

BLO/174/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3441967

BY

LEE MALIN

TO REGISTER THE TRADE MARK

**Garrison Coffee Company**

IN CLASSES 30 AND 43

AND

THE OPPOSITION THERETO UNDER NO 419728

BY

CARYN MANDABACH PRODUCTIONS LIMITED

## BACKGROUND AND PLEADINGS

1. On 6 November 2019, Lee Malin (“the applicant”) applied to register the above trade mark in class 30 for coffee and in class 43 for coffee supply services for offices [provision of beverages].<sup>1</sup>
2. The application was published on 6 December 2019, following which Caryn Mandabach Productions Limited (“the opponent”) filed a notice of opposition against all of the goods and services in the application.
3. The opponent bases its case on sections 5(2)(b) and 3(6) of the Trade Marks Act 1994 (“the Act”).<sup>2</sup> The pleadings are as follows:

### Under section 5(2)(b)

4. The earlier mark GARRISON is inherently highly distinctive for the goods. The application, GARRISON COFFEE COMPANY, is visually, aurally and conceptually highly similar to the earlier mark. The opposed goods and services are similar or identical to the goods for which the earlier mark is registered and which are relied on. As a result, there exists a likelihood of confusion, including a likelihood of association.
5. The opponent relies upon the following two trade marks for the purposes of the 5(2)(b) ground:

Mark details:	Goods relied on:
<p>UKTM: 3353684</p> <p><b>GARRISON</b></p> <p>Filed: 15 November 2018</p> <p>Registered: 12 April 2019</p> <p>Priority dates:</p>	<p><b>Class 30</b></p> <p>Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice;</p>

<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

<sup>2</sup> The original statement of grounds also relied on section 5(4)(a). This was removed in the opponent’s written submissions dated 20 October 2020.

<p>03 September 2018  EUIPO – from EUTM 17949939  15 May 2018  Benelux Office for Intellectual Property  1375127.</p>	<p>seasonings, flavourings and condiments;  chutneys [condiments].</p>
<p><b>EUTM:</b> 17949939   <b>GARRISON</b>   <b>Filed:</b> 15 November 2018  <b>Priority date:</b>  15 May 2018  Benelux Office for Intellectual Property  1375127.</p>	<p>Coffee, tea, cocoa and artificial coffee; rice;  tapioca and sago; flour and preparations  made from cereals; bread, pastry and  confectionery; ices; sugar, honey, treacle;  yeast, baking-powder; salt; mustard; vinegar,  sauces (condiments); spices; ice;  seasonings, flavourings and condiments;  chutneys [condiments].</p>

### Under section 3(6)

6. The opponent claims:

*“The Opponent is a producer of the acclaimed television programme Peaky Blinders ('Programme') and the owner of all intellectual property rights in and relating to the Programme, which prominently features a venue known as the “Garrison”. The mark applied for contains the mark ‘GARRISON’ in its entirety; and the Applicant also applied for the mark PEAKY GRINDERS (UK00003464768) for the same and similar goods and services (since withdrawn after the Opponent filed a TM7A against the present Application), and so the Applicant must have known of the reputation and success of the Programme and filed this Application not with the aim of engaging fairly in competition, but with the intention of undermining, in a manner inconsistent with honest practices, the interests of the Opponent, with the intention of obtaining an exclusive right which would conflict with the functions of a trade mark, in particular to indicate origin connected with the Opponent and take unfair advantage of the advertising and investment function of the*

*Opponent's marks. The filing of this application falls short of the standards of acceptable commercial behavior observed by reasonable and experienced operators, and amounts to the Applicant having acted in bad faith at the time of filing the Application. Accordingly, the Application should be rejected entirely."*

7. The applicant filed a counterstatement, to which I will refer in more detail later in this decision. The applicant focuses on the 5(4)(a) ground, which was initially pleaded by the opponent<sup>3</sup> and the 3(6) grounds and submits:

*"...I settled on The Garrison Coffee Company when looking for a new name because of my love for Birmingham City and The Garrison pub being where my 3 Uncles had taken me before that first game I attended in the 1976/77 season as it was where they would always go pre match for their refreshments and catch up with their friends and work colleagues before heading to the game."*

8. The applicant writes of family trips to visit The Garrison pub in Birmingham before attending Birmingham City football matches and says:

*"It's that history and affiliation with each other that I want to celebrate and that association with each other between club and pub started 107 years before Peaky Blinders ever hit the TV screens and will be associated still together a lot longer than I've finished working or Peaky Blinders is either being made or even repeated on TV or streamed on the internet."*

9. The opponent filed evidence and written submissions. The applicant filed written submissions. Neither side requested a hearing. The applicant is self-represented. The opponent is represented by Wiggin LLP. I make this decision following a careful review of all of the papers before me.

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<sup>3</sup> The opponent confirmed that it was no longer pursuing the 5(4)(a) ground of opposition in paragraph 2 of its submissions, dated 20 October 2020.

## **The opponent's evidence**

### Witness statement of Susan Waddell and exhibits SW01-SW26

10. Ms Waddell is the Commercial Director of Caryn Mandabach Productions Limited. Her witness statement is dated 20 October 2020.

11. I do not intend to provide an evidence summary here, but will refer to it as necessary throughout the decision.

## **The opposition under section 5(2)(b)**

12. In his counterstatement dated 25 July 2020, the applicant has made no reference to the opponent's claims under this section of the Act. Section 8 of the TM8 (counterstatement) reads:

“Your counterstatement is the reason(s) for your defence of your trade mark against the grounds presented by the opponent / applicant for cancellation.

The purpose of the counterstatement is to admit (agree), deny (disagree) or request proof of any of the grounds set out by the other party in their statement of grounds.”

13. However, the applicant has, throughout his narrative attached to the counterstatement, made reference to the fact that in his view customers would not associate his business with the TV show Peaky Blinders. The opponent has proceeded on the basis that the applicant has denied that there will be confusion between the parties' respective trade marks and I will do the same.

## **Approach**

14. I will deal first with the opponent's case under section 5(2)(b) of the Act in respect of its mark UKTM GARRISON. The UK and EU trademarks have the same specification and priority date and are registered for the same specification in class 30.

15. Section 5(2)(b) of the Act states:

“5. - (2) A trade mark shall not be registered if because -

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

16. The opponent's mark is an earlier mark which is not subject to proof of use. This is because, at the date of application of the contested mark, it had not been registered for five years.<sup>4</sup>

17. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C -342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has

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<sup>4</sup> See section 6A(3)(a) of the Act (added by virtue of the Trade Marks Regulations 2018: SI 2018/825) which came into force on 14th January 2019.

the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

18. Both parties have the term 'coffee' in their class 30 specifications. These are clearly identical terms.

19. The remaining term in the application is 'coffee supply services for offices [provision of beverages]' in class 43.

20. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

21. The nature of coffee goods and the service of supplying coffee are clearly different, the first being goods and the second being a service. The users and uses are likely to be the same or at least contain a considerable degree of overlap. A customer may make their own coffee, buy it from, inter alia, a coffee shop or café, or may choose to have it delivered. Coffee goods themselves are likely to reach the market via a store or online provider and in the case of prepared/ready made coffee drinks may also be delivered by a takeaway service. Coffee delivery services, which in this case are specifically deliveries made to offices, are likely to be encountered online or by visiting a retail store. They may also be part of an ongoing contract between an employer and a delivery service. They are in competition to the extent that a consumer may choose to buy coffee in order to prepare their own drink, or may choose to have coffee delivered.

22. In terms of whether or not these goods and services are complementary, I bear in mind *Sanco SA v OHIM*, Case T-249/11, in which the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

23. And, *Kurt Hesse v OHIM*, Case C-50/15 P, in which the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

24. The opponent submits that the applicant’s goods and the opponent’s services are, “plainly complementary”. It submits:<sup>5</sup>

*“25...it is common for business[es] that manufacture coffee to also supply coffee. By way of example Pret à Manger provides both coffee and office delivery services... and other[s] such as Costa and Starbucks offer coffee delivery (in conjunction with delivery service providers).”*

25. I agree. The opponent’s coffee goods are clearly necessary for the applicant’s coffee delivery services and I find that the average consumer is familiar with the same undertaking being responsible for the brand of coffee served and for the establishment providing the coffee to the consumer, in this case by a delivery service to offices.

26. Taking all of these factors into account I find there to be a medium degree of similarity between the applicant’s services in class 43 and the applicant’s coffee goods in class 30.

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<sup>5</sup> See opponent’s submissions dated 20 October 2020.

## **The average consumer and the nature of the purchasing act**

27. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*<sup>6</sup>, Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

28. The opponent submits that the average consumer in this case is a member of the public at large and submits that the level of attention paid to the purchase will be ‘average or low’.

29. I agree that the average consumer for both parties’ coffee goods is a member of the general public. With regard to the applicant’s coffee delivery services to offices, these services may be bought by a member of the public organising a delivery for themselves, but they may also be bought by an employer wishing to provide a coffee delivery service for its staff. In the latter case I would expect the level of attention paid to the purchase of such services to be a little above average. For the coffee goods the level of attention paid will be medium as the consumer will need to select the particular size and type of coffee/milk/flavouring they require. For the delivery services the level of attention paid is likely to be medium for a member of the public buying the service and a little higher where the purchaser is a business organising a delivery contract, though it still wouldn’t be at the highest level. In all cases the purchase is likely to be primarily a visual one with the purchaser accessing the goods and services from a

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<sup>6</sup> [2014] EWHC 439 (Ch)

store or website, though I do not rule out an aural element where there are word of mouth recommendations.

### Comparison of marks

30. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
GARRISON	Garrison Coffee Company

31. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.<sup>7</sup>

32. The opponent's mark consists of the single word 'GARRISON' in black capital letters, upper case. There is no additional stylisation. The overall impression rests purely in the word GARRISON.

33. The applicant's mark comprises the words 'Garrison Coffee Company'. Each word begins with a capital letter followed by lower case letters. The words 'Coffee Company' describe the nature of the applicant's goods and services. Consequently, it is the word 'Garrison' which plays the greater role in the overall impression of the applicant's mark.

34. Visual similarity rests in the fact that the entirety of the earlier mark is the first word of the mark applied for. The fact that the application is presented in upper and lower case letters and the opponent's in upper case, is not a point of difference since fair

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<sup>7</sup> *Sabel v Puma AG*, para.23.

and notional use of the trade marks would allow for use in upper or lower case and it is not a factor likely to be noticed by the average consumer. Overall, I find these marks to have a medium degree of visual similarity.

35. The opponent's mark will be easily understood as the word 'GARRISON' and will be pronounced as such. The first part of the applicant's mark will be pronounced in the same way by the average consumer, being easily identified as the word GARRISON. The words 'Coffee Company' describe the applicant's goods and services and may or may not be articulated. Where all words in both marks are articulated, I find these marks to be aurally similar to a medium degree. Evidently if the consumer does not articulate 'Coffee Company' in the application, then the respective marks are aurally identical.

36. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>8</sup> The opponent submits that the marks share a conceptual meaning due to the shared term 'GARRISON', but that does not define the word. I find the word to be a fairly common one, and one which I think most average consumers would understand to be connected in some way to soldiers or a group of soldiers. The additional words 'Coffee Company' in the application describe the goods and services and beyond that simple description, they do not add to or alter the conceptual message provided by the word 'Garrison'. Consequently, I find the marks to be conceptually very highly similar. Where a consumer is not familiar with the meaning of the word GARRISON then the marks have no concept.

### **Distinctive character of the earlier mark**

37. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been used as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.<sup>9</sup>

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<sup>8</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>9</sup> Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

38. The opponent submits that its mark is inherently distinctive for the goods and services at issue. It makes no claim to enhanced distinctiveness through the use made of it.

39. The word 'GARRISON' is likely to be considered to relate to soldiers or a group of soldiers. It makes no descriptive nor allusive reference to the opponent's goods and will be given its plain ordinary meaning. Consequently, it is a normal trade mark possessed of a medium degree of inherent distinctive character. For a consumer who does not know the meaning of the word GARRISON, the mark has no meaning in relation to the goods and has at least medium distinctiveness.

### **Likelihood of confusion**

40. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.<sup>10</sup> I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.

41. I have made the following findings:

- The average consumer is likely to be a member of the general public for goods in class 30 and may be a business or professional for the coffee delivery services.
- The level of attention paid to the purchase will be medium.
- The purchase will be primarily a visual one, though there may also be an aural element where advice is sought prior to purchase.
- The parties' marks possess medium visual and aural similarity (noting that they aurally identical where the average consumer does not articulate the

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<sup>10</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

words 'coffee company') and are conceptually similar to a very high degree.

- The earlier mark GARRISON has a medium degree of inherent distinctive character.
- The parties' goods in class 30 are identical and the applicant's services in class 43 are similar to the opponent's goods to a medium degree.

42. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

43. In this case, taking into account the factors at paragraph 41 into account, along with the similarity of the marks and the similarity between the goods and services, I find that the parties' marks, 'GARRISON' and 'Garrison Coffee Company', would be directly confused with one another.

44. With regard to indirect confusion, in *L.A. Sugar Limited v By Back Beat Inc*,<sup>11</sup> Mr Iain Purvis Q.C., sitting as the Appointed Person said:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of

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<sup>11</sup> BL O/375/10

the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

45. In that decision, Mr Purvis provides a non-exhaustive list of examples where one may expect the average consumer to reach such a conclusion. The second of these is where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension. The words ‘Coffee Company’ fall squarely into such a category.

46. It is easy to envisage a real-world example where a consumer has been exposed to Garrison coffee and subsequently encounters Garrison Coffee Company, for coffee or coffee delivery services. They would surely conclude that they both originate from the same undertaking.

47. I have reached this conclusion based on the opponent’s coffee goods in class 30. I do not intend to consider the remaining goods relied on as these are further away from the coffee goods on which the opposition has succeeded. I would note also that even if I had found the opponent’s goods and the applicant’s coffee supply services for offices to be similar to a lower degree than medium, I would still have concluded that there would be a likelihood of confusion, given the similarity between the marks.<sup>12</sup>

48. I bear in mind that the applicant’s services will be used both by businesses as well as members of the general public and will, in that case, involve a slightly higher level of attention to be paid than the purchase of coffee by a member of the general public. I have considered the impact this may have on the global assessment necessary under this ground and conclude that it does not disturb my primary finding that there is a likelihood of direct and indirect confusion.

**The opposition succeeds under section 5(2)(b) of the Act.**

49. I will now go on to consider the applicant’s claim under section 3(6) of the Act, which reads:

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<sup>12</sup> See subsection (g) at paragraph 17.

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

50. The relevant case-law covering trade mark applications made in bad faith can be found in the following cases: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C 529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C-104/18P, *Sky v Skykick*, CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark, The Appointed Person*, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark, The Appointed Person*, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch).

51. The relevant law appears to be as follows:

(a) While in everyday language the concept of ‘bad faith’ involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky CJEU*.

(b) Applying to register a trade mark without an intention to use it is not bad faith per se. Therefore, it is not necessary for the trade mark applicant to be using, or have plans to use, the mark in relation to all the goods/services covered by the specification: *Sky CJEU*.

(c) The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that applicant had no economic activity corresponding to the goods and services referred to in that application: *Sky CJEU*.

(d) However, where the trade mark application is filed without an intention to use it in relation to the specified goods and services, and there is no rationale for the application under trade mark law, it may constitute bad faith. Such bad faith may be established where there are objective, relevant and consistent indications showing that the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: *Sky CJEU*.

(e) This may be the case where the exclusive right was sought as part of a strategy of using widely cast trade mark registrations as legal weapons for use against others in opposition proceedings and/or for the purposes of blocking applications by third parties: *Sky EWHC* and *Copernicus-Trademarks v EUIPO*.

(f) A trade mark may be applied for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky CJEU*.

(g) ...

(h) In deciding whether there was a rationale for registering the trade mark in relation to any particular term, it is necessary to bear in mind that trade mark proprietors have a legitimate interest in seeking protection in respect of goods or services in relation to which they may wish to use the trade mark in future (even if there were no plans to use the mark in relation to the goods/services at issue at the time of filing the application): *Sky EWHC*. It is therefore relevant to consider whether the goods/services in the contested application are related to those for which the mark has been used, or for which the applicant had plans to use the mark.

52. The following points are apparent from the pre-*Sky* case-law about registering trade marks in bad faith:

(i) Although it may be a relevant factor, the mere fact that the applicant knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries*.

(j) Similarly, the mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton (paragraph 55)*. The applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.

(k) However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat*, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited*.

(l) ...

53. The correct approach to the assessment of bad faith claims is as follows. According to *Alexander Trade Mark*, the key questions for determination in such a case are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

54. The applicant's intention (i.e. objective) is a subjective factor which must be determined objectively by the competent authority. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case: *Lindt*.

55. The matter must be judged at the relevant date, which is the date of the application for registration: *Lindt*.

56. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull*. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani*.

57. A statement on the application form that the mark is in use, or there is a bona fide intention to use it may, if untrue, provide evidence supporting a bad faith case, but is not sufficient by itself to justify the refusal or cancellation of the registration: *Sky CJEU*.

58. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

#### The opponent's case

59. The opponent claims that:

*"The particular area being examined is the act or opportunity of merchandising a highly successful television show and characters and features within that show."*

60. In support of this claim the opponent relies on:

- the fact that the applicant knows of the TV show *Peaky Blinders* (and that *The Garrison* public house features in that show);

- the fact that the applicant previously filed a UK trade mark application for PEAKY GRINDERS.

61. It relies on the chronology of events set out in Ms Waddell's witness statement, as follows:

*"58. The chronology of events set out in the witness statement of Susan Waddell speaks for itself:*

*a. Five series of the Programme has [sic] been broadcast by September 2019, with significant critical acclaim and popularity;*

*b. The Applicant applied for [this] Application in November 2019;*

*c. In February 2020 the Opponent filed a TM7A against the Application and the Applicant also filed a new application for PEAKY GRINDERS including for the same goods and services as the Contested Goods and Services;*

*d. Later in February the Opponent's representatives wrote to the Applicant seeking withdrawal of both the Application and the Peaky Grinders Application; and*

*e. The Peaky Grinders Application was later deemed withdrawn due to non-payment of fees."*

62. The opponent also draws my attention to Mr Malin's counterstatement in which he submits that his application for 'Peaky Grinders' was a deliberate play on Peaky Blinders. The opponent concludes that this shows a *"tendency to undertake behaviour which falls short of the standards observed by reasonable and experienced operators."*

63. The application for 'Peaky Grinders' was made by Mr Malin on 6 February 2020, and was withdrawn before registration. Whether or not that application amounted to bad faith has not been tested and I am not prepared to accept the opponent's

statement that a different application by the same applicant shows ‘a tendency’ to engage in bad faith applications. For the purpose of the 3(6) ground relied on by the opponent in this opposition, it is for the opponent to show that Mr Malin’s application for the trade mark ‘Garrison Coffee Company’ amounts to bad faith.

64. The opponent claims that Peaky Blinders is very popular and has achieved critical acclaim.<sup>13</sup> Ms Waddell describes the viewing figures as follows:

*“20. As can be seen from the BARB Figures, the average audience size for first broadcast of an episode of the Programme in the UK on BBC2 was 2,586,221 and the peak size was 3,561,000 for the final episode of Series 4 in December 2017 (representing 14.72% of the audience share); and that for series 5, the first episode on BBC had over 5.6 Million viewers, representing 26.6% of the audience.”<sup>14</sup>*

65. Ms Waddell provides details of eleven awards won by the programme, which include three BAFTAs, including Best Director for series one and Best Drama Series for series four.<sup>15</sup>

66. The opponent provides evidence to show that popular TV shows give rise to a wide variety of merchandise. Examples include, inter alia, Breaking Bad, Dr Who, Game of Thrones and Stranger Things.<sup>16</sup>

67. The opponent also provides evidence of its range of merchandise based on characters, settings and the title of the show, including merchandise relating to The Garrison Public House. The only merchandise shown in evidence which relates specifically to ‘The Garrison’ pub is two t-shirts, two long sleeved t-shirts and two hoodies for sale. Ms Waddell submits that sales of these goods are made on the RockOFF trade website. The two designs shown on the items are as follows (they are not dated):<sup>17</sup>

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<sup>14</sup> Detailed viewing figures are provided at SW01.

<sup>15</sup> See paragraph 45 of Ms Waddell’s witness statement.

<sup>16</sup> See exhibits SW16 and SW17.

<sup>17</sup> See exhibit SW18.



68. The opponent also draws my attention to the fact that in correspondence the applicant has stated that he knew the TV show *Peaky Blinders* and was familiar with The Garrison pub in the programme. This is not disputed.

69. Mr Malin (the applicant) claims that The Garrison is a real pub in Birmingham which was for many years associated with Birmingham City Football Club. Mr Malin visited the pub himself in the 70s and 80s, on the way to Birmingham City matches with members of his family. He submits that, *“The Garrison’s history with Birmingham City exceeds its history with Peaky Blinders by over 100 years...”* In his counterstatement Mr Malin said that it is his family association and memories of the pub that led to him choosing the name for his coffee business. Mr Malin confirms in his final submissions that he is a ‘huge fan’ of *Peaky Blinders* and enjoyed a reference to The Garrison in an early episode where a reference was made to everyone going ‘up the blues’.

70. I accept that *Peaky Blinders* is a popular TV show, which has given rise to a range of merchandising. It is also clear that the applicant knows of the TV show and the pub The Garrison, as it features in that show and did so by the relevant date. Mr Malin talks of watching an early press copy of the first episode. The series is described throughout the evidence as a period or historical drama and it draws on some real-life characters and locations.

80. However, these facts in themselves do not point to a finding that Mr Malin has acted in bad faith. Mr Malin knows of the pub and chose the name for his coffee business as he has fond memories of attending it with his family. No explanation has been given by the opponent as to why Mr Malin's coffee business would be seen as an attempt to merchandise its TV show, beyond the fact that both Mr Malin's business and the Peaky Blinders TV show reference a real pub. An allegation of bad faith is a serious one which must be proven in evidence. It is clear from the decision in *Red Bull* that it is not enough to establish facts which are as consistent with good faith as with bad faith, which is what the opponent has done in this case.

**The opponent's claim is not made out and the 3(6) claim fails.**

## **Conclusion**

81. The opposition succeeds under section 5(2)(b) and fails under section 3(6).

## Costs

82. Caryn Mandabach Productions Limited has been successful under 5(2)(b) and is entitled to a contribution towards its costs which I award on the following basis, bearing in mind that there was no hearing and the opponent's claim under section 3(6) of the Act was unsuccessful:

Official Fee -	£200
Preparing statements and considering the other side's statements -	£300
Filing evidence -	£400
<b>Total</b>	<b>£900</b>

83. I order Lee Malin to pay Caryn Mandabach Productions Limited the sum of £900. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17th day of March 2021**

**Al Skilton**

**For the Registrar,  
the Comptroller General**