

**O-106-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3133517  
BY BRAND PROTECTION LIMITED TO REGISTER THE TRADE MARK**

**Come To The Dark Side**

**IN CLASSES 14, 21 AND 25**

**AND**

**THE OPPOSITION THERETO UNDER NO 406133  
BY ABT MERCHANDISING LIMITED**

## Background and pleadings

1. On 27 October 2015, Brand Protection Limited (“the applicant”) applied for the mark Come To The Dark Side for goods in classes 14, 21 and 25.

2. The application was published for opposition purposes on 27 November 2015. ABT Merchandising Limited (“the opponent”) opposes the application in class 25, claiming that it offends sections 3(1)(a) and (b) and 3(6) of the Trade Marks Act 1994 (“the Act”). The class 25 goods are:

*Class 25: Heels, heelpieces for boots and shoes, suits, layettes (clothing), babies' pants, bathing suits, bathing trunks, bath robes, bathing caps, bath sandals, bath slippers, bandanas (kerchiefs for clothing), berets, clothing of imitation leather, clothing for motorists, clothing, clothing of paper, boas (clothing), teddies (undergarments), brassieres, bodices, chasubles, women's clothing, shower caps, insoles, dress handkerchiefs, carnival costumes, mittens, fishing vests, football boots, footmuffs, not electrically heated, gabardines, galoshes, gaiters, money belts (clothing), non-slipping devices for shoes, belts (clothing), gymnastic clothing, gymnastic shoes, half-boots, scarves, gloves (clothing), slippers, slips (undergarments), blouses, shirt yokes, shirts, detachable collars, shirt fronts, wooden shoes, trousers, trouser straps, braces, girdles, hats, hat frames (skeletons), jackets, jerseys (clothing), stuff jackets (clothing), skull caps, hoods (clothing), gowns, ready-made linings (parts of clothing), pockets for clothing, ready-made clothing, wimples, headgear, camisoles, corsets, collars (clothing), hospital gowns, neckties, ascots, bibs, not of paper, leather clothing, underwear, sweat-absorbent underclothing, liveries, maniples, cuffs (clothing), coats, coats (fur-lined), mantillas, corselets, mitres (hats), dressing gowns, muffs (clothing), caps, cap peaks, outerclothing, ear muffs (clothing), overalls, slippers, paper hats (clothing), parkas, pelerines, furs (clothing), petticoats, ponchos, pullovers, pyjamas, cyclists' clothing, raincoats, skirts, sandals, saris, sarongs, collar protectors, shawls, sleepsuits, sleeping masks, veils (clothing), breeches for wear, lace-up boots, iron fittings for boots, shoes, welts for shoes, shoe soles, footwear uppers, tips for footwear, footwear, coveralls, aprons (clothing), dress shields, ski gloves, ski boots, underpants, socks, sock suspenders, boots for sports, sports shoes, boots, boot uppers, headbands (clothing), esparto shoes or sandals, stoles, fur stoles, studs for football boots, beachwear, beach shoes, garters, stockings, sweat-absorbent stockings, heel pieces for stockings, suspenders, tights, sweaters, T-shirts, togas, knitwear, jerseys, turbans, overcoats (clothing), uniforms, underclothing, sweat-absorbent underclothing, pants, underwear, leggings, body linen (garments), wet suits for water-skiing, waistcoats, hosiery (clothing), top hats.*

3. Sections 3(1)(a) and (b) and 3(6) of the Act state:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) ....
- (d) ....

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

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

4. The claims are expressed as follows:

- 3(1)(a): “The mark applied for is a well recognized slogan that is commonly used on merchandise. The mark is not capable of distinguishing goods or services of one undertaking from those of other undertakings”.
- 3(1)(b): “The mark consists exclusively of a well recognized slogan made famous from the Star Wars films. It is commonly used as a tongue-in-cheek fun way to encourage mis-behaviour. The mark is commonly used, with or without artwork as a slogan on merchandising. The mark is not capable of distinguishing good or services of one undertaking from those of other undertakings. A simple internet search for “Come to the dark side t-shirts”

provides many images of the words being used, with or without artwork, in various styles on t-shirts.”

- 3(6): “The applicant’s core business appears to be in clothing and merchandise. A search on the UK register finds 51 pages of registrations and applications predominantly covering clothing in class 25. The Opponent is aware of the Applicant using its registrations to remove competing clothing companies’ listings from online sales platforms such as eBay and Amazon, causing damage to the sales and reputation of that company. The motivation of the applicant in this case is to prevent any clothing company from being able to apply any statement or slogan (with or without artwork) which includes the well-known slogan “Come to the dark side” (or anything similar). This is easy to do with a registration because the online sales platforms like eBay and Amazon have very straightforward mechanisms to de-list items which are alleged to infringe a trade mark registration. The Applicant is attempting, and in many cases succeeding, to obtain registrations for simple and/or commonly used statements or slogans, to unlawfully prevent competition in the clothing and general merchandise industry where use [sic] such slogans and statements are common.”

5. The applicant filed a counterstatement which is signed by Andrew Scott, an officer/employee of the applicant. The contents of the counterstatement are reproduced below, verbatim:

As a company we are a builder of brands - not merely a designer and printer of apparel and accessories. Our practices and methods are completely distinct to any other company in the sector, as shown by our 'Sex Weights & Protein Shakes' (SWPS) brand, which is registered not only in the UK but also Australia and the USA. SWPS boasts its own Facebook site and a strong following, dedicated online platform, advertising campaigns but most importantly premium-quality garments that are re-labelled and professionally packaged. We do this to stand out and differentiate our quality products from cheap imitations that we very quickly find surfacing. While we do not dispute the phrase 'Come To The Dark Side' is inspired by Star Wars, we created a series of parody designs that proved so popular that others simply copied us - seemingly de rigueur in this sector. That we were the first with the 'cookies' idea is backed up in the UK by the number of positive feedbacks on the platforms upon which it is sold - these register in their hundreds, which equates to more than 6,000 sales. It is also proved by when the products were originally listed. Regardless of the opponent's wild and fanciful claims about our activities, the fact is we have taken our initial 'Come To The Dark Side We Have Cookies' design and developed it by extending it to other subjects, including cycling, gardening, golf, weight training, climbing, guitars, percussion and more. We are reinforcing the brand by continuing to use the same font and concept throughout and similar to our SWPS model, our 'Come To The Dark Side We Have Cookies' clothes and all designs in the brand are re-labelled with woven damask labels sewn in at the neck and hem/sleeve, to distinguish our product from all other copies. Similar to the Keep Calm And Carry On brand, we are the ones to have popularised the design and built a reputation. It is our belief the opponent in this case, ABT Merchandising, is simply adopting a malicious approach as retribution for our company having had one of their infringing listings removed from eBay in 2015. And while the opponent does have a 'Come To The Dark Side' design in its range that is virtually identical to ours, they appear to have sold 3 since it was first listed in July 2015.

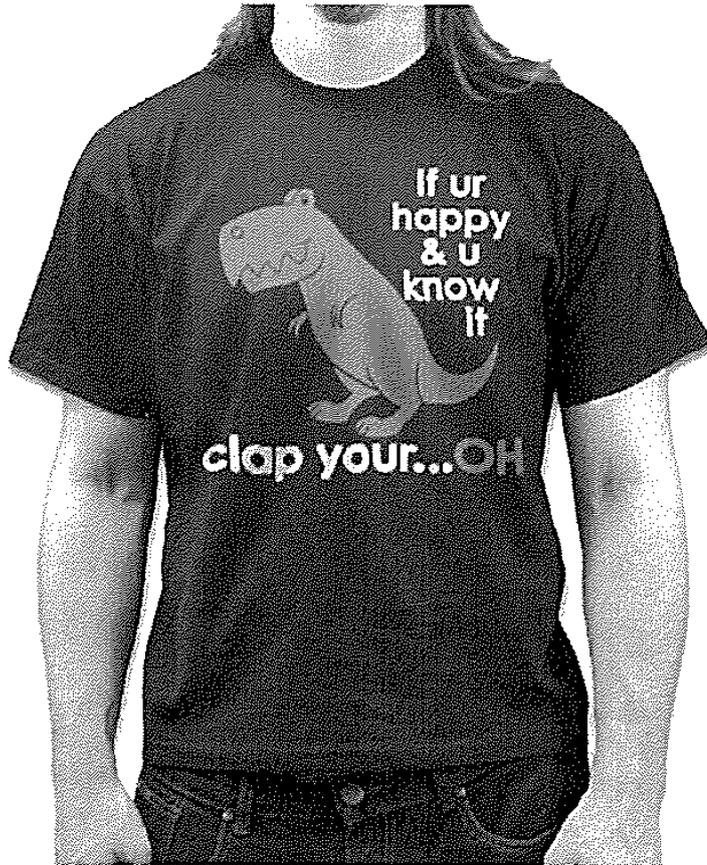
6. Both parties filed evidence. Neither side chose to be heard or to file submissions in lieu of attendance at a hearing. I make this decision on the basis of the law and a careful reading of all the papers filed.

## **Evidence**

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

ABT Merchandising design:

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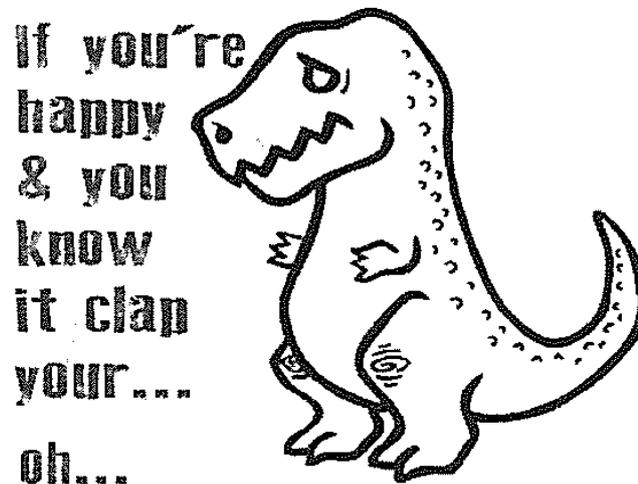
Created: March 18<sup>th</sup> 2014.

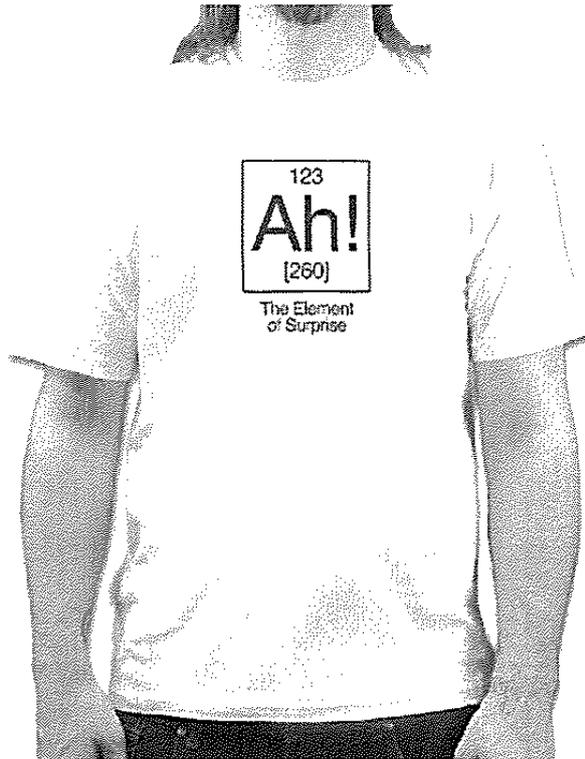
First sold on eBay : March 2014

Brand Protection registration:

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UK00003068962 filed 18 August 2014, registered 21 November 2014





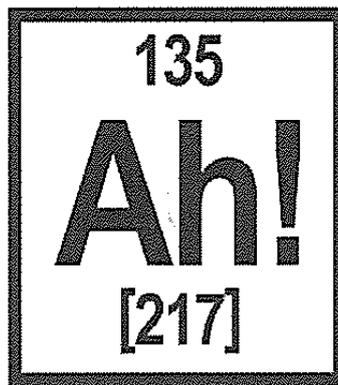
Created: 2<sup>nd</sup> October 2013

First sold on eBay : October 2013

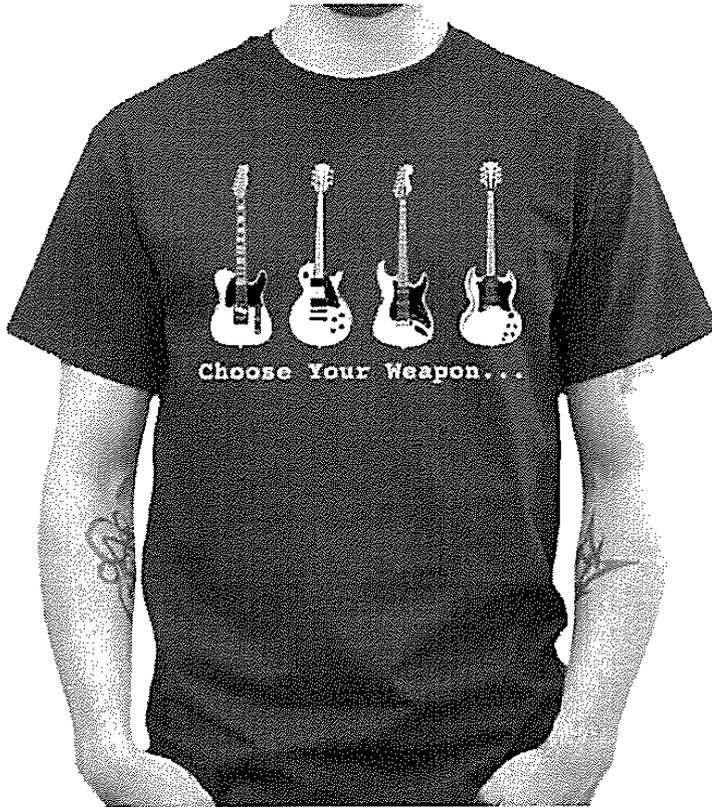
Brand Protection registration:

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UK00003069306 filed 20 August 2014, registered 21 November 2014



**The Element  
of Surprise!**



Created: August 14<sup>th</sup> 2012

First sold on eBay : August 2012

Brand Protection registration:

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UK00003137514 filed 6 November 2014, registered 13 March 2015



8. Mr Karam states that it was apparent to him that the applicant was deliberately taking the opponent's artwork, registering it as trade marks, and using the trade mark registrations to delist the opponent's goods in a deliberate attempt to cause damage to the opponent's business. There are no exhibits showing the contested application.

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

10. The factual content of Mr Fry's evidence is his statement that the mark is a term used in *Star Wars*. There are no exhibits to Mr Fry's statement.

11. The applicant has filed a witness statement, dated 21 October 2016, from Jason Robertson, who is a director of the applicant. Mr Robertson states that he established the applicant in 2015 to act as a licensing agent for numerous t-shirt designs and brands created over the years by his various other companies. He states that the applicant is also a developer of clothing brands focusing on specific interests, which the applicant licenses to third parties. The goods are sold via online sales channels as well as through 'dedicated brand platforms'. Much of the evidence is not relevant to these proceedings. Mr Robertson states that:

- Some of the applicant's graphic designs are grouped into themes, such as fishing, scuba diving and cycling, including 'SWPS' (which stands for Sex, Weights & Protein Shakes).
- It is the opponent which is copying the applicant's work. An example from eBay is shown as Exhibits BP003 and BP004, but the text in the prints is too small for me to read.

- The applicant began ‘trademarking some of [its] designs’ because they had been earmarked to be developed as brands.

12. Mr Robertson replies to the allegations of copying of the various t-shirt designs exhibited to Mr Karam’s evidence. For reasons which will become clear, I do not propose to detail the rebuttal of Mr Karam’s evidence, but simply note that Mr Robertson denies copying and has provided evidence intended to show that some of the applicant’s designs pre-date the opponent’s designs.

13. Mr Robertson states:

“22. With reference to my application to register ‘Come To The Dark Side’, we do not claim to be the first to sell this design or obviously create the slogan – we all know its origin – but we were the first to extrapolate the concept to other topics and are attempting to develop it as a brand in its own right. As a brand, it hones in on the obsessions that people have for certain things, such as biscuits, diving, bikes, and as you can see from the designs we have created and sold, as well as the woven damask neck labels that we wish to incorporate, the stylisation and use of typography on the clothing is achieved in a distinctive way, with a graphical representation of the hobby/interest alongside the text which is consistent throughout all designs. There is now exhibited as Exhibit BP015 examples of designs within the Come To The Dark Side brand”:



## Decision

### Section 3(1)(a) of the Act

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

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

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

15. Strictly speaking, there is no need for me to decide whether this ground succeeds or fails. As Mr Geoffrey Hobbs Q.C., as The Appointed Person pointed out in *AD2000 Trade Mark*<sup>1</sup>, s.3(1)(a) permits registration provided that the mark is ‘capable’ to the limited extent of “*not being incapable*” of distinguishing. Consequently, if I am satisfied that the mark complies with s.3(1)(b) of the Act, the ‘incapable of distinguishing’ objection under section 3(1)(a) is bound to fail. Alternatively, if the ground under section 3(1)(b) succeeds, the outcome under section 3(1)(a) becomes moot. However, for the sake of completeness, I set out here, briefly, why the ground fails, regardless of the ground under section 3(1)(b) of the Act.

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

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

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<sup>1</sup> [1997] RPC 168.

Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

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

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

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

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those

particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

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

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

#### **18. The ground under section 3(1)(a) fails.**

#### **Section 3(1)(b) of the Act**

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

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

(a) .....

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

(c) ....

(d) .....

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

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

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

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

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

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

21. There are no exhibits to support the pleading. Mr Fry submits that the applicant’s goods are the sort of media used by an undertaking to promote its business and so the mark will be taken as ‘merely descriptive’ of such goods (this is more the language of section 3(1)(c), which is not pleaded). Mr Fry goes on to make submissions about slogans and section 3(1)(b) of the Act. It appears that this is the

crux of the objection: that the mark will be seen as a slogan, not an indicator of trade origin, and that the applicant's goods are the media which will carry the slogan, which relates to a well-known film brand franchise.

22. Although the opponent has not provided any evidence that 'Come to the dark side' is a term used within *Star Wars*, the applicant has admitted that it is in its counterstatement (and more obliquely in the extract from Mr Robertson's evidence which I have reproduced in paragraph 13 of this decision):

"While we do not dispute the phrase 'Come To The Dark Side is inspired by Star Wars, we created a series of parody designs...we have taken our initial 'Come To The Dark Side We Have Cookies' design and developed it by extending it to other subjects, including cycling, gardening, golf...".

23. I must consider the various ways that a trade mark may be used in relation to the goods (notional and fair use of the mark). This would include use on the garment, such as across the front, or on the back, which is, in fact, the type of use which Mr Robertson exhibits, showing the mark as part of a longer set of words across the front of t-shirts:



24. Whilst I must not confine my analysis to this ‘worst case scenario’<sup>2</sup>, Mr Robertson states that the applicant wishes to use the mark on neck and sleeve labels, which implies that the mark has not, as yet, been used this way. There is, therefore, no question as to whether use on neck labels will have educated the relevant public that the mark is a trade mark. I have only the prima facie case to consider.

25. The applicant admits that ‘Come to the dark side’ is a phrase from *Star Wars*: “we do not claim to be the first to sell this design or obviously create the slogan – we all know its origin”. The applicant’s defence is predicated upon its use as a series of what it calls parody designs, where the mark appears as part of a longer phrase (e.g. Come To The Dark Side We Have Cookies/Bikes) on the front of garments. There are problems with this defence. The applicant’s intended use is not what has been applied for; the mark as applied for is what must be considered. The applicant concedes that the mark, as applied for, is widely known (“we all know its origin”) as a phrase from *Star Wars*. The mark is therefore, absent use as a trade mark, unlikely to be seen as indicating the trade origin of the goods for those average consumers who know it to be an iconic *Star Wars* phrase when used in relation to garments which are apt to carry phrases, statements or slogans. For average consumers who do not know that, it is likely to be seen simply as a narrative statement, or an invitation/instruction, without indicating trade origin. The mark is devoid of any distinctive character for goods which are apt to carry phrases, statements or slogans, but is not objectionable in relation to:

*Heels, heelpieces for boots and shoes; boas (clothing); chasubles; brassieres, bodices; shower caps, insoles, dress handkerchiefs; fishing vests, football boots; footmuffs, not electrically heated; gabardines, galoshes, gaiters; money belts (clothing); non-slipping devices for shoes; gymnastic shoes, half-boots; slips (undergarments); shirt yokes, detachable collars; wooden shoes, trouser straps; girdles; hat frames (skeletons), skull caps, ready-made linings (parts of clothing), pockets for clothing; wimples, corset;, collars (clothing), hospital gowns; bibs, not of*

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

*paper; liveries, maniples, cuffs (clothing), mantillas, corselets, mitres (hats), muffs (clothing), cap peaks, overalls, pelerines, petticoats, sandals, saris, sarongs, collar protectors, shawls, veils (clothing); breeches for wear, lace-up boots, iron fittings for boots, welts for shoes, shoe soles, tips for footwear; coveralls, dress shields, sock suspenders, esparto shoes or sandals, stoles, fur stoles, studs for football boots; garters, stockings, sweat-absorbent stockings, heel pieces for stockings; suspenders, tights, turbans, body linen (garments); wet suits for water-skiing; hosiery (clothing), top hats.*

**26. The ground under section 3(1)(b) fails in relation to the above goods and succeeds in relation to the following goods:**

*Suits, layettes (clothing), babies' pants, bathing suits, bathing trunks, bath robes, bathing caps, bath sandals, bath slippers, bandanas (kerchiefs for clothing), berets, clothing of imitation leather, clothing for motorists, clothing, clothing of paper, teddies (undergarments), women's clothing, carnival costumes, mittens, belts (clothing), gymnastic clothing, scarves, gloves (clothing), slippers, blouses, shirts, trousers, braces, hats, jackets, jerseys (clothing), stuff jackets (clothing), hoods (clothing), shirt fronts, gowns, ready-made clothing, headgear, camisoles, neckties, ascots, leather clothing, underwear, sweat-absorbent underclothing, coats, coats (fur-lined), dressing gowns, caps, outerclothing, ear muffs (clothing), slippers, paper hats (clothing), parkas, furs (clothing), ponchos, pullovers, pyjamas, cyclists' clothing, raincoats, skirts, sleepsuits, sleeping masks, shoes, footwear uppers, footwear, aprons (clothing), ski gloves, ski boots, underpants, socks, boots for sports, sports shoes, boots, boot uppers, headbands (clothing), beachwear, beach shoes, sweaters, T-shirts, togas, knitwear, jerseys, overcoats (clothing), uniforms, underclothing, sweat-absorbent underclothing, pants, underwear, leggings, waistcoats.*

**Section 3(6): bad faith**

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

“A trade mark shall not be registered if or to the extent that the application

is made in bad faith.”

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

“Bad faith: general principles

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

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

132 Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2009] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

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

*Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

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

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

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

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

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

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

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

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

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

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

29. As stated in the *Sun Mark* case, the relevant date is the date on which the application was made to register the trade mark, which in this case is 27 October 2015.

30. The opponent's claim under section 3(6) appears to be that the applicant obtains registrations to remove competing clothing companies' listings from online sales

platforms. Mr Karam's evidence focuses on the alleged copying of the opponent's t-shirt artwork, although there is no evidence that the opponent, itself, uses the words which comprise the mark. This evidence does not appear to be relevant to the pleadings in the present case. Rather, the complaint is that the opponent is concerned that the applicant will have a statutory monopoly in a term which is a commonly used statement or slogan, and therefore use its registration to remove from online listings third-party goods which carry the same or similar words.

31. This is not a fertile basis for a section 3(6) claim. Otherwise, section 3(6) would be a valid objection against every trade mark application which falls foul of section 3(1)(b) of the Act on the grounds that an applicant seeks a monopoly in a non-distinctive mark.

**32. The ground under section 3(6) fails.**

**Outcome**

**33. The opposition partially succeeds under section 3(1)(b) of the Act. The mark will be refused for the following class 25 goods:**

*Suits, layettes (clothing), babies' pants, bathing suits, bathing trunks, bath robes, bathing caps, bath sandals, bath slippers, bandanas (kerchiefs for clothing), berets, clothing of imitation leather, clothing for motorists, clothing, clothing of paper, teddies (undergarments), women's clothing, carnival costumes, mittens, belts (clothing), gymnastic clothing, scarves, gloves (clothing), slippers, blouses, shirts, trousers, braces, hats, jackets, jerseys (clothing), stuff jackets (clothing), hoods (clothing), shirt fronts, gowns, ready-made clothing, headgear, camisoles, neckties, ascots, leather clothing, underwear, sweat-absorbent underclothing, coats, coats (fur-lined), dressing gowns, caps, outerclothing, ear muffs (clothing), slippers, paper hats (clothing), parkas, furs (clothing), ponchos, pullovers, pyjamas, cyclists' clothing, raincoats, skirts, sleepsuits, sleeping masks, shoes, footwear uppers, footwear, aprons (clothing), ski gloves, ski boots, underpants, socks, boots for sports, sports shoes, boots, boot uppers, headbands (clothing), beachwear, beach shoes, sweaters, T-shirts, togas, knitwear, jerseys, overcoats (clothing), uniforms,*

*underclothing, sweat-absorbent underclothing, pants, underwear, leggings, waistcoats.*

**The mark may proceed to registration for the goods in classes 14 and 21, which were not opposed, and for the following goods in class 25:**

*Heels, heelpieces for boots and shoes; boas (clothing); chasubles; brassieres, bodices; shower caps, insoles, dress handkerchiefs; fishing vests, football boots; footmuffs, not electrically heated; gabardines, galoshes, gaiters; money belts (clothing); non-slipping devices for shoes; gymnastic shoes, half-boots; slips (undergarments); shirt yokes, detachable collars; wooden shoes, trouser straps; girdles; hat frames (skeletons), skull caps, ready-made linings (parts of clothing), pockets for clothing; wimples, corset;, collars (clothing), hospital gowns; bibs, not of paper; liveries, maniples, cuffs (clothing), mantillas, corselets, mitres (hats), muffs (clothing), cap peaks, overalls, pelerines, petticoats, sandals, saris, sarongs, collar protectors, shawls, veils (clothing); breeches for wear, lace-up boots, iron fittings for boots, welts for shoes, shoe soles, tips for footwear; coveralls, dress shields, sock suspenders, esparto shoes or sandals, stoles, fur stoles, studs for football boots; garters, stockings, sweat-absorbent stockings, heel pieces for stockings; suspenders, tights, turbans, body linen (garments); wet suits for water-skiing; hosiery (clothing), top hats.*

### **Costs**

34. Both parties have achieved an equal measure of success. I order both parties to bear their own costs.

**Dated this 8<sup>th</sup> day of March 2017**



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