

O/134/20

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3338254

IN THE NAME OF PASTA GO

FOR THE TRADE MARK



IN CLASS 43

AND

OPPOSITION THERETO UNDER NUMBER 414803

BY

KAMIL KRUK

## **Background and pleadings**

1. On 13 September 2018 PASTA GO (“the Applicant”) applied to register the trade mark as displayed on the front cover page for services in class 43 namely *Take away food and drink services*. The application was accepted and published in the Trade Marks Journal on 21 September 2018.

2. Mr Kamil Kruk (“the Opponent”) opposes the application on the single ground under section 3(6) of the Trade Marks Act (“The Act”) claiming that the Applicant’s mark was applied for in bad faith. The Opponent submits that he operates a chain of restaurants in Poland and that the Applicant being aware of his trade mark, copied not only the name and logo but also the whole business concept after visiting one of the original premises in Lodz (Poland). He claims that the Applicant has sought to gain an economic advantage and block the Opponent from entering the UK market as well as trade off the repute of the Opponent’s business. The Opponent states that the Applicant modified one of the Opponent’s images and used it in a social media post and only when challenged did the Applicant seek to file an application in the UK when it discovered that the Opponent’s mark was only registered in Poland. The Opponent argues that this behaviour falls short of the standards of acceptable commercial behaviour.

3. A defence and counterstatement was filed by Mr Lukasz Newelski, the Applicant’s controlling mind, denying the allegations. Mr Newelski denies that he has ever visited Lodz City or that the inspiration for his restaurant and logo was the Opponent’s business. He argues that the inspiration for the business idea was as a result of family holidays taken in Italy where he was inspired by the abundance and variety of pasta takeaways. He submits that the name of the company has not been copied from anybody; it was chosen as a simple and pure description of the services provided to his customers. In addition, he submits that the logo was designed by his graphic designer from “his private inspirations”. He denies that he has acted in bad faith and does not wish to stand in the way of or cause any harm to any other pasta business around Europe especially the Opponent’s.

4. In response to the allegations of bad faith the Applicant submits in particular that:

- The two businesses are very different and due to the distance between them (being located in different countries) no competition or rivalry would be caused particularly since the Opponent's mark was "not patented in the UK".
- Mr Newelski claims that the Opponent subjected him to threatening behaviour and scare tactics in an attempt to make the Applicant change the name of its business. It was only after Mr Newelski made contact with the "Poland Patent Office", that he discovered "that the company (Opponent's) only had a patent in Poland and since he was based outside Poland he had legal rights to expand his business anywhere in Europe". He applied for the trade mark as a measure to keep the "name and health" of his business.

5. The Opponent filed evidence by way of a witness statement in the name of Kamil Kruk. Both parties filed written submissions however neither party requested a hearing and neither filed additional written submissions in lieu. In these proceedings the Opponent is represented by Katarzyna Eliza Binder-Sony from Legal Force whereas the Applicant is unrepresented.

### **Preliminary Issues**

6. In his submissions the Opponent outlined the similarities between the respective marks and services, leading to a likelihood of confusion between the marks. These arguments are ordinarily ones put forward in an opposition under section 5(2) of the Act, which was not pleaded by the Opponent. On this basis the submissions in so far as they relate to a claim under section 5(2) will not be considered in my assessment.

7. Following the timetabling of the proceedings the Applicant was given the opportunity to file evidence by 20 August 2019. On 18 August 2019 it filed submissions which included material considered by the registry to be evidence of fact. The Applicant was given the opportunity to refile the material in the correct format accompanied by a form TM9R. The Applicant did not respond to this request and therefore the material filed by the Applicant was deemed inadmissible and only the Applicant's submissions were admitted into proceedings.

## **Evidence**

8. The Opponent's evidence consists of the witness statement of Mr Kamil Kruk dated 13 June 2019 accompanied by 9 Exhibits marked KK1-9. Mr Kruk is the owner and founder of the "Pasta GO!" brand.

9. Mr Kruk states that "Pasta Go!" was founded in Poland in March 2013. He registered his trade mark with the Polish Trademark Office in August 2016. He later applied to register the trademark at the EUIPO completing that process in January 2019.

10. Mr Kruk states that in 2016 sales from the business were 434 956.57 PLN (approx. £86,991) growing to 1 267 607.85 PLN (approx. £253, 520) in 2018. He states that the business started with one restaurant but has now grown to four with the plan to open another one at the end of the year.

11. Mr Kruk produces at Exhibit KK3 what he describes as a summary of the monthly and annual revenue, costs and profits between 2013 and 2018 in order to demonstrate the success of his business. Even though the document is in Polish, with no translation provided, it nevertheless outlines the income and expenditure of a growing business

over 6 years. This document supports the figures produced in paragraph 4 of Mr Kruk's statement.

12. Mr Kruk states that he has undertaken a strategic marketing and advertising campaign via print and promotional materials, social media and "in person (expos)". He states that over 100 000 PLN (approx. £20 000) has been spent on marketing and advertising since the commencement of the company. In support of this Exhibit KK4 includes a screenshot of the Opponent's Instagram account which clearly show the sign/trademark on its promotional material. Exhibit KK5 is described as pictures taken from an exhibition stand at the Franchise Expo in Katowice in March 2017. As a result of this exposure Mr Kruk states that he received a number of enquiries regarding franchising opportunities and was proposing to establish his first Pasta GO! franchise restaurant in 2020. The pictures produced clearly display the Opponent's sign/trademark on various items to include the stand itself, containers, leaflets and literature and t shirts worn by the exhibitors.

13. Mr Kruk states that he became aware of the Applicant's business in September 2018 after an employee drew his attention to a "company that was using the same business name and concept". Mr Kruk states that he viewed the Applicant's Facebook account and discovered that the Applicant had "stolen one of his pictures" and was using it as part of its own social media campaign. Consequently, he contacted the Applicant via social media and requested that the photograph be removed and that the Applicant change its name. Exhibit KK6-8 consist of screenshots taken from the respective parties' Facebook pages which include the original photograph taken from the Opponent's Facebook page and the modified picture "copied and altered by the Applicant". Mr Kruk states that the image is identical save for the logo. This Mr Kruk argues clearly demonstrates that the Applicant was "inspired" by the Opponent's logo and business concept.

14. Mr Kruk states that once he contacted the Applicant regarding the misuse of the photograph it was removed, but it was only after this contact that the Applicant filed for its trade mark at the UKIPO.

15. Mr Kruk accepts that currently the Opponent's restaurants are based in Poland but states that he intends to expand the business and brand internationally.

16. Mr Kruk concludes that whilst he is not against fair competition he objects to the Applicant "stealing [sic] the entire business concept including his name and logo" and argues that this is unacceptable market practice and the Applicant should not benefit as a result.

### **Applicant's submissions**

17. A summary of the Applicant's submissions in response to the allegations raised by the Opponent, are set out as follows:<sup>1</sup>

"All the documents provided by Mr Kruk clearly shows Poland only. The distance between the two company's is so vast our paths cannot possibly cross. We run concurrent, our customers are only locally based.

There are many other businesses that use online traders shopping, therefore the pots are not a copy of Mr Kruks. Numerous other businesses are doing the exactly the same. There are a number of multiple pasta shops that use Pasta Go as their key words as a selling point. For example, Pasta To Go, Pasta Go

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<sup>1</sup> Submissions filed 18 August 2019

Go and .....Go Pasta. Our company has been open since 9 April 2018 for takeaway food shops and mobile food stands.

The conception of the company logo, colours, shape, font, menu and also the appearance in the shop are my own idea.

Because my pasta shop is based in the UK, we applied for the patent in UK only. We have not tried to interrupt Mr Kruk's business at all and we have not got concerns of Mr Kruk opening further businesses around Europe, especially with the current Brexit situation.

Based on the image of my first menu, we understood that the image was the same. This was simply due to an error of my graphic designer. After realising what he had done I removed this immediately. This was a very simple mistake that bypassed through the opening of the business and was corrected quickly. We do not sell the food from the image displayed we only needed a picture of the white pot, with my logo on – a very silly mistake from the graphic team.

Although I do not want to blame them entirely as I rushed the process to open my shop. We never thought this would be a problem to anybody as he has no correspondence to me, seeing as we sell our salads in a completely different styled container.

Before we opened we checked that everything was all legal and there would be no issues. We checked that nothing would be in our way for using this as the name for our business. The perimeter for my shop is only local and we will not be standing in the way or causing any harm to any other pasta shops around Europe especially Pasta Go, Lodz.”

## Decision

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

“A decision shall not be registered if or to the extent that the application is made in bad faith.”

19. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

“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* [2008] 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)."

20. In these proceedings the relevant date is the date on which the application for the trade mark was filed, namely 13 September 2018.

21. The Opponent claims that having built a significant reputation in the contested sign, the Applicant has sought to free ride on this reputation and had a dishonest intention when it stole the Opponent's business concept. Mr Kruk claims that the Applicant must have known of the Opponent's business and mark, when it used the Opponent's image in its social media post and that the application was made in bad faith, as a measure to block the Opponent from entering the UK market.

22. Whilst I note that the Opponent does not rely on any other ground, in *Fianna Fail and Fine Gael v Patrick Melly* [2008] ETMR 41, Mr Geoffrey Hobbs Q.C., as the Appointed Person, pointed out that:

“Bad faith is an absolute, hence free-standing, ground for refusal of registration...”

23. In terms of reaching a decision on this sole ground of opposition, I must consider whether Mr Newelski, as the Applicant's controlling mind, knew of the Opponent's business and therefore its mark at the relevant date; and in light of that knowledge whether the filing of the trade mark was something which fell below the standards of acceptable commercial behaviour in the relevant field judged by the ordinary standards of honest people.

24. Mr Kruk's evidence shows that the Opponent was using his mark well before the Applicant. The pictures from the Franchise Expo in Katowice<sup>2</sup> clearly supports Mr Kruk's claim that the mark was in use in Poland prior to the relevant date and at least as at March 2017. There is also a Facebook entry dated 20 April 2017 which corroborates when Mr Kruk says his logo and mark were being used on social media. Whilst I note that the Opponent submits accounts from 2013 and registered its mark in 2016, there is no specific evidence from Mr Kruk demonstrating use of the mark between 2013 and 2016. However, there is clear evidence that the mark was being used during 2017 and 2018 but only within Poland. Mr Newelski does not appear to

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<sup>2</sup> Exhibit KK5

dispute the use claimed or that the use is in relation to services within the same market as those for which the application has been made, however, he only accepts that the Opponent has been trading in Poland.

25. Mr Newelski filed the form TM8 and counterstatement in which he outlines various matters which he wishes the registrar to take as evidence to counter the allegation of bad faith. Rule 64(1) of the Trade Marks Rules 2008 sets out the provisions as to what constitutes evidence in proceedings and the form they must take which would normally be by way of a witness statement, affidavit or statutory declaration and contain a statement of truth signed and dated by the maker of that statement.

26. Although Rule 64 sets out the format which the evidence should take, in the case of *Soundunit Limited v Korval Inc.*, BL/0468/12, Mr Daniel Alexander Q.C., sitting as the Appointed Person, acknowledged that “before the High Court a pleading verified by a statement of truth may be admitted as evidence (see CPR Rule 32).”

27. On this basis, whilst Mr Newelski did not formally file a witness statement in the correct format, I am able to consider the contents of his counterstatement as evidence as it has been signed by him personally and the attestation box includes a declaration of truth.

28. Mr Newelski states that he was completely unaware of the Opponent’s use until some 4 months after he opened his business and only after receiving contact from Mr Kruk via a Facebook message. The contact between the parties appears to have taken place during August/September 2018 and although the evidence produced does not specify the date that these Facebook messages were posted, neither party appears to dispute that the exchange took place prior to the filing of the application. I have no doubt that Mr Newelski must have been aware of the Opponent’s business at the very least at the time of the Facebook messages and highly probable for a period of time before then. In addition, Mr Newelski became aware of the Opponent’s trade

mark following the queries raised with the “PL Patent” office which occurred prior to the filing of the application. I have no doubt therefore in finding that Mr Newelski, and thus the Applicant, knew not only of the Opponent’s business but also his trade mark at the relevant date and it is highly probable that this knowledge extended prior to this.

29. In *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12, the Court of Justice of the European Union (“CJEU”) held that merely knowing that a trade mark was in use by another in another jurisdiction did not amount to bad faith under Article 4(4)(g) of the Directive (s.3(6) of the Act). The court found that:

“2. Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that, in order to permit the conclusion that the person making the application for registration of a trade mark is acting in bad faith within the meaning of that provision, it is necessary to take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration. The fact that the person making that application knows or should know that a third party is using a mark abroad at the time of filing his application which is liable to be confused with the mark whose registration has been applied for is not sufficient, in itself, to permit the conclusion that the person making that application is acting in bad faith within the meaning of that provision.

3. Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that it does not allow Member States to introduce a system of specific protection of foreign marks which differs from the system established by that provision and which is based on the fact that the person making the application for registration of a mark knew or should have known of a foreign mark.”

30. Mere knowledge of another mark outside the UK is not sufficient, however; a finding of bad faith must go beyond this. The Opponent claims that the Applicant’s

motivation was to block the Opponent's entry into the UK market and gain an economic advantage. This is denied by the Applicant.

31. It is accepted by both parties that the Applicant only filed its application following Mr Kruk's cease and desist request. Mr Kruk suggests that Mr Newelski's Polish connections were such that he would have been aware of his chain of restaurants and replicated his business model, logo and image, to use within the UK, thus hoping that Polish customers or those who had visited Poland would believe the services were connected in some way. He also claims that due to the mark PASTA GO! already enjoying a significant degree of recognition, it had a potential for growth within the European Union including the UK. Mr Kruk states that his intention was to franchise the restaurants, demonstrated by his attendance at the franchise fair in Katowice in 2017. Following several enquiries, he states that "in 2020 we are going to establish first Pasta Go! franchise restaurant."<sup>3</sup> He submits therefore that it cannot be ruled out that the Applicant was present at the fair or "heard from someone else" as to the Opponent's intention to expand his business. He accepts that currently his restaurants are based in Poland but believes that the Pasta Go! brand has great potential and his goal is to make it an international brand.

32. Mr Newelski submits that the application for registration was prompted when he became aware that the Opponent's mark only had protection in Poland and did not cover use throughout the EU. He applied for the UK trade mark to prevent a challenge to his business and to protect the name and health of his business. Furthermore, he only applied for the mark after checking that "everything was all legal and there would be no issues".

33. In *Daawat* Trade Mark [2003] RPC 11, Mr Geoffrey Hobbs QC, as the Appointed Person, stated:

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<sup>3</sup> Para 8-9 Mr Kruk's witness statement

“107. The domestic perspective of the objection under section 3(6) was correctly recognised in para 17 of the principal hearing officer’s decision:

“In my view a vague suspicion that a foreign proprietor may wish to extend its trade in the UK is insufficient to found an objection under section 3(6).”

34. In the *Daawat* case, the section 3(6) claim succeeded because it was found that the application was motivated by a desire to pre-empt an entry into the UK market in order to secure a commercial advantage in negotiations with the trade mark holder who was aware that the other party wanted to expand into the UK. It meant that not only was the mark known but there were other reasons for applying within the UK.

35. In relation to Mr Kruk’s claim, however, his intention to expand within the UK is not borne out by the evidence. Whilst the Opponent has been trading since 2013 in Poland, there is no evidence in these proceedings that the Opponent has any definitive plans to enter the UK market. It may well be the case that the Opponent had an intention at the relevant date, to enter the UK market in the future, however, there is no specific evidence to suggest that this expansion was imminent. Even if this were the case, it is not clear that the Applicant would have been aware of this intention as at the relevant date. The expansion of the Opponent’s business to date is limited, from 1 restaurant in 2013 to 4 restaurants by 2018. Whilst there is no evidence as to the geographical extent of the Opponent’s restaurants, it is clear, that they are all within Poland. The slow rate of expansion would not give any indication that the Opponent’s next step was to expand in the UK or throughout Europe-wide. It has not been established with any certainty that the Applicant would have had any knowledge of the Opponent’s intentions to franchise or whether if any of those extended to the UK.

36. I bear in mind that the onus is on the Opponent to substantiate his case since an allegation of bad faith is a serious one and not one that should be made lightly. Other than the contact in August/September 2018 via Facebook there is no other evidence submitted that there was any other contact between the parties prior to this date. The marks in suit are not identical, as can be seen below when comparing the marks. In

addition, the use of the words Pasta Go is allusive for a pasta takeaway business. The colour combination red and green is often typically associated with an Italian themed restaurant and therefore I do not consider that this is a decisive factor when assessing the bad faith claim.

Applicant's Mark	Opponent's Mark
	

37. Whilst Mr Newelski accepts that he used the Opponent's image in his first menu, his intention he submits was only for illustration purposes to show "a picture of a white cup with food in it" as a good representation of the food they sold and to indicate to his customers what they could expect. Mr Newelski argues that the containers are not unique to the Opponent's business and are fairly standard takeaway pots. In addition, the use of the image was simply due to an error by his graphic designer and once he realised this, it was removed immediately. He states that it was a simple mistake that was bypassed through the opening of the business and was corrected quickly. Irrespective of Mr Newelski's explanation, I attribute little weight to it as it was included in the Applicant's submissions and not filed as evidence of fact.

38. Nevertheless, despite the Applicant's shortcomings, I bear in mind that it is for the Opponent to establish a prima facie case to rebut the presumption that the Applicant acted in good faith. There has been no evidence submitted by Mr Kruk to suggest that the Opponent's restaurants are well known to any material extent within the UK or that

he has a reputation outside Poland. No evidence has been provided that he has UK customers and he has failed to establish any degree of recognition amongst the UK public of his logo/mark.<sup>4</sup> I do not discount that there may well be a narrow group of Polish consumers, who have come across the restaurants whilst in Poland and would therefore be aware of the mark within the UK, but no evidence has been filed in any event to support such a claim. It is therefore unreasonable for me to conclude that by using the same image, Mr Newelski was hoping to benefit and direct custom away from the Opponent's business, which is especially unlikely due to the geographical locations of both businesses. I do not discount that Mr Newelski may well have been aware that the business name and model worked for the Opponent in Poland and so it was likely to work for him in the UK. This is, however, again insufficient for me to find that the Applicant acted in bad faith.

39. Ordinarily a foreign business with no goodwill in the UK, has no legal protection in the UK.<sup>5</sup> I note Professor Ruth Annand, as the Appointed Person's comments in *Wright v Dell Enterprises Inc.* (HOGS AND HEFFERS), BL O/580/16. Professor Annand ruled that, given the territorial nature of Intellectual Property rights, the mere appropriation of a name registered/used abroad was not enough under UK law: there must be something else involved before this can justify a finding of bad faith.

40. Whilst I accept that there are similarities between the respective parties' marks, in so far as they both offer takeaway pasta and food, the Opponent does not have rights that protect the theme of its Polish restaurants in the UK. Certainly, at the time of filing there is no evidence to suggest that the Applicant was aware of the Opponent's intention to enter the UK market. It must be established that the Applicant's conduct if not dishonest, falls short of the standards of acceptable commercial behaviour.

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<sup>4</sup> AP decision Gourmet Trade marks; *Gourmet Bakers & Sweets London Ltd v Gourmet Foods*, BL O/226/17

<sup>5</sup> *Frost Products Limited v F C Frist Limited* [2013] EWPC 34, 26 July 2013

41. Other than the Facebook messages in 2018 there does not appear to have been any contact between the parties prior to this. Mr Newelski's motivation for applying for his mark appears to have been an opportunity taken, to gain what he saw as a commercial advantage knowing that the Opponent's protection was limited to Poland and did not extend to the UK or Europe. Mr Newelski wanted to protect his own interests in the UK, in light of the threatening behaviour towards his business, as he saw it. It cannot be said therefore that the Applicant filed the application to prevent the Opponent from using his mark nor as a pre-emptive strike to prevent him expanding his business in the UK market. I accept that the action taken by the Applicant was to protect his own business interest within the UK; a business which had been established for at least 4 months prior to the application.

42. Taking all this into account, I do not accept that the filing of the application was conduct that fell short of the standards of acceptable commercial behaviour but rather a strong business sense. Trade marks are territorial which means that effectively protection is granted to the party who filed its application first. I am satisfied therefore that the Applicant's behaviour did not amount to an act of bad faith.

43. The claim under section 3(6) fails; subject to any appeal, the application may proceed to registration.

### **Costs**

44. As the Applicant has been successful, ordinarily it would be entitled to an award of costs. However, as it has not instructed solicitors it was invited by the tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. It was made clear by letter dated the 14 October 2019 that if the pro-forma was not completed, no costs would be awarded. No response

was received to this letter, neither was a completed pro forma returned. On this basis no costs are awarded to the Applicant.

Dated this 4<sup>th</sup> day of March 2020

Leisa Davies

For the Registrar