

O-267-04

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2225198
IN THE NAME OF TRIYOGA (UK) LIMITED
TO REGISTER A TRADE MARK IN CLASSES 25, 28 AND 41**

AND

**IN THE MATTER OF
OPPOSITION THERETO UNDER NO. 90070 IN THE NAME OF
KALI RAY**

Trade Marks Act 1994

**In the matter of application No. 2225198
in the name of Triyoga (UK) Limited
to register a trade mark in Classes 25, 28 and 41**

And

**In the matter of opposition thereto
under No. 90070 in the name of Kali Ray**

Background

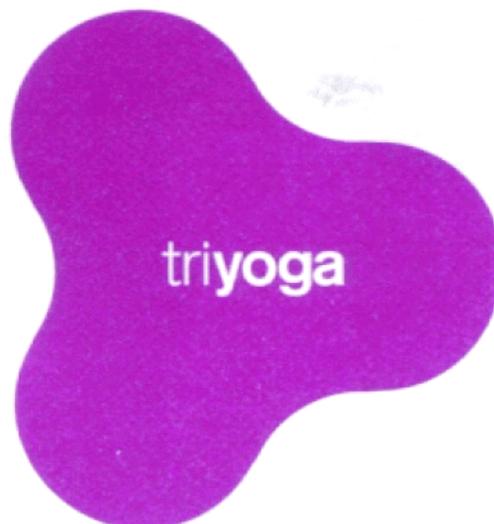
1. On 9 March 2000, Triyoga (UK) Limited applied to register a trade mark in Classes 25, 28 and 41 in respect of the following specifications of goods and services:

Class 25 Clothing, footwear, headgear.

Class 28 Yoga equipment and accessories.

Class 41 Provision of yoga instruction; provision of pilates instruction; provision of training relating to yoga.

2. The mark applied for is as follows:



The applicants claim the colour purple as an element of the mark.

3. On 13 February 2002, Kali Ray filed notice of opposition based on the following grounds:

1. **Under Section 5(4)(a)** by virtue of the law of passing off,
2. **Under Section 3(6)** because the applicants were made aware of the opponent's rights and reputation in relation to TRIYOGA prior to the filing of the application, which was therefore made in bad faith.

4. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

5. Both sides ask that an award of costs be made in their favour.

6. Both sides filed evidence in these proceedings. The matter came to be heard on 8 June 2004, when the applicants were represented by Mr Michael Edenborough of Counsel, instructed by David Keltie Associates, their trade mark attorneys. The opponent was represented by Mr George Hamer of Counsel, instructed by Ladas & Parry, their trade mark attorneys.

Opponent-s evidence

7. This consists of three Witness Statements. The first is dated 6 December 2002, and comes from Eva-Maria Beck, of Berlin Monumentenstr. 12, 10829, Berlin, Germany.

8. Ms Beck says that in 1998 she became interested in the TRIYOGA system of Kali Ray through her teacher, Daniel Orlansky, from Boston, USA. She recounts that in December 1999 she visited the TRIYOGA centre in the US to meet Kali Ray, saying that this was the first of a series of visits that she has made. Ms Beck says that she has become a certified teacher and representative of the TRIYOGA system in Europe, and has held a licence contract with Kali Ray since 8 December 1999, a copy of which is shown as exhibit 1. The exhibit contains a copyright statement, signed by Ms Beck on 8 December 1999, and refers to the Kali Ray TriYoga system TriYoga Flows and also TriYoga, most references being stated to be a registered right, which I take to be copyright. The foot of the page bears the legend "Kali Ray TriYoga 8 1999" and the date 8/18/99 although does not indicate the significance of this date. The second page of the exhibit is headed "Kali Ray TriYoga 7 - Copyright and Trademark Statement" and sets out the parameters under which the TriYoga name may be used. Inter alia it states that use must be accompanied by a copyright statement, the year being the same year as the original document. Ms Beck signed the statement on 18 January 2002.

9. Ms Beck says that since the commencement of her licence agreement she has organised and taught the TRIYOGA system throughout Western Europe. She refers to exhibit 2, which consists of examples of advertisements for workshops. All but one is in German and none, as far as I can see relate to the UK.

10. Ms Beck gives details of the TRIYOGA seminars at which she has participated (exhibit 3), and the articles that she has published on the system (exhibit 4), none of which occurred within the UK. She also refers to the establishment of an Internet e-mail address through which she receives and responds to enquiries from persons interested in TRIYOGA, although gives no further information. Ms Beck refers to future workshops that she will be running, including one to take place in London. Exhibit 5 consists of an interview that Ms Beck did with the Swiss Yoga Journal.

11. The second Witness Statement is dated 6 December 2002, and comes from Kali Ray, the opponent in these proceedings.

12. Ms Ray recounts that in 1980 she founded a new system of yoga for which she adopted the name TRI YOGA, initially promoting the system to yoga students in the US. She says that at the same time she developed a TRIYOGA Certification Handbook for use in training and certifying prospective teachers of the system, the first handbook being copyrighted and published in 1980. A copy of the handbook is shown as exhibit 1, and is marked A8 1980-2002 Kali Ray@confirming that this version must have been published in, or after 2002, but that the handbook itself dates from 1980.

13. Ms Ray says that in 1986 she established a TRIYOGA training centre in the US, and that at the date of her statement there are five such centres throughout the US. She says that training in TRIYOGA has been provided in many countries although she does not mention the UK in the list. Ms Ray does go on to give details of a UK contact that was established in 2002, who receives internet enquiries and is assisting in the organisation of a workshop in London, but this is all well after the relevant date. Exhibit 2 consists of teacher/licence certification documents, a teacher identification list, workshop advertisements and a training centre brochure, which apart from a reference to one person in England being a trained Tri Yoga teacher (but not that she was prior to the relevant date) does not relate to the UK. Exhibit 3 consists of a report from an Italian newspaper, which being outside of this jurisdiction and dating from well after the relevant date is of no assistance. Ms Ray says that she was a speaker at the 1988 and 1990 International Unity in Yoga conference, copies of the programmes being shown as exhibit 4.

14. Ms Ray states that the dominant and pre-eminent publication in the field of yoga is the Yoga Journal. She says that she has been told the journal has been circulated in the UK for many years and that the Journal has confirmed (in an e-mail dated 14 November 2002, exhibit 5) that it is published seven times each year, with the current sales in the UK amounting to approximately 3,000 copies of each issue. The exhibit also contains copies of the covers and extracts taken from various editions of the Journal. One cover referred to by Ms Ray is stated to date from 1995 and to show a cover price in pounds sterling; I have not been able to locate this part of the exhibit.

15. Ms Ray states that in addition to her yoga instruction services, the mark TRIYOGA has been used in connection with clothing, such as T-shirts, yoga mats, jewellery and instructional videos. Exhibit 6 consists of samples of advertisements relating to TRIYOGA goods and services that appeared in the Yoga Journal in 1996, 1998 and 1999. The exhibit shows TRI YOGA being used in connection with yoga instruction and a video tape on yoga.

16. Ms Ray says that she has advertised her TRIYOGA methodology and training programmes in the Journal since at least the latter part of the 1980s, and that since as early as 1989 she has featured on the cover of the Journal. She refers to having had articles and features published in this, and other unspecified publications, examples of which are shown as exhibit 7. None show that they were available in the UK.

17. Ms Ray says that international conferences on yoga are held in the US that were promoted to and attended by yoga masters, practitioners and prospective students from countries throughout the world. She makes particular reference to the Fifth International Conference of the Unity held in California in 1990, at which she appeared in connection with her TRI YOGA programme. Ms Ray says that the conference was also attended by Mr Ken Thompson, Director of the F M Alexander Technique Training Course, London. Exhibit 8 consists of a course programme which confirms that both Ms Ray and Mr Thompson were participating in the conference. Ms Ray goes on to refer to various occasions where she has been in the public eye, exhibit 9 consisting of programme documents from conferences where Ms Ray was a speaker or teacher. None appear to have taken place in the UK. Ms Ray mentions that she has served on various industry boards, including that of Unity in Yoga, which as confirmed by exhibit 10, included members from the United Kingdom.

18. Ms Ray refers to exhibits 11 and 12, which consist of a list of endorsements of TRIYOGA, none apparently from the UK, and an award presented to Ms Ray in 1991 by the Samata International Yoga and Holistic Institute. There is no indication where this institute is based, or the extent of its operation or influence.

19. Ms Ray refers to her having registered TRIYOGA as a trade mark in the US, in relation to yoga instruction services, a copy of the registration certificate being shown as exhibit 13. She goes on to refer to various applications that she has made to register TRIYOGA as a trade mark, inter alia, in the UK and OHIM. A copy of a registration certificate issued by the New Zealand trade mark office is shown as exhibit 14. Ms Ray gives details of her e-mail address, internet sites and domain name registration, exhibits 15 and 16 being extracts taken from Ms Ray's triyoga.com website.

20. Ms Ray asserts that the TRIYOGA methodology is exclusively associated with her. She goes on to refer to her becoming aware of an internet domain name registration for TRIYOGA.COM registered by the applicants. She recounts having telephoned Mr Jonathan Sattin, the named contact on the registration, informing him of her prior rights in the trade mark and trade name TRIYOGA, and demanding that he cancel the registration and cease using the name, neither of which they did. Ms Ray says that she became aware of the trade mark application by Triyoga (UK) Limited when her own application was made.

21. Ms Ray says that as a result of her filing a complaint with the National Arbitration Forum for the resolution of domain name disputes, the domain name registration for TRIYOGA.COM was transferred to her. Ms Ray makes reference to the findings of the arbitrator who is stated to have held:

The record clearly establishes Complainant Kali Ray is a very prominent and well-respected figure in the international yoga community. It is difficult for this Arbitrator to believe Respondent's contention that Respondent had no knowledge of the Complainant or her style of Yoga at the time of commencement of his business... Considering the fame and reputation of Complainant Kali Ray in the international yoga community, it is difficult to escape the conclusion that Respondent, by using the domain name, has intentionally attempted to attract, for commercial gain, internet users to its Web Site by creating a likelihood of confusion with Complainant's mark, as to the source, sponsorship, affiliation or endorsement of its Web Site or location of a product or service on its Web Site.®

A copy of the decision is shown as exhibit 16.

22. Ms Ray refers to searches that she conducted on the Internet for the term TRIYOGA, the results of two being shown as exhibit 17, which Ms Ray says mostly identify her with the name, but also include a number that relate to the applicants. This, she says is likely to cause confusion, and cause harm and damage to the integrity of her well known trade mark TRIYOGA. Exhibit 18 consists of a copy of an advertisement placed by the applicants in Yoga Journal 233, which Ms Ray says was published in December 2001.

23. The third Witness Statement comes from Jitendra Ramanlal Dave, Chief Biomedical Scientist employed in the Microbiology Department of Royal Brompton Hospital Trust.

24. Ms Dave details her experience of yoga , meditation and spiritual practices, and recounts her meeting Kali Ray of Tri Yoga in India in June 1992, and that she has subsequently recommended the Kali Ray TRI YOGA system. She states that Kali Ray is a well respected yoga practitioner, and that she associates the name TRI YOGA with her.

Applicants= evidence

25. This consists of four Witness Statements. The first is dated 27 November 2003, and comes from Robin Catto, a Director of Breathe Limited, a company that acts as an agency for yoga teachers and bodywork therapists. Mr Catto says that he has practised yoga for approximately fifteen years. He says that he is a qualified yoga teacher and that between 1997 and 1999 he studied and taught yoga in inter alia, the US.

26. Mr Catto says that he first became aware of the trade mark TRIYOGA in late 1999 when he was approached with an offer to teach at the applicants=centre, which opened in February 2000. He says that at that time he was aware neither of Kali Ray nor any other individual or firm using the trade mark TRIYOGA. He concludes saying that in the UK he associates the trade mark TRIYOGA with the applicants and no other.

27. The second Statement comes from Anna Ashby, a yoga teacher of some fourteen years. Ms Ashby says that she qualified as a yoga teacher in 1999, and between 1999 and 2002 taught in California and New York. She says that she first became aware of the trade mark TRIYOGA in early 2001 through some American friends who described it as one of the largest yoga studios in London. Ms Ashby says that in 2002 she read about it in the Yoga

Journal. She recounts having moved from the US to the UK in late 2002, to being invited to work at TRIYOGA in London, and to her beginning to teach at the centre in May 2003. Ms Ashby says that during this time she was neither aware of Kali Ray or any other individual or firm using the trade mark TRIYOGA. She concludes saying that in the UK she associates the trade mark TRIYOGA with the applicants and no other.

28. The third Statement comes from Peter Walker, a physical therapist and yoga teacher since the late 1970s. Mr Walker outlines his professional career, stating that he is currently running the International School of Developmental, Baby Massage and Movement in London. He refers to exhibit PW1, which consists of an extract from his website. Mr Walker says that although he is based in the UK, he also teaches in Japan, has students from all over the world, and has certified teachers in many countries. Exhibit PW2 consists of a further printout from Mr Walker's website listing the countries in which he has certified teachers. He gives an outline of his radio and television appearances, the publications in which he has featured in articles and the books that he has published.

29. Mr Walker says that he has taught yoga at Triyoga (UK) Limited's centre since it opened in early 2000, and has been aware of the company and its logo trade mark since late 1999. He says that at that time he was not aware of any other party using the trade mark TRIYOGA in the UK or overseas, and had never heard of Kali Ray. He concludes his Statement saying that he is not aware of any other party using the trade mark TRIYOGA in the UK or elsewhere in the EU.

30. The fourth Statement comes from Jonathan Sattin, co-founder and Managing Director of Triyoga (UK) Limited. Mr Sattin says that he has been practising yoga since 1985.

31. Mr Sattin says that the name TRIYOGA was derived from the TRI prefix of the name of a health club venture which was to be called TRIBECA, which he combined with the word YOGA. Exhibit JS1 consists of the company details for Triyoga (UK) Limited. Exhibit JS2 consists of details of the assignment of two domain names, triyoga.co.uk and triyoga.com. Mr Sattin gives details of his company, which commenced trading in February 2000, saying that it is the largest yoga centre in Europe with approximately 12,000 clients on its database and in excess of 2,000 attendees each week.

32. Mr Sattin says that his company's first contact with Kali Ray was in early 2000 when they received an e-mail from her enquiring about the nature of the business. He says that he responded by e-mail giving the information requested to which he says he received an e-mail wishing him the best of luck. Mr Sattin says that the next contact was in August 2000, when he received a complaint regarding the registration of the domain name triyoga.com. He gives an outline of the circumstances and result of the complaint, which required his company to assign the domain name to the opponent. He says that his company retains ownership of the triyoga.co.uk domain name which was not challenged.

33. Paragraphs 7 to 45 of Mr Sattin's Statement consists of submissions on the Statements filed by the opponent in her evidence in chief. Whilst I have read these I have not included them in my summary of the evidence. I will, however, take them fully into account in my decision.

34. Mr Sattin repeats that the name TRIYOGA came from the first part of the name TRIBECA, exhibit JS3 being an undated copy of the TRIBECA logo which Mr Sattin says was designed in 1998. He says that he considered TRIYOGA to be persuasive and catchy in that it suggested to potential customers that they should 'try yoga'. Exhibit JS4 consists of a copy of the original TRIYOGA logo that Mr Sattin says was first used by his company in September 1998, the version shown on the trade mark application being designed in February 1999.

35. Mr Sattin differentiates the opponent's use of TRIYOGA to identify a particular methodology with that of his company, saying that as shown by exhibit JS5, his company uses it as a trade mark to identify and promote the yoga centres, the yoga classes being indicated by other names. He refers to exhibit JS6 which consists of a list of UK publications in which the applicant's TRIYOGA centre was featured at the time of its launch, and copies of various articles. Exhibit JS7 consists of copies of features that appeared in UK newspapers between January 2000 and October 2002, Mr Sattin listing some of the statements made. Mr Sattin asserts that his company has a considerable reputation that has been enhanced by these features, and that a number of well known celebrities attend classes at his company's centre.

36. Mr Sattin gives figures for his company's expenditure on advertising for the first ten months of operation, and the years 2001 to 2003 thereafter. Exhibit JS8 consists of samples of direct marketing materials. Mr Sattin gives details of the number of classes and 'mat spaces' offered by his company between 2001 and 2003, concluding his Statement by making further submissions on the case.

Opponent's evidence in reply

37. This consists of a further Witness Statement by Kali Ray. She states that a student has discovered a brochure relating to a yoga conference that took place in North Wales in 1990. The brochure is shown as exhibit 19, and relates to an International Yoga and Health Conference held at Normal College, Bangor, North Wales in 1990, at which Ms Ray was a speaker. The biographical credit mentions her in connection with the development of TRI YOGA

38. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

39. Turning first to the ground under Section 5(4)(a). That section 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,

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.

40. The opponent contends that she would succeed in an action for passing off against the applicants should their mark be used in the United Kingdom. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* [1998] RPC 455 case set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

41. To this I add the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, and others*, [2002] RPC 19. In that case Pumfrey J said:

There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 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.

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 at 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 possibilities that passing off will occur.

42. In her evidence Ms Ray says that in 1980 she founded a new system of yoga adopting the name TRI YOGA, promoting the system to yoga students in the US. At the same time Ms Ray says she developed the TRI YOGA certification handbook, which is confirmed by exhibit 1 to her statement. Ms Ray's business expanded, and at the date of her statement operated five TRI YOGA training centres throughout the US.

43. In relation to the United Kingdom, Ms Ray relies upon having trained yoga teachers, to her having established a contact to deal with enquiries, features and advertisements that have

appeared in the Yoga Journal, and her participation in various conferences, workshops and boards.

44. Although Ms Ray may have trained a yoga teacher from the UK in the TRIYOGA system, there is no evidence that she did so prior to the relevant date. Ms Ray's UK contact who is said to receive Internet enquiries and to assist in the organisation of a workshop was not established until 2002, well after the relevant date in these proceedings.

45. The participation in yoga conferences, training workshops and boards relied upon by Ms Ray have primarily been held outside of the UK. She points out that some of the speakers and members are shown to have been from the UK. That may well be the case, but there is no evidence that those persons gained any knowledge of, or had contact with TRIYOGA. It is possible that some of the delegates were from the UK, but again there is no evidence to this effect and is no more than speculation. The single instance establishing Ms Ray having been present in the UK is the International Yoga and Health Conference that was held in Bangor, North Wales in 1990. The conference programme mentions Ms Ray's involvement with TRI YOGA, but there is none of the useful detail such as the number that were issued, or the number of people that attended. A considerable amount of time has elapsed since this conference, enough as Mr Edenborough pointed out, for it to have slipped from Ms Ray's recollection, and potentially every other attendees mind.

46. Ms Ray's most consistent potential contact with the UK consumer comes from advertisements and features that have appeared in a publication entitled Yoga Journal, which she describes as the dominant and pre-eminent publication in the field of yoga, a claim not challenged by the applicants. Ms Ray says she has been told (although not by whom) that the journal has been circulated in the UK for many years, and is published seven times each year with current UK sales amounting to approximately 3,000 copies of each issue. The details relating to the frequency of publication and current circulation have been provided in an email from the Journal, and presumably give the position as at the date of that communication, that is, November 2002. Whilst it seems unlikely that achieving this level of circulation happened overnight, the figure of 3,000 shows the position some two and a half years after the relevant date, a long enough period for it to be unsafe to infer that this reflects the position prior to the relevant date. It would have been useful to know when the Yoga Journal was first circulated in the UK. I do not know why Ms Ray is unable to be more precise about the date, or why the Journal did not say; this must be a fact at their fingertips.

47. Ms Ray states that she has been advertising TRI YOGA methodology and training programmes in the Journal since at least the latter part of the 1980s, and has exploited TRI YOGA in relation to goods, the earliest advertisement provided dating from 1996. Ms Ray also mentions that she featured on the cover as early as 1989. Exhibit 5 contains extracts taken from editions of the Journal, Ms Ray stating that the cover of the June 1995 edition bears a cover price in pounds sterling; there is no such document in the evidence before me.

48. The question of magazine use of a mark was considered in *Euromarket Designs Incorporated v Peters & Another* [2000] All ER(D) 1050. In that case Jacob J stated:

The right question, I think, is to ask whether a reasonable trader would regard the use

concerned as "in the course of trade in relation to goods" within the member state concerned. Thus if a trader from State X is trying to sell goods or services into State Y, most people would regard that as having a sufficient link with State Y to be "in the course of trade" there. But if the trader is merely carrying on business in X, and an advertisement of his slips over the border into Y, no businessman would regard that fact as meaning that he was trading in Y. This would especially be so if the advertisement were for a local business such as a shop or a local service rather than for goods. I think this conclusion follows from the fact that the Directive is concerned with what national law is to be, that it is a law governing what traders cannot do, and that it is unlikely that the Directive would set out to create conflict within the internal market. So I think Mr Miller is right. One needs to ask whether the defendant has any trade here, customers buying goods or services for consumption here. It was that sort of concept I had in mind in *800-Flowers*.@

49. The *800 Flowers* case [2000] FSR 697 also commented on use via the Internet, stating that, of itself, it does not mean that a trade mark has been used everywhere, nor constitutes evidence of an intention to use.

50. There is no evidence or even any suggestion that in placing advertisements in the Journal, Ms Ray was tendering her goods or services to potential customers in the UK. The evidence shows Ms Ray to have little knowledge of the circulation of the Journal, and I would go so far as to say I am not convinced that Ms Ray was even aware that it was being published here. I do not, therefore, see that these advertisements, or the features about Ms Ray are indicative of the mark being used in the course of trade in the UK. Setting my doubts aside, I do not consider that simply being featured or placing advertisements in a publication available in the UK is enough. In *The Athletes Foot Marketing Associates Inc. v. Cobra Sports Limited and Another* [1980] RPC 343, Walton J considered a large number of cases relating to passing off, inter alia, contrasting goodwill and reputation, from which he drew the following conclusions:

Having therefore commented upon all the cases on this point which were cited to me, unless the "hard line" alleged to have been taken by the Privy Council in the *Star Industrial* case, and by the House of Lords in the *Advocaat* case represents the law--in which case the plaintiffs' case is even more wholly unarguable than I think it to be--the position in law appears to be relatively clear. That is to say, it does not matter that the plaintiffs are not at present actually carrying on business in this country, provided that they have customers here. Equally, it is of no moment, if they have no customers here, that they have a reputation in the general sense of the word in this country. It is also of no moment that that reputation may have been brought about by advertising: this can be of no moment, unless (as it did in the *C. & A.* case) it brings in customers, when, of course, once again there is no need to rely upon it.@

51. At its highest, the most that I can say about the opponent's position in the UK is that prior to the relevant date, Ms Ray and her connection with the TRI YOGA methodology may have become known to an indeterminate number of yoga practitioners, but there is no conclusive evidence of this, and no evidence of any customers for any goods or services. It may well be that the applicants knew of Ms Ray and her involvement with TRI YOGA, but that in itself

does not establish her claim to passing-off. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millet LJ stated:

It is well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property which is protected by an action for passing off is not the plaintiff's proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant's misrepresentation.®

52. In *Hodgkinson & Corby v Wards* [1994] 1 WLR 1564, it was said:

A...there is no tort of taking a man's market or customers. Neither the market nor the customers are the plaintiff's to own. There is no tort of making use of another's goodwill as such. There is no tort of competition...®

53. Ms Ray may have had the intention of expanding her trade into the UK, and in 2002, some years after the relevant date, appears to have taken steps to do so, but as Walton J said:

I think this passage is extremely important in considering the present case, for it makes the distinction between "reputation"--gained possibly as the result of advertising, possibly merely by word of mouth--and "goodwill" which of course can hardly exist without the goods, services or provider of these acquiring a reputation, but which requires something more. Nor, of course, is that passage consistent with any suggestion that the plaintiffs' desire possibly to commence business in this country in the future would have made any difference to the outcome.®

54. The Witness Statement of Eva Maria Beck provides support to Ms Ray having a reputation, primarily in Germany, and adds nothing to the claim in relation to the UK. In her Witness Statement, Jitendra Ramanlal Dave refers to her having been introduced to Kali Ray in India in June 1992. Ms Dave states that Kali Ray is a well respected yoga practitioner, but this does not necessarily mean that is the case in the UK; she does not say. Ms Dave also says that she has known Ms Ray to participate in many parts of the world, including India, Germany and Switzerland; there is no mention of the UK. Ms Dave says that she has recommended Kali Ray TRI YOGA to many individuals, including a friend in San Jose; again no mention of the UK. Ms Dave states that she has always associated the TRI YOGA name and mark with Kali Ray, which may well be the case, but this was brought about by her contact with the name in India and not through use of the name in any trade in this jurisdiction. For this reason alone I do not consider that Ms Dave can be taken as being representative of the awareness of Ms Ray or TRIYOGA, or their likely reputation in the UK.

55. In my view the opponent's evidence provides no more than a suggestion that they may have a reputation within the UK. In *Radio Taxicabs (London) Limited v. Owner Drivers Radio Taxi Services Limited* [2001] WL 1135216, Mr John Randall Q.C., sitting as a Deputy Judge of the High Court considered a passing off claim on the basis of goodwill in the name RADIO CABS. The judge went on to find that the burden of proving reputation with the general public lay on the claimant, stating at paragraph 96 of his decision:

I consider it possible that the claimant may have built up a sufficient reputation in the

ways relied upon but I cannot conscientiously put it any higher in the Claimant's favour than that..... Thus one is left to speculate. Speculation is not enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name "Radio Taxis" lies on the claimant and I find that the claimant has not discharged it.

56. I consider this provides a fair description of the opponent's position in this case. That being so, I do not see that there can be a finding of either misrepresentation or a likelihood of damage, and the ground under Section 5(4)(a) is dismissed accordingly.

57. This leaves the ground under Section 3(6). That section reads as follows:

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

58. The opponent says that the applicants had been put on notice of her rights and reputation in TRIYOGA prior to filing the application, and in proceeding they acted in bad faith. I have already commented on the opponent's use and likely reputation in the UK.

59. Mr Sattin claims that he coined the name TRIYOGA in 1997, by combining the TRI prefix from TRIBECA, another name he had been considering for another venture, with the word YOGA, and subsequently formed and registered a company under the name TRIYOGA Limited in September 1999. In June 1999, this company registered the domain names triyoga.co.uk and triyoga.com. In December 1999, Triyoga Limited changed its name to Triyoga (UK) Limited. All of this is prior to the filing of the trade mark application.

60. Mr Sattin says that his "first contact" with Kali Ray was in early 2000. This choice of words leaves open the question of whether Mr Sattin had any previous knowledge of Ms Ray and/or her use of TRIYOGA, and the evidence provides little in the way of assistance. He says that the contact was in the form of an e-mail from Ms Ray enquiring about Mr Sattin's business. I do not know if the e-mail was sent prior to the trade mark application being made, whether it provided Mr Sattin with any details of Ms Ray's use of TRIYOGA, or made him aware that she considered the rights to the name to be hers. It would certainly appear to have been sent after the date on which Mr Sattin's company registered the domain and company names.

61. Ms Ray states that in February 2000 she became aware of the applicant's Internet domain name registration for triyoga.com, and on 22 February 2000 telephoned Mr Sattin who was named as the contact on the domain name registration and informed him of her prior rights in the trade mark and trade name triyoga. Mr Sattin makes no mention of this telephone conversation. Ms Ray states that she demanded that he cancel the registration and cease use of the name, which, given that at that time there was no trade mark application, let alone registration, can only be in respect of the domain name registration.

62. The dispute over the domain name registration erupted after the date on which the trade mark application was made. For the record I should say that although this was decided in Ms Ray's favour, the decision was made on its own facts and with considerable reliance placed on

Ms Rays trade mark registration in the US, and perceived reputation. I am required to determine the case on the evidence and facts before me. I do not consider that the decision of the National Arbitration Forum has any relevance in determining either ground in this dispute.

63. Whilst it seems probable that Ms Ray has a reputation in the US, the evidence in relation to the UK is thin to say the least and at best hints that TRIYOGA could have, but not that it was likely to have been known to the applicants prior to their making the trade mark application. There is the matter of the telephone call to Mr Sattin, but apart from Ms Ray's recollection there is no evidence of what was said or not said. The opponent may well have registered the name in various ways, and in a number of countries, but did not do so in the UK, nor have they stated that they ever intended to prior to having become aware of the applicants' use and intentions. Ms Ray may have considered that she had rights to TRIYOGA in respect of the UK, but this is a far cry from establishing this to be the case. Bad faith is not a carte blanche to enjoy trade mark rights across national boundaries. As was stated by the Hearing Officer in the *Hankook* trade mark case (0/521/01):

In considering the issue of ownership of a trade mark in a third country it is necessary to be circumspect. If any person in a third country could claim successfully that an application was made in bad faith simply because it consisted of his trade mark or was similar to his trade mark the long established geographical limitations of trade mark rights would be thrown into confusion.®

64. In the appeal against my decision in the *Smiley* logo trade mark case (BL No 0 /313/01) Mr Geoffrey Hobbs QC sitting as the Appointed Person considered the decision in relation to the ground advanced under Section 3(6), and cited with approval the following statement:

In my view the onus in such cases rests firmly with the opponents. If they are claiming that the trade mark is theirs and not the applicant's they must establish that their mark was well known, in the United Kingdom, to the point that the applicant must have known it belonged to them, or would have known through some other circumstances, for example, a trade connection.®

65. I would add that this must be the case prior to the date on which the disputed application is made, otherwise how can the applicants have made the application in bad faith? I do not consider that the opponent has come anywhere near to discharging the onus placed upon her, and the ground under Section 3(6) is accordingly dismissed.

66. The opposition having failed on all grounds, I order the opponent to pay the applicants the sum of , 2,100 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of September 2004

**Mike Foley
for the Registrar
the Comptroller-General**