pepper spray*” and “*Colt security UK legal spray*”.²⁸ Whilst Mr Hafezjee considers the search results indicative of strong brand recognition and market presence, the former is from after the relevant date, whilst the latter is not dated at all.

²⁵ Exhibit MH5

²⁶ Exhibit MH5

²⁷ Exhibit MH6

²⁸ Exhibit MH8

61. The evidence in respect of these goods also has its limitations. Again, there are no turnover figures and there is no market share information. There is no evidence regarding the amounts which were spent on promoting the 'COLT SECURITY' sign in the UK prior to the relevant date, and no evidence of any such activities being conducted. A significant amount of the evidence is either undated or from after the relevant date, including some of the orders, the customer feedback, the post on securityguards.org.uk, the YouTube videos, and the Google search results. Moreover, whilst the post on X was from before the relevant date, and received quite a large number of views, there is no way of knowing how many of those views occurred before the relevant date, and there is no way of knowing how many of those views were from internet users based in the UK.

62. As was the case with the personal safety alarms, the evidence does not display every order represented by the headline totals. In addition, a small number of the orders were cancelled or refunded, and a proportion of them were placed after the relevant date. However, on the basis of Mr Hafezjee's unchallenged narrative evidence and the documentary evidence, I accept that each record relates to a single product (with a unique 'SKU' number). In this regard, the evidence shows that there were at least 18,500 orders for 'COLT SECURITY' self-defence sprays before the relevant date. These were purchased by UK customers over a 15-month period. Whilst still representing a relatively modest level of trade, which was not particularly longstanding, the position here is stronger than it was for the applicant's personal safety alarms. Regular sales were made in August 2022, October 2022, December 2022, July 2023, August 2023 and October 2023. Again, some of the orders also appear to have been placed on a "*Subscribe & Save*" basis, suggesting some repeat custom. Having already found that the evidence in respect of personal alarms was sufficient for the purposes of demonstrating a small, but more than trivial, goodwill at the relevant date, I make the same finding in respect of the applicant's self-defence sprays. Again, I am satisfied that the sign 'COLT SECURITY' was distinctive of that goodwill.

63. I acknowledge that the term 'self-defence sprays' differs from 'pepper spray' (as was claimed by the applicant). It is my understanding that the latter refers to a chemical spray, used for self-defence or crowd control, which cannot legally be sold to the

general public in the UK. On the basis of the evidence before me, the applicant's product is not actually a pepper spray. Rather, it appears to be a criminal identifier spray marketed as a legal self-defence product and, in many cases, presented to the public as a legal alternative to pepper spray. I accept that 'pepper spray' has a specific meaning which does not accurately describe the applicant's product. However, I consider that it would be disproportionate to conclude that the applicant cannot rely on any goodwill in relation to its self-defence sprays purely because they were inaccurately described in the pleadings as 'pepper spray'. It seems clear to me from the evidence and the manner in which the proceedings were conducted that the applicant used 'pepper spray' as a catch-all term to refer to the self-defence spray shown in its evidence. This must have been sufficiently clear to the proprietor, who has also not raised this issue or argued that the applicant has not sold pepper sprays. The applicant was clearly intending to refer to the self-defence spray it has sold, rather than actual pepper spray. Notwithstanding the description in the pleadings, I am content to proceed on the basis that the goodwill in the applicant's business extends to self-defence sprays (in addition to personal safety alarms).

Misrepresentation and damage

64. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ 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.”

65. Later in the same judgment, it was stated that:

“[...] 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.”

66. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lloyd LJ commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

67. *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."

68. The proprietor's mark is identical to the applicant's 'COLT SECURITY' sign. Moreover, the proprietor's goods are identical to the goods in which the applicant has traded and accrued goodwill, namely self-defence sprays. I find that a substantial number of the applicant's actual or potential customers will be deceived into believing that the goods provided under the proprietor's mark and the applicant's sign are offered by the same or economically linked undertakings. In the circumstances, I consider that damage through diversion of sales is entirely foreseeable.

69. Even if I was wrong to proceed on the basis that the applicant's goodwill extended to self-defence sprays, I would reach the same conclusion regarding misrepresentation and damage. This is because I have also found that the applicant's goodwill extends to personal safety alarms. In *Marks and Spencer PLC v Interflora* [2012] EWCA Civ 1501, Lewison LJ cast doubt on whether the test for misrepresentation for passing off purposes amounted to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not mean that the average consumer is confused. However, considering the Court of Appeal's later judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.²⁹ This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. I have already found that there is a likelihood of direct confusion between the proprietor's mark and a registered mark equivalent to the applicant's sign. This was on the basis of the applicant's *personal alarms*, which are identical to the personal safety alarms to which the applicant's goodwill extends. For the same reasons as given under section 5(2)(a), I find that a substantial number of the applicant's actual or potential customers would be deceived. Damage through diversion of sales is also foreseeable here.

²⁹ Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

Conclusion

70. The applicant's claim under section 5(4)(a) is successful.

Section 3(6)

71. 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.”

72. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin SCJ considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described.

Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 [...]."

73. Later in his judgment (at paragraph 240), Lord Kitchin summarised the general principles applicable to bad faith as follows:

"(i) [...]"

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevenet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*"), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*"), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45;

[*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), para 45].

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([*Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”), paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to

the goods or services in relation to which it is sought to register the mark, or that the applicant has a bona fide intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

74. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies, i.e. the balance of probabilities. This means that it is not enough to establish facts which are as consistent with good faith as bad faith.³⁰ It is necessary to ascertain what the applicant knew at the relevant date, that being 12 November 2023. Evidence about subsequent events may be relevant if it casts light backwards on the position at the relevant date.³¹

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

- (i) What, in concrete terms, was the objective that the applicant (in this case, the proprietor) has been accused of pursuing?
- (ii) Was that an objective for the purposes of which the contested application could not be properly filed?
- (iii) Was it established that the contested application was filed in pursuit of that objective?

76. The applicant's pleaded case on bad faith is as follows:

"The registration of the trademark "Colt Security" under Class 13 was obtained in bad faith, with the complete knowledge that our registered trademark "Colt

³⁰ *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)

³¹ *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)

Security" belongs to us. The registered owner knowingly and intentionally sought to unfairly benefit from the reputation and goodwill associated with our mark in Class 9 by registering an identical mark in Class 13. This registration was obtained with complete knowledge of our prior trademark rights in Class 9 and with the intention to unfairly compete and exploit our market presence.

[...]

It is evident that the registered owner filed their trademark application with malicious intentions to disrupt our business operations and unfairly gain an advantage in the market. The timing of their registration coincides directly with our established presence and success in the market, indicating a deliberate attempt to exploit our brand recognition and market value. Despite our existing registration under Class 9 for a wide range of security-related products and services, including alarms and security apparatus, the registered owner sought to expand their protection to include a product directly competing with our offerings.

Furthermore, the immediate actions taken by the registered owner following the registration of their mark provide clear evidence of their bad faith intentions. Their swift reporting of our Amazon bestseller listings, coupled with their failure to engage in any legitimate use of the mark, demonstrates a clear motive to hinder our business activities and damage our reputation. And this is evident to state that they were well aware about our trademark and market presence.

The registration of "Colt Security" under Class 13 for pepper spray demonstrates a clear intention to capitalize on our established brand reputation and market success. By expanding their trademark protection to encompass a product category closely related to our own, the registered owner aims to create confusion among consumers and undermine our market position.

The actions of the registered owner in securing registration for pepper spray in Class 13, despite our existing rights and market presence, constitute bad faith. Their deliberate infringement upon our established trademark rights and

attempt to monopolize a product category in which we have a legitimate interest demonstrate a clear disregard for fair competition and the principles of trademark law.

We urge the Intellectual Property Office to recognize the bad faith intentions behind the registration of "Colt Security" under Class 13 for pepper spray and take appropriate action to invalidate the registration. Their actions not only threaten our business interests but also undermine the integrity of the trademark registration system."

77. In concrete terms, the proprietor has been accused of applying for her mark to unfairly benefit from the applicant's reputation/goodwill accrued through use of an identical sign and disrupt the applicant's business operations. If proven, these are objectives for which the application to register the proprietor's mark could not be properly filed.

78. Whilst I appreciate that it is wrong to expect a party to be able to give direct evidence of the motivation of another,³² I consider the evidence to be very limited in terms of establishing what the proprietor's intention was or even setting out objective facts from which inferences can be made.

79. Aside from the applicant's own use of its mark/sign, its evidential case on bad faith rests on Mr Hafezjee's evidence of the applicant's product listings being removed from Amazon following the registration of the proprietor's mark, as set out in his statement. In support, Mr Hafezjee provides communications from Amazon dated 1 March 2024 and 6 March 2024.³³ The communications are entitled "*Notice: Policy Warning*" and explain that Amazon had removed the applicant's listings after they received reports from the proprietor that they infringed her trade mark, which Amazon decided were valid. The reports from the proprietor were said to be as follows:

³² *Maya Appliances Pvt. Ltd v Prapaharan Sivaratnam*, BL O/0052/25, paragraph 27

³³ Exhibit MH7

“The following ASINS are in violation of my Intellectual property as they are being sold under my trademark ‘COLT SECURITY’.

B09HKVLKHM

B09MV2LGCK

B096B32394

Please remove with immediate effect.

Trade mark number: UK00003978460

[...]”

And

“The following ASIN is in violation of my Intellectual property as they are being sold under my trademark ‘COLT SECURITY’.

B09HKWGHN4

Please remove with immediate effect.

Trade mark number: UK00003978460

[...]”

80. The listings reported by the proprietor were the applicant’s ‘COLT SECURITY’ panic alarms and self-defence sprays; the ‘ASIN’ codes in the reports match those of the products shown in the Amazon order records discussed earlier in this decision.³⁴

81. The applicant’s evidence shows that it has been trading on Amazon (UK) under its ‘COLT SECURITY’ sign since August 2022. This had been the case for around 15 months when the proprietor filed the application to register her mark on 12 November 2023. I have already found that the applicant’s business had generated goodwill

³⁴ Exhibits MH1-MH4

through these trading activities by that date. Some of that trade related to goods identical to those included in the proprietor's application. I also accept that the proprietor's mark is identical to the applicant's sign. However, the applicant's goodwill was small. There is no evidence of the applicant's market share and, to my mind, the use shown in the evidence is not such that the proprietor must have known about the applicant's pre-existing trade when she applied for her mark. In any event, the mere fact that a trade mark applicant knew that another party used the trade mark in the UK is not sufficient to establish bad faith.³⁵

82. I acknowledge that the proprietor used her mark as a basis for reporting the applicant's listings on Amazon, resulting in them being removed, only two weeks after it became registered on 16 February 2024. There is nothing in the evidence which establishes that Amazon requires that a trade mark be registered before it can be used as the basis of a takedown notice. It is my understanding that it does not. In such circumstances, and without knowledge of the applicant's trade or prior dealings between the parties (neither of which are established in the evidence), it is my view that the proprietor's conduct is not consistent with the intention behind the application having been to interfere with the applicant's trading activities. If it were, it is reasonable to expect the proprietor to have reported the applicant's listings much sooner after making the application, rather than waiting for four months for the mark to become registered. In my view, the facts relied upon by the applicant are at least equally consistent with honest preparations for use commencing after achieving registration and attempting to enforce that registration, as is permitted under the law, after becoming aware of the applicant's use under an identical sign on Amazon.

83. As the authorities cited above make clear, bad faith is a serious allegation which must be distinctly proved. It is not enough to establish facts which are as consistent with good faith as bad faith. It is for the party alleging it to prove it. The initial evidential burden falls upon the applicant. Only when a rebuttable presumption of lack of good faith is established does the burden shift to the proprietor to rebut the allegation. Taking all of the above into account, I am not satisfied that it has been established that

³⁵ *Lindt, Koton*, paragraph 55

the application was filed in pursuit of the alleged objectives. The applicant has failed to establish a *prima facie* case of bad faith.

84. The applicant's claim under section 3(6) is dismissed.

OVERALL OUTCOME

85. The application for invalidation has been successful. Subject to appeal, the proprietor's mark is declared invalid. In accordance with section 47(6) of the Act, the registration is deemed to have never been made.

COSTS

86. The applicant has been successful and is entitled to a contribution towards its costs. As is required of unrepresented parties, the applicant filed a completed costs pro-forma on 23 September 2025, outlining the number of hours spent on these proceedings. There is no right to be awarded the amount claimed. This is subject to an assessment of the reasonableness of the claim. The Tribunal awards costs on a contributory, not compensatory, basis; account must be taken of this when assessing the claim made.

87. The applicant claims to have spent four hours on preparing and filing its Form TM26(I). Considering the nature, relevance and complexity of the form and statement of grounds, I consider this to be reasonable.

88. Next, the applicant claims to have spent five hours reviewing the proprietor's evidence. The proprietor did not file any evidence, but she did file written submissions during the evidence rounds. It is likely to be these submissions to which the applicant refers. Whilst I do not doubt that the applicant spent time reviewing the submissions, they were brief and not particularly complex. I consider one hour for this activity to be reasonable.

89. The applicant also claims four hours in respect of correspondence with the Tribunal and the proprietor. It has not explained what correspondence this was. The activities

listed in the costs pro-forma cover the various procedural stages of proceedings before the Tribunal. To my mind, this includes the ordinary work involved in each stage of the proceedings, including routine correspondence. Moreover, as outlined above, costs in proceedings before the Tribunal are intended to be contributory, rather than compensatory. Taking these factors together, I do not consider it appropriate to make a separate award for any routine correspondence prepared by the applicant in the prosecution of its case. I make no award for this activity.

90. Furthermore, the applicant claims 10 hours in respect of preparing for and attending the hearing. This is broken down into six hours for preparing its skeleton argument, two hours for hearing preparation and two hours for attending the hearing. The skeleton argument filed by the applicant was very brief. I consider six hours for this activity to be excessive. Moreover, the applicant has not explained what the additional hearing preparation involved. In combination, I consider four hours to be reasonable. The hearing did not last two hours. I consider one hour to be reasonable for attendance. In total, I award five hours for preparing for and attending the hearing.

91. Finally, the applicant has claimed £200 in official fees. This is a reasonable claim for the recovery of the fees paid in connection with the filing of its Form TM26(I).

92. The hourly rate awarded to litigants in person is analogous to that set out in part 46 of the Civil Procedure Rules. In respect of work carried out before 1 October 2025, this is £19.

93. Taking all of the above into account, I award the applicant the sum of **£390**, which is calculated as follows:

Preparing and filing the Form TM26(I) (4 x £19)	£76
Reviewing the proprietor's written submissions (1 x £19)	£19

Preparing for and attending the hearing (5 x £19)	£95
Official fees	£200
Total	£390

94. I order Stacey O'Connor to pay DropNet Ltd the sum of **£390**. This sum is to be paid within 21 days of the expiry of the appeal period, or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 30th day of September 2026

James Hopkins
For the Registrar