

TRADE MARKS ACT 1994

**In the Matter of Trade Mark Application No. 2531847
to register the mark ONE 1AWAYS in Classes 25 and 35
in the name of PAUL SQUIRE**

**IN the Matter of Opposition No. 100292 by
GABRIELLE JEMMOTT**

**And in the matter of an Appeal of the Opponent from the decision of Mr. C.J. Bowen,
acting on behalf of the Registrar, dated 28th April 2011**

DECISION

1. This is an appeal against a decision of Mr C J Bowen, the Hearing Officer for the Registrar, dated 28 April 2011, in which he rejected an opposition to the registration of a device mark. The Opponent was Ms Gabrielle Jemmott, who claimed to own the goodwill in the unregistered mark, '1aways'.

Background

2. On 16th November 2009, Paul Squire applied to register the trade mark set out below for clothing and hats in Class 25 and retail services connected with the sale of clothing in Class 35:



It may be seen that the mark includes not just the numeral 1, but also the word "one." The mark was published for opposition purposes on 18th December 2009.

3. On 17th March 2010, Ms Jemmott filed a Notice of Opposition based upon section 5(4)(a) of the Trade Marks Act 1994, on the basis that she had been using the mark 1AWAYS since July 2006, in London, in relation to the design of promotional T-shirts and the design and

production of sporting shoes or trainers. Mr. Squire filed a counter-statement challenging Ms Jemmott's claim to own goodwill in the name.

4. Both parties then filed evidence. Ms Jemmott's evidence consisted of a witness statement dated 1st July 2010. The 31 exhibits to her witness statement are described in some detail in the Hearing Officer's decision. Whilst she described herself as being the creative director of 1AWAYS Boutique and stated that she was authorised to speak on her company's behalf, no evidence was produced that 1AWAYS Boutique is a limited company or that she is a director in any formal sense, and the Hearing Officer proceeded on the basis that the claim to goodwill was made in her own name and the opposition was brought on her personal behalf. That is not disputed by Ms Jemmott on the appeal.
5. Mr. Squire's evidence consisted of a mixture of written submissions and facts relating to his own costs in setting up his own business.
6. Neither party sought a hearing before the Registrar, nor were written submissions filed, and the Hearing Officer's decision was therefore made on the papers.

The decision below

7. The Hearing Officer summarised the evidence on both sides and considered the law of passing off, in particular as set out by Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *Wild Child Trade Mark* [1998] RPC 455; he then considered the question of material date at which Ms Jemmott's claim was to be assessed. Although Mr Squire had commented on the preparatory steps taken in relation to his business, the Hearing Officer found no evidence that there had been any trading activity prior to the application date and he therefore considered that the material date for the purposes of opposition was the date of application, 16 November 2009.
8. The Hearing Officer went on to consider a number of decisions relating to the acquisition and extent of the goodwill necessary to found a passing off action. He set these out at paragraphs 23 to 27 of the decision:

“23. In order to succeed in an action for passing off, Ms Jemmott has to establish that at the material date there was goodwill in a business in which the numeral and word 1AWAYS had been used. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

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

24. The goodwill must be of more than a trivial nature. In *Hart v Relentless Records* [2002] EWHC 1984 Jacob J 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.

25. However, one does not need to be a large player to be protected under the law of passing-off. In *Stacey v. 2020 Communications Plc* [1991] F.S.R. 49 Mr. Justice Millett said:

“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.”

26. I also note that in *Stannard v Reay* [1967] FSR 140 it was held that:

“...even though the plaintiffs had only been trading for about three weeks, there was evidence of substantial takings by the business which fell when the defendants commenced trading. It was not impossible for goodwill in a new kind of business to be built up in a short period of time...”

(I note that the decisions in both *Stacey* and *Stannard* were made in the context of injunctive relief before full trial).

27. Finally, the following comment of Slade LJ in *Chelsea Man Menswear Limited v Chelsea Girl Limited and Another* [1987] RPC 189 is also relevant:

“However, the authorities show quite clearly that a plaintiff who has established a cause of action in passing off can obtain relief by way of

injunction extending beyond the boundaries of the particular areas in which he has proved the existence of his reputation and goodwill.””

9. The Hearing Officer then considered the necessity for an opponent to provide sufficient evidence for the court to assess an opposition based on section 5(4)(a), by reference to the decisions of Pumfrey J in *South Cone* and of Floyd J in *Minimax*, concluding in paragraphs 32-34 of his decision:

“31. In his written submissions Mr Squire said:

“I truly believe that even though we acknowledge that Gabrielle Jemmott has had the website 1AWAYS from 2006. It seems to us that she really hasn’t done anything with her company or brand that enables her to claim that not only has she acquired a reputation throughout the United Kingdom, and that we would profit from consumers thinking we are her...”

32. In her notice of opposition Ms Jemmott states that she first made use of the numeral and word 1AWAYS on 6 July 2006 and that this sign has been used in London, Essex, Hertfordshire and Greater Manchester; I note that Mr Squire accepts that Ms Jemmott had a website bearing this sign in 2006. A review of Ms Jemmott’s evidence shows the sign being used (sometimes alone sometimes with other signs) in a number of different ways. It appears in the domain names www.1AWAYS.com and www.1AWAYSboutique.com and on what Ms Jemmott describes as the “presentation pages” for those websites (exhibit GJ9). It also appears on a pair of sample training shoes (exhibit GJ1) which, given the contents of exhibit GJ4, I take to be from June 2006 and on a number of sample t-shirts and a sample vest (exhibits GJ2, 5, 13 and 14) which are said to date from 2006, 2007, 2008, 2009 and 2010. Exhibits GJ6 and 8 dated 22 and 26 October 2007 are e-mails from eBay to Ms Jemmott which contain references to 1aways as do exhibits GJ10, 11 and 12 which are the invoices from Fasthosts Internet Ltd dated 28 June 2008 and 31 March 2009 which I note also refer to 1awaysboutique.co.uk and 1aways.co.uk. Finally, I have exhibits GJ15-31 which are a range of sales receipts (the vast majority of which are dated prior to the material date) and which Ms Jemmott explains represents amounts spent by her on goods and services “for the production and customisation of leisure apparel and sporting footwear.”

33. Considering the totality of Ms Jemmott’s evidence, I think it is reasonable for me to conclude that her interest in the sign 1AWAYS probably began sometime before the summer of 2006, but it was in the summer of 2006 and in the following years she took steps to commercialise this interest (including the adoption of various websites and the purchase of a range of items and services to assist in the creation of a number of sample products i.e. a pair of training shoes, a number of t-shirts and a vest). The results of Ms Jemmott’s efforts (including some £1600 spent by her purchasing goods and services) are that by the end of 2008 she had achieved sales of £881 and spent £420 promoting her business.

34. While the decision in *Stacey v. 2020 Communications Plc* makes it clear that it is not necessary for Ms Jemmott to be a “big player” to succeed under the law of passing off, equally the decision in *Hart v Relentless Records* makes it clear that any goodwill relied upon by her must be of more than a trivial nature. When the results

of Ms Jemmott's activities since 2006 to commercialise the business using the 1AWAYS sign are considered in the context of the immense size of the clothing market in the United Kingdom (of which I take judicial notice), and in the absence of any evidence from the trade or the public, they are, in my view, most unlikely to have resulted in her business acquiring a protectable goodwill in the numeral and word 1AWAYS. Without a protectable goodwill there can be no misrepresentation or damage and as a consequence Ms Jemmott's opposition fails."

He awarded Mr Squire costs in the sum of £400.

Standard of the appeal

10. This appeal is a review of the Hearing Officer's decision, not a re-hearing. The Hearing Officer's decision involved assessments of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

"In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle."

The appeal

11. The appeal was launched as long ago as 20 May 2011, but was not actioned until much later due (it seems) to administrative error. Mr Squire made some submissions in response to the appeal which were filed on 11 November 2011. The hearing was booked to take place before me on 20th June 2012 and the parties were informed of the hearing date, time and location by a letter from the Treasury Solicitor dated 23 May 2012. On the day of the hearing, Ms Jemmott failed to attend and efforts by members of staff to contact her by telephone, on her mobile and landline telephone numbers, failed. Mr Squire did attend in person but in the circumstances I did not ask him to make any submissions as to the merits of the appeal. He informed me that he had not heard from the appellant. Following the hearing, on 20th June, the Treasury Solicitor contacted Ms Jemmott by e-mail to ask whether she had intended to attend the hearing, but no answer has yet been received from her.

12. Unfortunately, it is not altogether easy to discern from the grounds of appeal set out in Ms Jemmott's form TM55 exactly what is the basis on which she challenges the Hearing Officer's conclusions.
13. Ms Jemmott reiterated her earlier submissions that she had acquired goodwill in the word 1AWAYS and that it would have been apparent to Mr. Squire that she had a website under the domain name 1AWAYS.com. It is not clear to me whether that is intended to be a challenge to the Hearing Officer's conclusions, certainly, no allegation of bad faith had been made.
14. A more significant point which is raised on the second page of the grounds of appeal is put in these terms: "Though (in terms of sales) my label is not deemed a major player or a super brand in the UK clothing market, I do feel the promotional activities that I have undertaken have not been taken into consideration." I take this to be a criticism of the Hearing Officer's assessment of the evidence which Ms Jemmott had filed in support of the opposition. In my view, however, she has not raised any valid criticism of the Hearing Officer's conclusions. It appears to me that the Hearing Officer analysed her evidence extremely carefully and the comments which he made as to the impact of the evidence and documents which she had provided are sound. I see no material error or error of principle in the conclusion which he reached that Ms Jemmott had not substantiated her claim to have acquired goodwill in the mark at the relevant date.
15. The next point raised in Miss Jemmott's grounds of appeal relates to the value of promotional giveaways which she says she has made. She says: "Below is the retail price worth of promotional giveaways to date" and in the next line "1589 Units x retail price worth = £31,780." She added "This steady promotion is reflected in my growth of sales for 2010/2011." I understand that Ms Jemmott wishes to raise the point that the promotional activities which she has carried out in relation to her business has raised the profile of her mark, even though that may not have been reflected in the sales achieved by her business. Indeed, as Mr Squire pointed out, there was no evidence provided by the appellant that she has made any sales at all of any goods under the mark.

16. More importantly, it appears to me that by referring to this £31,780 worth of promotional giveaways, Ms Jemmott is seeking to add to the evidence which she filed in the first instance. There are various difficulties in her way in doing so. First, she has not made an application to adduce further evidence, nor to explain why further evidence should be admitted on appeal, if that is what she is seeking to do. However, in any event, she has made only a bare assertion that there has been such additional promotion of her mark, without any documents to back it up. I note the submissions which Mr. Squire has lodged, which point out the inadequacies in the evidence in this respect, and raise the issue of the amount of expenditure which would have been necessary to fund that level of promotional giveaway.
17. Moreover, there must be a real question as to whether the expenditure to which Ms Jemmott refers is relevant in terms of having been made prior to the relevant date for the purposes of this opposition. In the grounds of appeal she refers to the level of promotional giveaways made "to date", which would appear to be a reference to the date of the grounds of appeal rather than the relevant date of the opposition, whilst the figure which she gives is very significantly higher than that given in paragraph 6 of her witness statement, dated 1st July 2010, at which point she indicated that she had spent £420 in total on promoting her 1AWAYS goods and services, inclusive of promotional giveaways.
18. In all the circumstances, it does not seem to me that it would be appropriate for me to take into account Ms Jemmott's point about the possible expansion of her promotional activities, seemingly since the relevant date, and that does not provide a reason to overturn the Hearing Officer's decision.
19. The next point raised in the grounds of appeal relates to a further assertion by Ms Jemmott that her sales have grown in 2010/2011. Once again, she produces no evidence in terms of documentation to support that assertion, but even if she had done, the volume of sales made in 2010 and 2011 would not necessarily establish that she had acquired goodwill at the relevant date in 2009, which is a matter which should have been explored in the evidence lodged in July 2010.

20. Lastly, Ms Jemmott raises the lack of evidence provided by Mr. Squire in support of his assertion that he had traded under his mark before making his trade mark application in November 2009. She is correct to state that there was insufficient evidence before the Hearing Officer to establish that fact, but the Hearing Officer came to that conclusion himself in paragraphs 21 and 22 of his decision, concluding that he could not find that Mr. Squire had established his own goodwill prior to the relevant date. In the circumstances, it does not appear to me that any of the issues raised by Ms Jemmott in the grounds of appeal show that Hearing Officer was wrong to reach the conclusion which he did, and I will dismiss the appeal.

21. Mr Squire attended the hearing of the appeal in person. I indicated to him that I would make an award of costs in his favour. As a litigant in person, CPR 48.6 applies by analogy (see the decision of Mr Richard Arnold QC, acting as the Appointed Person in *South Beck*, B/L O/160/08, 9 June 2008). The Rule provides:

“ (2) The costs allowed under this rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.

...

(4)The amount of costs to be allowed to the litigant in person for any item of work claimed shall be –

(a) where the litigant can prove financial loss, the amount that he can prove he has lost for time reasonably spent on doing the work; or

(b) where the litigant cannot prove financial loss, an amount for the time reasonably spent on doing the work at the rate set out in the Costs Practice Direction.”

The Costs Practice Direction provides:

“The amount which may be allowed to a litigant in person under rule 46.3(5)(b) and rule 48.6(4), is £18 per hour.”

22. I asked Mr Squire whether he had incurred any costs in relation to the appeal and he identified the following costs:

- (1) preparation of the submissions had taken him a day;
- (2) costs of attending the appeal hearing included

- (a) £40 petrol to Cricklewood station;
- (b) £30 train fares for himself and his colleague;
- (c) £10 taxi fare, because initially Mr Squire went to the wrong place for the hearing, and
- (d) payment of 2 people to mind the shop in their absence, at the daily rate of £39.60 each.

I assess his costs as follows:

- (1) preparation of his submissions, I will allow 6 hrs at £18 an hour = £108;
- (2)
 - (a) £40 petrol,
 - (b) £15 train fare for Mr Squire only to attend in person,
 - (c) nothing towards the unnecessary taxi fare and
 - (d) payment of 1 person, to help mind the shop in the absence of Mr Squire = £39.60.

That makes a total of £202.60. That sum is well within the overall limit of two thirds of the amount which would have been allowed if Mr Squire had been legally represented.

23. I therefore dismiss the appeal and an order Ms Jemmott to pay Mr Squire the sum of £202.60 in addition to the £400 which the Hearing Office ordered her to pay in relation to the costs below, all such sums to be paid by 5 pm on 18 July 2012.

Amanda Michaels

2 July 2012