

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003437824 BY VLADIMIR
LAVRENTIEV**

**AND IN THE MATTER OF OPPOSITION NO. 419530 THERETO IN THE NAME
OF AIN'T ROCK N' ROLL LIMITED**

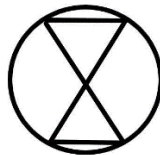
DECISION

Introduction

1. This is an appeal against the decision of Ms Stephanie Wilson, acting on behalf of the Registrar, dated 25th of January 2022 (O-065-22). In her decision the Hearing Officer dismissed the opposition under section 5(4)(a) and section 3(6) of the Trade Marks Act 1994 (*'the 1994 Act'*). Although Vladimir Lavrentiev (*'the Applicant'*) had been successful the Hearing Officer made no order as to costs against Ain't Rock N'Roll Limited (*'the Opponent'*) on the basis that the Applicant, an unrepresented party, had not filed the requisite costs pro-forma.

Background

2. On 20 October 2019 the Applicant applied to register the following mark:



The application was made with respect to the following goods and services:

Class 16	Adhesive labels.
Class 25	Clothing.
Class 36	Political fund-raising services.
Class 45	Organisation of political meetings.

(*'the Application'*).

3. On 20 February 2020 the Opponent opposed the Application. As originally put forward the Opponent relied upon section 5(4)(a), section 5(4)(b) and section 3(6) of the 1994 Act in support of its Opposition.

4. The section 5(4)(a) ground, that was originally pursued on the basis of a claim to copyright, was struck out by the Registrar on 16 September 2020.
5. With respect to the Ground of Opposition under section 5(4)(a) of the 1994 Act the Opponent relied upon an earlier unregistered right in a symbol that was described as ‘*a circled hourglass*’ (*‘the Extinction Symbol’*). It was not disputed that the Extinction Symbol was identical to the symbol the subject of the Application.
6. The Extinction Symbol was said to have been used since May 2018 throughout the UK. The goods or services which it was said the Extinction Symbol has been used for were stated in the TM7 to be as follows:

advertising signboards, badges, posters, papers, flags, clothing, advertising, publication of printed matter, advertising campaigns, transmission of news, production of films, education services relating to environmental issues, education services relating to conservation of the environment, news reporting, organisations of meetings and conferences, providing scientific information in the field of global warming and climate change, research relating to environmental protection, compilation of information relating to environmental conditions
7. On the basis of this earlier unregistered mark, it was maintained that the use of the mark the subject of the Application in relation to all the goods and services applied for could be restrained by the Opponent by means of a claim for passing off.
8. In relation to the ground of Opposition under section 3(6) of the 1994 Act it was maintained that:

[The Opponent] deem that the Applicant has applied for the mark in bad faith on the basis that they are likely to have had knowledge of the Opponent’s earlier rights. The Applicant has also applied to register its marks in classes pertinent to the Opponent and the activities it undertakes which further goes to show that the Application has been made in bad faith. The Applicant’s mark was applied for in order to take advantage of the reputation of the earlier mark. This act falls short of standard acceptable commercial behavior (sic).
9. Both sides filed evidence. The Opponent filed submissions (but no evidence) in reply to the evidence in answer filed by the Applicant.
10. Both parties filed submissions in lieu of attendance at a hearing. The Hearing Officer therefore made a decision on the basis of the written materials that were before her.

The Hearing Officer’s Decision

11. The Hearing Officer first considered the ground of opposition pursuant to section 5(4)(a) of the Act. Having set out the applicable legal principles the Hearing Officer first considered whether there was any goodwill at all.

12. As a preliminary to that analysis the Hearing Officer stated as follows:

19. There does not appear to be any dispute between the parties that the Extinction Rebellion movement is well known in the UK in the field of climate change activism. The applicant also appears to accept that the sign relied upon is associated with that movement. In his evidence, Mr Waterhouse states:

“Each one of those articles makes it very clear that the Extinction symbol is very well recognised and is very well recognised as being distinctive of the Extinction Rebellion movement.”

20. However, the goods and services relied upon in these opposition proceedings are not climate change activism; rather, the opponent relies upon the following goods and services:

Advertising signboards, badges, posters, papers, flags, clothing, advertising, publication of printed matter, advertising campaigns, transmission of news, production of films, education services relating to environmental issues, education services relating to conservation of the environment, news reporting, organisations of meetings and conferences, providing scientific information in the field of global warming and climate change, research relating to environmental protection, compilation of information relating to environmental conditions.

21. The burden is on the opponent to demonstrate that it owned the goodwill in relation to these goods and services at the relevant date.

13. The Hearing Officer having noted that *‘[t]he opponent’s evidence focuses almost entirely upon its association with the Extinction Rebellion movement’* (paragraph [22] of the Decision) proceeded to analyse the evidence filed on behalf of the Opponent to the extent that she considered necessary before going on to find as follows (emphasis as in the original and footnotes excluded):

23. In order to establish goodwill, it is necessary to demonstrate that there are customers or clients in the jurisdiction for the goods and services in question. The goods and services relied upon are such that I would expect to see information about the number of items sold or distributed, the number of customers served and/or the amount of expenditure invested in promoting the sign in relation to those goods and services. No such information has been provided by the opponent in these proceedings. There is no suggestion at all that the opponent has been involved in any way in creating or providing many of the

goods and services relied upon. For example, there is nothing before me to suggest that the opponent has been engaged in the production of “news reporting” or “production of films”. Consequently, it cannot possibly succeed in a claim to have goodwill in relation to all of the goods and services relied upon.

24. Clearly, the majority of the opponent’s evidence relates to the creation of various types of art work for the Extinction Rebellion movement. I accept that such activities could involve the creation of goods such as “posters” and “advertising signboards”. As all of the evidence, such that it is, is directed at these goods, it seems to me that this is the opponent’s best case. However, there is still no evidence before me to enable me to assess the extent of any use that has been made of the sign in relation to these goods. I note that in his evidence, Mr Waterhouse states:

“15. As to the specifics of use that is already made of the Extinction Symbol, use is already made for badges (including pin badges, embroidered badges, and magnetic badges), for bags, for flags and banners, for posters, and for clothing.

16. Where goods bearing the Extinction symbol are provided to members of the public at the moment, they are provided on a “pay what you can” basis. That will mean that in some instances goods will be given to some members of the public without the person who receives those goods themselves making a payment in return for them, but in most situations a payment will be made in return for those goods by the person receiving them. Where the goods are not paid for directly by the person receiving them, the ability to provide those goods is made possible by donations, either of money or of time, from others. For example, free provision of a bag bearing the mark of the Application can arise from the donation of time by people attending a sewing and embroidery group for the benefit of Extinction Rebellion.

17. In every case, the person who obtains the goods bearing the mark of the Application, whether or not they make a payment themselves, makes a choice to obtain those particular goods carrying the mark applied for.”

25. It is well established that a distinction must be drawn between trivial and small goodwill; even small businesses may benefit from protectable goodwill, but where any such goodwill is trivial it will not be protectable. Consequently, it is essential to be able to assess the intensity and extent of the use that has

been made of the sign in relation to the goods and services relied upon. I accept that the fact that the activities referred to by the opponent do not always attract payment is not fatal; whilst passing off claims are usually brought by businesses, charitable and other non-for-profit organisations may also seek to protect their goodwill. However, even in those circumstances, the party claiming goodwill would need to demonstrate the extent of the activities that it has undertaken, such as the number of goods distributed or the number of members subscribing to its cause. In the absence of such information, it is impossible to conclude that the opponent has established the requisite protectable goodwill.

26. In my view, the opponent has failed to establish that there was any goodwill in the goods and services relied upon at the relevant date and, therefore, the opposition based upon section 5(4)(a) falls at the first hurdle.

14. Despite concluding that the Opponent had not demonstrated that it had any goodwill in the goods and services relied upon at the relevant date the Hearing Officer nonetheless went on to consider the question of ownership of goodwill or as the Hearing Officer correctly observed whether the Opponent was the proprietor of the earlier trade mark or other earlier right for the purposes of the section 5(4) objection.
15. The Hearing Officer first identified the two questions that she was required to consider given the, apparently undisputed, evidence of Mr Waterhouse on behalf of the Opponent that the sign relied upon by the Opponent '*is distinctive of the Extinction Rebellion movement*'. First, was there any agreement in place which means that the Opponent benefits from any goodwill generated? and second who would the public perceive as being responsible for the trade?
16. In providing the answers to those questions the Hearing Officer found (emphasis as in the original and footnotes excluded):

31. In relation to the question of whether there is an agreement in place, I note the following narrative evidence provided by Mr Waterhouse:

“18. In addition to the association between the Opponent and Extinction Rebellion that is indicated by the publicly available documents referred to above and exhibited to this statement, I can state from my own knowledge that the Opponent has (and at the filing date had) the permission of Extinction Rebellion to exploit the Extinction Symbol (and the “Extinction Rebellion” name) commercially.

19. The Opponent was initially given that permission in July 2019 by Clare Farrell, Gail Bradbook, and Andrew

Medhurst, in addition to many other voices within the movement. Ms Bradbook was one of the founders of Extinction Rebellion. Ms Farrell was also a co-founder. She is included in the answer to the FAQ that I refer to at paragraph 10, above. Mr Medhurst is Extinction Rebellion's finance lead. A copy of his LinkedIn profile is at exhibit CW20.

20. As an indicator of the Opponent's role as the entity undertaking the commercial exploitation of indicators of origin associated with the Extinction Rebellion movement, I note that, with the permission of the movement, the Opponent is the legal owner of an application for a trade mark for the words "Extinction Rebellion". I attach as exhibit CW21 a copy of the detail of that trade mark application printed from the website of the UKIPO. [...]

21. As a result, I consider that the Opponent is the owner, or at least a co-owner, of the goodwill attached to the Extinction Symbol when used in connection with printed matter, badges, posters, flags, clothing, advertising, advertising campaigns, and in respect of the organisation of meetings (especially those in respect of political activism for protecting the environment). Further or alternatively, the Opponent brings this opposition with the consent and approval of the founders and organisers of the Extinction Rebellion movement, as a member of that movement itself, and in each case as a representative of the members of that movement."

32. In his evidence, the applicant challenges the opponent's claim to be the owner of the goodwill stating:

"8. The Opponent continuously and consistently claims; that the trademark belongs to the Extinction Rebellion 'movement'. Therefore it doesn't belong to The Opposition (sic) (THIS AIN'T ROCK N'ROLL LIMITED), and therefore The Opponent cannot claim opposition based on Section 5 grounds."

33. Although this challenge was made during the evidence rounds, the opponent elected not to file any evidence in reply to answer this criticism. Presumably, it would have been straightforward for the opponent to file copies of an agreement reached between itself and the Extinction Rebellion movement (as claimed) to demonstrate that it was the owner of the goodwill. Alternatively, it could have filed witness statements from the founders confirming that the consent claimed had

been given. In the absence of any evidence, and faced with a clear challenge to Mr Waterhouse's narrative evidence, I am unable to find that there was an agreement in place which conveyed goodwill upon the opponent at the relevant date.

34. In the absence of any such agreement, the goodwill will be owned by the undertaking that the public perceive as being responsible for the trade. Clearly, there has been reference made in various publications to the fact that the opponent has been engaged in the creation of artwork for the Extinction Rebellion movement. However, the fact that the opponent was engaged in creating such goods bearing the sign does not mean that it owns any goodwill in relation to those goods. For example, a design agency might be contracted to create an album cover for a music artist. The design agency, in those circumstances, would have a customer for its design services and may be said to be generating goodwill in relation to those services. However, such activities would not generate any goodwill for the design agency in relation to music albums and would not mean that the name of the artist displayed on the album cover would be distinctive of the design agency.

35. There does not appear to be any suggestion that the opponent itself has sold or distributed any of the goods it has created to customers. It is openly accepted that the opponent did not itself create the sign, but that it was created by a third party, and that the opponent then applied it to various goods for the Extinction Rebellion movement. At best, the opponent's evidence suggests that it has been engaged in the provision of design services and that the movement (or whatever legal entity is behind it) has been a customer, but there is nothing to suggest that it has itself been engaged in the provision of the goods and services relied upon or that the sign relied upon would have become distinctive of its own goodwill.

17. The Hearing Officer then went on to consider a further alternative line of argument put forward by the Opponent, both in the evidence of Mr Waterhouse and its submissions in lieu of attendance at the hearing, as to its right to bring the opposition proceedings namely that the Opponent was entitled to bring the proceedings as a representative of the members of the Extinction Rebellion movement.

18. This alternative proposition was rejected by the Hearing Officer as follows:

37. There are a number of issues with this line of argument. Firstly, it was not pleaded in the opponent's Form TM7. Secondly, in order for the opponent to be a co-owner of the goodwill it must first prove that there is goodwill for it to be a co-owner of. The same evidential flaws as set out above apply here; there is no evidence to enable me to assess the extent of

the use/trade in relation to these particular goods and services. Consequently, I am equally unable to assess whether Extinction Rebellion had a protectable goodwill in relation to these particular goods and services. Thirdly, although the opponent claims that the Extinction Rebellion movement is an unincorporated association in its written submissions in lieu, no evidence has been filed (narrative or otherwise) to support this assertion. Information has, of course, been provided regarding the identity of the founders of the Extinction Rebellion movement, but no information is provided about the structure of the movement or what an individual/entity is required to do in order to become a member. Finally, even if Extinction Rebellion is an unincorporated association, I have no evidence before me to prove that the opponent is a member. Most of the evidence refers to the opponent (or its directors) “working with” the movement, which suggests some sort of separation, rather than one being a member of the other. I note that the opponent’s directors are described as being founders of the Extinction Rebellion Art Group, but in the absence of any further information, it is not clear to me that this results in the opponent being a member in the sense required to bring this claim. The mere fact that the opponent agrees with and supports the principles and aims of Extinction Rebellion does not mean that it is a member entitled to bring a passing-off claim on its behalf. Taking all of this into account, I am not satisfied that the opponent is a co-owner of the goodwill or is entitled to bring this claim in a representative capacity and I do not consider that this line of argument assists the opponent.

19. On the basis of these findings the ground of opposition under section 5(4)(a) of the 1994 Act was dismissed.
20. With regard to the section 3(6) ground of opposition the Opponent stated in its Form TM7 as follows (emphasis as in the original):

“An Applicant who is aware of the existence of rights which might conflict with the mark it intends to register, but fails to make further enquiries, might be found to have acted in bad faith. Given the immense reputation of Extinction Rebellion the world over and its associated use of the Extinction symbol, mere knowledge of prior third party goodwill can be enough to constitute bad faith (Jules Rimet Cup Ltd v The Football Association Ltd [2007] EWHC 2376 (Ch)).

In Gromax Plasticluture Ltd v Don and Low Nonwovens Limited, some of the elements of bad faith were defined as dishonesty and dealings which fall short of standard acceptable commercial behaviour.

We deem that the Applicant has applied for the mark in bad faith on the basis that they are likely to have had knowledge of the Opponent's earlier rights. The Applicant has also applied to register its mark in classes pertinent to the Opponent and the activities it undertakes which further goes to show that the Application has been made in bad faith. The Applicant's mark was applied for in order to take advantage of the reputation of the earlier mark. This act falls short of standard acceptable commercial behavior (sic)."

21. On the basis of the way in which the Opponent put forward its case under section 3(6) the Hearing Officer made the following findings in accordance with the principles of law that she had set out in paragraphs [39] to [42] of the Decision (emphasis as in the original):

44. I accept that prior knowledge of a trade mark may amount to bad faith in some circumstances. For example, if the application is made with the intent of blocking another business' legitimate activities. However, the case law is clear that the mere fact that the applicant knew another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton*.

45. I have already found, above, that the opponent has failed to establish that it had any rights in the sign in question at the relevant date. Consequently, it cannot possibly be the case that the applicant should have known that the opponent had rights in the sign, as claimed. However, it may still be argued that the applicant should have known that a third party had rights in the sign. Nonetheless, there does not appear to be any suggestion of blocking or any other intention on the part of the applicant, which would fall short of the standards of acceptable commercial behaviour. I do not consider that the opponent has made out a prima facie case of bad faith.

46. The application based upon section 3(6) is dismissed.

The Appeal

22. By a Form TM55P dated 22 February 2022 McDaniels Law appealed the Decision on behalf of the Opponent. The Grounds of Appeal pursued at the hearing of the appeal were that the Hearing Officer was wrong to:

- (1) *'make a finding that no goodwill existed in the symbol of the [Opponent]';*
- (2) *'make a finding that it was necessary to show that goodwill existed in the goods and services listed. The [Hearing Officer] found that there was significant goodwill in the symbol of the Extinction Rebellion movement. The [Hearing Officer] should have found that the [Applicant] was attempting to*

pass itself off as being associated with the Extinction Rebellion movement and the [Opponent]. The [Hearing Officer] was wrong to make the finding that it (sic) did'; and

(3) *'to make the finding that the [Applicant] did not make the Application in bad faith. Even on the [Hearing Officer's] own decision it was accepted that the Extinction Rebellion movement has a significant reputation in the symbol. The decision that the Application was not made in bad faith is an illogical conclusion given the [Hearing Officer's] finding of fact'.*

23. At the hearing of the appeal, in my view correctly, it was submitted on behalf of the Opponent that ground (3) noted above did not arise unless grounds (1) and/or (2) were upheld.
24. No Respondent's Notice was filed.
25. At the hearing of the appeal, which took place by video link, Mr Jonathan Moss instructed by McDaniels Law appeared on behalf of the Opponent. Mr Lavrentiev, the Applicant, represented himself. Both parties also filed written submissions for the purposes of the appeal hearing.

The Standard of Review on Appeal

26. The principles with regard to the appellate function on appeals from the Registrar of Trade Marks have recently and conveniently been set out in Axogen Corporation v. Aviv Scientific Limited [2022] EWHC 95 (Ch) at [24]:

24. Although I was referred to numerous cases on the subject (including English v Emery Demibold & Struck Ltd [2002] 1 WLR 2409, REEF Trade Mark [2003] RPC 5, Fine & Country Ltd v Okotoks Ltd [2014] FSR 11, Fage UK Ltd v Chobani UK Ltd [2014] EWCA Civ 5, Shanks v Unilever Plc [2014] RPC 29, TT Education Ltd v Pie Corbett Consultancy [2017] RPC 17, Apple Inc v Arcadia Trading Limited [2017] EWHC 440 (Ch), Actavis Group PTC v ICOS Corporation [2019] UKSC 1671 and NINEPLUS O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

- i) The appeal is by way of a review, not a rehearing (see TT Education Ltd v Pie Corbett Consultancy Ltd (O/017/17) at [52(i)]);
- ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has

reached the wrong decision suffices to justify interference (NINEPLUS O/039/21 at [14]);

iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (Actavis Group at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (REEF Trade Mark [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (TT Education at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should 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. Special caution is required before overturning such decisions (TT Education at [52(iv)], REEF at [28] and Fine & Country at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (Actavis Group at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (REEF at [26], Actavis Group at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (Shanks at [28] citing the warning given by Baroness Hale in AH (Sudan) v Secretary of State for the Home Department [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see REEF at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (English at [17], Fage at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (English at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (TT Education at [52(vi)]).

27. The general principles are not in dispute and I will bear the above principles firmly in mind in considering the issues before me.

Decision

28. In summary the Opponent maintained at the hearing of the present Appeal that:

- (1) The Hearing Officer erred by failing to properly consider the nature of the Appellant's goodwill in the light of the way in which the Applicant had challenged the Opponent's goodwill in their TM8; and
- (2) Has the Hearing Officer held that the Appellant was the owner of the goodwill in the sign EXTINCTION REBELLION (of which they are the registered trade mark owner) then on her own findings, she should have held that the logo in issue also had goodwill associated with it.

29. The summary noted above largely formed the basis of the submissions made with respect to the first Ground of Appeal namely the failure by the Hearing Officer to find that there was goodwill in the Extinction Symbol.

30. With regard to the Extinction Symbol the relevant part of the TM7 stated as follows:

The Opponent, This Ain't Rock n Roll Limited, manages the interests, and own the associated branding, of the global movement Extinction Rebellion. . . .

Extinction Rebellion have used a circled hourglass as the symbol of the movement. The Extinction symbol is intended to help raise awareness of the urgent need for change in order to address this crisis. The Extinction symbol is used by protestors

across the world; it is for this reason as to why (sic) the Opponent applied for UK Trade Mark Number UK00003446061 as a means of protecting the goodwill in the Extinction Rebellion brand.

The Applicant has sought to register an identical mark to that of the Extinction symbol against the following goods and services:

Class 16 – Adhesive labels.

Class 25 – Clothing.

Class 36 – Political fund-raising services.

Class 45 – Organisation of political meetings.

The Applicant has sought to register an identical mark to that of the Opponent’s earlier mark in relation to identical and similar goods and services to those of the Opponent.

The Opponent’s logo was used in the course of trade prior to the filing date of the contested trade mark. The Opponent’s use of the mark since 2018 has generated substantial goodwill.

31. It is to be noted in connection with the TM7 that UK Trade Mark Number UK00003446061 was not relied upon as a basis for a ground of opposition in these proceedings. It is additionally to be noted that (1) this application was withdrawn on 6 March 2020 i.e., after the filing of the TM7 but prior to the filing of the evidence by the Opponent; and (2) no reference is made in the TM7 to UK Trade Mark Number UK00003446046 for the word mark EXTINCTION REBELLION that was filed on the same day as UK Trade Mark Number UK00003446061. The EXTINCTION REBELLION trade mark was first referred to in the evidence filed on behalf of the Opponent. Moreover, UK Trade Mark Number UK00003446061 was registered on 6 May 2022 after the date of the Decision the subject of the present appeal.
32. In his TM8 the Applicant responded, so far as is relevant, as follows:

I deny the grounds of opposition under Section 3(6) and Section 5(4)(a) for the reasons stated below.

The Opponent has not presented evidence of ownership for the trademark. Instead, The Opponent “This Ain’t Rock n Roll Limited” claims that it ‘manages the interests, and owns associated branding, of the global movement Extinction Rebellion’.

The claimed link between The Opponent and The Movement that they claim to represent is unclear. And no evidence has been presented for the existence of such a link.

Since a “movement” or an “idea” itself is not ‘a legal person governed by public law (as stated in The Trade Mark Regulations 2018 Provision 24, 1A) and hence such ideas cannot themselves be ‘the proprietor’.

I believe that the opponent has intentionally tried to manufacture this non-existent link to the movement to obfuscate and confuse this movement as themselves in order to mislead. And therefore; I disagree, and I deny The Opponent “This Ain’t Rock n Roll Limited” claims that based on Section 5(4)(a) Trade Mark UK00003437824 can be passed off as an existing property right.

33. On this appeal what is said with respect to the point taken on the pleadings is that whilst it appeared that there was a denial of goodwill the case put forward and which had to be answered by the Opponent by way of evidence was:
- (1) There was no evidence of ownership of the trade mark EXTINCTION REBELLION;
 - (2) There was no evidence of a link between the Opponent and the movement; and
 - (3) That as a movement is an idea, it cannot own anything.
34. With regard to the particular points (1) and (2) it is said on behalf of the Opponent that this was answered by the registered trade mark for EXTINCTION REBELLION in the name of the proprietor and/or the evidence of Mr Waterhouse. As to (3) it is said to be wrong in law.
35. I do not accept that this is an accurate reflection of the full position. As correctly stated by the Hearing Officer in paragraph [21] of her Decision in order to maintain a claim under section 5(4)(a) of the 1994 Act under the law of passing off ‘*The burden is on the opponent to demonstrate that it owned the goodwill in relation to [the goods and services identified in paragraph [20]] at the relevant date.*’
36. It seems to me that the pleaded case was sufficient to put the issue of the existence and ownership of the relevant goodwill in the Extinction Symbol. Moreover, no case was put forward in the pleadings by reference to the trade mark EXTINCTION REBELLION. In any event the issue of the goodwill and ownership of the trade mark EXTINCTION REBELLION as opposed to the Extinction Symbol was not an issue to be determined by the Hearing Officer in the present case.
37. I am fortified in my view that the Opponent was fully aware that it needed to file evidence in support of its position regarding the existence and ownership of a relevant goodwill in the Extinction Symbol by the contents of the evidence filed in support of

the Opposition and the written submissions filed in lieu of attendance at the hearing below in which it was asserted that ‘*it is the Opponent that has been granted, and which has exploited the right to use the [Extinction Symbol] commercially*’; and ‘*it is the Opponent that exploits the symbol commercially*’.

38. In the premises it does not seem to me that the Hearing Officer can be criticised in the manner in which the Opponent seeks to do, for not taking any or any sufficient account of its ownership of, at the time of the Decision an application by the Opponent to register, a trade mark for the words EXTINCTION REBELLION or any other alleged rights in the words EXTINCTION REBELLION when assessing the evidence before her.
39. Nor does it seem to me that the Hearing Officer can be criticised for, whilst noting that there was no dispute between the parties that the Extinction Rebellion movement was well known in the UK in the field of climate change activism or that the Extinction Symbol was associated with that movement (see paragraph [19] of her Decision), reaching the conclusions that she did with regards to goodwill. As Lord Neuberger explained in Starbucks (HK) Ltd v. British Sky Broadcasting Group plc [2015] UKSC 31 at paragraph [47]:

... I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. ...

Lord Neuberger then went on to say at paragraph [52]:

As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, ...

40. As to point (3) the Opponent is a limited company it clearly can own property including goodwill and trade marks. That is a different question from whether as a matter of fact it is the owner of any such property which must be established on the basis of evidence. As the Hearing Officer also correctly observed in her Decision there are other entities that can and do own property and who can bring actions for passing off such as unincorporated associations and charities see for example paragraph [25] of the Decision. However, the question of whether that entity exists and is the owner of a relevant property such that it can maintain a ground of opposition under section 5(4)(a) of the 1994 Act is a matter of evidence.
41. In the circumstances the burden was on the Opponent to prove that it was the owner of a relevant goodwill in the Extinction Symbol; and it was not for the Applicant to establish *inter alia* that the goodwill relied upon by the Opponent was owned by

someone else. In my view the Hearing Officer approached the issues that she was required to determine in the light of the pleaded issues correctly.

42. With regard to the second Ground of Appeal it was submitted on the Appeal that ‘*the Hearing Officer erred by imposing a requirement not found in law. Namely, she held that for the [Applicant] to succeed **they needed to show goodwill in the goods/services for which the [Application] is to be registered***’ (emphasis added).
43. If that in fact had been a requirement imposed by the Hearing Officer that potentially could have founded a Ground of Appeal which could be relied upon by the Opponent. However, that was not a finding that the Hearing Officer made.
44. The findings that the Hearing Officer made were all directed to whether the Opponent had established a protectable goodwill with respect to the goods and services relied upon **by the Opponent** in support of its section 5(4)(a) Ground of Opposition. Those goods and services were, as accepted on behalf of the Opponent during the course of the appeal, correctly set out by the Hearing Officer in paragraph [20] of her Decision.
45. None of those goods and services, as noted by the Hearing Officer in paragraph [20] of her Decision were climate change activism.
46. In the premises it is clear that when assessing the evidence, the Hearing Officer was considering the correct question from the correct perspective. That that was the case further confirmed by the conclusion set out in paragraph [26] of the Decision that ‘*the opponent [had] failed to establish there was any goodwill **in the goods and services relied upon** at the relevant date . . .*’ (emphasis added); and the conclusion in paragraph [35] of the Decision that ‘*At best, the opponent’s evidence suggests that it has been engaged in the provision of design services and that the movement (or whatever legal entity is behind it) has been a customer, but there is nothing to suggest that it has itself been engaged **in the provision of the goods and services relied upon** or that the sign relied upon would have become distinctive of its own goodwill.*’ (underlining as in the original, emboldened underlining emphasis added).
47. As a further over-arching point going to both the first and second Ground of Appeal the Opponent contended that the Hearing Officer had failed to assess the evidence before her correctly.
48. In circumstances where as I have already determined that the Hearing Officer adopted the correct approach as a matter of principle to the pleaded issues before her it seems to me that if the points raised by the Opponent were to be considered afresh by me then as stated by Geoffrey Hobbs QC sitting as the Appointed Person in NICO LONDON TM (O-338-20) at paragraph [36]:

. . . the Decision would end up being re-taken by this Tribunal under the guise of reviewing it for error. However, it is necessary in order to maintain the required distance between

the role of decision taker at first instance and the role of decision taker on appeal for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the [Applicant] relies are by force of what they reveal sufficient to establish that the Decision is vitiated by error.

49. I have reviewed the Decision and the evidence filed on behalf the Opponent in the light of the alternatives put forward by the Opponent.
50. In carrying out this review and in view of the criticisms made of the Hearing Officer's approach in not just assessing the evidence that was before her but commenting on the absence of certain categories of evidence, I kept in mind, by way of analogy, the observations of Geoffrey Hobbs QC with regard to the approach to the assessment of evidence of use set out in CATWALK Trade Mark (O-404-13) (emphasis added):

21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand.

As Mann J. observed in Matsushita Electric Industrial Co. v. Comptroller- General of Patents [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use

in relation to goods or services covered by the registration. **The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.** As to which see paragraphs [17] to [19] and [24] to [30] of the Decision of Mr. David Alexander QC sitting as the Appointed Person in PLYMOUTH LIFE CENTRE Trade Mark (BL O-236- 13; 28 May 2013).

51. I also kept in mind that the Opponent elected not to serve any evidence in reply to the evidence filed in answer by the Applicant which clearly challenged the factual position contended for by the Opponent.
52. Having conducted my review, I am satisfied that the conclusions the Hearing Officer reached are not ones that are vitiated by error rather they are ones that it was open to her to reach for the reasons that she gave.
53. In the circumstances grounds 1 and 2 of the appeal are dismissed.
54. Given that I have rejected grounds 1 and 2 of the appeal the third ground of appeal does not arise (as accepted on behalf of the Opponent) and I therefore say no more about it.

Conclusion

55. In the circumstances, for the reasons set out above, it does not seem to me that there is any error of principle or material error in the Hearing Officer's Decision. Moreover, it seems to me that the conclusions that the Hearing Officer reached were ones that it was open to her to reach on the basis of her evaluations of the material before her. In the result the appeal fails and is dismissed.

Costs

56. The appeal having been dismissed the Applicant is entitled to a contribution towards his costs. The Applicant has, as I understand the position, at all stages represented himself. The Applicant indicated during the hearing of this Appeal that he wished to seek an award of costs of the Appeal. Therefore, I direct pursuant to Rules 62 and 73(4) of the Trade Mark Rules 2008:
 - (1) That, if the Applicant wishes to maintain his application for an award of costs on appeal then, on or before 4pm on Thursday 22 September 2022 the Applicant should send to me by email to teamd@oeclaw.co.uk written representations in support of his request containing a schedule or statement of the items of work and expenditure to which his claim relates;

- (2) That on or before 4pm on Thursday 13 October 2022 the Opponent should send to me by email to teamd@oeclaw.co.uk any written representations that it would wish to make in response to the Applicant's schedule or statement;
 - (3) That on or before 4pm on Thursday 27 October 2022 the Applicant should send to me by email to teamd@oeclaw.co.uk any written representations he wished to make in reply to those of the Opponent under paragraph (2) above;
 - (4) Any written representations sent to me under paragraphs (1) to (3) above are at the same time to be copied to the opposite party and the UK IPO Appeals secretariat at enquiries@appointedperson.gov.uk .
57. Thereafter, unless either side have informed me in writing by 4pm on Thursday 3 November 2022 that they wish to be heard in relation to the request for an award of costs I shall proceed to deal with the matter in a supplementary decision in writing taking account of the written representations I have received.

EMMA HIMSWORTH QC

Appointed Person

1 September 2022