

O-105-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 3124131
BY MICHAEL MANOLIS
TO REGISTER THE TRADE MARK**

TRIM **APPAREL**

**IN CLASS 25
AND
OPPOSITION THERETO (UNDER NO. 405708)
BY ADAM GREENMAN**

BACKGROUND

1) On 26 August 2015, Michael Manolis ('Mr Manolis') applied to register the trade mark shown on the cover page of this decision in respect of *Clothing, bodybuilding clothing, fitness clothing, gym clothing. T-shirts, vests, tanks, t-shirts, hoodies, sweatshirts, jumpers, straps, shorts, trousers, tracksuits tracksuit bottoms, joggers, hats, caps, belts; Clothing, footwear, headgear; Athletic clothing; Casual clothing* in class 25.

2) The application was published on 25 September 2015 in the Trade Marks Journal and notice of opposition was subsequently filed by Adam Greenman ('Mr Greenman').

3) Mr Greenman claims that the application offends under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). The following UK Trade Mark ('UKTM') is relied upon in support of the first two of the aforementioned grounds:

| UKTM details | Goods relied upon ¹ |
|--|--|
| <p>UKTM No: 2464904</p> <p>TRIM</p> <p>Filing date: 22 August 2007</p> <p>Date of entry in the register: 18 April 2008</p> | <p>Class 25: Clothing; footwear; headgear; sports clothing; protective clothing for water-sports; wetsuits; caps; sports shoes; wetsuit boots; sandals.</p> |

4) In support of the ground under section 5(4)(a), Mr Greenman claims to be the proprietor of the mark **TRIM** which he states has been used throughout the UK since 4 October 2006 in relation to sporting goods and clothing. He states that a

¹ The earlier mark covers three classes but Mr Hands confirmed at the hearing that only class 25 is relevant (as foreshadowed in paragraph 5 of Mr Hands' skeleton argument).

substantial goodwill has been built up and that use of the applicant's mark in relation to the goods in class 25 would amount to passing off.

5) Mr Greenman's registered trade mark is an earlier mark in accordance with section 6 of the Act and, as it had been registered for more than five years before the publication date of Mr Manolis' mark, it is subject to the proof of use requirements, as per section 6A of the Act. Mr Greenman made a statement of use in respect of the goods relied upon.

6) Mr Manolis filed a counterstatement in which he agrees that there is similarity between the respective marks but denies that Mr Greenman has used his mark in respect of any of the goods in class 25 and puts him to proof thereof. The grounds under sections 5(3) and 5(4)(a) are also denied with supporting explanation.

7) Both parties filed evidence. A hearing took place before me on 14 December 2016. Mr Manolis represented himself; Mr Greenman was represented by Mr Lewis Hands of Handsome I.P. Limited. At the hearing, both parties made a request to file further evidence. In deciding whether to admit the evidence, I kept in mind the recent decision of the High Court in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). The relevant part of the judgment reads:

“2. Should the Hearing Officer have admitted the further evidence?”

41. The fact that the Hearing Officer made the errors of law and principle identified above does not necessarily mean that her decision to refuse to admit the further evidence was wrong. In considering this question, I have regard to the following factors:

- i) The evidence was highly material to the issues before the Hearing Officer. It shows trade mark use within the relevant period, of (at least) a number of services within the specification. Yet the 115 mark was revoked in respect of all services for which it was registered.

ii) There was some prejudice to Titanic Huddersfield if the further evidence was admitted. It had only been served a few days before the hearing, and Counsel would have had a limited time to consider it. On the other hand, the evidence is easy to follow and it consists of facts within the knowledge of TTL, to which Titanic Huddersfield did not intend to serve evidence in reply.

iii) The evidence could have been served earlier and there was no proper excuse for its lateness. The evidence could have been provided when TTL served its evidence in chief. Further, rather than merely writing in December 2015 to request an extension of time, TTL could have submitted the evidence with that letter. I am aware that CRS had just been instructed, and were busy with other aspects of the case, but it was necessary to prioritise.

iv) There was no question of an adjournment if the evidence was admitted, and therefore no question of any delay to the hearing.

v) There was very significant prejudice to TTL if the evidence was excluded, in that it stood to lose a valuable registered trade mark. This, in my judgment, outweighs any prejudice to Titanic Huddersfield if the evidence was admitted.

vi) Finally, I bear in mind the concern of the Hearing Officer that admission of the further evidence would undermine the decision of the IPO in December 2015 to refuse to admit such evidence. However, the decision in January 2016 was not the same. A mere indication that evidence might be filed is much less likely to carry weight than if the evidence is ready and the tribunal is asked to consider its contents.

42. Having regard to all the circumstances, in my judgment, the further evidence should have been admitted, and the Appeal on this issue is allowed.”

8) Mr Manolis' evidence was in the nature of what he described as 'expert evidence' purporting to show that the invoices in Mr Greenman's evidence had been 'doctored'. I refused to allow that evidence to be admitted for a number of reasons: i) the evidence was merely in the form a 'To whom it may concern letter' rather than evidential form, ii) expert evidence is not admitted as a matter of course², iii) Mr Manolis did not explain why the evidence could not have been filed earlier, iv) in order to ensure fairness to Mr Greenman, admission of such evidence would have required the hearing to be adjourned in order for him to have the opportunity to respond to it, leading to further costs and delay to the proceedings for both parties, v) the so-called expert, Mr Andreou, had merely stated that he had 'worked in design using photoshop for the past 15 years' but had not identified the precise position he held or qualifications he possessed to render him an expert in 'photo editing and manipulation', vi) in the light of the latter point, and the nature of the statements made by Mr Andreou, I did not consider the evidence to be of assistance, in any event and vii) the latter factor meant that the exclusion of the evidence would not be prejudicial to Mr Manolis.

9) Mr Greenman's evidence consisted of additional invoices in support of his claim to have made genuine use of his mark on clothing. Given the obvious materiality of this information to the matter before me, the potential prejudice to Mr Greenman should it be excluded, and bearing in mind that Mr Manolis was content for this evidence to be admitted and to respond to it by way of oral submission at the hearing such that an adjournment was not required, I allowed the request subject to the invoices being filed under cover of a witness statement. The invoices were duly filed in evidential form later that day.

² Tribunal Practice Notice 2/2012 'Survey Evidence and Expert Witness Evidence' refers.

EVIDENCE

Mr Greenman's evidence in chief

10) This consists of a witness statement by Mr Greenman dated 11 May 2016. He explains that he has been trading as Trim Surfboards since 2004. He also provides the following information:

- The trademark **TRIM** was first used in the UK in 2004 in respect of clothing. Since then, approximately 400 T-shirts and 200 hoodies bearing the mark **TRIM** have been 'distributed'.
- Exhibits 1 and 2 consist of photographs of the front and back of a t-shirt and a hoodie. Both bear the mark **trim** in a handwritten-type font. Mr Greenman states that these goods have been 'distributed' since 2005. I note that there is a website address prominently positioned in the middle of the back of the t-shirt and the hoodie which reads 'www.trimsurfboards.com'.
- Exhibit 3 consists of nineteen invoices which Mr Greenman states show that **Trim** t-shirts and hoodies have been 'distributed' to customers throughout the UK since 2006. All bear the word **trim** in a handwritten type font at the top. Three invoices emanate from February 2016, one is from October 2015, six come from the period April 2012 – September 2015 and nine come from November 2005 – April 2010. All of the invoices are 'From: Trim Surfboards' to various addresses in England, Ireland and Jersey. Most of the goods listed in the invoices appear to be surfboards (given that they are said to be 9'4/9'6/10'0 in size), many of which are listed under the 'item description' as 'Bing'/'Yater'/'Dewey Weber' which I note are the same brand names present on the poster in exhibit 4 (see next bullet point). None of the surfboards are described as 'Trim' in the 'item description'. On the six invoices from April 2012 - September 2015, Mr Greenman has highlighted goods such as 'Trim Squiggle Hoody', 'Trim baby T-shirt', 'Trim Pocket Hoody Grey' and 'Trim Pocket T Navy'. On five of those six invoices, there is no price listed for the highlighted goods; rather the letters 'FOC' are present. The nine invoices from

2005 - 2010, show a total of 18 'Trim' t-shirts/hoodies as being sold and 5 'Trim' t-shirts/hoodies are marked as 'FOC'.

- Exhibit 4 is a poster from October 2012 advertising a surfing event. The poster states that there will be a 'Free Trim T shirt for first 10 entrys' in a 'BOARD RAFFLE' (a surfboard raffle). The poster also advertises 'Longboards and retro shapes by' a number of brands such as 'Bing surfboards', 'Yater', 'Dewey Weber', 'Hansen' and 'Hap Jacobs'. Mr Greenman states that the poster was displayed widely in Devon and Cornwall in the weeks leading up to the event.
- Exhibit 5 consists of two photographs of a surfboard bag bearing the mark **trim** in a handwritten-type font which Mr Greenman states have been 'distributed to customers throughout the UK since 2006 with the surfboards and clothing identified in exhibit 3'.

Mr Manolis' evidence

11) This consists of a witness statement from Mr Manolis dated 7 July 2016. Much of the statement is in the nature of submissions criticising Mr Greenman's evidence which I will bear in mind but will not summarise here, aside from noting that Mr Manolis considers the evidence of use in relation to clothing to be 'merely in the nature of promotional merchandise'. In terms of evidence of fact, much of this relates to the use Mr Manolis has made of his mark in relation to items of clothing. In the circumstances, it is unnecessary to summarise that information; it does not assist me. Mr Manolis also provides a print out from the Mr Greenman's website www.trimsurfboards.com which he says shows that, although there is a clothing section on that website, there are no products listed for sale.

Mr Greenman's evidence in reply

12) This consists of a witness statement from Mr Greenman dated 8 September 2016 responding to Mr Manolis' criticisms. He states, inter alia, the following:

- ‘Some of the clothing was given away as promotional merchandise. However, 22 items are shown as sold on the invoices filed with my previous evidence...I confirm that there were more sales than this but only a selection have been provided.’
- ‘The [www.trimsurboards.com] website clearly states that we offer “clothing” for sale. Customers do not necessarily look at the website to choose the clothing. They know from the website that we sell t-shirts and hoodies. Just because the website does not have any further details of the specific clothing does not mean that they have not been continuously offered and available for sale, and indeed sold, since at least 2005.’
- The business is aiming to extend its clothing lines and in this connection Mr Greenman exhibits photographs of the newest designs for t-shirts and hoodies bearing the trim mark.

Mr Greenman’s further evidence

13) This consists of a witness statement from Mr Greenman dated 14 December 2016. He exhibits ten invoices. One dates from 2006, one from 2011, four from 2013 and four from 2014. Again, these all bear **trim** in a handwritten font at the top and list surfboards, t-shirts and hoodies under the heading ‘Item Description’. Most of the t-shirts/hoodies are described as ‘Captain Fin’ or ‘Bing’. Only five invoices list t-shirts/hoodies as ‘Trim’ in the ‘Item Description’; each showing the sale of one ‘Trim’ t-shirt/hoodie.

DECISION

Proof of use

14) Section 6A of the Act states:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the period of five years ending with the date of
publication.

(2) In opposition proceedings, the registrar shall not refuse to register the
trade mark by reason of the earlier trade mark unless the use conditions are
met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of
the application the earlier trade mark has been put to genuine use in
the United Kingdom by the proprietor or with his consent in relation to
the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper
reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements
which do not alter the distinctive character of the mark in the form in
which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

15) Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequently, the onus is upon Mr Greenman to prove that genuine use of the registered trade mark was made in the relevant period.

16) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of

the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

17) In accordance with section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five year period ending on the date of publication of the contested mark. In the case before me, that period is 26 September 2010 to 25 September 2015.

18) I should deal firstly with Mr Manolis’ contention that the invoices submitted by Mr Greenman appear to have been ‘doctored’. Although I did not allow any ‘expert evidence’ to be filed on the point, I did hear Mr Manolis’ own view on the matter. In his submission, the invoices do not appear to be genuine given the differing fonts used, the lack of £ signs on some of the prices listed and the different formatting used in some of the invoices. I note these points. However, the invoices have been exhibited to a witness statement bearing a statement of truth and I am more than satisfied by Mr Hands’ explanation that the invoices are PDFs of excel spreadsheets which Mr Greenman amends as, and when, necessary. He further explained that some invoices are generated on Mr Greenman’s computer whereas others are

generated on his wife's computer which also explains some of the different formatting. I therefore see no reason to question the veracity of the invoices.

19) I now turn to consider whether the evidence is sufficient to show that Mr Greenman's mark has been put to genuine use in relation to the goods covered by his class 25 specification. Mr Manolis drew my attention to what he considered to be the paucity of the evidence in relation to sales of clothing and to the phrase 'FOC' used on a number of the invoices in the price column for 'Trim' T-shirts and hoodies, some of which, he noted are also described as 'Trim Promo T-shirts' (my emphasis). He was also keen to stress that there are only two photographs provided in the evidence showing use of **trim** on a t-shirt and a hoodie, both of which bear the website address www.trimsurfboards.com in a prominent position across the back. All of this, he argued, shows that the t-shirts and hoodies are used primarily for the purpose of promoting Mr Greenman's business relating to the retailing of surfboards. Mr Hands conceded that some of the t-shirts and hoodies were given away free of charge in the form of promotional merchandise, as noted on the invoices, but submitted that others were not, and were indeed sold to consumers.

20) There are 16 invoices in the evidence before me that fall within the relevant period³ and all have **trim** (in handwritten-type font) in the top right-hand corner. However, of those 16 invoices, 5 list shirts/hoodies described as 'Bing...', 'Webber...' or 'Captain Fin...' It seems to me that these latter items are unlikely to have borne the **trim** trademark (and there is no evidence to show otherwise); instead they appear to be t-shirts and hoodies of third parties, namely, those which also produce the surfboards distributed by Mr Greenman (they are the same brand names used on the poster of the surfing event advertising various surfboards). The selling of third party t-shirts and hoodies does not establish the necessary link⁴ which would lead the average consumer to believe that the **trim** mark is being used to identify the origin, or indicate responsibility, for those t-shirts and hoodies. That leaves 11 invoices which do list items of clothing described as 'Trim'; there are just 13 items of

³ 6 in Mr Greenman's evidence in chief and 10 in his further evidence.

⁴ The matter of use of a shop, company or trade name in relation to goods has been considered in a number of cases, including *Céline SARL v. Céline SA*, Case C-17/06, *Euromarket Designs Inc. v Peters* [2001] F.S.R. and the comments of Mr Daniel Alexander QC sitting as the Appointed Person in *The Light* BL-O-472-11.

clothing in total (t-shirts/hoodies), 7 of those appear to have been sold and the other 6 are marked as 'FOC' (an abbreviation for 'free of charge'). Whilst I note that Mr Greenman states that there were more sales than this, he elaborates no further. There is, for example, no information as to the total volume of those sales, there are no turnover figures or advertising and marketing figures for the relevant period, no indication of the total number of units sold in that period nor any explanation about where those sales took place or to whom. Although, I note that, elsewhere in his evidence, Mr Greenman states that "a total of 400 T shirts and 200 Hoodies have been 'distributed' since 2004", it is not clear how many of those items relate to the relevant period nor how many of them were actually sold as opposed to being given away free of charge. The only thing that can be gleaned from those figures is that the total number 'distributed' (whether sold or free of charge) since 2004 has been very small; beyond that, they do not assist me.

21) Having considered all of the evidence before me, I have no hesitation in finding that it is insufficient to show that the mark **trim** has been put to genuine use on/in relation to the class 25 goods covered by Mr Greenman's registration. Whilst I agree with Mr Hands that sales need not be quantitatively significant to constitute genuine use, the number of t-shirts and hoodies which appear to have been sold within the relevant period bearing the **trim** mark is so small that it comes nowhere near an amount which would be sufficient for the purpose of creating or preserving a market share for the relevant goods. In reaching this view, I have borne in mind, in particular, the enormity of the clothing market, the lack of evidence showing any promotion or advertising of the mark in relation to the sale of the relevant goods and the lack of turnover figures for the relevant period for those goods. I agree with all of Mr Manolis' submissions set out in paragraph 19 above. The picture one gets from the evidence as a whole is of Mr Greenman having used **trim** primarily on promotional t-shirts and hoodies which are given away free of charge to customers of his business who purchase surfboards (and the like) to encourage the purchase of the latter or serve as a reward for doing so. Such use does not warrant genuine use for the reasons given by the Court of Justice of the European Union in *Silberquelle GmbH v Maselli-Strickmode GmbH*, Case C-495/07 where it held that:

“17. It is settled case-law that ‘genuine use’ within the meaning of the Directive must be understood to denote actual use, consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (Case C-40/01 *Ansul* [2003] ECR I-2439, paragraphs 35 and 36, and Case C-442/07 *Verein Radetzky-Orden* [2008] ECR I-0000, paragraph 13).

18. It follows from that concept of ‘genuine use’ that the protection that the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d’être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings (*Ansul*, paragraph 37, and *Verein Radetzky-Orden*, paragraph 14).

19. As the Commission submitted in its observations to the Court and as the Advocate General stated in points 45 and 55 of his Opinion, it is essential, in the light of the number of marks that are registered and the conflicts that are likely to arise between them, to maintain the rights conferred by a mark for a given class of goods or services only where that mark has been used on the market for goods or services belonging to that class.

20. For the reasons set out in points 48 and 56 of that Opinion, that condition is not fulfilled where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter.

21. In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings.

22. In the light of the foregoing considerations, the answer to the question referred is that Articles 10(1) and 12(1) of the directive must be interpreted as

meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items.”

22) As Mr Greenman has failed to establish genuine use of his mark, the grounds of opposition under sections 5(2)(b) and 5(3) must fail.

Section 5(4)(a)

23) Section 5(4)(a) states:

“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, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

24) The requirements to succeed in a passing off action are well established and are summarised in *Halsbury’s Laws of England* 4th Ed. as being that:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

25) In the circumstances, I need deal with this ground relatively briefly.

26) Bearing in mind my earlier comments as regards the nature and extent of the use of **trim** on/in relation to clothing, the opponent is in no better position under this ground insofar as it claims to have goodwill in a business selling clothing with which the sign **trim** is associated.

27) Mr Greenman also relies upon use of **trim** in relation to sporting goods under section 5(4)(a). It will be apparent from my comments earlier in this decision that I accept that most of the items listed in the invoices appear to be surfboards. However, I have reached this conclusion due to my own deductions from assessing the evidence rather than due to any assistance from Mr Greenman. His witness statement is completely lacking in any supporting explanation about those goods such as turnover figures or marketing/advertising spend or any other pertinent information which may assist me in determining whether the requisite goodwill exists in relation to them. Furthermore, whilst **trim** is present on the top of the invoices, the surfboards themselves are all described as Bing/'Yater'/'Dewey Weber' (for example) which appear to be brand names of third parties⁵. Accordingly, the nature of the use of the mark **trim** on the invoices appears more akin to a retail service connected with the sale of surfboards (or similar such service) rather than to use on/in relation to the surfboards *per se*. Insofar as use on bags for surfboards is concerned, although there is some limited evidence to support the use of **trim** on those goods⁶, again, Mr Greenman's lack of any narrative in his witness statement about the extent of use on those goods makes it impossible to ascertain whether the requisite goodwill exists in relation to them. Without the establishment of goodwill, there can be no misrepresentation or damage. **The ground under section 5(4)(a) fails.**

⁵ As indicated on the poster in exhibit 4 to Mr Greenman's first witness statement.

⁶ Including the two photographs in exhibit 5 to Mr Greenman's first witness statement.

Summary

28) **The opposition fails.**

COSTS

29) As Mr Manolis has been successful, he is entitled to a contribution towards his costs. Using the guidance in Tribunal Practice Notice 4/2007 (which was in force at the time of commencement of these proceedings) but keeping in mind that Mr Manolis has not incurred the expense of legal representation, I award costs on the following basis:

| | |
|--|-------------|
| Preparing a statement and considering Mr Greenman's statement | £100 |
| Considering and filing evidence | £150 |
| Preparing for, and attending, the hearing | £150 |
| Total: | £400 |

30) I order Adam Greenman to pay Michael Manolis the sum of **£400**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of March 2017



Beverley Hedley
For the Registrar,
the Comptroller-General