

O-138-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 2546233  
IN THE NAME OF NORTY LTD  
OF THE FOLLOWING TRADE MARK IN CLASSES 25 & 35:**

**JUST COOL BY AWDIS**

**AND**

**AN APPLICATION FOR INVALIDITY THERETO (UNDER NO 84242)  
BY ROY DALEY-SMOOTHIE**

## **The background and the pleadings**

1) The trade mark the subject of this dispute was filed on 30 April 2010 by Norty Limited (“Norty”) and it completed its registration procedure on 6 August 2010. The mark and the goods and services for which it is registered are set out below:

### **JUST COOL BY AWDIS**

**Class 25:** Clothing; footwear and headgear; leisurewear and sportswear; towelling robes and bathrobes.

**Class 35:** The bringing together, for the benefit of others, of a variety of textiles, furnishings, household textile articles, bed and table linen, clothing, fashionwear, fashion accessories, footwear and headgear, sportswear, towelling robes and bathrobes, enabling customers to view and purchase these goods in a retail outlet, from a wholesale outlet, via mail order or on-line via an internet website

2) Roy Daley-Smoother is the applicant for invalidation. His application was filed on 25 November 2011. Four grounds of the Trade Marks Act 1994 (“the Act”) are relied upon which, in summary, are as follows:

- 1) Under section 3(6) of the Act, in that Norty knew of Mr Daley-Smoother’s business and his JUST COOL mark, yet went ahead and registered its mark.
- 2) Under section 5(4)(a) of the Act, in that the use of Norty’s trade mark is liable to be prevented under the law of passing-off, Mr Daley-Smoother claiming to own goodwill associated with the sign JUST COOL.
- 3) Under section 5(4)(b) of the Act, in that Mr Daley-Smoother owns the copyright in the “JUST COOL brand/mark/logo”.
- 4) Under sections 5(1), 5(2) & 5(3) of the Act, on the basis of a well-known trade mark as defined by sections 55 & 56 of the Act.

3) Norty denies all these claims. Both sides filed evidence. A hearing took place before me on 18 February 2013 at which Mr Daley-Smoother represented himself and at which Norty was represented by Mr Simon Malynicz, of counsel, instructed by Mathys & Squire LLP. Two witnesses were cross-examined at the hearing.

## **The evidence**

4) The evidence filed in these proceedings represents something of a tennis match, with Mr Daley-Smoother adopting a piecemeal approach, often filing evidence in response to points raised by Norty rather than presenting his best

evidence up-front. I accept that this was down to his standing as a litigant in person rather than any attempt to complicate the process. I was, though, required to appoint a case-management conference to bring the tennis match to an end. Mr Daley-Smoothie did try to file further evidence a few days before the hearing. I dealt with this at the hearing itself, refusing his request for leave to file further evidence as I was not satisfied that the matters it contained took his case any further forward and was merely more of the same type of evidence already filed (evidence of Norty using JUST COOL but without BY AWDIS in conjunction).

5) I do not intend to summarise either sides' evidence on a piecemeal basis. I will, instead, refer to the relevant parts of the evidence when dealing with the various grounds of invalidity. The following gave evidence:

- i) Mr Daley-Smoothie gave the evidence on his behalf; he was also cross-examined on his evidence, particularly in relation to his business at the relevant date and whether he had a protectable goodwill.
- ii) For Norty, evidence was given by its general manager, Mr Jawad Jumani; Mr Jumani was cross-examined on his evidence, particularly as to his knowledge of Mr Daley-Smoothie's business at the relevant date, how Norty's mark was coined, and the nature of a discussion Mr Daley-Smoothie and Mr Jumani had had at a trade fair.
- iii) For Norty, evidence was also given by a graphic designer, Mr Thomas Dallespir Patterson. His evidence relates to a logo design that he was instructed to produce, which incorporated the words JUST COOL BY AWDIS; there was no request to cross-examine Mr Patterson.

6) In terms of the witnesses who were cross-examined, Mr Jumani was an excellent witness. He gave direct and clear answers to the lines of questioning put to him, which were often quick-fire in nature. He did not obfuscate. I did not sense in any way shape or form that he was trying to mislead the tribunal. Whilst his answer to one particular question was a little surprising (he could not remember which of his team had coined Norty's mark during a brainstorming session at which he was present - he could not even say if he had come up with it or not), this did not undermine my opinion of him as a witness.

7) In terms of Mr Daley-Smoothie, he was also a good witness, but only to a degree. Mr Daley-Smoothie came across as an open and honest witness. Again, I did not sense that he was trying to mislead the tribunal. He was, though, less reliable in two respects. Firstly, it was clear that his business was very important to him, a business of which he spoke very enthusiastically, and I was struck that his interpretation of his success was somewhat exaggerated when measured objectively against the facts. As I have said, this was not an attempt to mislead, but is something I must nevertheless bear in mind when I come to evaluate his evidence. Secondly, and a point raised by Mr Malynicz, is that Mr Daley-Smoothie

was not 100% accurate with some of the dates of various events/milestones relating to his business – this is understandable to a degree, but it is clearly something I must bear in mind when it comes to evaluating his evidence and what the nature of his business was at the relevant date.

### **Section 3(6)**

#### **Legislation and the leading case-law**

8) Section 3(6) of the Act states:

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

9) 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).”

### **The relevant date**

10) Whether Norty made its application in bad faith must be assessed at a particular point in time. Evidence from after the relevant date can, however, be instructive in deciding whether the application was made in bad faith at the relevant date if it sheds light backwards. As stated in the *Sun Mark* case, the relevant date is the application date of the trade mark. The relevant date is 30 April 2010.

### **Norty’s knowledge at the relevant date**

11) To get the claim off the ground, I must be satisfied that when it filed its application for registration on 30 April 2010, Norty knew of the use by Mr Daley-Smoothie of the words JUST COOL. Mr Daley-Smoothie submitted that there were a number of factors which, when taken together, were indicative of such knowledge, including:

- i) That Norty had adopted the same mark (albeit that it additionally included the words “BY AWDIS”).
- ii) That Norty had also, in trade, adopted a similar strap-line to that used by Mr Daley-Smoothie.
- iii) That Norty had adopted the same product coding as Mr Daley-Smoothie.
- iv) That Mr Jumani’s lack of memory as to who coined the mark was surprising.

- v) That Mr Jumani must have come across Mr Daley-Smoother's use of JUST COOL when he conducted an Internet search.
- vi) That Norty had failed to provide the results of trade mark searches carried out by its trade mark attorney.
- vii) That Mr Daley-Smoother had applied for the mark JUST COOL in the US and Norty, given that it had business interests in the US, would have searched the US register.

12) On an individual basis, none of the above is particularly telling. For example, JUST COOL is not a particularly unusual combination of words for clothing, it is not, for example, an invented word or a highly fanciful phrase. Further, the strap-line in question is LOOK COOL, FEEL COOL, STAY COOL (Mr Daley-Smoother's strap-line is LOOK COOL, FEEL COOL, BE COOL) which, again, is pretty unremarkable, particularly when it is clear from Norty's evidence that the garments it produces under its mark are designed to wick sweat away from the body. The coding is simply the taking of the initial letters of the mark and adding a numeral, so the fact that Norty have come up with JC001 (a code which Mr Daley-Smoother also claims to have used) is unsurprising.

13) In terms of the coining of Norty's mark, Mr Jumani was cross-examined on this and he explained that the mark was coined during a brainstorming session with his staff and that he could not recall exactly which member of staff suggested the name. He could not even say whether he came up with it or not. Whilst I agree that it is surprising that Mr Jumani could not even say whether he coined the mark, there is nothing implausible in not knowing which member of staff came up with the initial idea. In terms of the searches, Mr Jumani stated under cross-examination that he conducted an Internet search when the name was first coined and did not find anything to do with Mr Daley-Smoother's business. Mr Daley-Smoother submitted that this was implausible given that his business was up and running and the way in which search engines operated meant that his website would have been prominent. As I will come on to, the nature of Mr Daley-Smoother's business at the relevant date must have been small at best. The nature of the evidence is not indicative that Mr Jumani was bound to have seen hits for Mr Daley-Smoother's business. There is nothing implausible in Mr Jumani's explanation. In relation to trade mark searches, Mr Jumani explained that he was not sent copies of what his trade mark attorney had searched for; he was just given "the all clear". Of course, Mr Daley-Smoother did not have a trade mark in the UK, so a UK register search would have revealed nothing in terms of Mr Daley-Smoother's mark. For similar reasons to that given in relation to Mr Jumani's Internet search, it is not implicit that any common law searches would have revealed Mr Daley-Smoother's business.

14) The above analysis looks simply at the plain facts. To corroborate certain matters, Mr Jumani provided evidence as to the other brands that Norty produce.

It is clear from this evidence, evidence which is not challenged, that Norty have produced other JUST.... branded clothing. Norty have used the terms JUST HOODS (for hooded garments) and JUST POLOS (for polo shirts). It is stated that JUST COOL was therefore a logical name to come up with that fitted with its previous range of garments. It is explained that the name was coined after Norty decided, in March 2010, to create a new range of clothing designed to keep the wearer cool. This then led to the brainstorming session. A domain name was registered on 26 March 2010. There are emails placing orders for JUST COOL BY AWDIS garments dated 13 April 2010. Also provided is a spreadsheet with an analysis of what Norty considered to be the competing products in the field it was entering, Mr Jumani highlighting that it did not include Mr Daley-Smoothie's mark. There is also the evidence of Mr Patterson, who states that he previously designed a logo for Norty based on the JUST HOODS brand and that in April or May 2010 he was instructed to produce a logo featuring JUST COOL BY AWDIS.

15) Some of this evidence is not particularly significant. For example, the absence of Mr Daley-Smoothie from the spreadsheet is merely evidence that he was not a competitor in the wicking field in which Norty were about to engage. Furthermore, the fact that a domain name and orders were placed shortly before the relevant date does not mean that there was an absence of knowledge of Mr Daley-Smoothie's businesses. However, what is more significant is the previous use of JUST...brands which also includes use of coding based on those brands (JUST HOODS being coded JH001 for example). This gives credence to Mr Jumani's explanations and supports that the mark was coined without any knowledge of Mr Daley-Smoothie's use. Mr Jumani's explanation is very reasonable. Mr Daley-Smoothie suggests that JUST COOL is not consistent with Norty's other ranges – he highlights that the goods Norty makes are made from a material named NEOTERIC which means that if consistent branding were to be used then the garments would have been called JUST NEOTERIC. I consider Mr Daley-Smoothie simply to be clutching at straws here.

16) In relation to Mr Daley-Smoothie's US registration which was filed before the relevant date then, again, Mr Daley-Smoothie is just speculating (that Norty would have conducted a US search and identified it); speculation which is not very convincing. Norty were applying for a UK trade mark so there was no reason at all why it would have gone to the trouble of searching in the US. Norty only later applied itself (in 2011) in the US, so if a search was to be undertaken then this would have been the relevant time to do so.

17) Mr Daley-Smoothie submitted that there were too many co-incidences in play (similar name, similar strap-line, similar coding etc) and that not enough had been done to establish the innocence of the coining. I disagree. I found Mr Jumani to be an excellent witness. His written evidence stacks up well with the answers he gave during cross-examination. He has put forward a very reasonable explanation for the coining of the mark. He has stated, and maintained under cross-examination, that he knew nothing of Mr Daley-

Smoothe's business at the relevant date. There is nothing implausible in his evidence. His evidence is to be believed. I come to the clear view that Mr Jumani, the controlling mind of Norty, knew nothing of Mr Daley-Smoothe's business at the relevant date. Given this, no question of bad faith arises as Norty had no relevant knowledge.

18) I have considered the evidence of matters that have occurred subsequent to the relevant date. None of these matters alter my view of what Norty knew at the relevant date. Some of the things referred to by Mr Daley-Smoothe include:

- i) That Norty filed an application for its trade mark in the US (which was refused due to an earlier mark owned by Mr Daley-Smoothe).
- ii) That Norty has attacked Mr Daley-Smoothe's mark in the US.
- iii) That Norty has used JUST COOL alone.
- iv) That, more recently, Norty has stopped using JUST COOL and now uses "COOL by AWDIS".
- v) A discussion that Mr Jumani and Mr Daley-Smoothe had at a trade fair – Mr Daley-Smoothe alleging that Mr Jumani threatened to put him out of business.

19) The situations with the US trade marks arose after the relevant date. I do not see how a subsequent decision to extend to the US casts any light backwards. That there is some use of JUST COOL alone by Norty similarly casts no different light on what it knew at the relevant date. Apparently Norty have now dropped the word JUST from some forms of its use (Mr Jumani referred to this during his cross-examination). Mr Daley-Smoothe believed that this was significant in some way, presumably that Norty had seen the error of its ways, I do not share such an opinion.

20) In relation to the meeting at the trade fair, there are different versions of events. Mr Daley-Smoothe considered Mr Jumani to have been threatening, threatening to put him out of business and threatening to hamper his ability to travel to the US by making reference to US laws on fraud (which Mr Jumani highlighted because he was aware that a US application requires a formal declaration of use to be made which he argued Mr Daley-Smoothe may have made erroneously). Mr Jumani stated in his evidence and stated under cross-examination that he had merely said that there was no point in both of them going out of business and that they should try to resolve matters; he accepted, though, that he had made reference to US visa laws and the issue of the declaration of use, but not in the threatening way suggested. Having now considered the matter and the evidence in full, I do not consider whatever arose at this meeting to be relevant. By the time of the meeting, the parties had been in

dispute and, therefore, whatever was said, provides little that can be read backwards to the relevant date. For the record, I suspect that the discussion and what was said falls somewhere between the two, Mr Jumani indeed saying what he said with Mr Daley-Smoothe, understandably, regarding some of the conversation as aggressive (the US visa aspect).

## **Motive**

21) Even if I am wrong on the above and Norty did have knowledge of Mr Daley-Smoothe's business and/or his US trade mark, I agree with Mr Malynicz that this would not, in any event, lead to a finding of bad faith. The jurisdictional basis of trade mark rights means that the US registration has little bearing. I must consider the matter in the round and consider what motive Norty had and whether or not such motive means that filing the trade mark represents conduct falling short of acceptable commercial behavior. I can see no plausibility in the argument that Norty was trying to trade off Mr Daley-Smoothe's business. Firstly, the fields to which the parties market are very different – general fashion v wicking garments sold on a wholesale basis. Secondly, and as I will come on to, there is little business to trade off. The primary plank of Mr Daley-Smoothe's argument was that having identified that another trader was using JUST COOL, Norty ought not to have applied to register its mark. This is not enough. Any business Mr Daley-Smoothe had at the relevant date was small and in a different field. Mr Daley-Smoothe had not registered a mark in the UK so as to give him the exclusive right to prohibit use of the mark JUST COOL. Norty were filing for a whole phrase anyway with the point of similarity being fairly limited in distinctive character. I see nothing wrong in the behavior of Norty even if it knew of Mr Daley-Smoothe's business and/or US registration and I consider that this would be the view of reasonably experienced men in the trade.

22) I should add that although I have not referred to every single piece of evidence/argument given/made by Mr Daley-Smoothe (due to his somewhat scattergun approach), I have borne everything in mind in my findings under section 3(6) and those I come on to make.

## **Section 5(4)(a) of the Act**

### **Legislation and the leading case-law**

23) Section 5(4)(a) prevents the registration of a mark the use of which 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..”

24) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position thus:

“The law of passing off can be summarised in one short general proposition - no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

25) The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom.”

26) I note from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature<sup>1</sup>. However, being a small player does not necessarily prevent the law of passing-off from being relied upon<sup>2</sup>.

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<sup>1</sup> *Hart v Relentless Records* [2002] EWHC 1984

<sup>2</sup> See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49

## **The relevant date**

27) In terms of the relevant date, I note the judgment of the General Court in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Joined Cases T-114/07 and T-115/07* where it was stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

28) Use of Norty’s mark before its date of application may be relevant. It could establish that Norty were the senior users, or that there had been common law acquiescence, or that the status quo should not be disturbed which, in turn, could mean that the use of its mark could not have been prevented under the law of passing-off at the relevant date<sup>3</sup>. However, it is clear from the evidence that Norty began using its mark only around the date on which it applied for it, consequently, there is no impact on the position. The relevant date is 30 April 2010.

## **Goodwill**

29) It must be established that Mr Daley-Smoother had goodwill at the relevant date associated with the words JUST COOL. The evidence relating to his claimed goodwill is scattered throughout his evidence. The following is a summary of what the evidence contains.

30) Mr Daley-Smoother makes various statements about his marketing and launch activities that have taken place since “Q1 2009”. These include:

- i) That in July 2009, a JUST COOL retail store launch was held in the Charlie Browns Menswear store and in the main public product showcase area of the Westfield Shopping Centre. The boxer Nigel Benn was a brand ambassador and guest at this launch. Mr Benn has been an ambassador since the conception of the brand.

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<sup>3</sup> See, for instance: *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

- ii) That JUST COOL clothing has been sold in retail stores in the UK (and also in the US).
- iii) That there are production sales and distribution partners in the UK (and also the US).
- iv) That marketing material has contained the phrase LOOK COOL – FEEL COOL – BE COOL.
- v) That coding has been used in the format JC001-JC007 etc. since the conception of the brand.
- vi) That networking, brand partnership, endorsements etc. has taken place.
- vii) That JUST COOL has featured on BBC television (morning, afternoon and evening news) by way of being a sponsor of a British Bobsleigh athlete.
- viii) That JUST COOL has featured on film for a brand promotion video published on You Tube and DVD where famous music artists were interviewed.
- ix) That various celebrities have worn, been photographed in or have otherwise endorsed JUST COOL. A long list is provided of such celebrities including Peter Andre, Shirley Bassey, Colin Jackson, Tom Daley & Christopher Biggins.
- x) That JUST COOL has undertaken charitable partnership work including initiatives with Caudwell Children's charity, World Vision, RAAFA (a charitable organisation which ran the 2012 Olympic Inspire Awards) & Reggie Run.
- xi) That between 2009 and 2010 tens of thousands of flyers, leaflets and promotional wristbands have been produced.
- xii) That there are several JUST COOL websites owned by Mr Daley-Smoother (5 domain names are provided, one does not feature the words JUST COOL) and that "JUST COOL has always been on Facebook/Twitter".
- xiii) That JUST COOL has featured in the *Voice* magazine and the *Keep the Faith* magazine.
- xiv) That JUST COOL was featured in A Night in Paris, a fashion show in Los Angeles. The event was aired on US television. A DVD of this event was sold in the US and globally via the Internet.

xv) That JUST COOL has “recently” featured in the Midlands Independent newspaper.

xvi) That JUST COOL has featured in various promotional/sponsorship events including: National Student Entrepreneurs Conferences, Global Entrepreneurs week, Virgin Media Pioneers events, Institute of Directors Global Entrepreneurs week, Caudwell Children’s Celebrity Ball events, Passing the Baton Olympic events, The Big Church Day Out (over 25,000 attendees), Jamaica Live in Birmingham, The World Travel Market Show, Jamaica 50<sup>th</sup> Celebrations event, National Flux business events and awards, a tour of major UK cities with Nigel Benn, and a tour with Sports Directors from UtECH.

31) In his written evidence, Mr Daley-Smoothie gives little by way of commentary to explain the nature of the above, let alone when exactly they took place. One exception to this is the launch event with Nigel Benn in July 2009. In paragraph 10 of his witness statement of 11 August 2012 Mr Daley-Smoothie states:

“Again, I wish to refer to the printout copies of the partnerships, PR and press that Just Cool has had over the 2009- April 2010 period, which is produced and marketed in Exhibit RS2.”

32) Exhibit RS2 contains a number of documents filed to support the various activities that I have listed above. Many of the documents carry no information to place them at a particular point in time. Despite Mr Daley-Smoothie’s comment that they relate to the 2009 - April 2010 period (i.e. before the relevant date), some of the documents clearly come from after this period. For example, there are website prints which contain references to events in October 2010, so the print itself must have come from after the relevant date (a point Mr Daley-Smoothie accepted under cross-examination) although, I note that there is a reference on the print to the launch event with Mr Benn and a reference to a regional tour. There is an email from October 2010 (after the relevant date) relating to obtaining a model for a fashion show. Evidence relating to the Night in Paris Fashion Show demonstrates that it took place after the relevant date. A letter from Caudwell Children’s Charity demonstrates that the initial partnership with Just Cool was to commence on 5 October 2010, again after the relevant date. Internet prints relating to a karting event in Derby in which Just Cool was a sponsor are provided, but this took place in 2011, after the relevant date.

33) There are further problems with much of the evidence. The celebrity endorsement evidence lacks not only dating information, but also evidence as to its impact. The photographs simply show a celebrity with, for example, a JUST COOL wristband, and, in a number of photographs, a bottle of JUST COOL water. Without better evidence, I struggle to see how this will have had any material impact in terms of creating goodwill. Similarly, there are prints from websites featuring Dave Smith of the British Bobsleigh team who appears to be

wearing a JUST COOL item of clothing. One print is not dated. The other carries an indication that it is 542 days to the start of the 2014 Winter Olympics which puts the print at no earlier than 2012; in any event, simply wearing a garment does little to create goodwill.

34) During cross-examination, it was clear that whilst certain events referred to by Mr Daley-Smoother could be verified in terms of date (the launch event with Mr Benn for example) other dates were less verifiable. Due to this, and due to the evidence containing a mixture of non-dated material, post-relevant date material and some pre-relevant date material, I consider it appropriate to evaluate Mr Daley-Smoother's evidence with a critical eye and that only events/activities with documentary evidence proving that they took place before the relevant date may be relied upon. To that extent, I come to the view that the only reliable evidence is as follows:

- i) The launch event in Westfield Shopping Centre which is stated to have included the first concessions.
- ii) That some publicity followed the above in the *Voice Magazine* and the *Keep the Faith* magazine. The former is dated before the relevant date. The latter carries no date, but as the article refers to the "recent launch", I am prepared to accept that this was also published before the relevant date.
- iii) A charitable partnership with World Vision – a press release in Exhibit RS2 dated 5 April 2010 is provided in support.
- iv) That some form of regional tour took place – this is stated by Mr Daley-Smoother and the JUST COOL website indicates that this took place in March 2009.
- v) That a website may have been in operation (I accept this on the basis of Mr Daley-Smoother's cross-examination) but it is not the one depicted in the evidence as it was explained that the documented website was a later version.

35) In his submissions, Mr Malynicz highlighted that despite all of the evidence filed by Mr Daley-Smoother, he had not provided evidence of any sales. There were no turnover figures, invoices, accounts etc. He considered this to be virtually fatal to the passing-off claim because it was only in the rarest of circumstances that goodwill can be established on the basis of pre-trading activity. Mr Daley-Smoother stated that the whole point of his approach was to build demand and goodwill, with sales coming later. He did, though, ask me to infer that some sales had been made given that he had a retail concession (I also note the statement in his evidence that "JUST COOL clothing has been sold in retail stores in the UK").

36) Looking at the above evidence in more detail, in respect of the print articles listed at point ii), it is not clear what the circulation of these magazines containing the articles was or, furthermore, what impact they have had on the reader. The article in the *Voice*, whilst referring to the launch event with Mr Benn, refers to “Smoothe [Mr Daley-Smoothe] aims to launch the label in a major way during 2010...”. There are as many references to Mr Daley-Smoothe as there are to the name JUST COOL. Although it is stated that the range includes particular garments, no information regarding where the products may be purchased from is given. The reference to Westfield shopping centre is purely in relation to “a special launch”. There is no mention of a concession. The *Keep the Faith* article at least features some pictures of garments bearing the words JUST COOL - three garments are depicted, the first has the letters JC with the words JUST COOL running through them, the second has the words JUST COOL, the third just the letters JC. I note that where JUST COOL is written, both on the garments and in the text of the article, the T of JUST is a Christian cross (this also applies to the text in the *Voice* article). However, the *Keep the Faith* article also states “Roy [Mr Daley-Smoothe] and his team aim to launch the brand with a major campaign next year”. A website address is provided for “more details”. There is no information as to where the products may be purchased (if indeed they can be purchased at this stage).

37) In terms of the charitable activity listed at point iii), this was only just before the relevant date, and there is no evidence as to its public facing impact. In terms of the regional tour listed at point iv), no evidence is given as to the locations visited, the signage used, whether clothes were present, the number of attendees, the nature of the events. In terms of the website, again, it is not known what it looked like or the extent to which it was accessed. Information such as unique visitor numbers is easily obtainable but has not been provided. Similarly, archive prints of the website could easily have been provided from online tools which are also readily available.

38) In relation to the launch event with Mr Benn in the Westfield shopping centre, it is not clear how many members of the public encountered the event. Furthermore, the problem with these sorts of events is in assessing the impact on those people who encountered it. For many, there may have been only a passing interest which soon dissipated. It is stated that a concession was launched in Charlie Brown’s retail store within Westfield. However, it is not explained how long the concession was there. If it were simply installed as part of the launch event it may have been there for only a very short length of time. As already stated, no sales evidence is provided.

39) I cannot infer from the evidence that Mr Daley-Smoothe’s business has made sales sufficient to establish the existence of goodwill. Such inference is a leap too far when the totality of the evidence is considered. Bearing in mind my criticisms of the evidence, I am not satisfied that the other promotional activities

demonstrate goodwill of more than a trivial level. Without goodwill, Mr Daley-Smoothe's claim under section 5(4)(a) fails at the first hurdle.

### **Misrepresentation**

40) I shall give some brief views on the matter of misrepresentation in case I am wrong on the matter of goodwill. Misrepresentation requires that a substantial number of people would believe that the goods sold under the JUST COOL BY AWDIS mark are the responsibility of Mr Daley-Smoothe. In making this assessment I consider the following to be relevant:

- i) If Mr Daley-Smoothe has goodwill associated with JUST COOL then it is goodwill of a low level.
- ii) The goodwill is associated with other signs which are often used in conjunction with the JUST COOL name – e.g. the letters JC and the use of a Christian cross, and, to an extent, Mr Daley-Smoothe's name.
- iii) That the words JUST COOL are, from an inherent perspective, not a particularly distinctive sign as they have some clear suggestive qualities as to the nature of the goods.

41) Unlike matters under section 5(2) of the Act, the question of misrepresentation is not a pure notional matter comparing the two trade marks and their goods and services and then deciding whether there is a likelihood of confusion. Instead, passing-off requires a notional consideration of the mark the subject of the dispute (JUST COOL BY AWDIS) against the actual use made by Mr Daley-Smoothe. Given the factors I have identified in the preceding paragraph, my conclusion is that there will not be a misrepresentation. Mr Daley-Smoothe's claim fails for this reason also.

### **Well-known mark**

42) I intend to deal with this claim in the briefest of ways. Not having goodwill (or if I am wrong on that only having weak goodwill) is indicative that the mark JUST COOL is not well-known in the UK. A mark can be well-known on account of actual trade elsewhere but which is, nevertheless, well-known in the UK. There is no basis in the evidence whatsoever to come to the conclusion that this is the case here. Mr Daley-Smoothe's claims fails.

### **Section 5(4)(b)**

43) The pleaded case under section 5(4)(b) relates to the use of the applied for mark being restrained under the law of copyright. However, Mr Daley-Smoothe

did not pursue this ground at the hearing, accepting that his claim was weak. This is a sensible concession. The applied for mark has no graphic element and so, even if Mr Daley-Smoother established that one of his graphic logos was protected under the law of copyright, the plain words would not infringe it. Having regard to the plain word nature of the applied for mark, the only claim that Mr Daley-Smoother would have been able to make would be that the words JUST COOL constitute a literary work. Such words are clearly not a literary work. Furthermore, given my findings under Section 3(6), there is also an absence of copying.

### **Costs**

44) Norty has been successful and is entitled to a contribution towards its costs. However, before I make an award Norty is required to provide in writing the costs associated with Mr Jumani having to attend the hearing for cross-examination. I will then consider this information and decide what is reasonable. Norty should advise of the costs of Mr Jumani attending the hearing within two weeks of the date of this decision. A copy should be sent to Mr Daley-Smoother, who will have two weeks to comment upon the claim for costs for attending cross-examination and upon this claim alone. A supplementary decision will then be issued giving my decision on costs, which will then trigger the appeal period for both my substantive decision and my supplementary decision.

**Dated this 26th day of March 2013**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**