

O-169-20

**TRADE MARKS ACT 1994
IN THE MATTER OF REGISTRATION No. 3322196
STANDING IN THE NAME OF
NICHOLAS SEBASTION ALEXANDER AND KARL BROWN EDWARDS
AND
IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No.502595
BY TRAP KITCHEN LIMITED**

BACKGROUND

1) The following trade mark is registered in the name of Nicholas Sebastian Alexander and Karl Brown Edwards (hereinafter NAKE):

Mark	Number	Filing & registration date	Class	Specification
<p>TRAP KITCHEN TRAPKITCHEN</p> <p>A series of two marks</p>	3322196	03.07.18 26.04.19	25	<p>American football bibs; American football pants; American football shirts; American football shorts; American football socks; Ankle socks; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Athletic clothing; Athletic shoes; Athletic tights; Babies' clothing; outerclothing; Bandanas; [neckerchiefs]; Bandannas; Baseball caps; Baseball caps and hats; Baseball hats; Baseball uniforms; Bath robes; Bathing costumes; Bathing costumes for women; Bathing suits for men; Bathing trunks; Beanie hats; Belts for clothing; Belts made from imitation leather; Bodies [clothing]; Bodies [underclothing]; Body suits; Body warmers; Boys' clothing; Bralettes; Caps with visors; Clothing for men, women and children.</p>
			43	<p>Banqueting services; Bar and restaurant services; Carry-out restaurants; Catering; Catering</p>

				<p>(Food and drink -); Catering in fast-food cafeterias; Catering of food and drink; Catering services for providing Spanish cuisine; Fast food restaurants; Fast-food restaurant services; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Food and drink preparation services; Food preparation; Food preparation for others on an outsourcing basis; Food preparation services; Mobile catering; Mobile catering services; Mobile restaurant services; Organisation of catering for birthday parties; Outside catering; Outside catering services; Personal chef services; Private members dining club services; Private members drinking club services; Providing accommodation for functions; Providing food and drink catering services for fair and exhibition facilities; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars.</p>
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2) By an application dated 9 May 2019 Trap Kitchen Limited (hereinafter TKL) applied for a declaration of invalidity in respect of this registration. The grounds are, in summary:

- a) TKL contends that it has used the mark TRAP KITCHEN in respect of “food and drink and services for the provision of food and drink” since 2016 and has considerable goodwill in the mark. TKL contends that use of the mark in suit will cause misrepresentation and damage through loss of sales or detriment to the repute and distinctive character of its marks. The mark in suit therefore offends against section 5(4)(a) of the Act.

- b) One of the registered proprietors of the mark in suit, Mr Edwards, lives in the Camberwell district of South-east London, the same area that TKL’s business is located and so he must have been aware of TKL’s mark and its use. The mark in suit therefore offends against section 3(6) of the Act as it was registered in bad faith.

3) NAKE provided a counterstatement to the invalidity action, dated 22 July 2019, in which they state:

“The trademark in question has now been co registered to two separate entities, the invalidation applicant has again stated that his "extensive use" of the said Mark prior to the registration of the said mark. While this might be true it is also true for ourselves while our social media numbers might not compare to the invalidation applicants one knows certain numbers on social media can be paid for, but we have had just as much influence around the UK internationally promoting the Food Business on the Channel 4 TV SHOW "Come Dine With Me" and cooking for celebrities such as Jorja Smith, Nines, SL, Yung Fume, Lotto Boyz, ONE Acn, Bowzer, 9p, Big Zu, Grim Sickerz, Jay Kae, Depsa Robinson, and many more across the country who have all promoted our business via their social media platforms totalling in the millions of authentic followers.

While Co-registration is not ideal in this situation we have opted not to file an Invalidation Application at this time based on the fact that we are in the process of merging with our partners in America to launch a chain of restaurants globally with the help of investors which we hope will encourage or opposition to merely change the name of its one location as we have multiple locations internationally that will be opening up. NICHOLAS ALEXANDER created the business plan for this company in January of 2016 evidence can be provided. The invalidation applicant mentioned that

we would be riding the coattails of the applicant but the applicant himself saw this mark on social media and decided to make it his own where as we decided to work with the ORIGINATORS of the mark and create a Global conglomerate of American style street food restaurants under the Umbrella of TRAPKITCHEN. The applicant showed no "good will" when he registered the name Trap kitchen as a business he was just trying to take something he say on social media and make it his own, therefore making the grounds that my opposition are seeking to terminate my Trademark invalid because the applicant did not exercise goodwill when he registered this business. Given how easy it is to communicate globally the opposition could have taken the same steps as I did to give create a joint venture with the originators of this idea internationally .

My friends in the states have a company fully registered and Trademarked business under the same name TRAP KITCHEN or TRAPKITCHEN (<http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4810:lwn3x8.2.2>) in the US which is the origin of this specific style of cooking and the name. I have received their blessing to file this application in GOODWILL because I did not want to recreate what they had already created in 2013/2014 or even earlier and received more media coverage than anyone involved in this current dispute could ever afford to pay for so as we are taught in the states I filed for my trademark before I registered a business I would potentially need to change although I had all branding done and market research conducted over the course of a few years as I saved capital for the business.

Again the application was in no way made in bad faith and the MAIN APPLICANT (Nicholas Alexander) has no knowledge of the area that KARL BROWN EDWARDS is from as he only met the applicant in 2015 in his area of WOLVERHAMPTON where NICHOLAS ALEXANDER resides. If anything this is more a situation of circumstance as NICHOLAS ALEXANDER had no idea who KARL BROWN EDWARDS was until 2014/2015 when NICHOLAS ALEXANDER showed KARL BROWN the business he was seeing his now friends in America become successful in as he sought out support from various family members and KARL BROWN EDWARDS being the cousin of NICHOLAS ALEXANDER decided to help. There again is no bad faith in these circumstances, we literally have a case of two people creating the same business that was prevalent in the UNITED STATES OF AMERICA under the same name of which

has been on every major media outlet and even released cook books etc. No ill will has been done in regards to my opponents but we are merely victims of circumstance and I happened to be first in securing my circumstances legally as I our vision for the brand far exceed the Invalidation Applicants. To conclude this application was not made in bad faith at so is not eligible for termination in accordance with Section 3(6) of the trademark act. We in no way discourage the Applicant of the Invalidation application to reach out and try to create a joint venture in the future once this case is settled as there grounds for termination do not meet the threshold. Thank you for your time.”

4) Only TKL filed evidence. Both sides ask for an award of costs. Neither side wished to be heard; both sides filed written submissions which I shall refer to as and when necessary in my decision.

TKL’s Evidence

5) TKL provided a witness statement, dated 12 September 2019, by Prince Cofie-Owusu the Managing Director of TKL. He states that he conceived of and launched TRAP KITCHEN in early 2016. He states that the concept was take-away food prepared from the kitchen of his mother’s flat in Camberwell with the focus of African-American soul-food. He started using social media to promote his business almost immediately. Although he began as a sole trader the success quickly meant that he moved to a limited company status. On 15 November 2017 Vice media published on its website a profile of the company stating that despite having no shop window or website word of the company and its food had spread across South London. On 31 May 2018 Mr Cofie-Owusu appeared on the BBC2 programme Million Pound Menu which he states “allowed aspirant restaurateurs the opportunity potentially to obtain outside investment, while also facilitating a demonstration of the participants’ culinary and managerial skills by way of a “pop-up” restaurant”. Following the television programme the company was featured in an online article, dated 15 June 2018, by London News Online and spoke of the company’s growing “cult” reputation and headlined “Camberwell chef flooded with offers after TV show”. In June 2018 the Evening Standard did a profile of the company in anticipation of the opening of the first actual shop in Manchester. The article mentions that the company has 70,000 followers on Instagram. The article mentions that the company provides 200 meals a night earning approximately £10,000 per week. It also states that “Trap Kitchen is now

notorious within the urban music scene and fashion industry". He states that the business was such a success that other residents had complained to the Council about the number of cars queuing for their food and that the police had also been involved.

6) Mr Cofie-Owusu points out that one of the joint applicants, Mr Karl Brown Edwards lists as his address a property approximately half a mile from the premises used by TKL for its business, and where significant issues arose regarding traffic flow and parking. Mr Cofie-Owusu states that he finds it "inconceivable" that Mr Edwards would not have known of his business. He provides the following:

- PCO2: Undated photos from Instagram of the food on offer by TKL.
- PCO3: A copy of the VICE profile.
- PCO4: Documents regarding the BBC2 programme Million Pound Menu showing a Guardian article about the programme, photos from the programme on an Instagram account which shows TKL, an article from the BBC website about the episode of Million Pound Menu featuring TKL which gives prominence to TKL and talks about its success prior to the show.
- PCO5: A copy of the London News Online article, dated 15 June 2018. This shows photos of the show and talks about the reputation of TRAP KITCHEN before the show aired, which then increased substantially.
- PCO6: A copy of the Evening Standard article dated 24 June 2018 which states that TKL had a significant reputation for takeaway food with people queuing round the block awaiting their box of food.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) The invalidity is brought under Section 47 of the Trade Marks Act 1994 ("The Act") which reads:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

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

(2) The registration of a trade mark may be declared invalid on the ground-

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

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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

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

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

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the

United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

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

(2C) For these purposes –

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

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

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

9) I note that only TKL filed evidence in this case. NAKE filed submissions which included evidence but despite being advised by UKIPO that evidence needed to be filed in the correct format, failed to comply and refile its evidence correctly. I therefore do not regard anything included in the submissions as evidence, as such the evidence of TKL is unchallenged. I also take into account the comments of Mr Arnold Q.C (as he was) when acting as the Appointed Person in *Extreme* BL/161/07 where he commented on the issue of unchallenged evidence and cross examination:

“Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rules [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficult in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [205] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing

officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically).”

10) The first ground of invalidity is under Section 3(6) which reads:

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

11) The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. (as he was) 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)."

12) I take into account the comments in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2009] RPC 9 (approved by the COA in [2010] RPC 16), where Arnold J. stated that:

"189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely

because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

13) To my mind, this case is on all fours with *Cipriani*. It is clear from their submissions that NAKE believed that they had a right to use the mark given an association with users in the USA and therefore applied for the mark in the UK. I accept that the counterstatement only carries a denial from one of the joint applicants that it knew of the existence of TKL. However, simply living near to a place of business does not mean that one is aware of its existence particularly in a large built up area like Camberwell, and a business being operated out of a parent’s flat and not on the high street. There is no evidence of any advertising other than on social media and so if one does not look on Instagram one could be utterly ignorant of the existence of TKL. Similarly, if one does not read a local newspaper or watch culinary television programmes then one might never have heard of Trap Kitchen. Bad faith is a very serious charge and the evidence must be far more compelling than that someone lived nearby and must have been aware of traffic problems. **The ground of invalidity under section 3(6) fails.**

14) I next turn to the ground of invalidity under section 5(4)(a) which reads:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

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

15) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

16) Halsbury’s Laws of England Vol. 97A (2012 reissue) at paragraph 309 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

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

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

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

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

17) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely

separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

18) First, I must determine the date at which TKL’s claim is to be assessed; this is known as the material date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘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.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

19) The mark in suit was applied for on 3 July 2018, and is, therefore, the material date. However, if NAKE had used its trade mark prior to this then this use must also be taken into account. It could, for example, establish that NAKE is the senior user, or that the status quo should not be disturbed; any of which could mean that NAKE's use would not be liable to be prevented by the law of passing-off – the comments in *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer. As

NAKE has not provided any evidence of use of its mark then the date of application falls to be the relevant date. For the purposes of this ground of invalidity **the material date must be 3 July 2018.**

Goodwill

20) I now turn to consider the evidence filed by TKL to determine when it began use of its mark and upon which goods and services. In determining this I take into account the guidance in the case of *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), where Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

21) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

22) The evidence provided by TKL is sparse by any standards. However, there is, in my opinion, enough evidence provided to make a prima facie case. It is clear that the takeaway food sold for £20 a box and that approximately 200 boxes were sold on three nights a week which would equate to an absolute maximum income of £12,000 per week, whilst TFL only claims to have a turnover of £10,000 indicating that he is not overstating the position. The fact that his business caused issues for local residents which involved complaints to the council and police, as reported in the local media, is also testament to the fact that the business was by June 2018 generating considerable goodwill through its sales and its coverage on social media, local media and indeed national television.

23) In its submissions NAKE contended:

“I'd like to take the time to directly challenge my opponent on several grounds starting with the grounds of "goodwill" as defined by the Business Dictionary in brief; "an assumed value of the attractive force that generates sales and adds value to its assets". The name TRAP KITCHEN or TRAPKITCHEN isn't what draws my opponent's consumers to its product it's my opponent's actual product which in no way represents the meaning of the words involved in this trademark TRAP KITCHEN or TRAPKITCHEN, of which is an American term that stems from the gang culture of this very country in which NICHOLAS ALEXANDER (myself) was raised.”

24) This shows a fundamental misunderstanding of the meaning of goodwill. Goodwill was defined in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

25) It is true to state that it is the quality of the product or service that determines whether customers return, but they connect that quality to the name to the business. Whilst one may wax lyrical about a good or service it is inextricably linked to the name of the manufacturer / supplier. In the instant case, most restaurants and food outlets will sell dishes which include meat and vegetables, but there is a considerable difference in how they are prepared and cooked such that one will prefer one supplier over another. The goodwill accrues in the name of the business.

26) Of course, goodwill must be of more than a trivial nature. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

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

27) However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

28) See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA). In the instant case, the extent of use of TRAP KITCHEN by TKL in respect of takeaway services is such that it has goodwill in the services of provision of takeaway food.

29) In their submissions NAKE contended that they had co-existed with TKL and that NAKE also had goodwill in the UK. However, they failed to file any evidence to support such a claim. They also contended that they had goodwill through an association with a company in the USA which they claim invented the mark and have been using it for a considerable period. Again there is no evidence of any use by a third party in the USA, or indeed an association between said third party and NAKE. Even if there were evidence of use on the USA it would not equate to goodwill in the UK.

Misrepresentation

30) As part of the test under this ground of opposition I must take into account the distinctiveness of the sign being relied upon. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

31) TKL contends that it has used the mark TRAP KITCHEN in respect of takeaway foods services. There is no evidence that the word TRAP has any meaning in relation to food or takeaway services. Obviously, the word KITCHEN is descriptive of the area or building in which food is prepared. In the instant case I regard the mark relied upon TRAP KITCHEN as being distinctive for the services for which it has goodwill. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

32) When considering misrepresentation it is the plaintiff's customers or potential customers that must be deceived. In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

33) The customers of the plaintiff (TKL) are the general public. The marks both consist of the words “TRAP KITCHEN”. The conjoining of the two words in the second mark in the series will not affect the way that the average consumer views the mark as the words do not form a unit when conjoined but retain the same meaning as that when used with a gap

between them. Whilst TKL has reputation in respect of takeaway food services the mark in suit has been applied for in relation to goods and services in classes 25 and 43. Clearly, the vast majority of the class 43 services applied for by NAKE are identical or highly similar to the services provided by TKL. Most are related to catering services i.e. the provision of food and drink. The only service that seems to go beyond this remit is that of “Providing accommodation for functions”. I presume that the clothing in class 25 will be promotional items advertising the takeaway services. However, it is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade (*Harrods Ltd v Harrodian School Ltd* [1996] RPC 697). I must therefore consider whether, despite the goods and services being dissimilar, there would be deception amongst a significant number of TKL’s clients. To my mind, use of NAKE’s mark upon food and drink goods in class 43 (including the provision of accommodation for functions) would cause misrepresentation to the purchasers of TKL’s takeaway food, as they would regard all the services as merely a logical extension of the takeaway business. Similarly, use of the name of the takeaway service upon items of clothing would be viewed as advertising the takeaway business and again linked to TKL.

Damage

34) In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff’s reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant’s plastic irrigation equipment might be dissuaded from buying one of the plaintiff’s plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

35) In a *quia timet* action it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* 56 RPC 429 Goddard L.J. stated:

“But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man’s business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage.”

36) Consequently, in the instant case if TKL has established a goodwill and shown deception/misrepresentation then damage can be considered as the automatic sequitur and the three elements of the classic trinity of passing-off will have been established. **In the instant case the ground of invalidity under section 5(4)(a) is successful in respect of all the goods and services applied for by NAKE.**

CONCLUSION

37) The invalidity action under section 3(6) failed but was successful under section 5(4)(a). Trade mark 3322196 will be struck from the Register and deemed never to have been made.

COSTS

38) As TKL has been successful it is entitled to a contribution towards its costs. They have been professionally represented.

Preparing a statement and considering the other side's statement	£200
Expenses	£200
Preparing evidence	£400
Providing submissions	£800
TOTAL	£1600

49) I order Nicholas Sebastian Alexander and Karl Brown Edwards to pay Trap Kitchen Limited the sum of £1,600. This sum to be paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of March 2020

**G W Salthouse
For the Registrar
the Comptroller-General**