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TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 404744

IN THE NAME OF TELUGU NRI FORUM CORPORATION

TO TRADE MARK APPLICATION No. 3099108

IN THE NAME OF TELUGU NRI FORUM (A COMPANY LIMITED BY GUARANTEE)

DECISION

1. The parties to the present proceedings are Telugu NRI Forum Corporation ('Corp') and Telugu NRI Forum ('Forum') a company limited by guarantee. They each applied to register (and each opposed the other's application to register) the following logo as a trade mark under the Trade Marks Act 1994:



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Both oppositions were rejected by Mrs. Ann Corbett acting on behalf of the Registrar of Trade Marks for the reasons she gave in a decision issued under reference BL O-107-17 on 8 March 2017.

2. There is no appeal by Forum against the Hearing Officer's decision to allow Corp's application for registration (filed under number 3099266 on 14 March 2015) to proceed in respect of '*Social work services; Social networking services*' in Class 45. For its part, Corp appeals to an Appointed Person under s.76 of the 1994 Act against the Hearing Officer's decision to allow Forum's application for registration (filed under number 3099108 on 13 March 2015) to proceed in respect of the following services in Class 41:

Academies [education]; Academy education services; Academy services (education-); Adult education services; Adult education services relating to environmental issues; Adult education services relating to law; Adult education services relating to management; Advisory services relating to education; Advisory services relating to entertainment; Advisory services relating to publishing; Advisory services relating to the organisation of sporting events; Arrangement of seminars for educational purposes; Arranging and conducting of educational seminars; Arranging for students to participate in educational activities; Arranging for students to participate in recreational activities; Arranging group recreational activities; Arranging of award ceremonies; Arranging for competitions for cultural purposes; Arranging of competitions for education or entertainment; Arranging of competitions for educational purposes; Books (publication of-); Career information and advisory services (educational and training advice).

3. Corp maintains that it was entitled to prevent Forum from using the 'Telugu NRI Forum' logo shown in paragraph [1] above as a trade mark for such services by virtue of the law of passing off, with the result that trade mark application number 3099108 should have been refused under s.5(4)(a) of the 1994 Act. It contends that the Hearing Officer's decision to the contrary was wrong and should be reversed on the basis compendiously stated at the outset of its Grounds of Appeal in the following terms:

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Honorable Hearing Officer ignored or failed to understand / correlate our below written argument documents, though they were acknowledged in IPO's correspondence to us, namely:

- a) Applicants Written Arguments.pdf and Opponents Written Arguments.pdf which we submitted as part Evidence in Chief (acknowledged by IPO in the list of indices – 28. Written Submissions of Vishnu Alluri 404744; 25. Written Submissions of Vishnu Alluri 404665).
- b) Applicants written Arguments for Evidence in Reply.pdf which was submitted as part of our Evidence in Reply (acknowledged by IPO in the list of indices – 31. Written Submissions of Vishnu Alluri 404665/404744).
- c) Applicants Final Written Arguments/pdf, which was submitted on 18/10/2016 as per IPO guidelines to us in their letter dated 17th August 2016 in regards to written submissions.

In the remainder of its 9-page Grounds of Appeal, Corp provides details of the respects in which it contends that the Hearing Officer '*ignored or failed to understand/correlate*' the cited 'Written Arguments'.

4. At this point it is necessary to refer to the way in which the proceedings were conducted in the Registry. A Case Management Conference was held on 10 December 2015 to consider 'consolidation' of the pending oppositions (Forum's Opposition No. 404665 to Corp's Trade Mark Application No. 3099266 and Corp's Opposition No. 404744 to Forum's Trade Mark Application No. 3099108) and the giving of directions for the further conduct of the proceedings. By letter dated 11 December 2015, the Registry confirmed that it had decided to consolidate the oppositions, in the sense of requiring them to proceed and be dealt with together for case management purposes so as to facilitate the making of a single combined determination of the various matters in dispute between the parties.
5. The official letter gave directions for the filing of evidence in the following terms (emphasis as per the original):

In accordance with Tribunal Practice Notice 2/2010 a period of two months is allowed for **both the opponent and the**

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applicant to submit evidence and/or submissions, as appropriate. The evidence and/or submissions should therefore be received on or before **11 February 2016** and in accordance with Rule 64(6) a copy must be sent to the other party. Failure to do so will result in the evidence not being admitted into the proceedings.

The Registry has an overriding objective to ensure that proceedings are completed within a reasonable time. As a result the Registry would expect the parties to adhere to the following timetable:

Filing of opponent's evidence/submissions: 11 February 2016

Filing of applicant's evidence/submissions: 11 February 2016

On receipt of the applicant's evidence a period of one month will be given for the parties to notify the Registry whether or not they intend to file further evidence of fact in reply. If such a request is received a further period of one month will be allowed to file any evidence.

Upon the conclusion of the evidence rounds the parties will be asked if they wish to be heard on this matter.

Submissions are written arguments by a party to support its case or comment on the other side's evidence. Submissions are not facts and if a party wishes to rely on facts they must be presented as evidence.

Evidence is information provided to prove the facts of a case and is submitted in the form of either, a Witness Statement, Statutory Declaration or Affidavit. This is in accordance with Rule 64. Further guidance can be found on our website at <http://www.ipo.gov.uk/tmmanual-chap7-law.pdf>.

The Registry subsequently directed in a letter of 15 March 2016 that:

Both parties having now filed their evidence in chief are allowed until close of play on 16 May 2016 to file their evidence and/or submissions in reply to the evidence already filed by the other side.

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6. I have previously drawn attention to the legally and procedurally important distinction between filing ‘*evidence*’ and filing ‘*submissions*’ and to the undesirable consequences that are liable to flow from blurring that distinction by directing the parties to Registry proceedings to file ‘*evidence and/or submissions*’ or ‘*evidence/submissions*’ in official letters of this kind: KILLER CHORUS Trade Mark (BL O-431-12; 30 October 2012) at paras [5] to [8], [13] and [27]. As the present case amply demonstrates, the addition of paragraphs (such as the last two of those I have quoted from the official letter of 11 December 2015) narratively referring to the difference between ‘*evidence*’ and ‘*submissions*’ is frequently not effective to avoid the jumbling up of ‘*evidence*’ and ‘*submissions*’ in documents filed in response to ambiguously worded directions for the filing of ‘*evidence and/or submissions*’ or ‘*evidence/submissions*’.
7. The documents filed and admitted into the proceedings pursuant to the procedural directions given by the Registry are listed in the following tables alongside the numbers allocated to them in the index for the substantive hearing of the oppositions.

Telugu NRI Forum

8. Witness Statement of Dr Soma Sekhara Rao Vemuri dated 14th March 2016 (7 pages)
9. Exhibit A (89 pages)
10. Witness Statement of Mr Hariprasad Kuttambakam dated 14th March 2016 (1 page)
11. Witness Statement of Mr Kiran Kumar Mummaneni dated 14th March 2016 (1 page)
12. Witness Statement of Mr Chandra Sekhar Chandra dated 14th March 2016 (1 page)
13. Witness Statement of Mr Balanandam Kakarla dated 14th March 2016 (1 page)
14. Witness Statement of Dr Soma Kehara Rao Vemuri dated 6th June 2016 (16 pages)
15. Exhibit SSRV1 (103 pages)

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16. Witness Statement of Mr Surya Prakasa Rao dated 6th June 2016 (2 pages)
17. Exhibit SPR1 (5 pages)
18. Witness Statement of Mr Chandra Sekhar Chandra dated 16th May 2016 (2 pages)
19. Witness Statement of Mr Balanandam Kakaria dated 16th May 2016 (2 pages)
20. Witness Statement of Mr Hariprasad Kuttambakam dated 16th May 2016 (2 pages)
21. Witness Statement of Mr Kiran Kumar Mummaneni dated 16th May 2016 (2 pages)

Telugu NRI Forum Corporation

22. Sworn Affidavit of Mr Vishnu Alluri dated 9th February 2016 (2 pages) attesting to: the truth of the contents of item 28 below; the creation and authenticity of the compilation at item 29 below; and the creation and authenticity of the compilation at item 30 below.
23. Sworn Affidavit of Mr Venkata Ramesh Vudathu dated 1st February 2016 (3 pages)
24. Sworn Affidavit of Mr Venkataram Mondeddu dated 5th February 2016 (3 pages)
25. Sworn Affidavit of Mr Venkat Adusumalli dated 4th February 2016 (3 pages)
26. Sworn Affidavit of Mr Suresh Karothu dated 5th February 2016 (3 pages)
27. Sworn Affidavit of Mr Vishnu Alluri dated 9th February 2016 (2 pages) attesting to: the truth of the contents of item 31 below; and the creation and authenticity of the compilation at item 31 below.
28. Written Arguments: Evidence in Response to Opposition (16 pages)
29. Exhibit 1 – Screenshots (30 pages)
30. Exhibit 2 – Expense receipts (6 pages)
31. Written Arguments: Evidence in Opposition (12 pages)
32. Exhibit 1 – Screenshots (50 pages)
33. Sworn Affidavit of Mr Vishnu Alluri dated 3rd June 2016 (2 pages) attesting to: the truth of the contents of item 34 below; the nature of the reports at item 35 below; the creation and authenticity of the compilation at item 36 below; and the contents of the USB stick at item 37 below.

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| <p>34. Written Arguments: Evidence in Reply (19 pages)</p> <p>35. Annexure 1 (32 pages)</p> <p>36. Exhibit 1 – Screenshots (25 pages)</p> <p>37. Exhibit 2 – USB stick (containing video with file name “Surya Prakash Whom So Ever letters Comparison.mp4”)</p> |
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8. Unsurprisingly in view of the directions noted above, there were within this mass of material numerous instances of text presented as ‘*evidence and/or submissions*’; and ‘*evidence/submissions*’. There were also repeated accusations of wrongdoing made by Corp against Forum and expressed in strong terms. Forum reacted by sending a 7-page letter to the Registry on 5 July 2016 itemising the accusations which had been made against it and asking for a direction requiring them to be excised from the written material filed on behalf of Corp. The request for excision was premised upon ‘*the opposition being made solely on the basis of section 5(4)(a), an application to extend the opposition to include bad faith under section 3(6) having been rejected in the case management conference on 11 December 2015*’.
9. The Registry declined the request in an official letter dated 13 July 2016, observing that: ‘*Both parties’ objections are based on various parts of Section 5 of the Trade Marks Act and on that basis, it is only the evidence/submissions that go to these issues that would be relevant and taken into account. If you disagree with the Registry’s view, a case management conference has been provisionally booked for 15 August 2016 at 10.30 a.m.*’. Forum responded by letter dated 20 July 2016, thanking the Registry for confirming that ‘*only evidence going to the issues of objection under section 5 of the Trade Marks Act is relevant and will be taken into account*’ and saying that it saw no need on the basis of that confirmation to pursue its request for excision of ‘*the irrelevant evidence*’ at a case management conference.
10. Corp took a different view. It wrote to the Registry on 22 July 2016 stating: ‘*we have also claimed and proved our case under Trademark laws, which including*

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Section 3(6) Bad Faith – Knowledge of opponent’s use in the UK and Section 3(6) Bad Faith – Breakdown of former business relationship; this never came in any discussion nor was rejected. We are in impression that Hearing Officer will consider all the evidences which are submitted and relevant to Trademark laws; not just which are related to Section 5’. The Registry responded in an official letter dated 1 August 2016:

The grounds of opposition are all under Section 5. As advised in the official letter of 13 July 2016, it is only the evidence/submissions that go to these issues that are relevant and will be taken into account. There are no Section 3 grounds of opposition on either of the TM7s filed.

11. The position adopted by the Registry in its official letters of 13 July 2016 and 1 August 2016 was, for practical purposes, inconclusive. By invoking the concept of relevance without further elaboration in answer to the question which divided the parties (i.e. whether the Registrar was or was not prepared to regard Corp’s ‘*evidence / submissions*’ relating to wrongdoing as potentially ‘*relevant*’ to the grounds of opposition it had raised) the Registry effectively left it to them to assess for themselves whether or to what extent the Registrar would, for the purpose of determining the objection to registration based solely on s.5(4)(a) of the 1994 Act, take account of ‘*evidence/submissions*’ about ‘*Knowledge of opponent’s use in the UK*’ and ‘*Breakdown of former business relationship*’. This was not a matter of minor significance in circumstances where the thrust of the objection raised by Corp under s.5(4)(a) was (as summarised on p.10 of its Written Arguments: item 28 in the tables of evidence):

As long as the UK company Telugu NRI Forum keeps to its affiliation with its Founders it can use the same trademark, if not they can’t use. Since all the founders and members are with Telugu NRI Forum corporation, the logo belongs to Telugu Forum Corporation only. As per the Trademark Act Section 5(4)(a) where the use of the applicant’s trademark would be contrary to law, in particular, the law of passing off.

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12. I now turn to outline the facts of the case in sufficient detail to enable me to review the Hearing Officer's decision.
13. The evidence on file shows¹ that Corp is a 'Domestic Non-Profit Corporation' registered in the State of Georgia (USA) under number 14030379 on 16 March 2014 with its principal place of business at 430 Havenmist Landing, Suwanee, Georgia 30024. Mr. Venkataram Mondeddu is identified as the incorporator and registered agent of the corporation.
14. The evidence on file also shows² that Forum is a company limited by guarantee registered in England and Wales under number 8936815 on 13 March 2014 with entirely bespoke Articles of Association. Mr. Vamsikrushnam Penumatsa is identified as the first director and member of the company. In its Articles of Association filed at Companies House the company is called "*the charity*" and "*the directors*" of the company are stated to be "*charity trustees as defined by section 177 of the Charities Act 2011*".
15. Mr. Mondeddu explained in an Affidavit dated 5 February 2016 that Forum was registered under the auspices of what he referred to as '*the non-profit organization Telugu NRI Forum worldwide*' for the purpose of acting as the '*UK Chapter*' of that organisation. His evidence as to the formation and operation of the worldwide organisation was as follows:

I am one of the founders of Telugu NRI Forum. Myself, Mr. Venkat Adusumalli (Adusumalli), Mr. Suresh Karothu (Suresh), Mr. Partha Chaitanya Pabbu (Partha) from USA and Mr. Venkata Ramesh Vudathu (Ramesh) & Miss. Kalyani Inempudi (Kalyani) from UK founded the non-profit organization Telugu NRI Forum worldwide in Feb 2014. The organization is headquartered in USA. I am the Global President of the Telugu NRI Forum. Venkat Adusumalli is President of Telugu NRI Forum US Chapter. Venkata Ramesh Vudathu was Telugu NRI Forum UK Chapter President until he resigned in April 2015.

¹ numbered pages 4 and 5 of Exhibit SSRV1 to the WS of Dr. Soma Vermuri dated 16 June 2016.

² numbered pages 1 to 5 of Exhibit A to the WS of Dr. Soma Vemuri dated 14 March 2016.

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Partha created the email (telugunriform@gmail.com) account and Google groups account TeluguNRIForum@googlegroups.com for Telugu NRI Forum on 8th Mar 2014 for its global use and he also maintained Telugu NRI Forum membership online.

We have registered Telugu NRI Forum in UK, its registration number being 08936815, with the help of Mr. Soma Sekhara Rao Vemuri (Sekhar) from UK and we nominated Mr. Vamsi Krishnam Raju Penumatsa as Director for UK Chapter in March 2014. Sekhar wanted to help our organization from outside until he joined our organization Telugu NRI Forum on 21st Sep 2014 with emailid doctor@asianlite.com. Hariprasad Kuttambakam (Hariprasad) joined on 19th Oct 2014 with emailid dr.hariprasad7@gmail.com. Balanandam Kakarla (Bala) joined on 29th June 2014 with emailid bkakarla@gmail.com. Kiran Kumar Hummaneni (Kiran) and Chandra Sekhar Chandra (Chandra) never joined our organization Telugu NRI Forum, though Chandra has been given opportunities to participate in our events in the past.

...

Our Logo consists of TELUGU NRI FORUM, HERITAGE, PROSPERITY and TRANSPARENCY words and same translated into Telugu language script as Telugu NRI Forum, Samskruti, Pragati and Swachatha are present, background Indian Folk Art (Rangoli/Muggulu) and a female figure representing the Mother of Telugu language.

The name Telugu NRI Forum was suggested by me. The words Heritage, Prosperity, Transparency and the same in Telugu language script Samskruti, Pragati, Swachatha was the idea of Ramesh. The background Indian Folk Art (Rangoli/Muggulu) was the idea of Kalyani. The ring around female figure was the idea of Adusumalli. The female figure representing the mother of Telugu language was the idea of Suresh, which is part of the initial logo designed by him for Telugu NRI Forum. We took Sekhar's help and passed all the above information to him which in return has been passed to his graphic designer to create the image for us. Our logo is an unregistered trade mark. Since March 2014 we are using it for our global activities. Telugu NRI Forum Corporation (US Chapter) is representing us in this case.

16. It appears from this evidence that '*the non-profit organisation Telugu NRI Forum worldwide*' (founded in February 2014) started out as an organisation with a '*Telugu*

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NRI Forum US Chapter’ (being the corporation registered in the State of Georgia (USA) under number 14030379 on 16 March 2014) and a *‘Telugu NRI Forum UK Chapter*’ (being the company limited by guarantee registered in England and Wales under number 9636815 on 13 March 2014). It further confirms that the US Chapter (i.e. Corp) *‘is representing us’* (i.e. the non-profit organisation Telugu NRI Forum worldwide) in the present proceedings against the UK Chapter (i.e. Forum). The inter-relationship between the US Chapter (i.e. Corp), the UK Chapter (i.e. Forum) and the non-profit organisation Telugu NRI Forum worldwide (which I shall now call *‘TNFW’* for the purposes of this decision) is further confirmed in other parts of the evidence and materials filed on behalf of Corp.³ The fact that Corp is acting in a representative capacity in these proceedings relative to the non-profit organisation TNFW is also reiterated: *‘Our logo is an unregistered trade mark. Since March 2014 we are using it for our global activities. Telugu NRI Forum Corporation (US Chapter) is representing us in this case’*⁴ and *‘Telugu NRI Forum is a global Non-Profit Organization headquartered in USA, hence Telugu NRI Forum Corporation is representing the Founders of Telugu NRI Forum in this case’*⁵ and *‘The trademark is the intellectual property of the Telugu NRI Forum Founders. Telugu NRI Forum Corporation ... is representing the Telugu NRI Forum founders in this case’*⁶.

17. It appears from the Companies House records and related documentary materials filed in the present proceedings⁷ that Mr. Penumatsa was the sole director of Forum from registration of the company on 13 March 2014 down to the date of his resignation on 3 March 2015. There is no witness statement or affidavit from him

³ first paragraph, p.1 of the Affidavit of Mr. Venkatu Vudathu dated 1 February 2016; first paragraph, p.1 of the Affidavit of Mr. Venkat Adusumalli dated 4 February 2015; first paragraph, p.1 of the Affidavit of Mr. Suresh Karothu dated 5 February 2016; numbered p.2 of its Written Arguments: item 28 in the tables of evidence; numbered p.2 of its Written Arguments: item 31 in the tables of evidence; see also para. 2 of the WS of Dr. Soma Vermuri dated 14 March 2016 and the letter from Kan Clark LLP dated 16 June 2015 at numbered pp.43 to 45 of Exhibit A to his WS.

⁴ p.3 of the Affidavit of Mr. Venkata Vudathu dated 1 February 2016; repeated at pp. 2,3 of the Affidavit of Mr. Venkat Adusumalli dated 4 February 2016 and at pp.2, 3 of the Affidavit of Mr. Suresh Karothu dated 5 February 2016.

⁵ numbered p.10 of its Written Arguments: Evidence in Response to Opposition: item 28 in the tables of evidence.

⁶ numbered p.12 of its Written Arguments: Evidence in Opposition: item 31 in the tables of evidence; stated again on numbered p.17 of its Written Arguments: Evidence in Reply: item 34 in the tables of evidence.

⁷ numbered pages 3, 7 and 8 of Exhibit A to the WS of Dr Soma Vemuri dated 14 March 2016.

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on file. In the Minutes of the Annual General Meeting of Forum held on 11 April 2015⁸ he is recorded as clarifying that the company *'never had any bank account to the best of his knowledge. Moreover he reiterated that he had never collected any funds nor spent any money in his personal capacity. He declared that they have filed the returns as dormant for 2014-15'*. This is fully supportive of the Hearing Officer's finding (as to which there is, in any event, no appeal) that Forum had not itself established any goodwill through use of the trade mark in issue in the United Kingdom: Decision paras. [46] to [61].

18. Mr. Surya Prakasa Rao of Prakash Graphics based in Andhra Pradesh designed the 'Telugu NRI Forum' logo shown in paragraph [1] above in March 2014. Mr. Penumatsa does not appear to have had any involvement in the production of it. Dr. Soma Vermuri and several others involved in the activities of TNFW appear to have been collegiately responsible for commissioning Mr. Rao to produce the design and giving him guidance as to what was required. Having considered the evidence in detail, the Hearing Officer justifiably expressed her dissatisfaction with the unreliability and inadequacies of it from the point of view of Forum's claim to be the owner of the copyright in the logo. She concluded in para. [76] of her Decision that *'Whilst the evidence before me does not enable me to find that the ownership of any copyright vests with Corp when taken as a whole, I do not consider that Forum has established, even on the balance of probabilities, that it owns the copyright in the mark'*. There is no appeal against that finding.
19. The information provided by the evidence and materials on file is sparse with regard to use of the logo in the course of business activities (which can for the purposes of s.5(4)(a) be taken to include charitable activities) in the United Kingdom prior to March 2015. I note the following:
 - (1) On 1 April 2014, an event to celebrate Ugadi (Telugu New Year's Day) was held at the Houses of Parliament. It was organised and promoted under and

⁸ numbered pages 87 to 89 of Exhibit A to the WS of Dr. Soma Vemuri dated 14 March 2016.

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by reference to the ‘Telugu NRI Forum’ logo and appears to have been well-attended;⁹

- (2) On 11 and 12 July 2014, the Indian Orthopaedic Society held its annual conference at the Tower Hill Grange Hotel in London ‘*with support from Telugu NRI Forum*’. It seems that the event was attended by approximately 150 to 200 orthopaedic surgeons practising in the UK. The ‘**Telugu NRI Forum**’ logo was used both to promote the event and to raise awareness of the ‘*Telugu NRI Forum*’;¹⁰
- (3) In October 2014, severe cyclonic storm Hudhud caused extensive damage and loss of life in Eastern India. A ‘*Hudhud relief activity – emergency meeting*’ was convened on 14 October 2014 to organise aid on the basis that ‘*All activities should go under Telugu NRI Forum organisation name to avoid conflicting view*’¹¹. Substantial fund raising activities were undertaken under and by reference to the logo in, among other places, the United Kingdom.¹²

The above activities all appear to have been undertaken as part and parcel of a ‘global’ endeavour in which TNFW sought to operate internationally using the ‘Telugu NRI Forum’ logo and ‘Telugu NRI Forum’ websites, email addresses and Facebook pages as communal resources for the purposes of internal and external communication. Neither Corp nor Forum appears to have been set up to operate independently or autonomously of TNFW in that connection.

20. The oppositions came on for hearing in the Registry on 20 October 2016. The parties were united in contending that the ‘Telugu NRI Forum’ logo could not be used concurrently by economic entities operating independently and autonomously

⁹ numbered pp.4 and 18 to 20 of Corp’s Written Arguments: item 28 in the tables of evidence; numbered pp.1 of 3 and 2 of 3 of Corp’s Expense Receipts: item 30 in the tables of evidence; numbered pp.2 to 7 of Corp’s Screenshots: item 32 in the table of evidence; numbered p.6 of Corp’s Screenshots: item 36 in the tables of evidence.

¹⁰ numbered p.27 of Corp’s Screenshots: item 32 the tables of evidence.

¹¹ numbered pp.10, 11 of Exhibit SSRV1: item 15 in the tables of evidence.

¹² numbered pp.12 to 37 of Exhibit SSRV1: item 15 in the tables of evidence.

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of one another in the United Kingdom as providers of services of the kind listed in their respective applications for registration without giving rise to deception and confusion as to the provenance of the services so provided. I think they were right to proceed upon that premise for the purposes of the objections they were pursuing by reference to the law of passing off relative to the contested applications for registration. I would add that the conflict they both envisaged was prima facie real and not theoretical having regard to the declarations they had made in their applications for registration¹³ to the effect that the logo was being used by them or with their consent as a trade mark for such services or that they had a bona fide intention that it should be so used. However, the Hearing Officer's decision rejecting both oppositions stands for the proposition that the law of passing off could not be invoked for the prevention of such deception and confusion in the circumstances of the present case. Although Forum has accepted that proposition by not challenging it on appeal, Corp disputes it (as it did at first instance) on the basis I have noted in paragraph [11] above.

21. It is clear from the evidence and materials on file that Forum had ceased to be part of the TNFW organisation by the time it filed its application for registration on 13 March 2015. This was the result of a decision to use and register the 'Telugu NRI Forum' name and 'Telugu NRI Forum' logo for charitable activities independently and autonomously of TNFW. That decision seems to have been taken, without any prior notice or warning to TNFW, in late February or early March 2015. Corp naturally relied on the sequence, nature and timing of events preceding the filing of the contested application for registration as showing that Forum had broken away from the TNFW organisation and had filed the application as part of a strategy to set itself up as proprietor of the 'Telugu NRI Forum' name and 'Telugu NRI Forum' logo to the exclusion of TNFW. It seems to me that in the circumstances of the events which had happened Forum was indeed vulnerable to the accusation that it was guilty of usurpation amounting to or involving a likelihood of passing off relative to the activities of TNFW.

¹³ in accordance with the requirements of s.32(3) of the 1994 Act.

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22. In the morning on 20 October 2016, shortly before the hearing of the oppositions, Mr. Vishnu Alluri (the lay representative appearing for Corp) emailed a 9-page document to the Registry setting out *'our oral arguments in text format which we wish to present during the oral hearing'*. This developed the propositions that *'the Founders are the real owners of Telugu NRI Forum globally'* (p.2 of 9), that *'Telugu NRI Forum global committee designed, recommended and approved all the activities which are to be executed in US or UK or India or somewhere else. Under Telugu NRI Forum global leadership the local legal entities will raise funds and execute the activities in different countries'* (p.3 of 9), that *'the founders of Telugu NRI Forum established both organizations in US and UK and they are driving the activities, so all credit and goodwill goes to them, not only to a particular entity or child organization even if a local event was organised'* (p.3 of 9) and that the filing of the contested application for registration on 13 March 2015 was part of a *'master plan to topple Ramesh Vudathu and to grab our UK branch, Ramesh is one of the founding member and was nominated as President of Telugu NRI Forum of UK Company'* (p.8 of 9).
23. However, the Hearing Officer repeatedly intervened at the hearing with a view to cutting short the oral submissions that Mr. Alluri wished to make in relation to those aspects of the case.¹⁴ She did so from the perspective that the inter-relationship between TNFW, Corp and Forum as it had existed and operated in 2014 running into 2015 was not relevant to the objections she had to determine under s.5(4)(a). The following exchange is illustrative of the position she adopted:

MR. ALLURI:

...

With the trust, Ramesh is the president. We have a global company that decides which project should we take up and should not take up. When we decided to do the 2014 Ugadi celebrations, our president and the founder, Mr. Ramesh Vudathu, and Kalyani Inempudi did the work. We raised the money and we executed the projects. When coming to 2015 function, they planned to steal the company. In 2014, just before ----

THE HEARING OFFICER: I do not need to know any of that, Mr.

¹⁴ Transcript pp.3, 4, 5, 7 and 15.

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Alluri.

MR. ALLURI: I understand, but this is crucial for the case. That is the reason I am mentioning it.

THE HEARING OFFICER: I am not sure it is crucial for the case ...

At this point in the Transcript, Mr. Alluri was evidently referring to TNFW as ‘the trust’.

24. In her Decision issued on 8 March 2017, the Hearing Officer proceeded to determine the parties’ objections under s.5(4)(a) as if they had been raised by and between two companies that were strangers to one another. She first considered whether Corp had ‘*acquired the requisite goodwill or reputation in the UK at the relevant date for the goods or services claimed*’ and concluded that the evidence was insufficient to raise even a prima facie case that it had (paras. 13 to 21); she then separately considered whether Forum had ‘*used its mark since 15 March 2014 throughout the UK*’ so as to have ‘*acquired the requisite goodwill or reputation in the UK at the relevant date in the course of trade in the goods or services claimed*’ and concluded that the evidence was insufficient to raise even a prima facie case that it had (paras. [46] to [61]).
25. Her overall assessment of Corp’s objection was as follows:
 20. There may be no “absolute requirements” as to the nature of the evidence which needs to be filed when a party brings proceedings under section 5(4)(a) of the Act, however, there must be evidence that shows at least a prima facie case that it has acquired the requisite goodwill or reputation in the UK at the relevant date for the goods or services claimed. The goods and/or services in relation to which Corp claims to have used the mark in the UK is not well defined and, whilst there is an amount of evidence regarding various projects carried out in India, despite a very careful review of all the material which it has filed, I have found no evidence that Corp has shown it has even a prima facie case that it has acquired any goodwill or reputation in the UK at any time, and certainly not at the relevant date in relation to any particular goods or services. As set out above, there is some, very limited, evidence that a few individuals made contact between themselves by email and discussed various matters such as holding a celebration (Ugadi) in the Houses of Parliament. As I indicated above,

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both parties made a claim that particular elements of the evidence was their material and the invitation to the Ugadi Festival is such material. I do not consider it necessary to determine the ownership point. This is because the evidence includes copies of an invitation and there are some undated prints of photographs apparently taken at the celebration but there is no evidence to show who may have attended the celebration or what took place during it. Whoever organised it, the fact that a celebration may have taken place in the Houses of Parliament is not sufficient to establish goodwill in relation to any particular goods or services and certainly not one that accrues to Corp at the relevant date. There is also some, again very limited, evidence that someone suggested making contact with unnamed universities apparently with a view to making presentations to students on political matters, however, for the reasons given above, this evidence also fails to show Corp has the requisite goodwill in the UK in any goods or services at the relevant date. As to the allegations that some of the material in evidence is not genuine but has been created in order to deceive, I again do not consider it necessary to make a determination as none of this material shows that Corp has the requisite goodwill in the UK in any goods or services at the relevant date. There is, for example, no evidence of turnover or advertising expenditure in relation to any specific trade and no evidence from customers or the trade.

26. This omitted to grapple with the substance of the case that Corp had raised for determination. Corp was, as I have noted in paragraph [16] above, putting itself forward as ‘representing’ TNFW in the present proceedings against Forum. It was contending, as I have noted in paragraphs [21] and [22] above, that Forum had broken away from the TNFW organisation and was pursuing a strategy of usurpation amounting to or involving passing off. Contrary to what seems to have been the basis of the Registry’s response to Forum’s evidence objections (see paragraphs [8] to [11] above) and in any event contrary to the position which the Hearing Officer seems to have adopted at the hearing on 20th October 2016 (see paragraph [23] above), it was indeed permissible to maintain that Forum was pursuing a strategy of usurpation in support of the objection based on the law of passing off which had been raised for determination under s.5(4)(a) of the Act. The 1994 Act does not provide that impropriety must and can only be alleged in support of an objection on the ground of bad faith under s.3(6). Since Forum could not

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(according to the Hearing Officer's unchallenged finding) show that it had established any goodwill of its own through use of the trade mark in issue in the United Kingdom, the question which had to be confronted was whether Forum was engaged in the strategy of usurpation alleged against it, with an attendant likelihood of misrepresentation and damage to the goodwill which Corp 'representing' the TNFW organisation claimed a right to protect on the basis that it was a goodwill with a geographical footprint which at the relevant date¹⁵ extended to the United Kingdom.

27. I think it is clear that if the Hearing Officer had fully addressed that point, she would and should have found on the basis of the evidence and materials before her that Forum was engaged in the strategy of usurpation alleged against it. I also think it is clear that if the Hearing Officer had focused on the question whether the TNFW organisation had established goodwill through use of the trade mark in issue with a geographical footprint which extended to the United Kingdom, she would and should have found on the basis of the evidence and materials before her that it had.
28. The objection under s.5(4)(a) could not correctly be treated as if it was a claim for 'infringement of unregistered trade mark' or as if it was a claim which necessarily depended for its success upon proof of prior use of the Telugu NRI Forum logo in the United Kingdom for services identical or similar to those of the kind listed in Forum's application for registration in Class 41: see JOYSLEEP Trade Mark BL O-257-17 (25 May 2017) at paras. [7] to [9] and [16] to [19]. The logo is an intrinsically distinctive mark; the TNFW organisation had undoubtedly undertaken charitable activities under and by reference to it in furtherance of its 'global' objectives; those activities had extended to the United Kingdom in connection with the matters noted in paragraph [19] above. It is clear that these were economic activities of a kind which could, if conducted on a sufficient scale, establish goodwill protectable in the United Kingdom in accordance with the criteria for protection identified by the Supreme Court in Starbucks (HK) Ltd v. British Sky

¹⁵ the date of inception of the commercial conduct complained of (which seems to have been late February or early March 2015): Starbucks (HK) Ltd v. British Sky Broadcasting Group Plc [2015] UKSC 31 at para [16] per Lord Neuberger PSC; Maier v. ASOS Plc [2015] EWCA Civ 220 at para. [165] per Kitchin LJ.

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Broadcasting Group Plc [2015] UKSC 31 at para. [52] per Lord Neuberger PSC. Lord Neuberger referred to the need for ‘a significant goodwill’ to exist in the United Kingdom. A small (but not trivial) goodwill can be sufficiently significant to qualify for protection.¹⁶ The operations of the TNFW organisation were of particular interest to and primarily targeted at members of the Telugu community rather than the public at large. I do not think it can reasonably be denied that a significant (albeit small) goodwill was generated among that section of the population of the United Kingdom by means of the extension of the activities of the TNFW organisation to the United Kingdom from April 2014 onwards.

29. It was common ground at the hearing below (and continued to be common ground at the hearing of the appeal¹⁷) that there would be a likelihood of deception and damage to goodwill if the logo was used concurrently by entities operating independently of one another in the United Kingdom as providers of services for charitable purposes across the specifications of the trade mark applications in issue. I have already said that I think the parties were right to proceed upon that premise. It follows, on the basis that the TNFW organisation had established a protectable goodwill through use of the logo in the United Kingdom prior to March 2015, that the objection to Forum’s application for registration was liable to succeed under s.5(4)(a) subject to Corp’s entitlement to raise and pursue an objection to registration under that section, to which I now turn.
30. The prescribed Form TM7 (Notice of opposition and statement of grounds) filed by Corp on 23 July 2015 narratively states under the heading “*Please tick on what grounds you are opposing the trade mark and continue to the relevant section(s)*” that an opposition based on s.5(4)(a) “*must be made by the ‘proprietor’ (owner) of the earlier right*”. Section C of the Form is the section which needs to be completed when pursuing an opposition on that ground. Under the heading “*ABOUT THE EARLIER UNREGISTERED TRADE MARK*” the Form calls for a ‘*Representation*

¹⁶ Kerly’s Law of Trade Marks and Trade Names 16th Edn (2018) para. 20-020; Wadlow The Law of Passing Off 5th Edn (2016) paras. 3-13, 3-14; Caspian Pizza Ltd v. Maskeen Shah [2017] EWCA Civ 1874 at para. [23] per Patten LJ.

¹⁷ Transcript p.67, lines 6 to 20.

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of your trade mark’ and requires information to be provided in response to the following questions: “Q1. *When and where was the earlier right first used in the UK? Date used ... Where used ...*”; Q2. *On which goods or services has the earlier right been used for?* Under the heading “*DETAILS OF THE TRADE MARK YOU ARE OPPOSING*” the Form requires information to be provided in response to the following questions: “Q3. *For which goods or services (of the application that you are opposing) do you consider that use of the applicant’s mark would amount to passing off?*” and “Q4. *Why would use of the applicant’s trade mark be contrary to law, particularly the law of passing off?*”

31. Corp proceeded to complete the prescribed form in its own name. It presumably did so upon the basis that it was entitled to proceed in that way by virtue of the ‘representative’ capacity in which it was openly claiming to act on behalf of TNFW and its ‘Founders’. So far as I can see, no attempt was made either by the Registrar or by Forum to clarify the ‘representative’ status and capacity in which Corp was purporting to act. No one seems to have considered Corp’s entitlement to claim protection under s.5(4)(a) for any goodwill which may have been established through use of the ‘Telugu NRI Forum’ logo by TNFW in the United Kingdom prior to March 2015.
32. Mr. Alluri, who represented Corp at the hearing of the present appeal, told me that Corp does not have a bank account.¹⁸ Even allowing for the ability of one member of an alliance to raise an objection for the protection of collectively owned goodwill under s.5(4)(a) of the Act (as discussed in Williams and Williams v. Canaries Seaschool SLU (CLUB SAIL Trade Marks) [2010] RPC 32; BL O-174-10; at paras. [27] to [29]), the evidence on file is not sufficient to demonstrate that Corp had a proprietorial interest in the goodwill in the United Kingdom which it was seeking to protect under s.5(4)(a) in the present case. There is also no basis upon which it would be permissible in accordance with the law as stated by the Supreme Court in Prest v. Petrodell Resources Ltd [2013] USKC 34 at paras. [35], [81], [82], [99], [100], [103] and [106] and reiterated by the Privy Council in Persad v. Singh [2017]

¹⁸ Transcript p.26 line 12 to p.27 line 12.

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UKPC 32 at para. [17] to ‘pierce the corporate veil’ and equate or assimilate Corp with and to the founders and / or members of the TNFW organisation who stood behind or alongside it. Corp appears to have been purporting to speak and act simply as a nominee for the founders and / or members of that organisation in the present proceedings.

33. That is not what the prescribed Form TM7 envisages when it states that an opposition based on s.5(4)(a) “*must be made by the ‘proprietor’ (owner) of the earlier right*”. The question which then arises is whether that statement is the expression of a legal requirement which must lead to the rejection of an opposition under that section of the Act if and whenever the requirement is not met. The answer to that question is to be found in The Trade Marks (Relative Grounds) Order 2007 (SI No. 1976 of 2007) which came into force on 1 October 2007. In Regulation 2 of that Order it is specified that: *‘The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right’*. In s.5(4)(a) of the Act it is provided (with emphasis added) that *‘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; ... 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’*. I cannot see from the evidence on file that Corp was itself a person entitled to prevent the use of the ‘Telugu NRI Forum’ logo in the United Kingdom by virtue of the law of passing off.
34. Whilst preparing this decision, I reached the point at which I considered it to be both necessary and appropriate for the parties to be given an opportunity to make further submissions in relation to these matters. I wrote to the parties’ representatives summarising my understanding of the capacity in which Corp was purporting to speak and act for TNFW in the present proceedings, referring them to the provisions of s.5(4)(a) of the 1994 Act and Regulation 2 of the 2007 Order relating to the requirement for proprietorship of the relevant earlier right and inviting them to

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provide further submissions in writing with regard to the following question: *'whether (on the assumption that TNFW could legitimately claim to have established a protectable goodwill through use of the 'Telugu NRI Forum' logo in the United Kingdom prior to March 2015) Corp has shown that it was a person entitled to prevent the use of the logo in the United Kingdom by virtue of the law of passing off (for the purposes of s.5(4)(a) of the 1994 Act) and entitled to claim a proprietary interest in the relevant 'earlier right' (for the purpose of satisfying the requirement specified in Regulation 2 of the 2007 Order).'*

35. Forum responded in further written submissions observing that the individuals who provided witness statements on behalf of Corp had asserted in their witness statements that all activities which were said to have generated goodwill in the United Kingdom were said to have been undertaken either by them or by Forum acting under their control; that there was no suggestion - let alone any evidence - that any goodwill generated in the United Kingdom had been assigned to Corp; and that there was no suggestion - let alone any evidence - that Corp had undertaken any activities under or by reference to the logo capable of generating any goodwill in the United Kingdom of which it might be the proprietor. In conclusion, it was submitted that Corp was clearly not the right person to have brought the opposition under s.5(4)(a) to trade mark application 3099108.
36. Corp responded in further written submissions presented over 12 pages of text in which it repeatedly asserted and re-asserted that the individuals who had taken over the running of Forum in 2015 were guilty of *'stealing our UK branch / Chapter'*: paras. IV, VI, IX(8) and XII. It maintained that Mr Alluri *'misspoke or maybe he is talking about our UK branch / chapter / sister concern'* when he said at the hearing of the appeal that Corp did not have a bank account: para. IX(4). With regard to the question of Corp's entitlement to raise and pursue the relevant objection to registration under s.5(4)(a), its submissions were quite diffuse. In substance, it maintained as follows: with reference to membership of TNFW *'any branch / chapter / child / sister concern is a membership of the global organization'*: para. IX(2); the founders of TNFW *'registered the companies in USA, UK ... as different corporate entities as operating arms / hands through which the international*

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organization would operate': para. IX(4); it was believed that neither the founders nor members of TNFW could *'act on their own and file opposition to contest in this case without the support of another operating arm / hand'* and *'Since [TNFW] is virtual, we had to use our operating arm / hand Telugu NRI Forum Corporation of US, i.e. our main branch, in this case. We have treated the US branch as our world headquarters from start. ... [TNFW] and its operating hands are same, we can't look or treat them as separate entities.'*: paras. IX(9) and XIV; and *'The global [TNFW] and [Corp] aren't two different organizations or entities, they are one'*: para. XII.

37. Seven days after filing those further submissions, Corp wrote to the Tribunal asking for the opportunity to present arguments in support of the proposition that it could claim to be the proprietor by assignment of goodwill built up and acquired through use of the 'Telugu NRI Forum' logo in the United Kingdom. I refused the request on the basis that, in the absence of any pleading or evidence on file asserting any such claim, there was no basis for permitting or examining any arguments directed to establishing proprietorship by assignment in the context of the present appeal. Corp then raised the possibility of amending its submissions to contend that ownership or assignment of goodwill could and should be inferred from the fact that two United Kingdom registrations of the 'Telugu NRI Forum' logo had been transferred to it by assignment from Mr Ramesh Vudathu (the initial applicant for registration) in June 2015. These were: (1) trade mark number 3099266 registered in respect of services in Class 45 on 28 April 2017 with effect from 14 March 2015; and (2) trade mark number 3104606 registered in respect of services in Class 41 on 8 April 2016 with effect from 18 April 2015. It is not apparent to me that the suggested inference takes account of the difference between acquiring 'title by registration' under the 1994 Act (see Ennis v. Lovell (THE SWINGING BLUE JEANS Trade Mark) [2014] RPC 32; BL O-148-14; at paras. [9] and [10]) and acquiring 'title by use' for the purposes of a claim based on the law of passing off. I am, in any event, not willing to permit an amendment to the effect requested by Corp to be raised and pursued for the first time at this very late stage of the present proceedings.

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38. What I see explained in Corp's further submissions is a mistaken belief on the part of a self-representing litigant firstly, to the effect that TNFW could not (as an unincorporated association) present a claim for protection of goodwill in opposition proceedings under s.5(4)(a) of the 1994 Act and secondly, to the effect that Corp can and should be equated and assimilated with and to the founders and / or members of TNFW who stand behind or alongside it and thirdly, to the effect that Corp did not need to show that it had itself engaged in any activities by means or as a consequence of which goodwill could be said to have been generated under and by reference to the relevant logo in the United Kingdom.
39. What I see in the Hearing Officer's Decision is the rejection of what would, in my view, have been a well-founded objection to Forum's trade mark application on the basis of the evidence and materials on file if the objection had been properly assessed at the behest of an opponent who had established the necessary entitlement to raise it under s.5(4)(a) of the 1994 Act and Regulation 2 of the 2007 Order.
40. To add to the sense of disquiet resulting from these deficiencies, there is also the disorderly presentation of '*evidence and / or submissions*' and '*evidence / submissions*' in response to the Registry's directions and the inconclusiveness of the position adopted by the Registry in response to the 'evidence objections' raised by Forum in relation to Corp's accusations of wrongdoing. In my view, these shortcomings substantially hindered the identification and proper determination of the true basis of the grounds of objection raised and pursued by Corp under s.5(4)(a). As did the failure to consider the question whether, having regard to the information provided by the evidence and materials it had filed and its openly declared position that it was purporting to '*represent*' TNFW in these proceedings, Corp was entitled to proceed with the objection under s.5(4)(a) of the 1994 Act in compliance with the requirements of Regulation 2 of the 2007 Order.
41. In short, TNFW nominated Corp to bring the present opposition. Having at the outset chosen not to raise an objection to registration on the ground of bad faith under s.3(6) of the Act and to confine itself to an objection under s.5(4)(a) of the Act, Corp left itself with no alternative but to establish that it was entitled to proceed

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with the latter objection as proprietor of the relevant 'earlier right' in accordance with Regulation 2 of the 2007 Order. For the reasons I have given, I am unable to find on the basis of the evidence and materials on file that Corp was the (or a) proprietor of the relevant earlier right. The requirements of Regulation 2 of the 2007 Order are not waivable. I see no scope for Corp or TNFW to repair their position for the first time on appeal. I therefore dismiss Corp's appeal from the Hearing Officer's Decision dated 8 March 2017.

42. The costs of the proceedings in the Registry are covered by para. [79] of the Hearing Officer's Decision, in which she decided that each party should bear its own costs. There is no live appeal before me against her determination to that effect. With regard to the costs of the appeal, it appears to me that neither side has succeeded in obtaining substantially what it was seeking. Although Forum has retained the outcome of the proceedings below, it has failed in its attempt to secure the endorsement of the Hearing Officer's assessment for which it contended. Although Corp has successfully contested the Hearing Officer's assessment, it has failed in its attempt to secure the reversal of the outcome of the proceedings below for which it contended.
43. The late attention paid to the point about Corp's entitlement to proceed with the objection it was pursuing under s.5(4)(a) has given rise to that mixed state of affairs on appeal. As noted in paras. [31] and [40] above, the point about Corp's entitlement to proceed was there to be seen and examined, but was overlooked. I think it is reasonable to suppose that if it had not been overlooked in the course of the proceedings below, the Hearing Officer's Decision relating to Corp's objection under s.5(4)(a) would have been considerably more focused than it was and there would then either have been no appeal or any appeal would have been considerably more focused than it was. I also think it is reasonable to recognise that Forum's efforts and resources on appeal were substantially (but unsuccessfully according to my view of the evidence and materials on file) directed to resisting the contention that it was guilty of usurpation amounting to or involving a likelihood of passing off relative to the activities of TNFW.

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44. Looking at matters in the round, I think the right course in these circumstances is for me to dismiss the appeal with no order as to costs.

45. Finally, I would urge the Registrar to review his practice with regard to the giving of directions for the filing of '*evidence and / or submissions*' and '*evidence / submissions*' in the light of experience in this case (and more generally) and I would urge the parties to engage in serious and constructive discussions with a view to resolving their differences by agreement rather than expending more time, effort and money, which could otherwise be used for charitable purposes, in pursuit of litigation.

Geoffrey Hobbs QC

29 March 2018

The Appellant (Telugu NRI Forum Corporation) was represented by Mr Vishnu Alluri

Mr Jamie Muir Wood instructed by Marsans appeared on behalf of the Respondent (Telugu NRI Forum)

The Registrar took no part in the appeal