

O/0745/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00004084584
BY IRIDE LTD TO REGISTER:**



**AS A SERIES OF TWO TRADE MARKS
IN CLASSES 9 AND 39
AND
THE OPPOSITION THERETO UNDER NO. 450303
BY BITES LIMITED**

AND

**IN THE MATTER OF REGISTRATION NO. UK00004054517
IN THE NAME OF BITES LIMITED FOR THE TRADE MARK:**

:RIDE

**IN CLASS 39
AND
AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 508236
BY IRIDE LTD**

BACKGROUND AND PLEADINGS

1. This decision involves two trade mark proceedings, an application for a declaration of invalidity and an opposition, wherein BITES LIMITED (“BITES”)¹ and IRIDE LTD (“IRIDE”) brought actions against one another. I will summarise the relevant proceedings below, beginning with the opposition, on the basis that it was brought first.

BITES’s opposition against IRIDE’s trade mark application no. UK00004084584

2. On 07 August 2024, IRIDE applied to register the series of two trade marks shown below under no. UK00004084584:



3. The application was accepted and published in the Trade Marks Journal on 23 August 2024 in respect of the following goods and services:

Class 9: *Downloadable mobile software for booking, managing, and paying for taxi services.*

Class 39: *Taxi services; Transportation of passengers by taxi, including private hire services; Airport taxi services; Transportation to and from airports; School taxi services; Provision of transportation for school children; Minibus taxi services; Taxi services for group transportation; Pet-friendly taxi services; Local delivery services; Delivery of items via a taxi.*

¹ The original party was GULEX DIGITAL LTD however UK00004054517 was subsequently assigned to BITES on 1 August 2024 and on 24 September 2025 BITES stated that as the new proprietor it confirmed their agreement to the undertakings that (i) it had sight of any forms or evidence filed, (ii) it stood by the statements made in the counterstatement and confirmed that where the name of the original proprietor appears, this should be read as though it is made in BITES’ name and (iii) it was aware of and accepted the liability for costs for the whole proceedings in the event that the application is successful.

4. On 21 October 2024, the application was opposed in its entirety by BITES based upon Sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”) with BITES relying upon the following trade mark:

UK00004054517



Filing date: 21 May 2024

Date of entry in register: 16 August 2024

Class 39: *Taxi Services*

5. By virtue of its earlier filing date, the trade mark relied upon by BITES is an earlier mark in accordance with Section 6 of the Act. Since it had not been registered for more than five years at the filing date of the contested mark, it is not subject to the use conditions under Section 6A of the Act.

6. Under the grounds pleaded, BITES claims that there is either double identity (i.e. Section 5(1)) or likelihood of confusion because (i) the marks are identical and the goods and services are similar (Section 5(2)(a)) or (ii) the marks are similar and the goods and services are identical or similar (Section 5(2)(b)).

7. IRIDE filed a defence and a counterstatement whereby it denies the claims made on the basis that BITES’ earlier registration is invalid due to the existence of earlier unregistered rights vested in IRIDE. However, it acknowledges that the competing marks are substantially similar and have been filed for identical services.

IRIDE's invalidity application against BITES' earlier trade mark no. UK00004054517

8. Following the filing of BITES' opposition against IRIDE's application, on 20 December 2024, IRIDE filed an application for a declaration of invalidity of BITES' earlier mark no. UK00004054517 under Section 47 of the Act based upon Section 5(4)(a) of the Act. Under this ground, IRIDE relies upon the sign 'IRIDE' which it claims to have used throughout the UK since 12 January 2024 (this is said to be the date IRIDE was incorporated). IRIDE claims that it used its sign in relation to the same goods and services for which it seeks registration of its trade mark application no. UK00004084584 opposed by BITES, namely:

Class 9: *Downloadable mobile software for booking, managing, and paying for taxi services.*

Class 39: *Taxi services; Transportation of passengers by taxi, including private hire services; Airport taxi services; Transportation to and from airports; School taxi services; Provision of transportation for school children; Minibus taxi services; Taxi services for group transportation; Pet-friendly taxi services; Local delivery services; Delivery of items via a taxi.*

9. IRIDE claims that BITES's earlier mark is highly similar to its earlier unregistered sign and is protected for identical services. As such, IRIDE claims that use of BITES' earlier mark would be contrary to the law of passing off.

10. IRIDE further clarifies that it has been trading since April 2024 (i.e. a month prior to the filing date of BITES' earlier mark which is 21 May 2024). It stated:

"[IRIDE] was registered with Companies House on 12 January 2024. [Its] officer also registered a second Limited company on the same day, namely iRide New Forest Ltd. This allowed [IRIDE] to expand across the UK. Due to the nature of the services offered, [IRIDE] is required to obtain licence from the relevant councils to operate.

[IRIDE] therefore made the relevant applications to obtain the relevant licences to Southampton City Council and New Forest District Council. [IRIDE] was granted its licence for the New Forest on 8 March 2024 and in Southampton on 17 April 2024.

On 11 February 2024, the officers of [IRIDE] also registered a separate registered company iRide Wolverhampton Ltd to allow for expansion for the business. The relevant applications to obtain the licences needed have been filed and these were granted on 2 October 2024.

[IRIDE] has been trading publicly since April 2024. [IRIDE]'s customer base can engage with its services through its website www.irideuk.co.uk where customers can find telephone and email contact details to book. Customers can also book through the website and through its mobile App. [IRIDE]'s customer base has grown since its launch, having built a reputation as the provider of quality services. This has been reflected by engagement by such customers with [IRIDE]'s online presence and attendance at marketing events. [IRIDE] is in a position to evidence its use of 'iRide' in due course."

11. BITES filed a counterstatement denying the claim under Section 5(4)(a). BITES also states that the earlier mark was filed in good faith and states that it denies any claim of bad faith. However, IRIDE's application is based on Section 5(4)(a) only, and does not include any allegation of bad faith, hence I will disregard these comments. BITES also states that it "has prior use" because it has been working on app development since July 2023 and has invested a significant amount of time and financial resources in designing, branding and developing the app.

12. Upon the filing of the counterstatement in both proceedings, the Tribunal consolidated them under the power given to it under Rule 62(1)(g) of the Trade Marks Rules 2008. This was communicated to the parties by way of written correspondence dated 27 January 2025.

13. Both parties filed evidence in chief.

14. IRIDE is represented by Lawdit Solicitors Limited and BITES is a litigant in person.

15. Neither party requested a hearing, but only BITES filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

16. 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.

EVIDENCE

17. IRIDE's evidence in chief came in the form of a witness statement from Imran Khan dated 27 March 2025 alongside nine exhibits (being those labelled Annex 1- Annex 9). Mr Khan is the director of IRIDE.

18. BITES' evidence in chief came in the form of a witness statement from Gul Zamir dated 23 April 2025 alongside three exhibits (being those labelled Annex 1-Annex 3). Mr Zamir is the Director of Gulex Digital Ltd, BITES' predecessor in title.

19. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will refer to them to the extent that I deem necessary below.

DECISION

MY APPROACH

20. The ability of BITES to rely on its earlier trade mark in the opposition against IRIDE's trade mark application depends on the outcome of IRIDE's invalidity against BITES' earlier trade mark. Hence, I shall start with IRIDE's application for invalidity which is based on Section 5(4)(a).

IRIDE'S INVALIDITY AGAINST BITES' REGISTRATION NO. UK00004054517

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

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

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

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

23. The relevant parts of Section 47 state:

“47. (1) [...]

(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.”

24. 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)."

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

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

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

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

The relevant date for Section 5(4)(a)

26. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (now KC), as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Allan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

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

27. In *Smart Planet Technologies, Inc. v Rajinda Sharma* [BL O/304/20], Mr Thomas Mitcheson QC (now KC), as the Appointed Person, pointed out that “*the start of the behaviour complained about*” is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when the first offer was made to market relevant goods or services under the mark. However, it could also be the date the first public-facing indication was made that sales were proposed to be made under the mark in the future. If the user of the applied-for mark was not passing off at the time such use commenced (usually because no one else had acquired a protectable goodwill under a conflicting mark at that time), he or she will not normally be passing off by continuing to use the mark.

28. BITES filed evidence claiming that it has used its registered mark (which is subject to IRIDE’s application for invalidity) prior to applying to register it. Hence, before turning to IRIDE’s evidence about goodwill, I need to establish whether BITES’ evidence of use amounts to the “*start of the behaviour complained about*” before the filing date of 21 May 2024 (“the primary relevant date”); if it does, I will need to consider IRIDE’s position at that date, as well as at the primary relevant date.

BITES’ evidence

29. Mr Zamir states that IRIDE’s first public reference to the brand “iRide Taxis” appeared on 23 May 2024 via a Facebook post.² He also states that additional posts show IRIDE’s mobile app launch on 28 May 2024, and their website launch on 11 June 2024,³ all of which occurred after BITES filed the contested trade mark (i.e. the primary relevant date). This evidence was filed in support of BITES’ submission that IRIDE did not own any goodwill at the primary relevant date.

² Annex 2

³ Annex 2

30. As regards the use by BITES of the contested mark (which is relevant for the purpose of establishing the start of the behaviour complained about and whether goodwill should be assessed at an earlier relevant date), Mr Zamir states as follows:

“Gulex Digital Ltd had already commenced development of the iRide platform before IRIDE LTD’s public announcements. I received a Figma design file for the iRide mobile app on 16 May 2024.

On 19 May 2024, we paid INR 40,000 to Technorizen Software Solutions Pvt Ltd for an initial development milestone. On 25 May 2024, we made a second payment of INR 40,000 for continued app development. Invoices start from annexed 3 page 8-15.

We have also made continued payments to our development team, including transfers from August 2024 through February 2025. These are detailed in annexed 3 page 8-15.

These financial transactions demonstrate genuine investment, intent to use the trade mark, and ongoing development of our brand prior to and following the date of registration. Our use predates IRIDE LTD’s public branding and contradicts their claims of prior rights.”

31. The primary relevant date is 21 May 2024. This is the date BITES applied to register the contested mark. Strictly, this is also the date goodwill and misrepresentation must be evaluated. However, as I have explained, if the proprietor/applicant used the mark before that date, the tribunal must look at the position at the start of the behaviour complained about. The start of the behaviour complained about is, effectively, the date the proprietor/applicant committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. This would typically be the date the proprietor/applicant started using the contested sign on the market.

32. Mr Zamir refers to BITES’ predecessor in title carrying out activities aimed at developing their platform; it is reasonable to assume that this was meant to be used

to offer the registered taxi services under BITES' contested mark to the public. These activities are listed as (i) receiving a design file for the app on 16 May 2024 (a few days prior to the relevant date) and (ii) making payments to the company responsible for developing the app on 25 May 2024, as well as on various dates from August 2024 to February 2025 (after the primary relevant date). None of these activities constitute outward use of the contested mark (or use on the relevant market). Consequently, this evidence does not establish a use of the contested mark which amounts to the start of the behaviour complained about for the purpose of establishing an earlier relevant date in passing off. Accordingly, BITES has not substantiated its claim that its use began in July 2023 and the only relevant date I need to consider is the primary relevant date/filing date of 21 May 2024.

33. I now turn to IRIDE's evidence about goodwill.

IRIDE's evidence

34. Mr Khan's witness statement contains a mix of evidence and legal submissions. Notably, the first legal submission made by Mr Khan proceeds on a fundamental misconception. He states, in fact, that (a) BITES failed to file any evidence of use of its contested mark prior to the filing date of 21 May 2024 and (b) on this basis, IRIDE holds earlier unregistered rights, which predate BITES's mark and therefore such mark should not have been registered. This submission is wrong in law. In order for IRIDE to be successful in its action for passing off, it is not sufficient to show earlier use (i.e. that IRIDE used its unregistered sign prior to BITES filing/using the contested mark). Rather, IRIDE must demonstrate that, when BITES filed the application to register the contested mark, IRIDE owned a protectable i.e. (more than trivial) goodwill, sufficient to sustain its claim for passing off.

35. The next identifiable misconception is that the mere act of registering IRIDE's company on 12 January 2024 (or any other company incorporating the word IRIDE in the company name)⁴ means that IRIDE owns earlier unregistered rights in the sign claimed. Likewise, Mr Khan's reference to IRIDE applying to obtain the relevant

⁴ Annex 1 and 3

licenses to provide the relevant taxi services⁵ is misconceived. This is because goodwill is generated by trading activities and to build a protectable goodwill a business must show customers, not merely license and incorporation of companies.

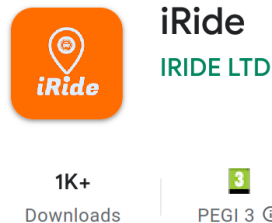
36. In terms of trading activities, Mr Khan states that IRIDE has been trading publicly since April 2024 – this is only a month before BITES filed the contested application on 21 May 2024. He also states that IRIDE’s customer base can engage with IRIDE’s services through its website www.irideuk.co.uk where customers can find telephone and email contact details to book. In support of this claim, Mr Khan provides screenshots from IRIDE’s website;⁶ however, the pages are undated, the only visible date being the printing date of 21 March 2025 (which is after the primary relevant date). This means that it is not possible to know whether the opponent’s website was a fully functioning website promoting the IRIDE’s sign prior to the primary relevant date. In this connection, BITES filed evidence showing a Facebook post dated 11 June 2024 introducing the IRIDE website – this suggests that the website was launched a few weeks after the primary relevant date. BITES also filed evidence showing a Facebook post dated 23 May 2024 introducing the IRIDE Taxi business to Southampton – this suggests that the business was launched two days after the primary relevant date.

37. Mr Khan also states that customers can book the relevant taxi services through IRIDE’s mobile app. In this connection, Mr Khan provides screenshots showing the app available for download from Google Play and the Apple App Store as shown below:

⁵ Annex 2

⁶ Annex 4

21/03/2025, 13:10



21/03/2025, 13:10

iRide. on the App Sto

App Store Preview

Open the Mac App Store to buy and download apps



iRide. 4+
iRide Ltd (UK)
Designed for iPhone
Free

38. However, this evidence suffers from the same deficiencies as the website evidence because it is undated (save for the printing date of 21 March 2025); whilst Mr Khan points out that the Google Play screenshot shows 1K downloads, it is impossible to know how many times the app was downloaded prior to the primary relevant date.

39. Mr Khan further states that IRIDE's customer base has grown since its launch, having built a reputation as the provider of quality services and that *"this has been reflected by engagement by such customers with [IRIDE]'s online presence and attendance at marketing events"*. However, no details are provided as to the number

of customers who engaged with IRIDE's services and marketing activities. Significantly, IRIDE made no efforts to provide evidence about (a) the turnover generated by the provision of the services under the sign prior to the primary relevant date; (b) the number of consumers who used IRIDE's services prior to the primary relevant date and (c) the sum spent by IRIDE in promoting the services under the sign prior to the primary relevant date.

40. Mr Khan further states that IRIDE is present on all social media platforms and is building its customer base. Screenshots from IRIDE's Facebook and Instagram pages are provided,⁷ however, this evidence suffers from the same deficiencies as the website and app evidence because it is undated (save for the printing date of 21 March 2025).

41. Lastly, Mr Khan states that IRIDE can evidence its reputation through customer feedback and holds over 110 Google reviews, with an overall score of 4.9 out of 5.⁸ Copies of customers' feedback are provided, however, the oldest ones are from 5 months before the printing date of 31 March 2025, which is after the primary relevant date, and as such cannot contribute towards establishing goodwill at that date.

42. In the last part of his evidence, Mr Khan states that IRIDE has invested in its marketing efforts to ensure the business is noticed from the outset and has "*an ongoing Call Ads campaign, in place since 15 February 2024*". No information is provided about marketing spend, however, a copy of this agreement is enclosed⁹ along with the Call Ads report dated 12 March 2024 to 12 April 2024. It shows that the campaign costs £451 and is dated February 2024 which is 3 months prior to the primary relevant date. Mr Khan points out that this evidence shows that the Ads attracted over 5,600 impressions in the first month – which is prior to the primary relevant date.

Conclusions on goodwill

⁷ Annex 7

⁸ Annex 7

⁹ Annex 8

43. Goodwill is normally proved by evidence of, *inter alia*, trading activities, advertising, and customers. Genuine trading activities, which result in acquiring reputation and gaining customers, are usually sufficient to establish goodwill. The meaning of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) as follows:

“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.”

44. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing

officer that it is not shown on the balance of probabilities that passing off will occur.”

45. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

46. Goodwill must be more than trivial in extent. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

47. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (now KC), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

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

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

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi’s witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

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

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was

some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

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

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

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

49. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The

goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, “*very limited*”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the defendant’s trade under LUMOS.¹⁰

50. I have already highlighted the gaps in the evidence. There is no specific information about the turnover generated by the provision of the services under IRIDE’s sign, nor is there any evidence about the number of UK customers/transactions or market share. There is no evidence of IRIDE’s having a fully functioning website or app prior to the primary relevant date. The only specific evidence provided by Mr Khan is about the cost (which is relatively low) of an online marketing campaign carried out a month before the primary relevant date, however, there is no information as to whether any of the 5,600 impressions generated any sales at all.

51. Accordingly, IRIDE’s evidence is not sufficient to establish goodwill in the UK. In particular, the evidence fails to establish that IRIDE had, at the primary relevant date, a more than trivial goodwill involving the presence of clients or customers in the UK for the goods and services claimed. It follows that IRIDE having failed to establish an actionable goodwill, its passing off action fails at the first hurdle. The application for invalidity is unsuccessful.

CONCLUSIONS ON IRIDE’S APPLICATION FOR A DECLARATION OF INVALIDITY OF BITES’ EARLIER TRADE MARK NO. UK00004054517.

52. IRIDE’s application for a declaration of invalidity is unsuccessful and BITES’ earlier trade mark no. UK00004054517 will remain registered.

¹⁰ See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); (COA)

53. I now turn to BITES' opposition against IRIDE's trade mark application no. UK00004084584.

BITES'S OPPOSITION AGAINST IRIDE'S TRADE MARK APPLICATION NO. UK00004084584

54. BITES' opposition is based on the grounds under Sections 5(1), 5(2)(a) and 5(2)(b) of the Act.

55. IRIDE's defence does not include any denials as to the similarity of the goods and services, the similarity of the marks and the likelihood of confusion. The only defence that IRIDE advanced is that BITES' mark is invalid, due to the earlier unregistered rights vested in IRIDE. In addition, in its pleadings IRIDE admits that the respective marks are substantially similar and filed in relation to identical services. In *SKYCLUB*, BL-O/044/21, Mr Phillip Johnson, sitting as the Appointed Person, stated as follows:

"24. The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a "blank" defence would lead to the whole of the Claimant's case being admitted.

25. The procedure before neither the registrar nor the Appointed Person is governed by the CPR, but there is a Tribunal Practice Notice (TPN 4/2000) which deals with pleadings and provides a similar rule to the CPR:

19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.

20. The counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counter-statement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided.

26. In the context of the CPR, the Court of Appeal has emphasised that there is a positive duty on a defendant to admit or deny matters unless the party is unable to do so: *SPI North Ltd v Swiss Post International (UK) Ltd* [2019] EWCA Civ 7 at [48]. As Lord Hoffmann opined in *Barclays Bank Plc v Boulter* [1999] 1 WLR 1919 at 1923:

The purpose of the pleadings is to define the issues and give the other party fair notice of the case which he has to meet.

27. In that case, their Lordships excused otherwise inadequate pleadings (under the old Rules of the Supreme Court) because the case the defendant would have to meet was made abundantly clear (from concealed and referential allegations) and the pleading point was said to be “technical in the highest degree” (*Barclays* at 1923). In that case, the defendant’s Counsel had made it clear that he would be able to deal with the point without the trial being adjourned. On the other hand, the plaintiff would merely have to make a formal request to amend. On balance it was concluded that no amendment was necessary.

28. In this case, it is clear from the Hearing Officer’s decision that the amendment would have been allowed if an application had been made and (as in fact occurred) the parties were ready to proceed on the basis that the similarity of goods and services, the global appreciation test and the likelihood of confusion was in issue. However, in contrast to *Barclays*, in this case there was no concealed or referential allegation. The defence appeared only to address the (now abandoned) section 5(3) ground and nothing (other than experience) would have put the Appellant on notice that the similarity of goods

and services or confusion were in issue in relation to s 5(2)(b). The Hearing Officer has the power to request clarifications from a party to proceedings under r 62(1)(a) of the Trade Marks Rules 2008. He also could have invited Mr Engelman to apply to amend his pleadings to put in issue the similarity of goods and services, confusion and so on. Neither of these things happened. Accordingly, the Hearing Officer was wrong to proceed on the basis that the similarity of goods and services, confusion and anything other than similarity of the marks was in issue.”

56. Accordingly, as the identity of the services and the substantial similarity of the marks have been admitted, and the similarity of the goods and the likelihood of confusion have not been denied, I will proceed on the basis that the similarity of the goods and the likelihood of confusion (in respect of all of the goods and services for which registration is sought) are not in issue. Consequently, the opposition succeeds under Section 5(2)(b), which is the ground based on the marks being similar and the goods and services being identical and/or similar. For the sake of completeness, I should say that even if likelihood of confusion had been in issue, I would have found that there is a likelihood of confusion because of the similarity of the marks which share the distinctive verbal element IRIDE, the identity of the services, and the similarity of the goods and services. Consequently, the opposition is successful in its entirety.

CONCLUSIONS

57. The invalidity application against BITES’ earlier trade mark no. UK00004054517 has failed. The mark will remain registered.

58. The opposition against IRIDE’s trade mark application no. UK00004084584 has been successful. The application will be refused registration.

COSTS

59. BITES has been successful in both proceedings. In relation to costs, the successful party is usually entitled to an award of costs. I note that BITES has been unrepresented throughout the proceedings. As a matter of practice, litigants in person are asked to

complete a costs proforma. As I have not been provided with a completed proforma detailing the actual costs and estimates of the amount of time spent on various activities associated with these consolidated proceedings, I can only make an award for the official fees paid by BITES in relation to the opposition which amounts to £100.

60. I therefore order IRIDE LTD to pay BITES LIMITED the sum of £100. 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 18th day of August 2026

TERESA PINTO
For the Registrar