O/0128/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003674283
BY EDEN APPARELS (PVT.) LTD
TO REGISTER THE TRADE MARK:

edenrobe

IN CLASSES 24 AND 35

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600002015
BY EDENROBE LTD

AND IN THE MATTER OF REGISTRATION NO. UK00003210185
IN THE NAME OF EDENROBE LTD FOR THE MARK:

edenrobe

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 504679 BY EDEN APPARELS (PVT.) LTD

BACKGROUND AND PLEADINGS

1. On 28 July 2021, Eden Apparels (Pvt.) Ltd ("Eden Apparels") applied to register the following trade mark under application no. 3674283 in the UK ("the 283 Mark"):

edenrobe

2. The application for the 283 Mark was published for opposition purposes on 24 September 2021 and protection is sought for the following goods and services:

Class 24 Textile fabrics for the manufacture of clothing, cotton fabric, woolen fabric, embroidered cotton fabric, linen, polyester fabric, cambric, jersey material, knitted fabric, fabric for footwear, bed sheets; quilt covers; comforters; cushion covers; hand towels; bath towels; face towels; gym towels; bath sheets; table runners of textile; table mats of textiles; coasters of textiles; Textiles and substitutes for textiles; household linen; curtains of textile or plastic.

Class 35 Retail clothing stores, online retail store services featuring clothing, namely, ready-made garments, clothing fabric, foot wear, head wear, jewelry, perfumery, cosmetics, and fashion accessories, Online advertising and marketing services in the field of clothing; business management, organization and administration; office functions.

3. On 11 November 2021, the application for the 283 Mark was opposed by Edenrobe Limited ("Edenrobe") under the fast track opposition procedure, based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 ("the Act"). Edenrobe relies upon the following trade mark:

edenrobe

UKTM no. 3210185

Filing date 1 February 2017; registration date 12 May 2017

Relying on all goods for which the mark is registered, namely:

Class 14 Jewellery.

Class 25 Clothing.

("the 185 Mark")

4. Eden Apparels filed a counterstatement denying the claims made.

5. On 9 March 2022, Eden Apparels applied to invalidate the 185 Mark pursuant to section 47 of the Act. Eden Apparels relies upon sections 5(4)(a), 5(4)(b) and 3(6) of the Act.

6. Under section 5(4)(a) of the Act, Eden Apparels relies upon the sign EDENROBE and the sign shown below which it claims to have used throughout the UK since at least 2016 in relation to "clothing, footwear and headgear" and "perfumery":

edenrobe

Eden Apparels claims that use of the 185 Mark would be contrary to the law of passing off.

7. Under section 5(4)(b) of the Act, Eden Apparels asserts that it is the owner of the following copyright work which was created by one of its directors in Pakistan in 2006:

8. Under section 3(6) of the Act, Eden Apparels claims that at the time the 185 Mark was filed, it was in discussions with Edenrobe about the possibility of a UK licence/franchise agreement, with the intention that Edenrobe would distribute Eden Apparels' goods in the UK. Eden Apparels claims that the 185 Mark was filed with the intention of misleading its customers and taking Eden Apparels' position in the market in the UK.

9. Edenrobe filed a counterstatement denying the claims made.

10. On 25 May 2022, the Registry wrote to the parties giving a preliminary view that these cases be consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008 ("the Rules") and that the fast track opposition be converted to a standard opposition pursuant to rule 4(7)(b) of the Rules. This preliminary view was made final in the Registry's letter of 6 September 2022.

11. Only Eden Apparels filed evidence. Eden Apparels is represented by Wynne-Jones IP Limited. Edenrobe was originally represented by Bailey Walsh & Co LLP but is now unrepresented. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

12. Eden Apparels filed evidence in the form of the witness statement of Muhammad Junaid Dandia dated 8 December 2022, which is accompanied by 11 exhibits (MJD1 to MJD11). Mr Dandia is a Director of Eden Apparels, a role he has held since 1988.

13. Eden Apparels also filed written submissions dated 8 December 2022.

14. I have taken the evidence and submissions into account in reaching my decision and will refer to them below, where necessary.

RELEVANCE OF EU LAW

15. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

MY APPROACH

16. As Edenrobe's ability to rely upon the 185 Mark in the opposition is dependent upon the success (or failure) of Eden Apparels' invalidity claim, I will assess the invalidation first, returning to the opposition once I have established whether the 185 Mark is valid or not.

THE INVALIDATION

17. Sections 5(4) and 3(6) of the Act have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

> "47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> (a) […]
>
> (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
>
> unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> […]
>
> (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

Section 5(4)(a)

18. Section 5(4)(a) of the Act states as follows:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, 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".

19. Subsection (4A) of section 5 of the Act 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."

20. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

The relevant date

21. Edenrobe has not filed any evidence of use. Consequently, I have only the prima facie relevant date to consider, which is the filing date for the 185 Mark i.e. 1 February 2017.

Goodwill

22. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

> "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."

23. Mr Dandia gives evidence that Eden Apparels was established in 1988. In 2006, they began trading under the name EDENROBE and created the sign relied upon to use for their business. Mr Dandia confirms that Eden Apparels sells clothing for men, women and children, as well as products such as perfume and deodorant. Mr Dandia states: “our company was founded in Pakistan and has since become well-known in Pakistani communities throughout the world including the UK”.

24. Mr Dandia has provided examples of the opponent’s website and social media pages.[1] However, there is nothing to suggest that these are targeted at the UK market. Indeed, most of the website pages show prices in “RS” which I understand to refer to rupees. However, I note that there is one page which lists the prices in GBP.

25. Mr Dandia states that Eden Apparels undertook a marketing campaign in 2016 and 2017 with English cricketer, Kevin Pietersen. This is supported by examples of posts on social media, both dated 24 December 2016.[2] No information is provided as to what the reach of this marketing campaign was in the UK.

26. Mr Dandia has provided examples of enquiries placed with Eden Apparels by customers located in the UK.[3] These include the following:

a. Messages dated 20 June 2016 in which a customer requests to place an order for clothing, but is unable to do so because of issues with the payment method.

b. Messages dated 11 November 2016 in which a customer successfully places an order for three outfits, amounting to a sale of 13,000RS. If this is a reference to the Pakistan Rupee then this would amount to approximately £36.

27. Mr Dandia has provided a Google Analytics page. He states that this shows the number of “internet users in the UK whom accessed our website and the number of transactions through our website”. No attempt is made to explain the various figures provided in the tables. However, I assume that the total revenue shown relates to

[1] Exhibit MJD01
[2] Exhibit MJD03
[3] Exhibit MJD04

revenue generated from UK customers. This is listed as over 10million PKR. No conversion to GBP has been provided. However, I understand that this amounts to around £30,000. I note that these figures relate to the period 1 January 2017 to 31 December 2019, most of which falls after the relevant date. I note that the figures for the period 1 January 2016 to 31 December 2016 records 0 UK users, but records revenue from the UK of over 350,000 PKR. It is not clear to me how there can be no users, but also revenue generated through the website. However, even if the revenue figures are accurate, I understand that this would amount to sales of only around £1,000.

28. A number of invoices have been filed addressed to customers in the UK.[4] These show sales to UK customers and display the sign relied upon. However, they are problematic for a number of reasons. Firstly, the product description is just a series of letters and numbers, meaning that it is impossible to identify to what goods these invoices relate. Secondly, there are significant discrepancies between the price for each item listed in the invoices and the invoice total. For example, one invoice lists the price of the item as PKR3,283 and confirms that the quantity ordered is only 1 unit, but lists the invoice total as PKR40,003.[5] No explanation is provided for this and so only the lower amount could be taken into account (which amounts to a total of PKR728,000 for all invoices, which I understand to be approximately £20,000). Finally, and most importantly, all of the invoices are dated 2018 and 2019. This means that they are dated after the relevant date and do not assist me in identifying whether (or to what extent) Eden Apparels had goodwill in the UK at the relevant date.

29. Eden Apparels has provided screenshots of posts on Facebook which appear to show its bridal range of clothing. These are dated December 2017 (which is after the relevant date). In any event, there is nothing in these screenshots to identify that they are aimed at the UK public, relate to an event that took place in the UK or that they would have been seen by the UK public.

[4] Exhibit MJD10
[5] Exhibit MJD10, page 85.

30. In order to establish goodwill, Eden Apparels must demonstrate that it had customers in the UK prior to the relevant date.[6] The earliest evidence of use in the UK relates to the marketing campaign which began in 2016. This is only one year prior to the relevant date. I have no information about the reach of that marketing campaign in the UK. Only two examples of enquiries made by UK customers have been provided, and only one of these resulted in a sale (of only around £36). Although the Google Analytics page shows sales of around £30,000 to UK customers, this is a very small level of sales given the size of the clothing market in the UK. Further, this relates to a period which continues well beyond the relevant date, and so only a proportion of these sales (at best) are likely to have occurred prior to the relevant date. Although there is evidence of sales relating to a period prior to the relevant date (i.e. 2016), these amounted to only around £1,000 and do not seem very reliable given that the same page also confirms that there were 0 UK users of the website during that time period. The invoice evidence filed all post-dates the relevant date.

31. The evidence before me paints a picture of a business that predominantly trades outside of the UK. Whilst there is evidence of some limited sales to UK customers prior to the relevant date, the number and value of those sales is extremely low. This is important because the law of passing off does not protect goodwill of only a trivial extent. As Mr Thomas Mitcheson QC, sitting as the Appointed Person, noted in *Smart Planet Technologies, Inc. v Rajinda Sharma*:[7]

> "…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."

32. I do not consider that the evidence demonstrates that Eden Apparels had a protectable goodwill in the UK at the relevant date. Consequently, the application for invalidation under this ground must fall at the first hurdle.

[6] *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others,* [2015] UKSC 31
[7] BL O/304/20

33. The application based upon section 5(4)(a) of the Act is dismissed.

Section 5(4)(b)

34. Section 5(4)(b) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> a) …
>
> aa)…
>
> b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright or the law relating to industrial property rights.
>
> 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".

35. Section 1 of the Copyright, Designs and Patents Act 1988 ("CDPA") provides for copyright to subsist in original artistic works. Section 4 CDPA further provides:

> "4 – Artistic works.
>
> (1) In this Part *"artistic work"* means –
>
> (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
>
> […]
>
> (2) In this Part –

[…]

"graphic work" includes –

(a) any painting, drawing, diagram, map, chart or plan […]"

36. I accept that the work identified by Eden Apparels qualifies for copyright protection as a graphic work under the above provisions. Mr Dandia's unchallenged evidence is that he created the work relied upon in 2006, during the course of his employment with Eden Apparels. As that evidence is not challenged, I accept the evidence that that is the date on which the work was created. A copy of the registration certificate for the following work has been provided, as issued by the IPO in Pakistan:[8]

The registration certificate has been provided in black and white and so it is not clear whether this is presented in the same colour as claimed in the pleadings. However, the supporting documentation filed as part of the application for registration does show the work in the form set out in the pleadings.[9] Consequently, I am satisfied that the registration certificate relates to the right relied upon.

37. Given the date on which the work was created, if it qualifies for copyright protection, the relevant date in this invalidation would fall within the scope of the copyright protection. Section 22 of the Intellectual Property Act 2014 states that section 159 of the CDPA should be read as meaning that:

"(1) Where a country is a party to the Berne Convention or a member of the World Trade Organisation, this Part, so far as it relates to literary, dramatic,

[8] Exhibit MJD06
[9] Exhibit MJD06

musical and artistic works, films and typographical arrangements of published editions –

> (a) applies in relation to a citizen or subject of that country or a person domiciled or resident there as it applies in relation to a person who is a British citizen or is domiciled or resident in the United Kingdom."

38. Pakistan is a party to the Berne Convention. It follows that the owner of the work in question has the same rights in the UK as would a British national. A British national would be entitled to protect the copyright in the work by virtue of section 154 of the CDPA. The copyright in the work is, therefore, enforceable in the UK under the CDPA.

39. As to the ownership of the work, section 11 of the CDPA states:

> "(2) Where a literary, dramatic, musical or artistic work, or a film, is made by an employee in the course of his employment, his employer is the first owner of any copyright in the work subject to any agreement to the contrary."

Mr Dandia's unchallenged evidence is that he created the work during the course of his employment and that Eden Apparels (i.e. his employer) is the owner of the work. Consequently, I am satisfied that the Eden Apparels is the owner of the right relied upon.

40. Section 17 of the CDPA states that:

> "(1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies shall be construed as follows.
>
> (2) Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form."

41. The 185 Mark is identical to the work relied upon, save for the colour; the 185 Mark is presented in black, whereas the work relied upon is presented in red. However,

given that registration of a mark in black and white covers use of that mark in any colour, I do not consider this to be a significant point of difference. The word EDENROBE is not an ordinary dictionary word, and the font used in both is identical. To my mind, this creates a prima facie case of copying.

42. Mr Dandia gives evidence that in 2017 and 2018 the parties were in negotiations regarding a potential franchise agreement. However, it is not clear whether negotiations began before or after the application for the 185 Mark was made. Nonetheless, I note that Edenrobe has filed no evidence at all to explain how they came up with the mark applied for or to put forward any narrative to counter the position as claimed by Eden Apparels. The only comment made in the counterstatement in relation to the 5(4)(b) ground (and, indeed, during the course of these proceedings) is as follows:

> "[Edenrobe] denies the registration is invalid pursuant to Section 5(4)(b) of the Act. [Edenrobe] can neither confirm nor deny that the purported work is original or satisfies the other requirements of the Copyright Designs and Patents Act 1988 and asks that [Eden Apparels] is put to strict proof of the same."

43. In the absence of any justification or explanation, I find that the 185 Mark was copied from Eden Apparels' copyright work and that it represents an unlawful reproduction of the work. It follows that use of the 185 Mark would be contrary to the CDPA.

44. The application for invalidation based upon section 5(4)(b) of the Act is successful.

Section 3(6)

45. Section 3(6) of the Act states:

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

46. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ,* Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening,* Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening),* Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening),* Case T-507/08, EU:T:2011:46. It summarised the law as follows:

> "68. The following points of relevance to this case can be gleaned from these CJEU authorities:
>
> 1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
>
> 2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].
>
> 3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacilik* at [45].

4. The concept of bad faith, so understood, 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 standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacilik* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]."

47. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

48. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

49. Eden Apparels' bad faith claim is pleaded as follows:

"The trade mark owner's registered trade mark was made with the dishonest intention to undermine, in a manner inconsistent with honest practices, the interests of the Applicant. The registered owner applied for the registered mark in 2017 and was in recorded discussion with the Applicant to seek a UK

licence/franchise to distribute EDENROBE goods in the UK around 2017/2018. In addition, representatives of the registered owner visited the Applicant's factory site during the negotiations. It was made clear to the registered owner that a franchise would not be granted unless the registration was transferred to the registered owner and/or a related party.

Further, the registered owner applied for the exact stylised Mark of the Applicant covering the Applicant's core goods under the Mark. The registered owner was clearly aware of the Applicant's Mark and use and even sought a licence/franchise. This demonstrates the registered owner applied for the registered mark with the dishonest intention of obtaining exclusive rights to the Mark so as to mislead consumers as to the origin of the Mark, causing confusion and such actions progressed in the knowledge that it would "step into the trade mark and business space" occupied by the Applicant."

50. In response, Edenrobe states:

"The Proprietor denies that the application for the registration of the mark was made in bad faith pursuant to Section 3(6) of the Trade Marks Act. The Proprietor denies their actions amount to bad faith and requests that the applicant is put to strict proof of the behaviours that they allege amount to bad faith. The Proprietor maintains their actions and behaviour was well within the accepted norms of the sector. The Proprietor also submits that the Applicant had no trade mark or business space established in the UK that they could "step into"."

51. It does not appear to be denied that Edenrobe sought a licence/franchise arrangement from Eden Apparels. The fact that this arrangement was sought out supports Eden Apparels' claim that Edenrobe was aware of Eden Apparels. However, mere knowledge of another party using a mark in a different jurisdiction is not grounds for bad faith.[10] That being said, the fact that they sought a licence/franchise from Eden Apparels at all indicates that they believed they needed authorisation to be able to

[10] *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12

trade under the mark in issue in the UK. I also bear in mind that the 185 Mark is so close to the copyright work owned by Eden Apparels that the only plausible explanation is that Edenrobe intentionally copied it and no alternative narrative has been put forward by Edenrobe. I consider that the facts as set out by Eden Apparels are sufficient to establish a prima facie case of bad faith and the statement of Edenrobe does not rebut (or sufficiently rebut) that prima facie case.

52. The application for invalidation based upon section 3(6) of the Act is successful.

THE OPPOSITION

53. The only earlier right relied upon in the opposition against the 283 Mark is the 185 Mark. As I have found the 185 Mark to be invalid for the reasons set out above, it is deemed never to have been made. Consequently, it was not an earlier right at the relevant date (i.e. the filing date of the 283 Mark). The opposition must, therefore, fall away and the 283 Mark can proceed to registration.

CONCLUSION

54. The application for invalidation against UKTM no. 3210185 is successful. Under section 47(6) of the Act, the registration is deemed never to have been made.

55. The opposition against UKTM(A) no. 3674283 is dismissed. Consequently, the application may proceed to registration.

COSTS

56. Eden Apparels has been successful in both the invalidation and the opposition. Consequently, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award Eden Apparels the sum of **£2,000**, calculated as follows:

Preparing a counterstatement in the opposition and filing a Notice of Invalidation	£600

Preparing and filing evidence and written submissions during the evidence rounds	£1,200
Official fee for the invalidation	£200
Total	**£2,000**

57. I therefore order Edenrobe Limited to pay Eden Apparels (Pvt.) Ltd the sum of £2,000. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 19th day of February 2024

S WILSON
For the Registrar