

O-0857-26

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO 3936160

IN THE NAME OF JOIZA FZCO

FOR THE FOLLOWING

TRADE MARK:

Teamwork Puzzles

IN CLASSES 9, 16, 25, 28 & 41

AND

OPPOSITION THERETO (UNDER NO. 445157)

BY

HAMZAH KHALID MIRZA

BACKGROUND

1) Joiza FZCO ('the applicant') is the applicant for the mark 'Teamwork Puzzles'. It was applied for on 20 July 2023 in respect of a variety of goods and services in classes 9, 16, 25, 28 & 41. For reasons which will become apparent, it is unnecessary to set out all those goods and services. The application was published in the Trade Marks Journal on 10 November 2023.

2) Hamzah Khalid Mirza ('the opponent') claims that the trade mark application offends under Section 5(4)(a) of the Trade Marks Act 1994 ('the Act'). The opponent claims to have acquired goodwill under the sign, 'Teamwork Puzzles 2 (Obby)', which is said to have been used in the UK since 28 February 2023 in relation to 'downloadable computer game programs, downloadable video game programs, providing interactive multiplayer online computer games via a global network, entertainment services, namely providing non-downloadable online video games and entertainment services, namely, providing non-downloadable online multiplayer video games'. It is claimed that there will be a misrepresentation and damage to the opponent's goodwill.¹

3) The applicant filed a counterstatement denying the opponent's claims and requesting proof thereof.

4) The opponent is represented by IBB Law LLP; the applicant is represented by Lewis Silkin LLP. Both parties filed evidence. The opponent's evidence consists of a witness statement from Hamzah Khalid Mirza² with exhibits HM1 – HM33. The applicant's evidence consists of a witness statement in the name of Christopher Boomer,³ with exhibits CB1 – CB16. Neither party requested a hearing. Only the opponent filed written submissions in lieu.⁴ The instant proceedings were once part of a consolidated group of proceedings. However, the other cases are now concluded, leaving only this case to be decided.

¹ As per the amended Form TM7 dated 03 April 2024

² Dated 11 November 2024

³ Dated 13 January 2025. Mr Boomer was the original applicant in these proceedings, before the contested mark was assigned to the current applicant.

⁴ Dated 25 February 2025

DECISION

5) 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.”

6) 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.”

7) 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)."

Relevant date

8) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (as he then was), sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan 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.'

In the instant case, the opponent must show that it had the necessary goodwill in the UK at the filing date of the contested mark, namely **20 July 2023**.

Goodwill

9) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) the Court stated:

“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.”

10) In terms of the evidence that is required to establish the existence of goodwill, 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.”

11) 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.”

12) 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.”

13) Further, in *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (as he then was), 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.”

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."

14) 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.⁵

15) I also remind myself that the opponent must establish that it has actual goodwill in this jurisdiction which necessarily must involve the presence of customers in the UK for the goods and services relied upon. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 47 of the judgment) that:

“I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question. And, where the claimant's business is abroad, people who are in the jurisdiction, but who are not customers of the claimant in the jurisdiction, will not do, even if they are customers of the claimant when they go abroad.”

16) With all of the above in mind, I now turn to consider the evidence filed by the opponent. I note that much of it refers to the position in 2024, which is after the relevant date of 20 July 2023. Other parts of the evidence are not clearly dated nor is it explained whether it pertains to the position as at the relevant date. Furthermore, none of the aforementioned evidence is of such a nature to shed light backwards on to the position at the relevant date. It is therefore of no assistance to the opponent.⁶ Some of the evidence also pertains to marks which are not relied upon in the instant proceedings and is also irrelevant for that reason.

17) I do, however, note the following from the evidence:

⁵ See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC)

⁶ This includes, but is not limited to, the narrative evidence at [17] – [23] and the exhibits referred to therein.

- 'Teamwork Puzzles 2 (Obby)' (the Game') was first launched on to the Roblox Platform by the opponent on 23 February 2023.
- It is said that the Game 'has now' (my emphasis) accumulated over 710,000,000 visits 'with approximately 2.5% of all users accounting for the UK audience'.
- Exhibit HM5 is a screenshot of a YouTube video dated 12 May 2023 of the Game being played by a 'YouTuber' which has 375, 586 views.
- Exhibit HM6 is a screenshot of a YouTube video dated 29 April 2023 of the Game being played by a 'YouTuber' which has 902, 556 views.
- Exhibit HM7 is a screenshot of a YouTube video dated 21 June 2023 of the Game being played by a 'YouTuber' which has 3,945,455 views.
- Exhibit HM8 is a screenshot of a YouTube video dated 11 July 2023 of the Game being played by a 'YouTuber' which has 696, 928 views.
- Exhibit HM10 is a screenshot of a YouTube video dated 04 July 2023 of the Game being played by a 'YouTuber' which has 576, 227 views.
- Exhibit HM11 is a screenshot of a YouTube video dated 29 June 2023 of the Game being played by a 'YouTuber' which has 11,057, 292 views.

18) There are numerous problems with this evidence in terms of establishing the necessary goodwill at the relevant date of 20 July 2023. Firstly, although the number of visits to the Game of over 710,000,000 appears to be impressive on its face, this figure (like other figures provided in the evidence) appears to represent the position as at the date of Mr Mirza's witness statement (11 November 2024) which is well after the relevant date. As that figure is not broken down in any way, I cannot tell what proportion of it, if any, relates to visits which occurred prior to the relevant date. As such, that evidence is no assistance to the opponent. Secondly, the evidence in exhibits HM5 – HM8, HM10 and HM11, although dated prior to the relevant date, merely shows that six different 'YouTubers' uploaded a video of themselves on to YouTube playing the opponent's game. This does not tell me how many customers, in total, the opponent had for its game prior to the relevant date (aside from the six YouTubers who played the game) let alone how many of any such customers were in the UK. As the caselaw above makes clear, 'goodwill is the attractive force which brings in custom'. There must therefore be evidence of sufficient custom in the UK prior to

the relevant date to establish the necessary goodwill. The evidence before me falls far short of establishing this. Without goodwill, there can be no misrepresentation or damage. **The opposition fails.**

COSTS

19) As the applicant has been successful, it is entitled to a contribution towards the costs it has incurred in these proceedings. The relevant guidance is found in Annex A of Tribunal Practice Notice 1/2023. Using that guide, I award the applicant costs on the following basis:

Preparing a statement and considering the opponent's statement	£300
Preparing evidence and considering the other side's evidence	£600
Total:	£900

20) I order Hamzah Khalid Mirza to pay Joiza FZCO the sum of **£900**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of September 2026

Beverley Hedley
For the Registrar