

**O-215-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3269370  
BY SANANTONE LIMITED TO REGISTER:**

**Simply Loveleh**

**&**

**SIMPLY LOVELEH**

**AS A SERIES OF TWO TRADE MARKS IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 411834  
BY JULIE REDGATE**

## **BACKGROUND & PLEADINGS**

1. On 9 November 2017, Sanantone Limited (“the applicant”) applied to register **Simply Loveleh** and **SIMPLY LOVELEH** as a series of two trade marks for the following goods in class 25:

Articles of outer clothing; Ties [clothing]; Tops [clothing]; Jackets [clothing]; Clothing for leisure wear; Clothing for men, women and children; Hats (Paper -) [clothing]; Hoods [clothing]; Bottoms [clothing]; Jackets (Stuff -) [clothing]; Jackets being sports clothing; Jerseys [clothing]; Jogging bottoms [clothing]; Leisure clothing; Motorists' clothing; Outer clothing; Shorts [clothing]; Clothing; Clothing for cyclists; Clothing for sports.

The application was published for opposition purposes on 1 December 2017.

2. The application has been opposed in full. Although the original opponent was identified as David Oxley, during the course of the proceedings, there was a change of opponent with Ms Julie Redgate named as the new opponent; I shall return to this point later in this decision. The opposition is based solely upon section 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. The opponent indicates that the unregistered trade mark “Simply LoveLeh” has been used since 1 December 2016 “throughout UK and the rest of the world”. The opponent responded to the following questions appearing in the Notice of opposition thus:

**“Q2. On which goods or services has the earlier right been used for?”**

It has been used for Video Blogs, Social Media and Merchandise.

[www.simplylovelehbrotherhood.co.uk](http://www.simplylovelehbrotherhood.co.uk) (registered 8th November 2017)

<https://twitter.com/SimplyLoveleh> (Created June 2017)

<http://facebook.com/simplylovelehbrotherhood> (Created 27th October 2017)

[https://www.youtube.com/channel/UC8vIGQ4HsQ\\_Pks9rQ8DoVaQ](https://www.youtube.com/channel/UC8vIGQ4HsQ_Pks9rQ8DoVaQ) (Created 8th November 2017)

All created and used before this Trademark Application. Before this the video blog was available only via WhatsApp and the Merchandise via eBay, Amazon etc.

Merchandise includes the following items: T-Shirts, Hoodies, Sweatshirts, Vinyl Stickers and Mugs.”

**“Q4. Why would use of the applicant’s trade mark be contrary to law, particularly the law of passing off?”**

1) Simply LoveLeh possess a reputation & goodwill in our goods, name, mark & other identifying feature that associates the public with our goods, & distinguishes them from others;

2) Their could be misrepresentation by the other party which could lead others to believe goods are actually those of the claimant. Confusion is not be sufficient to prove misrepresentation;

3) This misrepresentation would cause damage to our reputation or goodwill should the merchandise not be of sufficient quality, not fulfilled, cause offence to others or break any copyright laws etc.

This is clearly a passing off exercise by the applicant as our mark is distinctive; the word LoveLeh doesn't exist in the English dictionary and nor does it appear

for any other brand, mark or slogan in known existence. It is a made up word, created by ourselves & clearly distinguishes us from anyone.

The applicants representative approached Simply LoveLeh on the 14th November 2017 and requested a meeting with us to discuss working together or in their own word "I need to speak with the voice behind "Simply Loveleh" with regards to business/partnership." So clearly they were aware of us as this was shortly after their trademark application. It is clear therefore they were looking to pass off our reputation and goodwill."

4. The applicant filed a counterstatement in which it stated:

"The Applicant denies that the Opponent has accrued goodwill through use of the trade mark SIMPLY LOVELEH in respect of the goods specified before the application in suit was filed...

The Applicant denies there is any misrepresentation because the Opponent had not made trade mark use of the sign in a commercial context before, or at the time, the application was filed. As such the Applicant's use of the mark in respect of the goods specified could not cause damage...

Furthermore the Applicant denies they were looking to pass off the goods specified in the application in suit. The Applicant was not aware of the Opponent's video blogs at the time the application was filed. The Applicant subsequently became aware of the Opponent's video blogs but this was after the application in suit was filed.

The Applicant has approached the Opponent to discuss working together however this approach was rejected by the Opponent..."

5. In these proceedings, the opponent represents herself; the applicant is represented by Bailey Walsh & Co LLP. Although only the opponent filed evidence, the applicant filed written submissions during the evidence rounds. The matter came before me at a hearing held on 9 April 2019. Ms Redgate attended the hearing in person, accompanied by Mr Fredrick Steel, who spoke on her behalf; the applicant elected not to attend the hearing or to file written submissions in lieu of attendance.

### **The opponent's evidence**

6. This consists of a witness statement from Ms Redgate, who states she is the owner of Simply LoveLeh Brotherhood ("SLB"), a position she has held since 1 May 2017. She explains that the trade mark "Simply LoveLeh" was first used in the UK in 2017 by SLB "in relation to Class 25." She adds that the trade mark was first used on 1 September 2017 and at exhibit 1 she provides a copy of what is described as a "Licence Agreement" (dated 31 August 2017) "for the use of Simply LoveLeh" between SLB and James Brookes T/A WillDesign/Shoebob with an address in Skegness. The non-exclusive licence is signed by both parties and is in respect of "clothing merchandise only".

7. Exhibit 2 consists of what Ms Redgate describes as an "invoice of sales made for class 25..". She states:

"5. The mark has been used on the goods/services in the United Kingdom."

8. The exhibit (which makes reference to 2017) appears to show that following the date of the above Agreement, 7 t-shirts bearing the words "SIMPLY LOVELEH" (either alone or with other text) were produced, with the total value of the invoice amounting to £76.14. No indication is provided as to whom the t-shirts may have been sold.

## **DECISION**

9. The opposition is based upon section 5(4)(a) of the Act which reads as follows:

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

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

(b)...

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.”

### **Preliminary issue - the identity of the opponent**

10. In its written submissions, the applicant states:

“7. In paragraph 1 of her witness statement Ms. Redgate states she is the "owner of SLB (Simply LoveLeh Brotherhood) a position which I have held since (date): 1<sup>st</sup> May 2017".

8. Clearly as the purported owner of the unregistered trade mark and therefore presumably any goodwill associated with the same the Notice of Threatened Opposition and Opposition filed against the application by Mr Oxley have not been filed in the correct name and are therefore invalid.”

11. In a request dated 17 August 2018, Ms Redgate asked the tribunal to change the name of the opponent from David Oxley to her own name. In response to an official letter dated 4 September 2018, she stated:

“I Julie Redgate of 153 Wooley Wood Road, Sheffield, S5 OUF can confirm the following: • have had sight of all the forms, correspondence and any evidence admitted into the proceedings; • stand by the grounds of the pleadings and confirm that where the name of the opponent appears this should be read as though it is made in my name; • are aware of and accept liability for any costs that may be awarded against me.”

12. In an email dated 5 April 2019, Ms Redgate responded to the applicant’s comments in paragraph 10 above, stating:

“1) The use of the name David Oxley to apply for an opposition rather than Julie Redgate the owner of Simply Loveleh Brotherhood’s (SLB). This was done as Ms Redgate was a LIP [i.e. litigant-in-person] and required assistance to complete the forms. Mr Oxley offered to file them on SLB’s behalf but unfortunately Mr Oxley was unable to carry on his representation and therefore all correspondence needed to be addressed to Ms Julie Redgate the owner of SLB.”

13. At the hearing, it was further explained to me that Mr Oxley has never had any role in the opponent’s business. The inclusion by him of his name as the opponent on the Forms TM7A and TM7 were simply mistakes borne out of his unfamiliarity with the Forms mentioned.

14. As I mentioned earlier, the following is included in the amended Notice of Opposition:

“The applicants representative approached Simply LoveLeh on the 14<sup>th</sup> November 2017 and requested a meeting with us to discuss working together or in their own word "I need to speak with the voice behind "Simply Loveleh" with regards to business/partnership...”

15. Also as mentioned above, in its counterstatement dated 16 July 2018, the applicant stated:

“The Applicant has approached the Opponent to discuss working together however this approach was rejected by the Opponent...”

16. Thus it appears that as early as 14 November 2017 i.e. five days after the filing of its application (and over two and a half months before Mr Oxley completed the first of the Forms mentioned), the applicant was fully aware of Ms Redgate’s identity. Indeed, in its own counterstatement filed a little over a month before the request to change the name of the opponent was made, the applicant confirms it had approached the opponent “to discuss working together”. In those circumstances, the applicant has, in my view, suffered no prejudice as a result of the administrative errors which occurred when the Forms mentioned were completed. In addition, even if I were to conclude that the basis of the opposition was, as the applicant suggests, invalid, once the application achieves registration, the opponent could, of course, file an application for invalidation on, inter alia, the same ground. Given the very late stage these proceedings have reached, to allow them to continue would, in terms of time and cost, be beneficial for all concerned.

17. Rule 74 of the Trade Marks Rules 2008 reads as follows:

“(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made -

(a) after giving the parties such notice; and

(b) subject to such conditions,

as the registrar may direct.”

18. Although as far as I can tell the above rule is not explicitly mentioned in any of the official correspondence, given the factual matrix described above, the tribunal’s decision to allow the correction of the name was, in my view, sensible and in accordance with rule 74. In reaching this conclusion, I have considered whether the correction has any bearing on the application of rule 77; I have decided that it does not. This is because although the periods for filing a request to extend the opposition period, and to file opposition, are governed by rule 77(5), these time limits were observed. The change of identity of the opponent is a different matter to the observation of the time limits. It is tolerably clear that the intention was always that Ms Redgate would be the opponent, with Mr Oxley acting as her representative. In these circumstances, the initial mis-identification of the opponent as Mr Oxley was an error which can and has been corrected under rule 74.

### **The passing off claim**

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

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (Reckitt &

Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

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

20. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

"39. In *Last Minute*, the GC stated:

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

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

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied

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

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

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

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

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

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

21. As there is no evidence that the applicant has used its trade mark, the relevant date is the date of the application for registration i.e. 9 November 2017.

22. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of

opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

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

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

24. In relation to the evidence filed by Ms Redgate, the applicant submits:

“10...the evidence provides no proof whatsoever of use of the mark Simply LoveLeh or evidence of any sales. Simply agreeing to a licence is not commercial use of the mark and therefore the Opponent wholly fails to show the generation of any goodwill associated with such use. Exhibit 2 is also seriously deficient as it does not show that any goods have been sold, only what appear to be indicative prices for the same.”

25. At the hearing, I began by making it absolutely clear that my decision could only be made on the basis of the evidence filed; a point Ms Redgate accepted. Having provided me with background to the opponent’s business and confirmed that SLB is a trading style used by Ms Redgate, Mr Steel explained that the words relied upon had been used since October 2016 (rather than December 2016 as mentioned in the Notice of Opposition), in relation to what began as a blog, initially on WhatsApp. Mr Steel confirmed there had been no commercial use of the words being relied upon prior to the Agreement which was entered into on 31 August 2017. At the hearing, I pointed out that the information provided in response to question 2 on the Form TM7 (paragraph 3 above refers), had not been supported by evidence and I noted the closeness of many of the dates provided to the date of the application for registration i.e. 9 November 2017. In this regard, I pointed out that while the twitter account had been created in June 2017 and the Facebook page on 27 October 2017, the website and YouTube channel were only registered/created one day prior to the date that the application was filed.

26. In her email of 5 April 2019, Ms Redgate responded to the applicant’s comments in paragraph 24 stating:

“2) The point around Exhibit 2 not showing sales from the period before the application for trademark was lodged is disputed. The sales invoice clearly shows items that have been ordered, paid for and despatched. This is also clearly

evidenced by the displayed of Royal Mail tracking numbers for the items despatched. The key to the order on the right of each item is: C = Purchase Order Created, P = Order Processed, S = Item Despatched.

We are not able to show the senders name and address due to Data Protection Act 2018 and GDPR as ShoeBob have to protect their customer details and not share with 3rd parties without their consent. This is consent they do not ask for on purchase as per the Terms and Conditions.”

27. In relation to exhibit 2, Mr Steel accepted that the invoice bore none of the “key” indicators mentioned above (possibly because the page provided was incomplete). He pointed to the references to “First Class”, “SC” (meaning second class), “International sale” and to what he explained was a Royal Mail tracking number i.e. “XT XS XZ CN22”, as evidence that the items were sold. Having accepted that the value of the 7 t-shirts sold amounted to £76.14, he explained that these items were sold shortly after the Agreement was entered into and, to the best of his recollection, prior to the date that the application was filed.

28. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish

a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

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

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

30. It appears that use of the words relied upon by the opponent began at best in October 2016 in a blog available on WhatsApp. Since that time, various social media sites have been set up, the earliest (twitter), was created in June 2017. The other social media sites were created in close proximity to the date of the application for registration as was the website. There was no commercial use prior to the date of the Agreement in late August 2017.

31. I begin by reminding myself that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off. In reaching a conclusion, I shall proceed on the basis most favourable to the opponent. However, even if I do and even if I assume that: (i) the use of the words “SIMPLY LOVELEH” on the t-shirts is use as a trade mark (as opposed to being merely a slogan), (ii) the customers were based in the UK and (iii) the sales occurred prior to

the date of the application, the sale of £76.14 worth of t-shirts in a market which must amount to many tens (if not hundreds) of millions of pounds each year is, in my view, to be regarded as trivial. In my view the opponent has not shown that at the date that the trade mark application was filed, she had the necessary goodwill to get her claim to a passing off right off the ground. As a consequence, the opposition falls at the first hurdle and is dismissed accordingly.

### **Overall conclusion**

32. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

### **Costs**

33. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, but keeping in mind the briefness of the Notice of opposition, counterstatement, opponent’s evidence and the applicant’s written submissions (which in relation to the latter a good deal of which was taken up by background to the proceedings and the relevant case law), I award costs to the applicant on the following basis:

Reviewing the Notice of Opposition and filing a counterstatement:	£200
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Reviewing the opponent’s evidence and filing written submissions:	£200
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<b>Total:</b>	<b>£400</b>
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34. I order Julie Redgate to pay to Sanantone Limited the sum of **£400**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 26 April 2019**

**C J BOWEN**

**For the Registrar**