O-0008-24

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3632380

BY NEOX LIMITED

TO REGISTER

AS A TRADE MARK

IN CLASSES 18 & 25

AND OPPOSITION THERETO (UNDER NO. 427856)

BY

DOG ROUGH LTD

Background & Pleadings

1. Neox Limited ("the applicant") applied to register the trade mark set out on the title page of this decision on 26 April 2021. The mark was published for opposition purposes on 30 July 2021 in classes 18 and 25. Only the following goods are opposed:

Class 18: Travelling bags; umbrellas, parasols and walking sticks.
Class 25: Clothing, footwear, headgear.

2. Dog Rough Ltd ("the opponent") opposes registration under section 5(4)(a) of the Trade Marks Act ("the Act") on the grounds that use of the applicant's mark and goods would amount to passing off. The opponent relies on the following sign.

DOG ROUGH
Date of first use: 2006 **Where used:** Throughout UK **Goods & services:** clothing, bags, umbrellas, memory sticks, keyrings, water bottles, headgear, accessories, services in connection with operating a record label and organising music events.

3. The applicant filed a counterstatement denying the ground of opposition.

4. The applicant is representing itself in the person of Drew Waymont, one of its founders, and the opponent is represented by LawBriefs Ltd. Only the opponent filed evidence and written submissions. No hearing was requested and neither side filed submissions in lieu. I make this decision following a careful reading of all of the material filed.

5. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

DECISION

Section 5(4)(a)

6. Section 5(4)(a) states:

> "(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, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> >
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

7. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

8. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

9. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,[1] Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off:

[1] [1990] RPC 341, HL, page 406.

> "First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

10. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

> "Establishing a likelihood of deception generally requires the presence of two factual elements:
>
> (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
>
> (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.
>
> While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon;
(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
(c) the similarity of the mark, name etc used by the defendant to that of the claimant;
(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action".

Relevant date

11. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited,*[2] Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in SWORDERS Trade Mark:[3]

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

[2] BL O-410-11
[3] BL O-212-06

whether the position would have been any different at the later date when the application was made.'"

12. The filing date of the application is 26 April 2021. Although information was provided in the form of exhibits attached to the applicant's TM8 and counterstatement about its commercial activities prior to the filing date, the information was not correctly provided in an appropriate evidential format so cannot be taken into account in this decision, as set out in the official letter of 18 September 2022. As such, all factors in this case will be assessed as at the filing date ("the relevant date").

Opponent's evidence

13. The opponent filed a witness statement dated 28 March 2022 in the name of Nicholas Cussy, a director and shareholder, and he appended 11 exhibits. Mr Cussy states that the sign **Dog Rough** was first used in 2006 during a collaborative project and was subsequently formed into the opponent's company name, namely The Dog Rough Music Co. Ltd, and has been used as a "core identifier of goods and services"[4] since the opponent's incorporation in August 2007. Mr Cussy describes the opponent's business as "a boutique music company offering a number of audio services for the music world with the sole purpose of helping music makers create great music"[5] and he also states that the opponent sells branded clothing and merchandise at gigs and from its website.

14. Exhibit TS1 consists of several undated images. The first 2 undated images are of the sign **Dog-Rough** in use on guitar plectrums. The third undated image is of a USB memory stick where the sign shown is  , which Mr Cussy states was a logo used by the opponent up to August 2021. The words "the dog-rough" are also visible on the USB stick. The next 5 images contain various garments for the upper body, adorned with the  logo and the words "the dog-rough music co." in lower

[4] Witness Statement Nicholas Cussy, paragraph 7
[5] Witness Statement Nicholas Cussy, paragraph 5

case lettering. The first dated image[6] appears to be an Instagram social media post from 23 March 2015 posted by the handle ‘dogroughmusic’. The sign **Dog Rough** does not appear on the garments in the images. The sign shown on the garments is the  logo.

15. There are two additional images dated 2 November 2008[7] from what I presume is the Instagram social media platform (although it is not clearly apparent) in which a dog is photographed wearing a red garment emblazoned with the words ‘Jimmy Choo Dog-Rough’. The word ‘Choo’ is clearly visible being depicted in black thread, but the remaining words namely ‘Jimmy’ and ‘dog-rough’ are much less visible being depicted in what appears to be orange thread. It is not clear who posted these photographs as the header of the dog images is titled Ashby-De-La-Zouch. Nor is the context of the images apparent, i.e. if was it intended to be a promotional post for the opponent’s business.

16. Exhibit TS2 consists of a screenshot of the opponent’s website dated 27 March 2022 so is after the relevant date.

17. Exhibit TS3 consists of 9 invoices, 1 of which from Vistaprint is dated 23 June 2021 so is after the relevant date. Of the remaining 8 invoices, 4 are from Site Supply Group dated 23 July 2014, 16 September 2014, 12 and 14 January 2015. The Site Supply invoices indicate that they supplied 1 jacket, 2 shirts, 4 hooded sweatshirts, 3 polo shirts and 1 sweatshirt in total to the opponent. The invoices also indicate that this logo, namely  , was to be printed on the front of the garment and the image below to be printed on the back of the hooded sweatshirt, namely  .

[6] Exhibit TS1, page 12
[7] Exhibit TS1, pages 14-16

The letters under the  logo are illegible on the invoice . The remaining 4 invoices are from Vasile Printing and are dated 8 March 2016, 4 May 2017, 11 May 2018 and 22 April 2019. These invoices indicate that Vasile Printing supplied 100 T-shirts, 30 hoodies and 200 plectrums in total to the opponent. However the orders are described in the following way,

Description	Quantity	Unit Price	Cost
Branded T-Shirts	25	£7.95	£198.75
Branded Hoodies	5	£16.15	£80.75
Branded Guitar Plectrums	100	£0.30	£30.00

So it is not clear from the invoices what the actual goods looked like and what sign has been used as the brand. As there are undated images of guitar plectrums in exhibit TS1 which bear the sign DOG-ROUGH, I assume these are the same plectrums supplied by Vasile Printing.

18. Exhibit TS4 is stated to be evidence of confusion between the opponent and applicant's clothing goods. It consists of what appears to be an Instagram thread and whilst the time stamp gives a day and a month, eg Wed 3 Nov at 12.08, there is no apparent year so I cannot determine if this falls before or after the relevant date.

19. With regards to the remaining exhibits, Exhibit TS5 is a confirmation of when the opponent purchased its domain name in 2009. Exhibits TS6, 7 and 8 are stated to be evidence that the applicant's website was not in use according the Wayback Machine Internet Archive service and on Google as at 27 March 2022 (which is after the relevant date) when the screenshot was taken. Exhibits 9 and 10 contain details of the applicant's apparently limited social media presence. Finally Exhibit TS11 is an undated screenshot of the applicant's website showing images of garments for sale.

20. That concludes my summary of the evidence.

Goodwill

21. The first hurdle for the opponents is to show that they had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*[8] viz,

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

22. In *Smart Planet Technologies, Inc. v Rajinda Sharm*[9] Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> *".. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."*

23. After reviewing the evidence relied on to establish the existence of a protectable goodwill, Mr Mitcheson found as follows:

> "The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi's

[8] [1901] AC 217 (HOL)
[9] BL O/304/20

witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of "reCUP" ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca's Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

24. The relevant market for assessing goodwill is the UK. At the relevant date, the opponent states it had been trading in goods and services using the sign **Dog Rough** since at least 2007, although I note that the sign at issue was stated to be first used in 2006. However the opponent has provided no information on its turnover either for its music services or for selling any clothing, plectrums or USB memory sticks which are the only goods apparent in the evidence. Neither has it provided any narrative evidence as to when or where its clothing and/or other goods are sold, i.e. the gigs which Mr Cussy stated were points of sale. Moreover the opponent has not provided any additional evidence on the volume of garments or other goods sold. If all the garments provided to the opponent, from the invoice information provided, were added together and sold to customers that would still only total 141 garments which is a very low amount. The opponent provided evidence that it purchased branded clothing and plectrums prior to the relevant date but even if I assume the undated images or the dated Instagram images in Exhibit TS1 are the same clothing goods supplied by Site Supplies or Vasile Printing then the signs on the garments are as follows

 and 

Neither of these images contain the sign **Dog Rough** solus.

25. The opponent's website screenshot at Exhibit S2, dated 27 March 2022 so after the relevant date, shows the following goods for sale in pounds sterling, namely a cap, 2 bags, a USB memory stick and 2 zipped sweatshirts which all bear the words 'dog rough' and the device of a dog. However I have not been provided with any evidence indicating what goods were available for sale from the opponent's website at the relevant date and what sign was used on any such goods for sale at that date.

26. On the basis of the evidence provided, I do not find that the opponent has demonstrated any goodwill for the sign **Dog Rough** solus on clothing goods. The only goods on which **Dog Rough** appears solus are the guitar plectrums, but the image of these goods is undated and no turnover or other customer information has been provided to indicate when or where these particular goods were sold. If any goodwill has been accrued then it is likely to be in the  logo or in the words 'The Dog-Rough Music Co.' which are the only signs apparent in the evidence used on clothing and USB memory sticks prior to the relevant date and even then the lack of turnover or any other customer information makes that a difficult conclusion to draw; in any event, any goodwill in relation to these signs would be no more than trivial.

27. Taking all the following factors into account, namely that the sign **Dog Rough** is only on apparent on plectrums and is not used solus on clothing and when the words are used on clothing or on USB sticks, it is within the opponent's company name which changes its identity as a sign and as an indicator of trade origin, plus the lack of any turnover details and the apparent low volume of goods sold (using the guidance given in *Smart Planet* regarding low levels of trade and turnover as well as the size of the market in comparison to the likely impact of the opponent's trade in that market), I find that the evidence provided is insufficient to demonstrate that the opponent had acquired goodwill at the relevant date for the goods and services it claims.

Conclusion on 5(4)(a)

28. I find the opponent has not been able to establish goodwill and therefore has failed at the first hurdle. The case has not been made out under section 5(4)(a). Subject to any appeal of this decision, the application can proceed to registration.

Costs

29. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the applicant is not legally represented, the Tribunal invited it, in the official letter dated 2 June 2023, to indicate whether it wished to make a request for an award of costs. The applicant was invited to complete a costs pro-forma including a breakdown of actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition. The letter made clear to the applicant that if the pro-forma was not completed "costs may not be awarded". As the applicant did not respond to that invitation and as it has incurred no official fees in the defence of its application, I make no order as to costs.

Dated this 5th day of January 2024

June Ralph
For the Registrar
The Comptroller-General