

O-0638-25

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3865957
BY PHOTO-IMAGE LTD. IN RESPECT OF THE SERIES OF TWO TRADE MARKS**



AND



IN CLASS 9

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 441893 BY
HOYA CORPORATION**

Background and pleadings

1. Photo-Image Ltd (hereafter “the applicant”) applied to register the following series of two trade marks (no. 3865957) in the UK on 9 January 2023:



(together, “the contested marks”)

2. The application was accepted and published in the Trade Marks Journal on 14 April 2023 in respect of the following list of goods:

Class 9: *Cameras; Tripods for cameras; Tripods [for cameras]; Viewfinders [for cameras]; Lenses for cameras; Cameras [photography]; Lenses for video cameras; 35mm cameras; Mirrorless cameras; Photographic cameras; Shutters [for cameras]; Cameras shutters; Cameras for vehicles; Cameras (Cinematographic -); Cinematographic cameras; Zoom lenses for cameras; Film cameras; Bags for cameras; Camera tripods; Fisheye lenses for cameras; Bellows for cameras; Bellows [for cameras]; Flash guns for cameras; Flash guns [for cameras]; Lens hoods [for cameras]; Flashlamps for cameras; Self-timers [for cameras]; Lens filters [for cameras]; Spools for cameras; Plate cameras; Slings for cameras; Camera lenses; Bags for cameras and photographic equipment; Mounting devices for cameras; Multipurpose cameras; Photographic flash units for cameras; Photographic flash units [for cameras]; View cameras; Camera monopods; Still cameras; Action cameras; Flash lamps for cameras; Flash lamps [for cameras]; Camera hoods; Shutter releases [for cameras]; Light filters for cameras; Camera shutters; Cameras for self-developing film; Film magazines for cameras; UV filters for digital cameras; Range finders for cameras; Range finders [for cameras]; Camera filters; Camera goggles; Camera flashes; Camera mounts; Tilting heads [for cameras]; Camera lens adapters; Photographic cameras for the instant production of*

pictures; Camera casings; Camera straps; Multiframe view cameras; Camera bipods; Camera lens mounts; Camera closures; Camera cases; Adapter rings for camera lenses; Protective caps for cameras; Cases adapted for cameras; Multiple purpose cameras; Camera covers; Waterproof camera cases; Camera stands; Lenses for projectors; Exposed camera film; Shutter sensors.

3. Hoya Corporation (“the opponent”) opposes the application on the basis of Section 3(6) of the Trade Marks Act 1994 (“the Act”). It argues that at the time of the filing of the contested marks, the applicant was aware of the long-standing global use of the opponent’s earlier marks and by its predecessors in title. It claims that the applicant has, nonetheless, chosen confusingly similar marks and in respect of highly similar or identical goods with the aim of taking advantage of the goodwill and high reputation enjoyed by the opponent’s earlier mark.

4. It points to the contested marks consisting of the three elements (i) the word ASAHI, (ii) the word PENTAX, and (iii) the AOCO device and that these replicate the marks of the opponent and its predecessors in title’s well known marks ASAHI and AOCO device.

5. The opponent explains that the ASAHI PENTAX mark was adopted by a Japanese company that later changed its name to Pentax Corporation and in 1957 introduced the ASAHI PENTAX camera. It asserts that the AOCO device mark dates back to 1923 and was affixed to cameras, projection lens for movies and binoculars.

6. The opponent also points out that a company called RICOH Imaging Company Ltd (hereafter “RIC”) owns the Japanese trade mark registration for the AOCO device that has been registered since 1960. The three “iconic and legacy brands” are reproduced in the contested marks and “[t]here are no plausible reasons to explain why the Applicant chose to register [such trade marks]” other than to:

- (i) intentionally acquire the contested marks with a view to selling or licensing them to the opponent who is the legitimate owner;
- (ii) have the intention to use the contested marks to create a conflict/dispute with the opponent;

- (iii) intentionally mislead the public by misappropriating the opponent's PENTAX brand and the AOCO and ASAHI brands.

7. The opponent states that it has instructed third party investigators to conduct in-depth investigations into the applicant and its listed director, Raj Pal Senna. The opponent claims that its results have shown compelling evidence that Mr Senna was/is engaged in trade mark squatting activities, citing trade mark applications made by the applicant in 2020 for "Asahi Pentax 6x7" (3519251), "Pentax 6x7 (series of 2)" (3471446) and "Pentax67" (3471446). Together, these marks are referred to as "the 2020 marks". Oppositions were filed against these marks on the basis of grounds other than bad faith but ultimately did not succeed. The opponent failed to demonstrate use of its mark or the above-mentioned marks.

8. The applicant filed a counterstatement denying the claims made. It asserts that in the last ten years neither the opponent nor RIC have used their marks and that the opposition is misconceived and totally without merit.

9. The applicant also states that it already owns the 2020 marks and, together with Mr Senna, have engaged in trade, including making camera parts and used the contested marks.

10. It is asserted that the opponent's lawyer gave an undertaking that the opponent will accept the Registry decisions in respect of the applicant's "Asahi Pentax 67" and "Asahi Pentax 6x7" marks in which the applicant was successful. Consistent with that undertaking, no appeal was lodged against the Registry's decision in that case. It is not clear how that undertaking, even if binding, has any impact upon the current proceedings and I say no more about the claim.

11. The applicant also states that the opponent is not entitled to register the mark "Pentax" because it does not make photographic cameras or lenses but, rather, it only makes medical endoscopes. This goes to the validity of the opponent's "Pentax" mark rather than the validity of the applicant's marks that are the subject of the current proceedings. Therefore, I need not consider the merits of the argument, but I keep it in mind insofar as it shines light on the motives of the applicant when applying to register the contested marks.

12. The parties both filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. A hearing took place on 26 March 2025, with the opponent represented by Sam Carter of counsel, instructed by Lewis Silkin LLP and the applicant by Mr Senna. The submissions made during the hearing have been fully considered in reaching this decision and will be referred to as and when appropriate.

13. The provision of the Act relied upon in these proceedings is assimilated law, as it is 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.

Evidence

14. The opponent's evidence takes the form of the following two witness statements:

- (i) That of Miho Ikenishi, Leader of the Corporate IP Office of the opponent, a position he has held since August 2015. His statement is accompanied by Exhibits MI1 – MI14;
- (ii) That of Liam Egan, Trade Mark Attorney at Lewis Silken, the opponent's legal representation in these proceedings. His statement is accompanied by Exhibits LE1 – LE9.

15. The applicant's evidence takes the form of the of the following witness statements, all dated 11 April 2024 by:

- (i) Raj Pal Senna, accompanied by Exhibits RPS1 – RPS29;
- (ii) Barbara Jankowska, together with Exhibits PIL1 – PIL24
- (iii) Surinder Kaur Sagoo.

16. These individuals made these witness statements in their capacity as directors of the applicant.

DECISION

Preliminary Comments

Mr Senna's behaviour

17. The conduct of these proceedings has proven to be challenging for myself and other Registry colleagues involved in the case and, I am sure, for the opponent's counsel and representatives. Mr Senna has at various times been accusational, verbally abusive and aggressive. He has explained that this is because he suffers from health and psychological issues. However, despite attempting to make allowances and to guide Mr Senna to the issues relevant to the case, the two case management conferences have both proved to be very difficult to progress in a calm orderly manner and, as a direct result of Mr Senna's behaviour, were not efficient use of the parties' or the Registry's time and resources. Further, Mr Senna has also used abusive language when referring to Registry employees.¹

18. The parties both requested a hearing but Mr Senna requested a hearing in person. This was denied because of his behaviours discussed above and the overriding need for all attendees at the hearing to be kept safe, in particular, I considered that there is increased insulation from verbal abuse or aggression when conducting the hearing via video-conference facilities. By his own admission, Mr Senna is prone to verbally aggressive outbursts. He provided a letter from his GP regarding his disability and his request for an in-person hearing. I took the contents of this letter into account but when balancing this with the impact of such behaviour at attendees of an in-person hearing, I declined Mr Senna's request for an in-person hearing. At the hearing itself, Mr Senna's behaviour was a notable improvement compared to at the CMCs. He generally controlled his anger and was clearly very heavily emotionally invested in the case. I put on record my gratitude to Mr Senna for the clear efforts he made at the hearing to control his behaviour.

¹ See for example in Mr Senna's email of 14 February 2024 and [10] of his witness statement

Decisions made at two Case Management Conferences (“CMCs”)

19. At the hearing Mr Senna expressed his desire to lodge an appeal to some decisions made at these case management conferences, and in particular:

- a. The decision to not strike out evidence relating to a spent conviction taken by the Hearing Officer at the first CMC on 7 February 2024 and confirmed at [9] of her letter of 12 February 2024;
- b. The Registry’s refusal to transfer the proceedings to the High Court;
- c. The authority of the opponent’s attorneys to act for the opponent.

20. In respect of the spent conviction, subsequent to the first CMC conducted by a colleague, the opponent voluntarily removed from its evidence all references to this and it formed no part of my considerations.

21. The annex to this decision contains copies of both of the post-CMC letters where various procedural decisions were made and explained.

Filing of post-hearing material

22. On 27 March 2025, the applicant sent information illustrating RIC have paused the production of the Pentax 17 film camera. The applicant stated that, at the hearing, the opponent “*heavily relied on Ricoh making a film camera*” and that it was “*knowingly concealed this critically important information that Ricoh has stopped everything and sacked [the inventor] for a failed project.*” An undated screenshot presumably obtained on the same date is provided showing that there are “No products found” on the page on RIC’s website titled “Explore Our Renovated Pentax Classics” and further pages confirming the applicant’s claim.

23. The opponent responded claiming that, firstly, the email and attachments do not constitute evidence and is inadmissible. Secondly, it claims that “[e]ven if the Pentax 17 camera has been withdrawn/paused, and even if at a particular moment in time no refurbished cameras are offered at the [pentax.eu website], there is plainly a real possibility film cameras might be offered, and/or that other refurbished items might be offered via that or other domains.”

24. I agree with the opponent, that the evidence is not admissible. It is not in evidential format and it is filed after the evidence rounds have been completed. Further, even if admissible, it would appear that the information implies that there was something to withdraw/pause and that RIC may have been producing film cameras or preparing to produce film cameras at the relevant date in these proceedings, namely 9 January 2023, contrary to the applicant's assertion.

The issue of cross-examination

25. Mr Senna repeatedly referred to his frustration at not being allowed to be cross-examined because there was additional evidence he wanted to give that, in his view, could only be presented as part of a question and answer situation. Mr Senna appeared to be under the impression that the opponent had made a request to cross-examine him. He also appeared to believe that he had been refused permission to cross examine the opponent's witnesses (and several other individuals who had not provided evidence). These beliefs appear to result from a mis-interpretation of the Registry letter of 10 September 2024 and its email of 12 March 2025. In paragraph 7 of the former communication, the applicant was informed that it should provide further information regarding its cross-examination request and that in the absence of this information, the Hearing Officer was unable to consider the request. No further information about the request was forthcoming. In the latter communication, the Registry stated "[f]or clarification, no cross-examination is scheduled, and it is not correct to state that the opponent wishes to cross examine [Mr Senna]. No such request has been made." Consequently, the applicant was only refused permission in respect of the individuals who were not witnesses in the case. In respect of the request to cross-examine the opponent's witnesses, no cogent reasons were provided despite being given an opportunity to provide them.

Legislation

26. 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."

27. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (Lindt, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition 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 consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (Lindt, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([*Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a bona fide intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

28. The essence of a bad faith objection is that applicant’s intended conduct is a departure from accepted principles of ethical behaviour or honest commercial practices. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already

referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 [...]."

29. 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?

30. It is necessary to ascertain what the applicant knew at the relevant date (9 January 2023) and it is not enough to establish facts which are as consistent with good faith as bad faith: *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).

Discussion and findings

31. I keep in mind that an allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. the balance of probability).

32. I consider the following of the opponent's evidence as being relevant to the issue before me:

- The Asahi Pentax series of cameras was introduced in 1957 with more than 2 million units sold worldwide by 1969;²
- The popularity of these cameras is confirmed by the number of PENTAX camera collectors and photography enthusiasts worldwide.³ A Facebook fan page is referenced that was started in 2007. A screenshot dated "2024/01/15", shows that the page is called "Asahi Pentax 67", and is a public group with 15.1k members. A photograph featuring three cameras is at the top of the page. One is branded Asahi Pentax and another is clearly branded PENTAX. The body of the third camera does not display any brand but the words ASAHI and PENTAX are visible on the outer edge of the camera lens;⁴
- Screengrabs, obtained on 12/12/2023, of YouTube videos featuring ASAHI PENTAX cameras are provided.⁵ They appear to be uploaded by various third-party individuals and one uploaded by "PentaxTips". They variously have

² Mr Ikenishi's witness statement ("WS1") at second paragraph, page 2

³ Ditto

⁴ Ditto and Exhibit MI6

⁵ At Exhibit MI7

subscriber numbers of between 3.83k to 227k subscribers. These include product specific videos relating to:

- a Pentax K-1000 35mm Film Camera that has both the Asahi and Pentax marks appearing on the camera;
 - a Pentax K1000 (1976) featuring in a video titled “History of Pentax (1919 – 2022)”. The camera has the Asahi and Pentax marks prominently visible;
 - a Pentax K1000 described as “Best Intro to Shooting Film” with the marks ASAHI and PENTAX visible on the body of the camera;
 - a Pentax 6x7 camera with ASAHI and PENTAX visible on the body of the camera;
 - loading and unloading film to an Asahi Pentax Spotmatic camera and a second video being a video manual for the same camera;
- Various models of camera, most of them having the marks ASAHI and PENTAX on the body of the camera, dating from as far back as the 1950s are shown in screenshots obtained from undated English language archive pages of the RIC Japanese website;⁶
 - A design study model was exhibited in June 2007, but never sold to the public, to celebrate the 50th anniversary of the launch of the ASAHI PENTAX camera. A screenshot from the German digital camera museum is provided showing this “Pentax AP 50th DSLR camera” is provided;⁷
 - ASAHI PENTAX cameras have, since their launch, enjoyed a global reputation as iconic cameras as illustrated by:

⁶ Exhibit MI8

⁷ Exhibit MI9 and obtained from www.ditalkameramuseum.de/en/prototypes-rarities/item/pentax-ap-50th

- featuring in the global press, including being the preferred cameras of The Beatles;⁸
 - a historical book, first published in 1966, titled “The Asahi Pentax Way” about the ASAHI PENTAX cameras;⁹
 - three example user manuals or guides about ASAHI PENTAX cameras published in 1991 (and in respect of “Asahi Pentax and Pentax SLR 35 mm Cameras, 1952-89), the 17th edition of an “Asahi Pentax Guide” published in 1975 and “The Ultimate Asahi Pentax Mount Guide, 1952 – 1977” published in 1999;¹⁰
- Vintage ASAHI PENTAX cameras are the subject of discussion on online photography forums at the “present time” (the witness statement is dated 18 January 2024). Screen shots showing two different discussions of these cameras are provided from the Pentax User Forum on the website pentaxuser.com, The third is a discussion on “PentaxForums.com” from July 2023 discussing the ASAHI PENTAX S camera;¹¹
 - Despite no longer being in production, there exists a UK market of sellers and buyers of replacement parts for ASAHI PENTAX cameras as well as dedicated online websites which offer repair services.¹²

33. I take from this evidence that the ASAHI PENTAX brand has been used in respect of globally respected cameras since the late 1950s. These cameras are no longer in production but there are third-party buyers and sellers of replacement parts for these cameras and third parties, of which the applicant is one, that offers repair services in respect of these cameras.

⁸ WS1, last paragraph, page 2 and Exhibit MI10 consisting of a 2023 online article discussing how the association with The Beatles helped to popularise the 35mm SLR camera and Pentax cameras in the early 1960s.

⁹ Ditto and Exhibit 11

¹⁰ Ditto and screenshots provided at Exhibit MI12

¹¹ Ditto and Exhibit MI13

¹² Ditto and Exhibit MI14. Also, evidence of other third-party sellers of refurbished ASAHI PENTAX providers in the UK is provided at WS4, para 11 and Exhibit LE8. The screenshots were obtained on “21/07/2024”; that post-dates the relevant date by approximately 18 months, but I consider it likely that this would have reflected the position at the relevant date because the refurbishment of such vintage cameras is likely to have been in existence for many years before the relevant date.

34. The opponent also provided evidence that the applicant is a non-trading entity that was incorporated in 2003, has submitted dormant financial accounts and does not appear to have any active trading presence or history. It has one named director, being Mr Senna who was appointed in September 2019.¹³

35. The investigation report (see footnote 13) discloses that on the LinkedIn networking website, Mr Senna is a “Photography specialist deploying film and digital, ranging from 35mm, medium format and large format [and an] ambassador of Pentax 6x7...”. However, the investigation found no evidence that Mr Senna had ever worked for, or been associated with, Asahi Optical Limited, its affiliates or subsidiaries.

36. According to an investigation report commissioned by the opponent, Mr Senna has previously been involved in a domain name dispute concerning the fashion brand HERMES where he registered a domain name containing the HERMES trade mark without consent. The WIPO Administrative Panel ruled that the domain name www.hermes-sellier.com was registered in bad faith. The Panel noted that in a previous WIPO case HERMES had “a global reputation” and that Mr Senna “perfectly knew of, and targeted [the complainant] and its HERMES marks at the time of registering the disputed domain name.”¹⁴

37. Mr Egan draws attention to Mr Senna or one of his affiliated entities having applied to register or registered a number of trade marks that use the sign “Pentax” or “Mamiya” or “Asahi Pentax”. Mr Egan explains that MAMIYA is a brand belonging to another Japanese company that manufactures high-end cameras.¹⁵ The opponent’s oppositions to UK trade marks 3519251 “Asahi Pentax 6x7”, 3471446 “Pentax 6x7” (series of 2), and 3471477 “Pentax67” failed but were based upon grounds other than bad faith.¹⁶

38. I consider the evidence and arguments of the parties in the context of the three key questions suggested in *Alexander Trade Mark*:

¹³ Mr Egan’s witness statement (hereafter “WS2”), Exhibit LE1 (an investigation report into Mr Senna, commissioned on behalf of the opponent) and pages 25 – 29 of Exhibit LE2 (information from the Companies Register about the applicant)

¹⁴ WS2, para 33 and Exhibit LE12 (see finding “C” of the WIPO ruling)

¹⁵ WS2, para 37 and Exhibit LE15

¹⁶ WS2, para 34 and 35

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

39. The applicant has been accused of:

- (i) Intentionally acquiring the contested marks with a view to selling or licensing them to the opponent;
- (ii) Having the intention to use the contested marks to create a conflict/dispute with the opponent, and;
- (iv) Intentionally misleading the public by misappropriating the opponent's PENTAX brand and the AOCO and ASAHI brands.

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

40. All three objectives, if made out, are purposes for which the contested marks could be considered as not being properly filed.

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

41. At this point, I consider the salient aspects of the applicant's evidence to inform me of its intentions when applying to register the contested marks.

42. Mr Senna's relevant evidence can be summarised as follows:

- He/the applicant rebuilds old film cameras including Mamiya, Asahi Pentax and Rolleiflex and he indicates that he can build these from scratch and make all the necessary parts to do so.¹⁷ He claims to "have put together a formidable team to re-engineer the essential components and parts that fail because of [the decisions] of original equipment manufacturers ..."¹⁸
- Mr Senna accuses the opponent and RIC of abandoning film cameras made by Pentax Asahi Optical Co (later Pentax Corporation) stating that "neither has

¹⁷ Mr Senna's witness statement (hereafter "WS3") at para 23

¹⁸ Ditto, at para 27

lifted a finger to help the legions of fans and customers around the world who over the past 70 years bought film cameras from ... Asahi Pentax...”¹⁹

- He observes that the original manufacturers went out of business in their attempts to migrate to digital cameras at the beginning of the century.²⁰
- He expresses the view that the world’s biggest manufacturers such as Hoya and RIC as well as Nikon, Canon, Sony and Fuji have all abandoned film cameras in favour of “digital” and they have failed to offer support to the millions of users of film cameras around the world.²¹
- Mr Senna claims Hoya and RIC have nothing to do with the original equipment manufacturers Asahi Optical or Pentax Corporation who have no right to pass off themselves as such.²² Further, it is claimed that they have no right whatsoever to any trade marks in connection to film cameras and their renewal of Pentax trade marks are not bona fide.²³ Mr Senna also complains of what he perceives as an absence of checks on trade mark renewals and no protocols in place to prevent “evergreening”, the implication being that he considers that the opponent undertakes such activities.²⁴
- An announcement, on the Reuters website and dated 9 August 2007, that the opponent is to buy Pentax for \$860 million;²⁵
- The applicant’s own evidence includes prints of RiceHigh’s Pentax Blog.²⁶ The blog describes itself as “the most popular and fastest updated unofficial and non-affiliated online Pentax resource”. This blog includes a post, dated 20 September 2008, announcing that “Hoya Closing Pentax Production Facilities in Japan”. It states that production of cameras, lenses and other camera

¹⁹ Ditto, at para 28

²⁰ Ditto, at para 29

²¹ Ditto, at paras 30 and 31

²² Ditto, at para 37

²³ Ditto, para 41. The opponent, RIC or affiliate companies have very many trade mark registrations around the world as shown at Exhibit M15 of Mr Ikenishi’s witness statement and includes 9 UK registrations for PENTAX in the name of the opponent, 3 of which include goods and/or services included in the contested application.

²⁴ Ditto, at para 45

²⁵ Ditto

²⁶ At Exhibit RPS12

accessories/peripherals is being moved to factories “at Vietnam and Philippines”. This would lend support to the opponent having control, at that time, of the Pentax brand in respect of cameras;

- A joint press release from the opponent and RIC, dated 1 July 2011, announcing that RIC was acquiring the “PENTAX Imaging Systems Business” from the opponent. It states that RIC will use the PENTAX brand name for some of its digital camera products and that the opponent will “continue to use the brand name for their endoscopes and other products”. This sale is also reported on the Australian website www.photoreview.com.au;²⁷
- In response to the opponent’s claim that the applicant is not trading, Mr Senna explains that it is a non-trading company holding assets such as trade marks, domain names, equipment etc.²⁸ In light of this explanation, it is not necessary that I comment on this issue;
- An undated article on the website amateurphotographer.com titled “Pentax UK speaks out on sale to Ricoh (update)” and recounts the 2011 purchase of the Pentax imaging systems business by RIC and the article records the positive comments of the General Manager of Pentax Imaging Systems UK;²⁹
- A copy of the Wikipedia entry for “Pentax”, obtained on 23 January 2024, is provided that sets out the corporate history. Under the heading “Asahi Pentax trade mark and domain name”, the following text appears:

“The brand “Asahi Pentax”, the brand “Asahi Pentax 6x7” and the brand “Pentax 67” were revived in the UK in 2020. In the period 4 Aug 2020 and 9 January 2023, the trade mark “Asahi Pentax” was taken over by [the applicant] in the UK, spearheaded by S. Santini, an ex employee of Asahi Optical Co. This was followed by acquisition of the domain asahipentax.com, completing the takeover of the brand. Additionally in the same period, the trade marks “Asahi Pentax 6x7” and Pentax 67” were similarly acquired by [the applicant].”

²⁷ Ditto

²⁸ Ditto

²⁹ Ditto

43. Ms Jankowska repeats many of the same points, but in addition, the following is of relevance to my considerations because they cast light on the beliefs of the applicant at the relevant date. She states that:

- the opponent and RIC “have no connection whatsoever with the OEM Asahi Optical Co or Pentax Corporation, and have no right to pass off themselves as the OEM Asahi Optical Co or Pentax Corporation.”³⁰
- “It is a fraud on the public to for [the opponent and RIC] to make any claim that Asahi Optical Co or Pentax Corporation somehow exist within [the opponent or RIC].”³¹, and
- [the opponent and RIC] do not have any monopoly over the names Asahi Optical Co, Pentax Corporation, Asahi Pentax or the “AOCO” logo”³²
- It is her belief that the opponent and RIC have no right to any trade marks in connection to film cameras and considers their renewal, transfer and assignments to be “fraudulent”.³³

44. Mr Sagoo also repeats many of the points made by Mr Senna and, insofar as the evidence relevance to the single issue, namely, whether the act of filing the contested marks amounts to an action that is considered to be bad faith, there is nothing further in his evidence that I need to refer to here.

45. The opponent’s evidence (see final bullet point of paragraph 32, above and footnote 12) confirms that ASAHI PENTAX cameras are no longer in production, but this is not quite the same as Mr Senna’s claim that PENTAX, ASAHI PENTAX and the AOCO logo are “defunct brands”. The opponent submits that these marks retain goodwill in the UK as legacy brands which continue to be associated with modern PENTAX cameras, camera lenses and parts thereof. Further, as recorded owner of the historical PENTAX brand it would be entitled to restart production using the name and, despite its own evidence that ASAHI PENTAX cameras are no longer in production, the opponent’s evidence in reply attempts to demonstrate that PENTAX

³⁰ Ms Jankowska’s witness statement at para. 29

³¹ Ditto, para. 30

³² Ditto, para. 31

³³ Ditto, para 67 and para 69

cameras are still available for sale in the UK. Evidence of some relevance to the issue is:

- A printout from www.amazon.co.uk, dated 10 December 2020 (i.e. over 2 years before the relevant date in these proceedings) showing three different PENTAX branded digital cameras offered for sale on a UK facing online retail site and these are priced in pound sterling;³⁴
- A further printout from 19 July 2024 (which is after the relevant date in these proceedings) from the PENTAX store on www.amazon.co.uk showing PENTAX branded digital cameras and film cameras being offered for sale in the UK.³⁵

46. Before turning to the applicant's objectives when filing the contested application, I comment briefly on the applicant's claim that it is not permissible to lift the "corporate veil" and look at the motives of Mr Senna as, what the opponent claims, the controlling mind of the applicant. It is not necessary that I consider this point fully because my findings apply to the applicant regardless of Mr Senna's role. That said, I will comment very briefly on the point. The applicant relies upon a number of criminal law authorities that I consider to be of little assistance. This is not a case where a party is seeking access to the assets of a director that should be properly accessible in an action against the company for which the person is a director. The opponent is merely asserting that the actions of the applicant are influenced by Mr Senna in a capacity as the controlling mind behind the applicant company. Putting aside the applicant's counter claim that Mr Senna is not the controlling mind, the opponent's claim is not an attempt to make Mr Senna personally liable, but rather an attempt to shed light on the motives of the applicant company by reference to one of its directors. A director may still be protected from personal liability (the purpose of a corporate veil) in circumstances where the motives of that director are relevant in assessing bad faith in civil proceedings such as these. In the current case there is no attempt to make Mr Senna personally responsible nor is there an attempt to obtain costs from Mr Senna's personal assets. It would be perverse if the concept of "corporate veil" could be used to obstruct proper and correct findings regarding how a company acts when such acts

³⁴ Mr Egan's second witness statement ("WS4"), para. 6 and Exhibit LE1

³⁵ WS4, para 7 and Exhibit LE2

are the result of the motives of one of its directors. Therefore, there is no lifting of the “corporate veil” in the sense of its meaning in criminal proceedings, but the motives of Mr Senna may be relevant in my considerations here.

47. It is submitted by the applicant that the opponent has abandoned its film camera customers. It is implicit in this submission that the applicant knew of the opponent and of its brands. Whilst I recognise that mere knowledge of the fact that another undertaking has adopted and is using a mark in another jurisdiction does not automatically form a basis for a bad faith objection, it is one of a number of factors that casts light on the beliefs of the applicant at the time of applying to register the contested marks. The applicant considers that the leading players in the camera industry (including the opponent) had abandoned the customers of film cameras and the applicant’s business model appears to be an attempt to fill the perceived void left by the original manufacturers in providing support, repair and refurbishment of specific film cameras. Whilst this explains the applicant’s business model, these proceedings require that I assess whether the attempt to register the contested marks amounts to bad faith.

48. This belief is combined with an allegation that the opponent is “evergreening” its trade mark registrations. “Evergreening” is the term used to describe the practice of re-filing marks when an earlier, identical, trade mark registration approaches the end of the five years period where it is sheltered from challenges based upon non-use. There is nothing before me that proves this and I am not aware that any challenges to the opponent’s registrations have been made on this basis. However, the allegation is relevant because it illustrates the disenchantment that the applicant feels for the opponent’s activities and can cast light upon the motives for attempting to register the contested marks.

49. The opponent asserts that all three elements that make up the contested marks all continue to have a residual goodwill in the UK that stems from the popular cameras sold in the UK up to the early 1990s. In order to understand the motives of the applicant, it is not necessary that I determine what the extent is of any residual goodwill or reputation generated by these historical activities. This is because the applicant’s business model is founded upon the existence of residual goodwill or reputation in the ASAHI PENTAX film cameras. These cameras are the subject of its repair, rebuilding

or refurbishing services. I note that the applicant also manufactures parts for such cameras in order to repair, refurbish or enhance original ASAHI PENTAX cameras. If there was no residual goodwill or reputation in the PENTAX ASAHI brands, the applicant's business would not exist. The customer base of the applicant's business exists solely because of a desire of the owners of such cameras to maintain, what appears to be, a highly considered historical film camera brand. The applicant's business model supports the opponent's claim that there is a valuable residual goodwill attached to these brands and supports the opponent's evidence to that effect.

50. Insofar as there appears (to the applicant) to be tension between such a finding and the findings in Registry decision BL O/809/22 PENTAX 6x7 (and two other marks), this can be easily dismissed. In the earlier proceedings, the current opponent failed to demonstrate genuine use of its PENTAX marks for periods between March 2015 and March 2020. These periods post-date the historical activities relating to the AOCO/ASAHI/PENTAX brands by fifteen years or more. Consequently, any perceived tension does not exist between my view that there exists a valuable residual goodwill or reputation arising from historical use during the second half of the last century and that of the hearing officer in the earlier case where genuine use in a more recent five year period was being considered. The test for genuine use is different to that for establishing goodwill or reputation.

51. I now return to the allegations against the applicant. I will consider these in the following order:

Intentionally misleading the public by misappropriating the opponent's PENTAX brand and the AOCO and ASAHI brands

52. In the applicant's evidence there are various references to the opponent's involvement in the AOCO/ASAHI/PENTAX brands as being fraudulent and that the original manufacturers went out of business in their attempt to migrate to digital cameras at the beginning of the century.³⁶ However, the applicant's own evidence shows that, at least as recently as 2011, the opponent was actively involved in the brand as it was reported in the specialist photography press that it had sold the PENTAX brand to RIC who intended to continue to use the name in respect of digital

³⁶ WS3 at para. 29

cameras. This is nothing in the evidence to suggest there has been a further change of ownership of the brand.

53. The opinion of the applicant that the brand has abandoned its film camera customers may or may not be an accurate characterisation, but that reason alone does not permit the applicant to acquire the brand through registration. The applicant operates as one of a number of aftermarket repair service providers for AOCO ASAHI PENTAX film cameras produced some decades ago. It also appears to make bespoke parts as part of the repair and refurbishment service.³⁷ There is no evidence of an official connection to the opponent or RIC. It is now attempting to register the contested marks and, if successful, would be able to portray itself, erroneously, to the public as the owner of the ASAHI PENTAX brand and that it was either responsible for the original ASAHI PENTAX film cameras or that it is the successor in title. This would not be correct either.

54. As Mr Carter pointed out, there is also narrative evidence³⁸ that the applicant manufactures parts. Further, at the hearing and at the first CMC, Mr Senna stated that “we stamp items with that logo just like the original manufacturer did”.³⁹ Mr Carter asserted that this misrepresents to consumers that there is a trade connection between the applicant and the proprietor of the goodwill identified by the marks. This lends further support that the motives of the applicant in attempting to register the contested marks were to be able to represent itself as the owner of the brand and being responsible for the original cameras.

55. It is clear from the evidence that the applicant is aware of the ownership of the ASAHI and PENTAX brands by RIC and the applicant’s business model illustrates its awareness of the residual goodwill attached to the brands in the UK⁴⁰ and acknowledges that there are a “...legion of fans and customers around the world ...” (see paragraph 42, above). Therefore, its attempt to acquire the brands through trade mark registration amounts to an attempt to misappropriate the brands and will mislead

³⁷ Narrative evidence, WS3 at para.23

³⁸ See WS3 at paras 23 and 39

³⁹ See page 10 of the transcript provided at Exhibit PIL21

⁴⁰ This distinguishes the circumstances of this case from that discussed in *Ladislav Zdút v EUIPO*, T-250/21 where knowledge of the past existence of a reputation (as opposed to the clear existence of residual goodwill) was considered not to be sufficient to amount to bad faith

the public into believing that the applicant is the legitimate owner of the brand and the business. Further, the amendment of the Wikipedia page, about the brands and the business behind the brands, to record the applicant as the owner of the brand is *prima facie* evidence that the applicant is actively attempting to mislead the public. As Mr Carter pointed out at the hearing, the opponent's evidence illustrates that the amendment was made by a third party user known as "Opcouk"⁴¹ and that in 2012 – 2013, Mr Senna was a director of a company called Opco (UK) Ltd.⁴² I also note that the amendment references a "S. Santini" and that this is a name provided as a contact name on the applicant's eBay account together with the contact email address opcouk@icloud.com.⁴³ Mr Carter asserted that this illustrates that the amendments were made by Mr Senna or on his behalf. The amended content reflects the applicant's erroneous belief on ownership of the ASAHI PENTAX brand. Taking all of this into account, I agree with Mr Carter's assertion.

56. Regardless of the applicant's opinion regarding the claimed abandonment of film camera customers by the opponent and RIC, this does not change the fact that the residual goodwill or reputation remains and that whether the applicant considers it to be right or not, this residual goodwill/reputation is retained by the successor in title to the ASAHI PENTAX brand. Its action of filing a trade mark for these brands was made with a view of monopolising the brands to the exception of the opponent and RIC and would have led to consumers being misled into believing that the brands were now in the ownership of the applicant. This erroneous belief would be reinforced by the amended Wikipedia page. In light of this, I conclude that the purpose of filing the contested application was to intentionally lead the public to believing that the applicant was the successor in title of the AOCO/ASAHI/PENTAX brands when, in reality, it is but one of a number of third parties that provides services and parts relating to an aftermarket in maintaining, restoring and repairing original AOCO/ASAHI/PENTAX film cameras.

57. In summary, I find that the filing of the contested application falls short of acceptable standards of commercial behaviour and amounts to bad faith. The application was made with the intention of (i) appropriating the ASAHI PENTAX brand

⁴¹ WS4, para 14 and Exhibit LE11,

⁴² WS2, para 7 and Exhibit LE2, pages 20 - 24

⁴³ WS2, para 15 and Exhibit LE14

through registration without the authority of the brands' owner(s) and (ii) misleading the consumer into believing it is the brand owner.

Having the intention to use the contested marks to create a conflict/dispute with the opponent

58. The opponent claims that the applicant is seeking to use its trade marks to:

(i) undermine the interests of the original equipment manufacturer by threatening them with infringement proceedings;

(ii) as seems highly likely, prevent other of numerous third-party businesses engaged in the repair and refurbishment of ASAHI PENTAX cameras.

59. The opponent also submits that even if the applicant does not believe it is doing anything wrong (because of its belief that the opponent/RIC has abandoned ASAHI PENTAX branded film cameras) and that it is the applicant who is "keeping the brand alive" (as stated by Mr Senna at the first CMC),⁴⁴ the subjective intention is irrelevant because, objectively, it remains bad faith to seek to appropriate a goodwill and reputation that the applicant knew to exist.

60. As I have already found, the applicant's attempt to register the contested trade marks was an attempt to mislead the public as to the correct owner of the brand and residual goodwill and reputation and to misappropriate the brand. It must have, or should have been, obvious to the applicant that this would lead to undermining the interests of the original equipment manufacturer or its successor in title. Mr Carter submitted that the applicant/Mr Senna has repeatedly threatened to deploy trade mark rights against the actual successors in title to the original equipment manufacturers and this is supported in the evidence. Certainly, the applicant has accused the opponent of infringing its marks ASAHI PENTAX 6x7 and PENTA 67⁴⁵ but there appears to be no direct evidence to suggest that the intention of the applicant is to deploy its marks. However, I also keep in mind that it is the applicant's stated view that the opponent is engaging in "evergreening". When this is taken into account, together with the belief that the opponent's marks infringe the applicant's marks, I agree with

⁴⁴ The transcript of which is provided by the applicant Exhibit PIL21

⁴⁵ See Exhibit LE26, para 137

the opponent that it is likely that the contested marks would be deployed against both the successor in title to the original equipment manufacturer and against third parties' businesses also engaged in repair and refurbishment of ASAHI PENTAX cameras.

61. Consequently, for these reasons also, the filing of the contested marks falls short of acceptable commercial behaviour and amounts to bad faith.

Intentionally acquiring the contested marks with a view of selling or licensing it to the opponent

62. There is no evidence before me to suggest that this is the intention of the applicant and neither can it be inferred from the evidence. Rather, the evidence appears to illustrate that the applicant erroneously believed it is entitled to register and use the mark for its own business. Consequently, I dismiss this claimed reason for asserting bad faith.

Conclusion

63. The filing of the contested marks amounts to conduct that falls short of acceptable standards of commercial behaviour and amounts to bad faith. Subject to any appeal, the application to register the contested marks is refused.

COSTS

64. The opponent has been successful and is entitled to a contribution towards its costs. At the hearing, the opponent sought off-scale costs citing the applicant's manner of conducting the proceedings and that this has required multiple CMCs to debate unmeritorious points. Further, it was pointed out that the opponent had to deal with a near-constant barrage of aggressive and irrelevant correspondence. I agree that the costs associated with these proceedings are likely to have been significantly higher because of the way the applicant conducted these proceedings. Consequently, I direct that the opponent provide, within 21 days of the date of this decision, written submissions (not more than 3 pages) and a schedule of costs identifying any additional costs arising from the applicant's unreasonable behaviour. The applicant should provide any submissions in reply within a further 21 days. These should also be limited

to 3 pages. I will consider the parties' comments and then issue a supplementary decision on costs.

Dated this 14th day of July 2025

**Mark Bryant
For the Registrar,
The Comptroller-General**

ANNEX

Registry letter setting outcomes of case management conference held on 7 February 2024



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Your Reference: 118312.5
Opposition No: OP000441893
Examiner: Jacob Robinson
Direct Telephone: +44(0)1633814208
Date: 12 February 2024

Trade Mark No:
UK00003865957

Applicant:
Photo-Image Ltd

Opposition No: OP000441893

Opponent:
HOYA CORPORATION

Please quote your Opposition ID Number in all correspondence

If you wish to correspond by email please reply to Tribunalsection@ipo.gov.uk and ensure your email is copied to the other party.

Dear Sir or Madam,

1. I refer to the case management conference ("CMC") held by telephone conference on 7 February 2024 at 11am. Mr Sam Carter of Counsel, instructed by Lewis Silkin LLP, appeared for the opponent. Mr RP Senna, a litigant in person, represented the applicant, of which he is the director.

2. The CMC was originally arranged because the applicant objected to the preliminary view of the Tribunal to allow the opponent's request for an extension of time to file its evidence-in-chief. The deadline for the opponent's evidence had been 20 December 2023. It made its extension of time request on 8 December 2023 for a further six weeks. This was reduced by the Tribunal to four weeks, with the new deadline being 22 January 2024. The opponent filed its evidence on 19 January 2024.

3. By the time of the CMC, the original reason (the extension of time request) was only one of large number of issues which the applicant wished to cover.

Endeavouring to focus the issues prior to the CMC, I asked the hearings clerks to inform the applicant of the following (two days prior to the CMC, on 5 February 2024):

- (i) Regarding cross-examination, parties must make a request to cross-examine witnesses as per Tribunal Practice Notice 3/2010, which will be considered by the Hearing Officer. The Hearing Officer has treated your submissions and the reasons therein as an application to cross-examine the opponent's witnesses regarding the extension of time request. The request to cross-examine the witnesses at the case management conference about the extension of time is refused. It is late and disproportionate. If the applicant wishes to cross-examine the opponent's witnesses on the substance of their evidence when the proceedings are ready for a substantive decision, it must make a request at that point which complies with Tribunal Practice Notice 3/2010.
- (ii) The IPO has first instance jurisdiction in opposition proceedings. They cannot be transferred to the High Court. The IPO has its own inherent jurisdiction, underpinned by the Trade Mark Rules 2008 (as amended).
- (iii) These opposition proceedings are separate to those decided in BL O/809/2022. An opposition to a new application, which this is, is not barred by (different) previous opposition proceedings. Section 38 of the Trade Marks Act 1994 ("the Act") provides for oppositions against each separate trade mark application.
- (iv) The proof of use findings made in BL O/809/22 have no effect on the present opposition. This is for several reasons. Firstly, there are no consequences under section 6A of the Act for earlier marks which fail the proof of use requirements in specific opposition proceedings. Secondly, the IPO will not and cannot in law move to revoke a trade mark registration under section 46 of the Act of its own volition. An application must be made to the IPO under section 46(4) which will enter proceedings if such an application is defended by the registered proprietor. Thirdly, the present opposition proceedings are brought under a single ground, section 3(6). This is not a relative ground but is

an absolute ground of opposition which can be brought by any legal person: see the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person under section 77 of the Act in *Paper Stacked Limited v CKL Holdings NV* BL O/036/18 at paragraph 19.

- (v) It is for the IPO to decide what the timetable is for the parties to file evidence. If either or both parties wish the substantive decision to be made after a hearing, the IPO will appoint the date taking into account IPO resources.

4. Some of these issues were raised again in lengthy correspondence from the applicant on 6 February 2024 and again on the morning of the CMC; however, they did not all feature in oral submissions from Mr Senna at the CMC. I will deal with the issues which appeared to cause the applicant most concern, although this was at times not entirely clear from the oral submissions made on behalf of the applicant.

5. My decision is to maintain the Tribunal's preliminary view to allow the extension of time request. I consider the reasons given were adequate and an extra month warranted. The opponent is correct that the evidential burden upon it for its section 3(6) ground is heavy. There were two aspects to the evidence: the history of the opponent's involvement with the Pentax brand, and the evidence going to the applicant's director's interactions with the judicial system. It is apparent from the evidence, which I have seen, that one of the reasons given for the delay was the complex corporate structure of the opponent and the historical details about use of Pentax. Contrary to the applicant's submissions, there would be a great deal of prejudice to the opponent were I to overturn the preliminary view. The consequence of that would be that its opposition would fail by default because the ground pleaded requires evidence. Conversely, a month's delay is less prejudicial to the applicant. The applicant desires a substantive decision to be issued before the end of this financial year; however, as I explained, that will not be possible, even if no extension of time had been requested. The applicant requires a hearing and there is currently a waiting list of four to five months for substantive (main) hearings. The decision would not be issued for several weeks after the hearing.

6. I agree with the opponent that the applicant appeared to have withdrawn its objection to the extension of time request by way of its email of 18 January 2024, but reinstated its objection the following day having seen the content of the evidence filed on 19 January 2024. The principle complaint was in relation to the content of Mr Egan's evidence (going to the applicant's director's interactions with the judicial system). Mr Carter submitted that although some investigations were in place when the form TM7 was filed in, more needed to be done once the defence had been filed. It is therefore not the case that the opponent had had seven months to prepare its evidence. In any event, the opponent was under no obligation to begin work on evidence until the defence and counterstatement had been served: see *Liquid Force Trade Mark*, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, [1999] R.P.C. 429. Further, in *Liquid Force*, Mr Hobbs stated that, whilst not an invariable rule, the fact that the evidence has been filed by the time the decision is taken (i.e. my decision resulting from the CMC) is an important point, as is the potential for fresh proceedings to be started if the opposition fails because the evidence is shut out. In this case, that would be the commencement of invalidation proceedings against the applicant's mark.

7. Another important point is the public interest in ensuring that bad faith grounds are properly ventilated in order for marks not to gain registration if they should not be registered. The applicant is incorrect in stating that it has five years to use its mark and no bad faith claim can be raised in that time: a section 3(6) ground can be brought by any legal person at any time, and will succeed if that party can show that, contrary to the declaration on the form of application, an applicant had no bona fide intention to use the trade mark at the date of filing the application.

8. I had already refused permission for Mr Senna to cross-examine Mr Egan about the extension of time request in the letter of 5 February 2024. At the CMC, Mr Senna repeated his wish to cross-examine Mr Egan about the extension of time request. I do not need to refuse it again, having already done so. For the avoidance of doubt, the request is misconceived and disproportionate, having regard to the need to deal with cases which are proportionate to the complexity of

the issues; to give cases an appropriate share of the Tribunal's resources; and to save expense.

9. In terms of the applicant's objection to the admissibility of the evidence pertaining to his interactions with the judicial system, the weight of evidence is a matter for me to assess at the end of the proceedings. I may give this particular evidence some weight in the context of the bad faith claim or I may give it none at all. There will not be a separate CMC regarding this matter, which was requested by the applicant, because I heard more than enough argument about the issue at this CMC. The evidence is admissible and will not be excluded.

10. Other points:

- Section 98 of the Criminal Justice Act is not relevant to these proceedings.
- There is no requirement for the statements of truth of the opponent's witnesses to be the 'new' version used in the courts. The registry has its own rules (Trade Mark Rules 2008, "the Rules") and the format of evidence is provided for in rule 64. The applicant requests the witness statements to be re-filed as affidavits. This request is refused as there is no good reason for it.
- The applicant disputes the authority of the opponent's attorneys to act for the opponent. This is misconceived. The TM7 was filed with a statement of truth by a firm of attorneys which regularly appears before this Tribunal. That firm has filed a witness statement by the opponent's Leader of Corporate IP Office. That would not have been possible without the authority having been given. This allegation also arose in earlier proceedings between the same parties (decision reference BL O/809/22) and was dismissed. The request for disclosure of documents relating to this issue is refused.
- There is no requirement for the opponent to expand upon its pleadings to match the wording used by Mr Carter in his oral submissions. Mr Carter was paraphrasing part of the judgment of the Court of Appeal in *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121. This is

available on BAILII, to which the general public has free access. The weblink to this judgment is [Sky Ltd & Ors v Skykick, UK Ltd & Anor \(Rev2\) \[2021\] EWCA Civ 1121 \(26 July 2021\) \(bailii.org\)](#). The relevant paragraph is 67. This is a standard authority in trade mark proceedings which include a bad faith ground.

- Mr Carter referred to the case of *Hollington v Hewthorn*. The reference for this is *Hollington v Hewthorn & Co Ltd* [1943] KB 587.
- The opponent has not waived legal privilege by Mr Egan filing evidence as instructed by the opponent. It is normal and routine in this Tribunal for attorneys and legal representatives to file their own witness statements of fact on behalf of their clients. There is no right for the applicant to seek disclosure of the privileged contents of the opponent's files.
- Although not raised at the CMC, the applicant raised in correspondence that it seeks disclosure by the IPO of the IPO's data in relation to earlier rights held by the opponent which is not visible on the IPO's website. The applicant may make a sales request via the IPO Information Centre, provided that no order for confidentiality exists in relation to information it seeks to see.
- There was nothing sinister about the fact that the IPO responded to the opponent's extension of time request within three days but took longer to respond to the applicant's request for a hearing. Extension of time requests are time-critical. It takes longer to schedule a hearing once one is requested owing to availability of hearing officers, the hearing request having been made on the last working day prior to Christmas at 11.21pm.

Next steps

11. The applicant now has its opportunity to file evidence. For the avoidance of doubt, the attachments to its email of 7 February 2024, referred to at paragraph 41 of that email, were not filed in proper evidential format; i.e. as exhibits adduced by a witness statement, with numbered exhibits referred to in the body of the witness statement and accompanied by header sheets which refer to these proceedings. **The applicant's deadline for filing its evidence is on or before 12 April 2024.** The evidence must not exceed 300 pages (see Tribunal Practice

Notice 1/2015) and must be sent by the applicant to the opponent at the same time as it is sent to the IPO. After the applicant's evidence has been admitted to the proceedings by the IPO, the opponent will be given one month to indicate if it wishes to file evidence-in-reply. If it does, it will have a further month to do so. This is the standard timetable (see Tribunal Practice Notice 2/2010).

12. The opponent referred to the attachments to Mr Senna's email of 7 February 2024 in the context of them having been sent directly to the opponent by Mr Senna the previous week. The opponent wished to file evidence about the attachments. It will have the chance to do so in reply if the attachments are filed in proper evidential format by the applicant. If not, the opponent may make an application to file further evidence in addition to its evidence-in-reply at the appropriate time, under rule 20(4) of the Rules.

13. I heard submissions in relation to costs for the CMC. Mr Senna asked for normal costs, which would be in line with Tribunal Practice Notice 1/2023 for litigants in person. Mr Carter asked for costs off the scale owing to the amount of issues raised by the applicant and the amount of material sent, all of which he submitted was disproportionate. I will deal with costs at the conclusion of the proceedings.

Registry letter setting outcomes of case management conference held on 9 July 2024



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Date: 09 July 2024

Trade Mark No:
UK00003865957

Applicant:
Photo-Image Ltd

Opposition No: OP000441893

Opponent:
HOYA CORPORATION

Please quote your Opposition ID Number in all correspondence

If you wish to correspond by email please reply to Tribunalsection@ipo.gov.uk and ensure your email is copied to the other party.

Dear Sir or Madam,

I write to confirm the outcome of the Case Management Conference ("CMC") held before me earlier today. The applicant, Photo-Image Ltd was represented by Mr Raj Pal Senna (with Ms Jankowska and Mr Sagoo also present on the call). The opponent, Hoya Corporation, was represented by Mr Sam Carter of counsel. The parties' submissions at the CMC were largely covered by the opponent's letter of 19 June 2024 and the applicant's emails of 1 July (2), 4 July and 5 July 2024. Further, both parties were present and, consequently, I need not set out the parties' submissions in detail, but I will refer to them where I consider relevant.

The CMC lasted 3.5 hours and was at times made difficult by Mr Senna's frequent outbursts and interruptions. He explained that he suffers from health and psychological issues and whilst I tried to make allowances for these, it was nevertheless very difficult at times to restrict Mr Senna to the relevant issues and to progress the discussion. As a result, the CMC proved to be very challenging for myself and, I'm sure, for Mr Senna himself and was not an efficient use of the parties' or the Registry's time and resources.

I spent some time explaining to Mr Senna the Registry's procedures and the available route to final determination and appeal, including correcting the applicant's erroneous belief that the case can and should be heard by the High Court. It is not necessary for me to say more here about this.

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The CMC was initially requested in respect of two preliminary views communicated to the parties in the Registry's letter of 24 June 2024. I also considered a number of points raised in the applicant's subsequent emails and by Mr Carter. I briefly comment on the issues as follows:

1. Additional time given to the opponent to file its evidence-in-reply

The applicant challenged what it believed to be an inconsistent approach in the Registry's letters of 16 June and 24 June 2024. In the first letter, the Registry noted that the opponent had not filed its evidence-in-reply and, therefore, the evidence rounds were closed. This comment mistakenly overlooked a telephone call from the opponent's representatives querying the deadline for such evidence. In that telephone call, the opponent was informed that no letter had been issued yet setting the deadline. The applicant had no knowledge of this telephone call or what the opponent had been told. This is why the applicant perceived an inconsistency when the Registry then set a one-month deadline to provide this evidence in its letter of 24 June. This deadline took into account that until that point the scope of the applicant's evidence admitted into the proceedings was unknown and the opponent had a right to wait until it knew what evidence it was replying to.

The applicant also submitted that the deadline had been set and could not be varied. This is incorrect and rule 62(1)(a) of the Trade Mark Rules 2008 ("the Rules") gives the Registry wide discretion in such issues.

The applicant argued that the setting of the deadline amounted to a decision of the Registry and therefore could only be varied on its own volition, but only by way of a successful appeal. I explained that the setting of a deadline does not constitute a decision of the office and, consequently, it could be varied under the powers afforded by rule 62(1)(a).

I dismissed the challenge to the preliminary view and confirmed that the opponent's deadline for submitting its evidence-in-reply remained 24 July 2024.

2. Applicant's evidence

In light of the difficulties experienced in progressing these proceedings and the number of interim issues raised in the course of what are, essentially, straight forward proceedings I considered that to direct significant amendments to the applicant's evidence would result in further interim actions, delays and costs. This would not be to the benefit of either party. Therefore, balancing these considerations with the additional burdens associated with the unamended evidence, I directed that the applicant's evidence be admitted as filed but that the following paragraphs will be disregarded:

Defence and Counterstatement of Applicant

Paragraphs [25] – [31], [36], [37], [40] – [47], [50], [51], [65] – [72], [86] – [89], [90] – [99], [100] – [104]

Mr Senna's Witness Statement

Paragraphs [9] – [16], [72] – [88], [89]

Mr Sagoo's Witness Statement

Paragraphs [4 - 10], [11 – 16], [25 – 29], [45] – [55]

Ms Jankowska's Witness Statement

Paragraphs [5] – [13], [14] – [17], [33] – [36], [45] – [49], [51] – [55]

The parties both indicated agreement to the approach (albeit with a little reluctance on the part of Mr Carter).

3. Applicant's request that these proceedings are heard concurrently with two related cases

Mr Senna submitted that these proceedings should be suspended and then be heard concurrently with proceedings relating to two other of the applicant's marks (4005752 and 3865957) on the basis that these two other proceedings involve the same issues. I agreed with Mr Carter that this would cause an unacceptable delay in the current proceedings that are approaching final determination, that the evidence in the new cases will be different and that the most proportionate and cost effective approach would be for the current proceedings to proceed alone. It is relevant that the 4005752 mark is already opposed (with the Form TM8 filed today) but the 3865957 mark is not yet opposed.

I refused to suspend the current proceedings, noting that the decision in these proceedings might have some precedent value to the later proceedings. I also noted that Mr Senna remained free, at the appropriate time, to request that the proceedings in respect of 4005752 and 3865957 follow a common evidence timetable.

4. Additional issues

(A) Mr Carter provided early notice that:

- (a) the opponent is considering cross examination of some of the applicant's witnesses.
- (b) it will be seeking off-scale costs if it wins and even if it loses, costs associated with the applicant's unreasonable behaviour and conduct of the case.

(B) Mr Carter pointed out that since Mr Senna is no longer a director of the applicant and that he is not appointed as its representative in these proceedings this creates a procedural irregularity. Mr Senna pointed out that the applicant has offered that he can return to his previous role as director and that it was put in writing in a recent email from the applicant that he was to represent it at this

CMC. I informed Mr Senna that to rectify the procedural irregularity, the applicant must now either confirm that he is, once again, a director or that he has been appointed as its representative in these proceedings. **I directed that the Registry must be informed within 14 days i.e. 23 July 2024.**

(C) The opponent has drawn attention to the fact that Exhibit PIL 24 to the witness statement of Ms Jankowska is missing. I gave Mr Senna permission to provide this. **This must be provided within 14 days i.e. 23 July 2024.**

5. Applicant's oral request for leave to appeal these decisions

The applicant stated that it was minded to appeal the decisions. I referred to rule 70(2) of the Rules and explained its purpose and that, in respect of the interim decisions included in the first CMC (held on 7 February 2024) and in this letter, I declined to allow leave to appeal. In doing so, I explained that an appeal was still available to the applicant once a decision is issued in respect of the substantive section 3(6) ground.

6. Future conduct of the case

I indicated that:

- (i) The Registry will not respond to any further submissions regarding decided issues;
- (ii) The Registry will not respond to any further demands for the proceedings to be transferred to the High Court;

7. Next steps

The applicant must resolve the issue of the status of Mr Senna in these proceedings and notify the Registry by **23 July 2024** (see 4(B) above)

The applicant must file the missing Exhibit PIL 24 by **23 July 2024**.

The opponent's amended evidence in chief is due by **24 July 2024** by removing the elements that relate to Mr Senna's spent convictions.

The opponent's evidence in reply is due on **24 July 2024**.

Upon receipt of the opponent's amended evidence in chief, the applicant will have 14 days to, if it so wishes, redact its evidence addressing the spent conviction point.

Yours faithfully,

Mark Bryant
Hearing Officer
Trade Marks Registry