

O/630/21

TRADE MARK ACT 1994

IN THE MATTER OF APPLICATION NUMBER: 3587268

BY GLOBAL TRADEMARK SERVICES LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25:



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Background

1. On 29 January 2021 Global Trade Mark Services (the applicant) applied to register the above mark for the following goods:

“Clothing, footwear and headgear”.

2. On 18 March 2021 the Intellectual Property Office (‘IPO’) issued an examination report in response to the application, informing the applicant that there was an objection under Section 3(6) of the Act which prohibits the registration of a trade mark if or to the extent that the application has been made in bad faith. The objection was raised because the mark consists of the name ‘HENRY’ a retired famous French footballer, imprinted upon a logo which is confusingly similar to that of the Arsenal F.C. badge. The applicant was informed that the objection could be overcome by gaining consent to use and register the name Henry. The applicant submitted a number of emails putting forward his case for acceptance of the mark and the submissions included in his emails are included in the following paragraph.

3. The applicant’s submissions for acceptance of the mark, submitted in correspondence both pre and post hearing are as follows:

- The IPO accepts last names as referred to in the EUIPO Common Practice Rules of 2014. This states that the names of individual persons are, in principle, distinctive, irrespective of the frequency of the name and even in the case of the most common surnames, such as Jones or García (16/09/2004, C-404/02, Nichols, EU:C:2004:538, § 26, 30), and the names of prominent persons (including heads of state) are also in principle, distinctive. The badge included in this application is significantly different to the Barcelona badge.
- The IPO has a responsibility to act impartially and not as agents or representatives of individuals or organisations.
- The EU Common Practice Rules are intended to create consistency in decision making. There is no consistency with the examination of this mark and the marks already registered.
- There is no right of publicity or a right to protect a person's image or likeness in the UK.

4. The examiner was not persuaded by the applicant's submissions to accept the mark and on 31 March 2021 Mr Dear requested a hearing.

5. On 29 April 2021 I held a hearing with Mr Dear, the hearing was held in respect of the following four marks:

3587268



3591582



3591586



3595047



All for clothing, footwear and headgear.

6. At the hearing Mr Dear was extremely upset about the objection raised in respect of bad faith, seeing it as an implication that he had in some way acted in an underhand manner which was contrary to honest business practice. He felt that the examiner had tried to confuse the issue and intimidate him. I reassured Mr Dear that

we were not accusing him of acting in an underhand way, but where the names of famous individuals are involved we may need to establish whether or not that individual has given consent for their name to be used. Well known personalities are known to endorse products and if consumers see the name of e.g. a famous footballer on clothing, as a registered trade mark, they may assume that that that particular footballer has some connection with the product, for example by endorsing the product or otherwise having consented to the use of their name.

7. At the hearing Mr Dear pointed out that he has a number of registrations which include the names of footballers and also two published marks; no objection had been raised against any of those marks. Oppositions had been raised against four of these marks, but the oppositions had been overcome. Mr Dear referred to the Common Practice Rules CP4 regarding the scope of protection of black and white marks and whether black and white marks are identical to the same mark in colour (please see Annex A). I did not consider this issue to be relevant here as the marks are filed in colour, but had they been filed in black and white the same questions would have been asked. Mr Dear pointed out that there are a number of people in the world with the surname 'Henry', not just the name of a particular football player and acceptance of the mark for registration should be the case of first come first served. In view of his earlier filed marks Mr Dear felt that he had a reasonable expectation that subsequent applications filed in the same format would be given the same treatment. I reserved my opinion at the hearing as Mr Dear asked me to look at the oppositions filed in respect of the applicant's earlier marks as he thought those decisions, and the correspondence included in those files, had some bearing on the decision regarding the marks of these applications.

8. Having looked at the earlier oppositions referred to above they did not have any relevance to the marks under consideration at the hearing as the oppositions related to Section 5 issues and not in respect of bad faith. I issued my hearing report on 5 May 2021 informing Mr Dear that I was maintaining the objection.

9. On 17 June 2021, following much correspondence Mr Dear submitted a form TM5 requesting a statement of grounds. I am now requested under section 76 of the

Trade Marks Act 1994 and rule 69 of the Trade Mark Rules 2008 (as amended) to state, in writing, the grounds for my decision and the materials used in arriving at it.

Decision

10. The relevant parts of Section 3 of the Act read as follows:

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

The relevant legal principles – section 3(6)

11. The law relevant to a finding of bad faith was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*¹⁹ (“Red Bull”) in the following terms:

“131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA [2004] ECR I-1159 at [31] and Case C-192/03 Alcon Inc v OHIM [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good

faith: see BRUTT Trade Marks [2007] RPC 19 at [29], von Rossum v Heinrich Mack Nachf. GmbH & Co KG (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and Funke Kunststoffe GmbH v Astral Property Pty Ltd (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also 'some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined': see Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367 at 379 and DAAWAT Trade Mark (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see Melly's Trade Mark Application [2008] RPC 20 at [51] and CHOOSI Trade Mark (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see Cipriani at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see Lindt v Hauswirth at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see AJIT WEEKLY Trade Mark [2006] RPC 25 at [35]-[41], GERSON Trade Mark

(Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and Campbell v Hughes [2011] RPC 21 at [36].

138. *Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in Lindt v Hauswirth:*

'41...in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 48)."

12. There is no definition of 'bad faith' in the Trade Marks Act 1994, but case law provides some guidance. In the 'Neymar' decision (General Court of the EU, case T-795/17) it was stated:

“Thus, the concept of bad faith relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices (judgment of 7 July 2016, Copernicus-Trademarks v EUIPO — Maquet (LUCEO), T-82/14, EU:T:2016:396, paragraph 28).”

13. The Neymar decision, referred to above, makes it clear that ‘bad faith’ may be assumed in the event of the lack of a proper explanation by the applicant to rebut certain known facts, which in turn led to inescapable motivations on the part of the applicant and as far as the filing of the trade mark application was concerned. In that decision the applicant rejected the objection of ‘bad faith’ by denying knowledge as to who ‘Neymar’ was. The Court however found the case for bad faith, based only on the footballing fame of the individual, of which the Court found the applicant knew in fact, and that the filing of the application was with the intention to ‘free ride’ on that fame. That, of itself, in the Court’s opinion was sufficient subjective intention or motivation to find ‘bad faith’. The Court stated that:

49 However, as is apparent from the judgment of 11 June 2009, Chocoladefabriken Lindt & Sprüngli (C-529/07, EU:C:2009:361), the existence of bad faith on the part of the applicant for registration at the time of filing the application for registration of an EU trade mark must be assessed, inter alia, in the light of his intention (judgment of 11 June 2009, Chocoladefabriken Lindt & Sprüngli, C-529/07, EU:C:2009:361, paragraphs 38 to 41). In that regard, the Court of Justice has explained that the intention of the applicant for registration at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case (judgment of 11 June 2009, Chocoladefabriken Lindt & Sprüngli, C-529/07, EU:C:2009:361, paragraph 42).

50 In the present case, it is apparent from paragraphs 24 to 31 of the contested decision that the Board of Appeal relied, inter alia, on objective factors from a portfolio of evidence consisting of press and internet articles to determine that the intervener was a very talented footballer who already had

global standing in the world of football at the relevant date. It then deduced from another objective element — namely, the fact that the applicant had filed an application for registration of the word mark IKER CASILLAS on the same day as the application for registration of the contested mark was filed — that the applicant possessed more than a little knowledge of the world of football. It is in the light of only those factors and particular circumstances of the present case that it based its finding regarding the applicant’s intention.

14. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] the Court set out tests of bad faith for applications for the registration of trade marks:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context: how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

15. Commenting on this passage from the *Gromax* decision Mr Geoffrey Hobbs Q.C., acting as the Appointed Person, stated in *DEMON ALE Trade Mark* [2000] R.P.C. 345 at page 356:

“These observations recognise that the expression “bad faith” has moral overtones which appear to make it possible for an application for registration to be rendered invalid under section 3(6) by behaviour which otherwise evokes no breach of any duty, obligation, prohibition or requirement that is legally binding upon the applicant.”

In that same decision the Appointed Person went on to say that:

“I do not think that section 3(6) requires applicants to submit to an open-ended assessment of their commercial morality. However, the observations of Lord Nicholls on the subject of dishonesty in Royal Brunei Airlines Sdn Bhd v Philip Tan [1995]2 AC 378 (PC) at page 389 do seem to me to provide strong support for the view that a finding of bad faith may be fully justified even in a case where the applicant sees nothing wrong in his own behaviour.”

Application of legal principles – section 3(6)

16. The mark in question consists of the name ‘Henry’ on a badge which is very similar to that of the badge of Arsenal FC. Mr Dear does not consider that the badges to be similar. I do not agree. From his perspective that may be the case; the relevant question for me though is how would the relevant consumer perceive the mark as a whole? Both badges are the same overall shape with a red centre and a dark blue and light brown border, and both contain the representation of a cannon. A consumer does not pause to consider the finer details in the way suggested by Mr Dear, they will simply respond to an overall impression based upon vague memory of key features of the badge. The comparison is shown below:

The badge of this application



The Arsenal football badge



17. On first impression, consumers (in my opinion the relevant consumer for these goods is the general public) are likely to see both badges as representing Arsenal football club. Thierry Henry is considered an iconic striker and one of the greatest players in the history of the Premier League. He signed for Arsenal in 1999 and became Arsenal’s all-time leading scorer and spent his final two seasons with Arsenal as club captain. There is no doubt in my mind that the mark, as a whole, references as far as the relevant consumer is concerned the well-known player Thierry Henry.

18. Having identified the famous individual that most will assume the mark refers to, I am unable to accept Mr Dear's submissions that some form of legal presumption exists whereby anyone, including those without any commercial connection, is entitled to apply to register as a trade mark that famous name, or that it is, otherwise, a case of 'first come first served'. The authorities (such as Nichols) and guidance (such as Common Practice Rules) referred to by Mr Dear were plainly not intended to prescribe that names were in all circumstances to be accepted for registration; clearly they did not concern themselves with the issue of 'bad faith', such as in these circumstances, and I will discuss these in greater length below.

19. As I have previously stated, well known personalities are known to endorse products and I consider it more than likely that anyone seeing this mark on the goods applied for would expect Thierry Henry to have endorsed or otherwise had some control over them, and in view of his fame, consumers would be encouraged to buy those goods. Mr Dear makes reference to the absence of a 'right of personality' or 'image' in the UK and whilst this is correct in terms of a specific and sui generis right, there have been a number of cases concerning a famous person's goodwill under the common law action of passing off. A trade mark registration held by someone completely unconnected to Henry himself would, in my opinion, not just free ride in relation to his reputation but potentially impede Henry's legitimate use of his own name in the course of trade or, for example, potentially link him to goods which may be of a kind or quality, for example, in respect of which Henry himself would have no wish to be associated. On the question of the goodwill which may be held by a famous person and for example only, Laddie. J. in the decision of *Irvine v Talksport Ltd* [2003] EWCA Civ 423 provided a definition of endorsement:

"When someone endorses a product or service, he tells the relevant public that he approves of the product or service, or is happy to be associated with it. In effect, he adds his name as an encouragement to members of the relevant public to buy or use the service or product."

20. If Henry has not consented to the application or endorsed the goods then I consider a bad faith objection appropriate and although I reserved my opinion at the hearing in order that I could review correspondence referred to by Mr Dear, I

maintained the objection following a review of that correspondence. That correspondence related to earlier marks of the applicant which had been opposed and was not relevant to the mark of this application. As I have said, the earlier correspondence referred to Section 5 matters and not to issues of bad faith. At the hearing I also gave Mr. Dear the opportunity to obtain consent from Henry but none has been forthcoming.

21. It is clear from the case law stated in paragraph 24 that bad faith consists of conduct falling short of acceptable commercial behaviour, even if this had not been intended or considered to be the case by the applicant. As the Appointed Person stated in the *Demon Ale* decision “*a finding of bad faith may be fully justified even in a case where the applicant sees nothing wrong in his own behaviour.*” Mr Dear may believe he acted legitimately in applying for this trade mark but I must refer to point 7 in the criteria laid out in the ‘Red Bull’ decision referred to above, i.e. does Mr Dear’s conduct fall short of the standards of acceptable commercial behaviour judged by ordinary standards of honest people. Mr Dear has not drawn our attention to any commercial link or association he has with Henry. I believe that on face value, given Henry’s fame and the goodwill that he would have, notwithstanding that he has retired from the game, most reasonable, business people would question whether standards of acceptable commercial behaviour have been breached by the filing of this application. At the very least Mr Dear, given the known facts, owed the registry a plausible explanation for his application in order to overcome the presumption.

22. I have to take into account that it would not be right to allow the applicant to take advantage of the fame and reputation of Henry and in this respect I refer to the comments in the Neymar decision referred to above in paragraph 12:

“The Board of Appeal was indeed entitled to deduct, without committing any error, from the particular circumstances of the present case that the real purpose of the commercial logic behind the applicant’s application for registration of an EU trade mark was to ‘free-ride’ on the intervener’s reputation and take advantage of that reputation”

23. In correspondence Mr. Dear stated that the acceptance of trade marks was on a first come first served basis and that he was the first to apply for the mark. However, as was made clear in the decision of *Copernicus-trademarks v EUIPO* (T-82/14) the 'first- to file' principle is qualified in the face of an objection of bad faith on the part of an applicant.

“26. The European Union trade mark registration system is based on the ‘first-to-file’ principle, laid down in Article 8(2) of Regulation No 207/2009. In accordance with that principle, a sign may be registered as a European Union trade mark only in so far as that is not precluded by an earlier mark (see Judgment of 11 July 2013 in SA.PAR. v OHIM — Salini Costruttori (GRUPPO SALINI), T-321/10, EU:T:2013:372, paragraph 17 and the case-law cited).

27. However, the application of that principle is qualified, inter alia, by Article 52(1)(b) of Regulation No 207/2009, under which, following an application to EUIPO or on the basis of a counterclaim in infringement proceedings, a European Union trade mark is to be declared invalid where the applicant was acting in bad faith when it filed the application for a trade mark (see judgment of 11 July 2013 in GRUPPO SALINI, T-321/10, EU:T:2013:372, paragraph 18 and the case-law cited).”

24. In Mr Dear's correspondence he referred to the Registry practice regarding surnames, full names and nicknames and to the acceptance of marks in colour and black and white. I will not go into detail concerning the Registry's practice in these areas as these relate to the acceptance of marks on the basis, only, of distinctiveness. That is not the issue here, the objection here is based on the issue of bad faith. A mark can be distinctive, but it can also be considered to have been made in bad faith.

25. I have found then, concerning Mr Dear's motivation behind making the application, that given the known and objective facts as regards Henry's fame, his intention was to free ride on that fame. I have also found that, in the absence of any proper and plausible explanation from Mr Dear as to why he filed the application, this, of itself, can amount to bad faith. I have also found that, in fact, Henry himself

has not consented to application or given any indication as to how he regards the filing of a trade mark application in his name. There is though, one further fact which I believe to be relevant. At the hearing, four cases were considered in total, all relating to footballers, admittedly some more famous than others. In correspondence dated 3 June 2021 Mr Dear informed me that he has hundreds of similar marks to register. This points to a pattern of behaviour, or likely behaviour which would have the capacity to further convince me that, if given free rein or carte blanche to register these marks, Mr Dear's actions could seriously impact the registration of trade marks and those relating to famous people in particular. I do not think it an exaggeration to say that there would be a serious risk of the mechanism of trade mark registration being brought into disrepute. It is well established that the registrar has the duty of being a 'gatekeeper' to the register and should do their utmost to ensure that marks are strenuously examined to ensure statutory compliance. If, as suggested by Mr Dear, he should have rights to select any famous (or even less famous) person to use as a trade mark, the consequences could be very severe. From the registrar's perspective, it is desirable, and of course depending on the marks concerned, Mr Dear will face similar objections to many of those marks. As stated in the decision of *Trump International Limited v DTTM Operations LLC* [2019] EWCH 769 (Ch):

54. Finally, as to Mr Gleissner's concerns that the Decision may prevent him, or companies which he controls, from filing trade mark applications in the future, that depends on the nature of the mark filed. If it has no connection with a third party (for example an application to register "GLEISSNER TV") then the Decision should not prevent such an application. Absent evidence to the contrary, such an application would not be made in bad faith. However, if the application is in respect of a sign which is identical or similar to a mark owned by a third party, of which there are many examples in the evidence, then he is right to be concerned. Such applications should not be made in the future, whether by Mr Gleissner or by companies which he controls.

and

85. In these circumstances, the Registrar seeks guidance from the Court as to how the IPO should deal with such applications in the future. Whilst the

decisions discussed in this judgment suggest that the IPO is applying the correct approach, the following may be of some assistance:

“(i) Where an application is made for a well-known trade mark with which the applicant has no apparent connection, this requires explanation and justification by the applicant”.

“(ii) Other instances of such applications by the applicant (or persons or companies connected to the applicant) may be admissible as similar fact evidence and may refute the explanation and justification provided by the applicant.

iii) It is necessary to distinguish between unsubstantiated allegations and established facts of direct relevance to the case before the IPO. In the present case the similar fact evidence was potentially probative and it was just to consider it;

iv) The Alexander questions provide a useful structure for considering allegations of bad faith, as shown by the Decision of the Hearing Officer in the present case. However, like the Pozzoli questions, which provide a structured approach to the issue of inventive step in relation to patents, they are not a substitute for the statute and do not have to be used in every case. Bad faith has numerous manifestations and cannot be classified comprehensively;

v) The Registrar may strike out proceedings brought for an ulterior and improper purpose as an abuse of process; and

vi) The power to strike out must be exercised with caution. However, where a prima facie case of bad faith is established, and no evidence in answer is filed on behalf of the applicant, it may well be appropriate to exercise that power.

26. Although the circumstances surrounding that decision are not exactly the same as the circumstances surrounding this mark, that decision clearly gives the registrar the authority to ask relevant questions, in an ex-parte situation as much as an inter-partes one, to ascertain if an objection under bad faith is appropriate. As stated in that decision *‘bad faith has numerous manifestations and cannot be classified*

comprehensively'. If, as Mr Dear suggests, he has many further similar applications to file, if those marks consist of the names of famous footballers for example, the registrar says this requires explanation and justification by Mr Dear and it would be necessary to consider whether consent, or some other form of legitimate approval from the person concerned, has been given to use and register the marks from the individuals in question. If such has not been provided, an objection under Section 3(6) will need to be considered, as in this case.

27. Mr Dear has referred to his earlier marks which have been accepted, pointing out that he expected equal treatment for these marks. I have to point out that each mark is examined on its own merits which is why I was able to accept the marks 'Wallace' (3591586) and 'Clark' (3591582), There are a number of football players with the names 'Wallace' and 'Clark' and therefore I did not consider those names to raise any expectations of a particular footballer on the part of the consumer . All the earlier marks contain the names of football players but it may have been thought that these footballers did not command the level of fame that Henry commands and therefore there would have been no expectation regarding endorsement on the part of the consumer. Of course, Mr Dear may contend that such an approach may give rise to the question of, what level of fame is required in relation to whether the registrar decides to intervene on a given case. This is a question of individual circumstance but certainly whatever threshold may exist, both Neymar and in this case, Henry are considered to have passed it.

28. In his submissions Mr Dear stated that there are no rights in publicity or image. I have touched on this briefly above. He is correct in that there is no specific right of publicity in English law, however it is possible for a celebrity to exploit his or her image for commercial gain or to prevent unauthorised use by applying to register a trade mark for their name, signature nickname etc. For example, David Beckham has registered his name as a trade mark for a range of goods including perfume, hair care and cosmetics and Alan Shearer has registered his image in relation to goods such as clothing, bags and sporting articles. However, had someone other than David Beckham or Alan Shearer applied for these marks it would have been necessary to determine if the applicant had the authorisation of David Beckham or Alan Shearer to apply for these marks. If the authorisation had not been given, then an objection under

bad faith would have been considered as consumers would expect those goods to have been endorsed by David Beckham or Alan Shearer.

29. Mr Dear submitted that the IPO has a responsibility to act impartially and not as agents or representatives of individuals or organisations. I have to point out that raising a bad faith objection does not mean that we are acting impartially or as a representative of any particular individual. The registrar reserves the right to intervene on the basis of bad faith, not just in an inter-partes capacity (judging between private parties) but also in an ex-parte examination which may save the parties the time and expense of engaging in an inter-partes action. In so doing the registrar is applying known facts to determine intent and seek to protect not just the famous person but also the average consumer who would be misled if Henry had not authorised the registration of the mark and had not endorsed the goods sold under that mark.

30. In correspondence Mr Dear made a number of complaints and allegations against the examiner and myself regarding the handling of the application and the objection raised. These are all refuted.

31. The registrar is aware that after the decision was taken in this case, the Court of Appeal considered bad faith in the specific context of an overbroad specification and intent to use, in the case of *SKY and others v SKYKICK [2021] EWCA Civ 1121*. The circumstances are not the same but the registrar notes that the CoA, drawing on European jurisprudence, places the notion of bad faith in the context of the registration of trade marks which may undermine both fair competition and third party interests [para 60]. In applying for this registration the registrar maintains that both limbs are satisfied notwithstanding the applicant may see nothing wrong in his actions. Fair competition may be undermined in the sense for example that Henry may be prevented from using his own name in trade based on any goodwill and his interests are also undermined in similar vein.

32. Having considered all factors I conclude that an objection of bad faith under Section 3(6) is appropriate, as without the consent of Henry I consider the application to have been made in bad faith. Mr Dear was given the opportunity to obtain consent to the use and registration of the mark from Henry but he appears to

have chosen not to do so. Having given due care and attention to all of the arguments put forward during the proceedings I must maintain the objection and refuse the application under Section 3(6).

Dated this 24th day of August 2021

Linda Smith

For the Registrar

Comptroller-General

Annex A

Common Practice Rules on marks filed in black and white

The common practice consists of three parts:

PRIORITY

Objective	<i>Is a trade mark in B&W and/or greyscale from which priority is claimed identical to the same mark in colour?</i>
Common Practice	<ul style="list-style-type: none"> • A trade mark in B&W from which priority is claimed is not identical to the same mark in colour unless the differences in colour are insignificant*. • A trade mark in greyscale from which priority is claimed is not identical to the same mark in colour or in B&W unless the differences in the colours or in the contrast of shades are insignificant*. <p>*An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon side by side examination of the marks.</p>
Provisions	Article 4(2) Paris Convention Article 29(1) CTMR

RELATIVE GROUNDS

Objective	<i>Is an earlier trade mark in B&W and/or greyscale identical to the same mark in colour?</i>
Common Practice	<ul style="list-style-type: none"> • An earlier trade mark in B&W is not identical to the same mark in colour unless the differences in colour are insignificant*. • An earlier trade mark in greyscale is not identical to the same mark in colour, or in B&W, unless the differences in the colours or in the contrast of shades are insignificant*. <p>*An insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon side by side examination of the marks.</p>
Provisions	Article 4(1) TMD Article 8(1) CTMR

GENUINE USE

Objective	<i>Is the use of a colour version of a trade mark registered in B&W/greyscale (or vice-versa) acceptable for the purpose of establishing genuine use?</i>
Common Practice	<ul style="list-style-type: none">• A change only in colour does not alter the distinctive character of the trade mark, as long as the following requirements are met:<ul style="list-style-type: none">a) the word/figurative elements coincide and are the main distinctive elements;b) the contrast of shades is respected;c) colour or combination of colours does not possess distinctive character in itself and;d) colour is not one of the main contributors to the overall distinctiveness of the mark. <p>For establishing genuine use, the principles applicable to trade marks in B&W also apply to greyscale trade marks.</p>
Provisions	Article 10(1)(a) TMD Article 15(1)(a) CTMR