

BL O/264/22

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATIONS No. 3587268 AND No. 3595047

IN THE NAME OF GLOBAL TRADEMARK SERVICES LTD

DECISION

1. Global Trademark Services Ltd (“the Applicant”) applied to register the following trade marks for use in relation to goods which it identified at the filing date of each application as “*clothing, footwear, headgear*” in Class 25:



Application No. 3587268

Filing date: 29 January 2021



Application No. 3591582
Filing date: 6 February 2021



Application No. 3591586
Filing date: 6 February 2021



Application No. 3595047

Filing date: 12 February 2021.

2. The Registrar raised *ex officio* objections to all four applications for registration under section 3(6) of the Trade Marks Act 1994. The Registrar's representative confirmed at the hearing before me that the objections were raised on the basis of the following 'bad faith' practice set out in the Registry's Examination Guide:

Where third parties apply to register the name of a famous individual or a recently deceased famous individual an objection under section 3(6) may be appropriate. However, this will depend upon whether the application covers goods and / or services with which the famous individual is associated, and who has applied for the mark. For example, an application to register the name of a famous fashion model for 'clothing' or 'cosmetics' would be liable to an objection because it is an obvious attempt to take unfair advantage of the other person's reputation, unless of course that mark was applied for by the model themselves. Conversely, an objection to register a name of a famous fashion model for 'agricultural machinery' would not be liable to a bad faith objection.

An objection under section 3(6) to the name of a famous individual can be overcome by obtaining consent from that person, if it appears that the mark has not been applied for in their name. Applications to register the names of famous musical groups will not normally face an objection under section 3(6) at the examination stage. This is because to firmly establish who are the rightful owners of the names of musical groups often requires evidence and is therefore best left to be determined in opposition proceedings.

3. On 29 April 2021, a hearing took place before Ms Linda Smith acting for the Registrar of Trade Marks to consider the Registry's objections to the applications for registration identified above. The Applicant was represented at the hearing by its director Mr Jim Dear.
4. The Hearing Officer decided to maintain the Registrar's 'bad faith filing' objections in relation to Application No. 3587268 (HENRY) and Application No. 3595047 (RONALDINHO). She waived them in relation to Application No. 3591582 (CLARK) and Application No. 3591586 (WALLACE). With regard to the latter applications: the Register shows that Application No. 3591582 (CLARK) was subsequently opposed by C & J Clark International Ltd on 8 July 2021 and that Application No. 3591586 (WALLACE) proceeded to registration without opposition on 16 July 2021.

5. The Applicant requested written reasons for the refusal of Application No. 3587268 (HENRY) and Application No. 3595047 (RONALDINHO). These were issued in substantially similar terms under reference BL O/629/21 (RONALDINHO) and BL O/630/21 (HENRY) on 24 August 2021. The paragraph numbers I refer to below are interchangeable as between the two Decisions.

6. In her Decisions, the Hearing Officer noted (paragraph [3]) the submissions made by Mr Dear on behalf of the Applicant to the effect:
 - (1) that surnames are, in principle, eligible for registration as trade marks in accordance with the Judgment of the Court of Justice in Case C-404/02 Nichols EU:C:2004:538 at paragraphs [26], [30];
 - (2) that the Registry has a duty to act impartially and not as agents or representatives of individuals or organisations;
 - (3) that the examination of these marks was inconsistent with the examination of other ‘surname’ marks which the Applicant had successfully applied to register in Class 25;
 - (4) that there is no right of publicity or a right to protect a person’s image or likeness in the UK.

7. The Hearing Officer observed at paragraph [6] that: “At the hearing Mr Dear was extremely upset about the objection raised in respect of bad faith, seeing it as an implication that he had in some way acted in an underhand manner that was contrary to honest business practice. ... **I reassured Mr Dear that we were not accusing him of acting in an underhand way**, but where the names of famous individuals are involved we may need to establish whether or not that individual has given consent for their name to be used. ...”

8. She nonetheless went on to confirm in paragraph [12] that she was guided by Case T-795/17 Moreira v EUIPO (NEYMAR) EU:T:2019:329 at paragraph [23] as to the test that she was applying for the purpose of assessing “bad faith”: “...***bad faith relates to a subjective motivation on the part of the trade mark applicant namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices ...***”.
9. Her approach to the application of that test was as indicated in paragraph [13]: “***The Neymar decision ... makes it clear that bad faith may be assumed in the event of the lack of a proper explanation by the applicant to rebut certain known facts, which in turn led to inescapable motivations on the part of the applicant and as far as the filing of the trade mark application was concerned***”; and in paragraph [21]: “***At the very least Mr Dear, given the known facts, owed the registry a plausible explanation for his application in order to overcome the presumption***”.
10. The Hearing Officer stated in paragraph [25] that it was the Registrar’s duty to raise and maintain “bad faith filing” objections of the kind that had been raised in the present case: “***It is well established that the registrar has the duty of being a ‘gatekeeper’ to the register and should do their utmost to ensure that trade marks are strenuously examined to ensure statutory compliance***”.
11. The interests which the Registrar was seeking to protect by doing so were identified in paragraph [29]: “***The registrar reserves the right to intervene on the basis of bad faith, not just in an inter-partes capacity (judging between private parties) but also in an ex-parte examination which may save the parties the time and expense of engaging in an inter-partes action. In so doing the registrar is applying known facts to determine intent and seek to protect not just the famous person but also the average consumer who would be misled ...***”.
12. With reference to the Judgment of Henry Carr J in Trump International Ltd v DTTM Operations LLC [2019] EWHC 769 (Ch) the Hearing Officer said in paragraph [26]:

“... that decision clearly gives the registrar the authority to ask relevant questions, in an ex parte situation as much as an inter-partes one, to ascertain if an objection under bad faith is appropriate.”

13. The Hearing Officer acknowledged in paragraphs [19] and [28] that there is no right of publicity or personality or right to protect a person’s image or likeness in the UK, but treated that as inconsequential for the purposes of the Registrar’s bad faith filing objections in view of the scope for rights to exist on the basis that ***“there have been a number of cases concerning a famous person’s goodwill under the common law action for passing off”*** with the definition of ‘endorsement’ given by Laddie J in Irvine v Talksport Ltd [2002] EWHC 367 (Ch) at paragraph [9] being one example ***“on the question of the goodwill which may be held by a famous person”***.
14. The ‘first to file’ principle was treated as inconsequential for the purposes of the Registrar’s objections to registration on the basis of bad faith filing: paragraph [23].
15. The Hearing Officer referred in paragraph [25] to ***“one further fact which I believe to be relevant”***. This was that: ***“In correspondence dated 3 June 2021 Mr Dear informed me that he has hundreds of similar marks to register. This points to a pattern of behaviour, or likely behaviour which would have the capacity to further convince me that, if given free rein or carte blanche to register these marks, Mr Dear’s actions could similarly impact the registration of trade marks and those relating to famous people in particular. I do not think it an exaggeration to say that there would be a serious risk of the mechanism of trade mark registration being brought into disrepute.”***
16. This general criticism of the Applicant did not sit easily with paragraph [27], where the Hearing Officer referred to the principle on which she had decided to waive the Registrar’s bad faith filing objections to Application No. 3591582 (CLARK) and Application No. 3591586 (WALLACE): ***“I have to point out that each mark is examined on its own merits ... such an approach may give rise to the question of,***

what level of fame is required in relation to whether the registrar decides to intervene on a given case. This is a question of individual circumstance ...”.

17. In paragraph [32], the Hearing Officer summed up her Decisions in a way which indicated that the Registrar was, in effect, conferring a ‘right to a name’ on the famous individuals concerned: “ ... *without the consent of [Ronaldinho / Henry] I consider the application to have been made in bad faith. Mr Dear was given the opportunity to obtain consent to the use and registration of the mark from [Ronaldinho / Henry] but he appears to have chosen not to do so.*”
18. The Applicant appeals under section 76 of the Trade Marks Act 1994 contending, in substance, that the Registrar’s rejections of its trade mark applications on the ground of bad faith filing were legally and procedurally flawed and that the Decisions under appeal should be set aside so as to enable the applications in question to move forward to publication for the purposes of opposition under section 38 of the Act and beyond that to registration in the absence of opposition.
19. On 6 March 2022, after the hearing of the present appeals, the Applicant filed a Form TM21 for each of the applications in issue requesting amendments to the list of goods in Class 25 so as to specify:
 - (i) in relation to Application No. 3595047 (RONALDINHO) that the goods “*will only be marketed and sold to online supporters of a Spanish League Football Club and not to the General Public or the Average Consumer. The clothing will only be sold online through a specific website targeting the above supporters.*”
 - (ii) in relation to Application No. 3587268 (HENRY) that the goods “*will only be marketed and sold to online supporters of a English Football Club through a specific online website targeted at only the above supporters. This trademark will not be marketed to the General Public or the Average Consumer.*”

20. The Registry has thus far declined to process the requests on the basis that the applications are under appeal and have been refused. The preliminary view indicated in the Registry's official letter of 22 March 2022 is that the proposed limitations are, in any event, not acceptable. That is because they are liable to create legal uncertainty in breach of 'the POSTKANTOOR principle' by identifying characteristics which may be present or absent without changing the nature, function or purpose of the specified goods: see RFC Trade Marks BL O/414/16 (25 August 2016) at paragraph [19]. If the Applicant nonetheless wishes to maintain that its proposed limitations can legitimately be accepted, it will need to take that point through to a determination by the Registrar in the first instance.
21. The Applicant and the Registrar were informed in the email notifying them of the date for the hearing of these appeals that on the basis of the matters raised for consideration in the Grounds of Appeal, I wished to receive submissions as to whether the Registrar was able of his own motion to raise and uphold the particular 'bad faith' objections that are now in question: (1) compatibly with the Applicant's right to a fair hearing by an independent and impartial tribunal; (2) consistently with the legal principles referred to by the Court of Appeal in Sky Ltd v SkyKick UK Ltd [2021] EWCA Civ 1121 at paragraphs [67] and [78].
22. In the Judgment of the Court of Appeal in Sky at paragraph [67] Sir Christopher Floyd stated as follows:

The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Magazacilik* at [45]
4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].
5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].
6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].
7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].
8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].
9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41]-[42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].
 11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Magazacilik* at [45].
 12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].
 13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88]; *Pelikan* at [54].
23. In paragraph [78] he confirmed that ***“an allegation of bad faith is ‘akin to an allegation of dishonesty’. In accordance with conventional principles, the party against whom bad faith is alleged must be told in clear terms the respects in which his conduct is to be so characterised, and the facts on which such an allegation is being made.”***
24. The Applicant adheres to its position as summarised in paragraph [6] above. The Registrar acknowledges that the initial examination letters would not suffice to establish a bad faith claim and that subsequent exchanges from the Registry prior to the hearing did not really help to establish the precise nature of the section 3(6) claim beyond the initial examination letter.
25. The Registrar maintains that it was nonetheless implicit that the Registry regarded the act of knowingly filing applications in the names of famous people, in and of itself, comprised an act of bad faith (‘free riding’) which required explanation on the part of the Applicant and none has been forthcoming. The Registrar's position

is that in the circumstances of the implicit form of objection and on the basis that no explanation of any plausible connection in trade between the Applicant and famous footballers has been provided, which may have offset what he refers to as the ‘rebuttable presumption of bad faith’, the ground of refusal is still applicable.

26. More specifically with regard to the ‘rebuttable presumption of bad faith’ the Registrar’s representative submitted that:

Only the Applicant really knows what its true ‘subjective intention’ was. The Registrar can only make an assumption ... What we do know is that there was nothing to indicate any connection between the famous names or their clubs and the Applicant.

Under European law, such as the *Neymar* case, the very act of applying for the registration of a trade mark using the name of a famous person, but without any commercial connection, amounted to ‘free riding’ on that person’s fame, which in turn amounted to an act of bad faith. So, in the Registrar’s mind there was a rebuttable presumption on that basis which the Applicant had to dispel.

Taking the proceedings as a whole, including correspondence and hearing, the Registrar submits that the Applicant has failed to displace the rebuttable presumption. ... Furthermore the conclusion arrived at by the Registrar is wholly consistent with the principles identified in the *Sky* case ... Specifically principle 4, in the sense that, as per *Neymar* there is a prima facie case of ‘free riding’, which according to the European Authorities at least amounts to, in and of itself, an act of bad faith. 7 and 8, in the sense that the Registrar was obliged to conduct a stringent assessment which served to undermine any presumption the applications were made in good faith and from the information provided was entitled to arrive at a rebuttable presumption of bad faith.

27. In view of the emphasis that has been placed on the enforcement of a ‘rebuttable presumption of bad faith’ in the Decisions under appeal and in the Registrar’s submissions before me, it is necessary to consider the required approach to the assessment of evidence filed in relation to an accusation of bad faith filing.

28. The Judgment of the General Court in Case T-663/19 Hasbro Inc v EUIPO EU:T:2021:211 confirmed at paragraphs [42] and [43] that:

[42] It is for the applicant for a declaration of invalidity ... to prove the circumstances which make it possible to conclude that an application for registration was filed in bad faith, the good faith of the Trade mark applicant being presumed until proven otherwise ...

[43] Where EUIPO finds that the objective circumstances of the particular case which were relied on by the applicant for a declaration of may lead to the rebuttal of the presumption of good faith which the proprietor of the mark at issue enjoys when he or she files the application for registration of that mark, it is for the proprietor of that mark to provide plausible explanations regarding the objectives and commercial logic pursued by the application for registration of the mark.

It is incumbent on the accuser to overcome the ‘rebuttable presumption of good faith’. That is done by filing evidence which is sufficient to make it possible for the decision taker to conclude that the contested application for registration was filed in bad faith. The decision taker can then proceed to find: (i) that the ‘rebuttable presumption of good faith’ has been rebutted if the person accused of bad faith filing has provided no ‘plausible explanations’ for pursuing the contested application for registration; or (ii) that the ‘rebuttable presumption of good faith’ has not been rebutted if the accused person has provided such ‘explanations’. The end result of the process of assessment is an overall finding to the effect that **the accuser** has (or has not) succeeded in rebutting the ‘rebuttable presumption of good faith’. In my view, it is inconsistent with the governing presumption to invert that into an overall finding to the effect that the **accused person** has (or has not) succeeding in rebutting a ‘rebuttable presumption of bad faith’.

29. The Registrar acknowledges that the Judgment of Henry Carr J in Trump International Ltd (above) was delivered in the context of inter partes proceedings

(and so also, I would add, were the comparable decisions in Sherlock Systems C.V. v Apple Inc BL O/015/17 (18 January 2017); Paper Stacked Ltd v CK Holdings NV (ALEXANDER Trade Mark) BL O/036/18 (18 December 2017); and Case R 2445/2017–G Fashion TV Brand Holdings CV v CBM Creative Brands Marken GmbH (SANDRA PABST Trade Mark) (EUIPO Grand Board of Appeal, 11 February 2020); so, too, was the Judgment of the General Court in Case T-795/17 Moreira v EUIPO (NEYMAR) (above) which is heavily relied on by the Registrar). It is nevertheless contended on his behalf that paragraphs [54] and [85] of Trump International support the view that he can of his own volition raise and determine an *ex officio* objection on the ground of bad faith filing in relation to applications for registration such as those in issue here.

30. In those paragraphs of his Judgment, Henry Carr J said:

[54] Finally, as to Mr Gleissner’s concerns that the Decision may prevent him, or companies which he controls, from filing trade mark applications in the future, that depends on the nature of the mark filed. If it has no connection with a third party (for example an application to register “GLEISSNER TV”) then the Decision should not prevent such an application. Absent evidence to the contrary, such an application would not be in bad faith. However, if the application is in respect of a sign which is identical or similar to a mark owned by a third party, of which there are many examples in the evidence, then he is right to be concerned. Such applications should not be made in the future, whether by Mr Gleissner or by companies which he controls.

...

[85] In these circumstances, the Registrar seeks guidance from the Court as to how the IPO should deal with such applications in the future. Whilst the decisions discussed in this judgment suggest that the IPO is applying the correct approach, the following may be of some assistance:

- i) Where an application is made for a well-known trade mark with which the applicant has no apparent connection, this requires explanation and justification by the applicant;
- ii) Other instances of such applications by the applicant (or persons or companies connected to the applicant) may be admissible as similar fact evidence and may refute the explanation and justification provided by the applicant;
- iii) It is necessary to distinguish between unsubstantiated allegations and established facts of direct relevance to the case before the IPO. In the present case the similar fact evidence was potentially probative and it was just to consider it;
- iv) The *Alexander* questions provide a useful structure for considering allegations of bad faith, as shown by the Decision of the Hearing Officer in the present case. However, like the *Pozzoli* questions, which provide a structured approach to the issue of inventive step in relation to patents, they are not a substitute for the statute and do not have to be used in every case. Bad faith has numerous manifestations and cannot be classified comprehensively.
- v) The Registrar may strike out proceedings brought for an ulterior and improper purpose as an abuse of process; and
- vi) The power to strike out must be exercised with caution. However, where a *prima facie* case of bad faith is established, and no evidence in answer is filed on behalf of the applicant, it may well be appropriate to exercise that power.

31. With regard to the ‘pattern of filing’ element that played a large part in the determination of the Trump International case and additionally with regard to the existence of a ‘duty to explore’, the Registrar’s representative submitted:

From the Registrar's perspective, the marks 'Henry' and 'Ronaldinho' were and still are famous names to many within the UK and not just football fans, despite both individuals having retired from football at the time the applications were made. In both cases, their identities were reinforced by the overall context of the marks as a whole, consisting also of badges, if not identical to the badges of the most famous teams they played for, then very close imitations.

This, in particular, coupled with the fact that the Applicant in correspondence dated 3 June 2021 had admitted to a desire to file many other applications along the same lines ... pointed, in the Registrar's opinion, to the fact that the *Trump* case had some relevance and resonance.

The Applicant had clearly filed previous applications also along the same lines but perhaps because the names of those individuals did not enjoy the same level of fame, particularly at a national level, as the names in suit these were not faced with the same difficulties.

The Registrar acknowledges however this may not be the equivalent of the probative 'pattern of filing' evidence found in the *Trump* case, but nevertheless that case, at the very least, could be said to support the proposition that the Registrar had a duty to explore the nature of any possible commercial links the Applicant had or did not have with the famous people concerned, and which may have provided a legitimate reason for the filing of these applications.

32. For the reasons given in paragraphs [58] to [65] below, I do not accept that the observations of Henry Carr J in the Trump International case can bear the weight that the Registrar seeks to place upon them for the purposes of the present proceedings.
33. Section 2(1) of the 1994 Act provides that: "***A registered trade mark is a property right obtained by the registration of the trade mark under this Act ...***". This reinforces the point that the rules for obtaining and retaining protection by registration proceed on the basis that title to a protected trade mark arises solely by virtue of an entry in the register identifying the natural or legal person(s) to whom the original certificate of registration is issued on completion of a procedure initiated

by a simple request for registration filed in the required manner. There is no legal or administrative requirement for a person requesting registration to make an *a priori* claim to proprietorship of the trade mark he is putting forward for protection. The present system factors nothing more than the concept of acquiring ‘title by registration into the application stage and leaves it to those who would wish to contend that title has not been validly acquired to object on grounds available for that purpose under the Act: Ennis v Lovell (THE SWINGING BLUE JEANS Trade Mark) BL O/148/14; [2014] RPC 32; paragraphs [9] and [10].

34. Section 3(6) of the Act (implementing what is now Article 4(2) of Directive (EU) 2015/2436) provides that: ***“A trade mark shall not be registered if or to the extent that the application is made in bad faith”***. The basic proposition is that the right to apply for registration of a trade mark cannot validly be exercised in bad faith. The invalidity of the application is not conditional upon the trade mark itself being either registrable or unregistrable in relation to any goods or services of the kind specified. The objection is absolute in the sense that it is intended to prevent improper use of the system for acquiring title to a trade mark by registration.
35. An objection to registration on the basis of bad faith filing can be pursued by any natural or legal person and not only by holders of prior rights: Joined Cases T-3/18 and T-4/18 Holzer v Cia, SA de CV v EUIPO (ANN TAYLOR and AT ANNE TAYLOR) EU:T:2019:317, paragraph [56]. There is ***“no requirement whatsoever”*** for the objector to be the proprietor of an identical or similar earlier mark or sign protected by registration or by use in the United Kingdom: Case C-528/18P Outsource Professional Services Ltd v EUIPO EU:C:2010:961, paragraphs [71] and [72]; Case T-167/20 Tornado Boats International ApS v EUIPO EU:T:2021:257, paragraphs [49] and [76] to [78]; Case T-273/19 Target Ventures Group Ltd v EUIPO EU:T:2020:510, paragraph [30]; all citing Case C-104/18P Koton Magazacalik Textil Sanayi ve Ticaret v EUIPO EU:C:2019:724, paragraph [53].
36. The assessments which are relevant in order to establish whether relative grounds of objection exist under section 5 of the Act are not necessarily applicable to a

finding of the existence of bad faith: Joined Cases T-3/18 and T-4/18 Holzer v Cia. SA de CV (above), paragraph [55].

37. The intention of the applicant for a trade mark is a subjective factor which must be determined objectively by the competent administrative or judicial authorities. Consequently, any claim of bad faith must be the subject of an overall assessment taking into account all the factual circumstances relevant to the particular case, it is only in that manner that a claim of bad faith can be assessed objectively: Case C104/18P Koton (above), paragraph [47] citing Case C-529/07 Chocoladefabriken Lindt & Sprungli AG EU:C:2009:361, paragraphs [37] and [42]; and see Sky Ltd v SkyKick UK Ltd (above), paragraph [67(9)].
38. The General Court has repeatedly pointed out that the concept of bad faith is not defined, delimited or even described in any way in the applicable legislation.
39. The Court of Justice has ruled that there must be objective, relevant and consistent indicia tending to show that, when the application for a trade mark was filed, the trade mark applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: Case C-371/18 Sky Plc v SkyKick UK Ltd EU:C:2020:45, paragraphs [75], [77] citing Case C-104P Koton (above), paragraph [46].
40. The General Court speaks of the need for a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive involving conduct which departs from accepted principles of ethical conduct or honest commercial and business practices: for example, Case T-663/19 Hasbro Inc. v EUIPO (above), paragraph [41] (permission to appeal to the Court of Justice in Case C-373/21P was refused by Order dated 1 December 2021: EU:C:2021:983); and see Sky Ltd v SkyKick UK Ltd (above), paragraph [67(4)]. Case T-795/17 Moreira v

EUIPO (NEYMAR) (above) is one of a steady stream of cases in which the General Court has identified this as the test for bad faith which it was applying.

41. The required determination is, on any view of the matter, fact sensitive and case specific. It falls to be made with due regard for the fact that the trade mark applicant is best placed to provide the decision taker with information as to his or her intention at the time of the application for registration: Case T-663/19 Hasbro Inc. (above) paragraph [44]; Case T-592/20 Univers Agro EOOO v EUIPO EU:T:2021:633, paragraph [33] citing Joined Cases T-3/18 and T-4/18 Holzer v Cia. SA de CV (above) paragraph [37]. However, that does not reduce or eliminate the need for the accuser to give notice in clear terms of the respects in which the conduct of the applicant for registration is alleged to have involved or amounted to bad faith filing and of the factual basis on which the accusation is made; and nor does it reduce or eliminate the need for the decision taker to proceed on the basis that innocence is to be presumed unless and until it is proved, on the balance of probabilities, that the contested application for registration was filed in bad faith as alleged (see paragraphs [23] and [28] above).
42. I regard it as self-evident that there can be no carve out or special exemption for the names of famous individuals from the legal considerations and requirements applicable to bad faith filing objections noted above. The Registrar's practice statement on famous names came up for consideration in Campbell v Hughes (IAN ADAM Trade Mark) BL O/094/11 (7 March 2011); [2011] RPC 21; at paragraphs [18] and [30]. My approach was (and remains) that: ***“There is ... no wooden rule to the effect that any application to register the name of a [deceased] celebrity must always or necessarily be objectionable on the ground of bad faith.”*** I will now expand on that proposition for the purposes of the present appeals.
43. The practice statement (paragraph [2] above) is, on the face of it, applicable to famous names: irrespective of whether they are protected by registration in the United Kingdom under the 1994 Act; irrespective of whether they qualify for protection in the United Kingdom as well-known marks under section 56 of the Act;

irrespective of whether they have actually been used as trade identifiers in the course of trade in the United Kingdom; and irrespective of whether the name in question refers to an individual who (or whose successors) could only pursue a ‘false endorsement’ objection to registration under the provisions of sections 5(1) to (4) of the Act if they were able to establish proprietorship of the right to object thereunder as required by Articles 2 and 5 of The Trade Marks (Relative Grounds) Order 2007. The requirement for consent to be obtained presupposes the existence of a right to object which the Registrar is entitled to step in and protect of his own volition in a way **“which may save the parties the time and expense of engaging in an inter-partes action”** (paragraph [29] of the Hearing Officer’s Decisions).

44. It seems to me that bad faith filing objections on the basis envisaged by the Registrar’s practice statement amount to the assertion of a specially protected right for the names of famous individuals. The source of that approach under the 1994 Act was identified by Mr Mike Reynolds in his Decision on behalf of the Registrar in JANE AUSTEN Trade Mark [2000] RPC 32 at p.890, lines 17 to 26:

The Notes on the Trade Marks Act (based on the Notes on Clauses which were prepared for use in Parliament when the Trade Marks Bill was before it) suggest, by way of example, that bad faith might be found: “(iii) where the mark incorporates the name of a well-known person without his agreement. (This should not be taken as meaning that this provision is legislating for the protection of a personal name or reputation — these remain unprotected under English law, but the nexus between unregistrability and the name of a well-known person is that of the bad faith in which the application is made.)”

The distinction drawn in the text in parentheses is, to me at least, elusive.

45. In its effort to single out famous names for special attention the Registrar’s practice statement goes against the grain of the policy decision recorded in the White Paper on Reform of Trade Marks Law (Cm 1203) published in September 1990:

3.10. At present the Registrar has discretion when considering whether to register a trade mark or to remove a mark from the register. **He is able for example to refuse marks which make unauthorised use of the name or image of a real person**, and to take account of obligations under the Paris Convention. This discretion has been in the law since 1883 and there is a century of precedents guiding the Registrar in its exercise.

3.11. Such administrative discretion is however out of place in a modern trade mark law. The grounds of objection to registration should be found in the statute, and a mark should be entitled to be registered unless such grounds apply. Moreover, as already noted ... the Directive contains an exhaustive list of permissible grounds for refusal. ...

46. The discretion to refuse registration of the name or representation of **'Living persons or persons recently dead'** was expressly conferred by Rule 18 of the Trade Marks Rules 1938 (in substance repeating Rule 15 of the Trade Marks Rules 1906). Rule 18 provided:

Where the name or representation of any person appears on a trade mark, the Registrar shall, if he so requires, before proceeding to register the mark be furnished with consent from him or, in the case of a person recently dead, from his legal representatives, and in default of such consent he may refuse to register the mark.

I do not see why the policy considerations which led to the jettisoning of the practice carried forward from the Trade Marks Act 1905 to the Trade Marks Act 1938 by Rule 18 should not also be taken to have ruled out anything approximating to a re-adoption of Rule 18 by a practice statement designed to protect **'the name of a famous individual or a recently deceased famous individual'** under the Trade Marks Act 1994.

47. Article 4(4)(c)(i) and (ii) of Directive 89/104/EEC (now Article 5(4)(b)(i) and (ii) of Directive (EU) 2015/2436) optionally provided that:

Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that ... the use of the trade mark may be prohibited by virtue of ... in particular: (i) a right to a name; (ii) a right of personal portrayal; ...

The law of England does not confer any general ‘right to a name’ or general ‘right of personal portrayal’ to which those optional provisions could have been extended. And yet the implementation of Registrar’s practice statement in cases such as the present seems to me to be setting up such rights for assertion against trade mark applicants under section 3(6) of the Act. As does the Registrar’s reliance on the Neymar case to support what happened in the present proceedings ‘under European law’.

48. In Neymar the General Court decided, after considering the evidence and submissions received from both sides to the proceedings before it, that Neymar Da Silva Santos Junior was entitled to object to Carlos Moreira’s application to register NEYMAR as an EU trade mark for “*clothing, footwear, headgear*” in Class 25 on the ground of bad faith filing. The Court did not base its decision on any *a priori* approach of the kind set out in the Registrar’s practice statement. Nor did it apply any rebuttable presumption of bad faith. To the contrary, it stated in paragraph [24] of its Judgment: “***Moreover, it is for the applicant for a declaration of invalidity seeking to rely on that ground to prove the circumstances which substantiate a finding that the EU trade mark proprietor was acting in bad faith when the application for registration of that mark was filed***”, it then referred in paragraph [48] to Mr Moreira’s complaint that: “***the Board of Appeal also established a presumption that knowledge of a person’s renown is sufficient to ascertain bad faith on the part of the applicant for registration of a trade mark bearing the same name***” and proceeded to reject the complaint in paragraph [52]: “***Moreover, it is clear from paragraph 50 above that the Board of Appeal assessed the factors mentioned above in the specific context of the present case. Accordingly, it cannot be considered in any way that, in so doing, the Board of Appeal established any general presumption that the fact that the applicant for registration of a mark***

consisting of a word element identical to a person's name has knowledge of that person's renown is sufficient to ascertain, automatically, bad faith on the part of that applicant."

49. The Judgment of the General Court in the Neymar case does not endorse or legitimise either the adoption of an *a priori* approach to bad faith filing or the adoption of a rebuttable presumption of bad faith filing for the protection of famous names. It therefore does not provide support for those aspects of the *ex officio* approach to bad faith filing set out in the Hearing Officer's Decisions and the Registrar's submissions on appeal. The difficulty, as I see it, with attempting to uphold the Registrar's practice statement as it stands is the way in which it overwrites relevant legal and procedural considerations.
50. The Judgment of Kitchin LJ in Fenty v Arcadia Group Brands Ltd [2015] EWCA Civ 3 comprehensively explains and confirms at paragraphs [29] to [43]: that *"there is in English law no 'image right' or 'character right' which allows a celebrity to control the use of his or her name or image"* (paragraph [29]); that *"A celebrity seeking to control the use of his or her image must therefore rely upon some other cause of action such as breach of contract, breach of confidence, infringement of copyright or, as in this case, passing off."* (paragraph [33]); that *"It is of course inherent in these propositions that, registered trade marks aside, no-one can claim monopoly rights in a word or name. Conversely, however, no-one may by the use of any word or name, or in any other way, represent his goods or services as being the goods or services of another person and so cause that other person injury to his goodwill and so damage damage him in his business."* (paragraph [34]); that (as decided by Laddie J in Irvine v Talksport Ltd [2002] EWHC 367 (Ch) at paragraph [46]) *"there is nothing which prevents an action for passing off succeeding in a false endorsement case"* (paragraphs [39], [40]); that *"it by no means follows that simply because the name or image of a celebrity appears upon a consumable commercial item, the public will assume that it has in some way been endorsed by that celebrity."* (paragraph [41]); and in agreement with the observations of Simon Brown LJ in Elvis Presley Trade Marks [1999] RPC 567)

that “*Each case must, he considered, be decided on its own facts. He concluded, at p.598: ‘In addressing the critical issue of distinctiveness there should be no a priori assumption that only a celebrity or his successors may ever market (or licence the marketing of) his own character. Monopolies should not so readily be created.*” (paragraph [42].

51. In paragraph [40] Kitchin LJ expressly approved what Laddie J had said in Irvine v Talksport Ltd with regard to what a claimant must establish in a false endorsement case:

... the burden on the claimant includes a need to establish at least two, interrelated, facts. First, that at the time of the acts complained of he had a significant reputation or goodwill. Second, that the actions of the defendant gave rise to a false message which would be understood by a not insignificant section of his market that his goods have been endorsed, recommended or approved of by the claimant.

52. The Registrar’s practice statement is silent as to whether or how enforcement of the **absolute** right of objection it envisages for the protection of famous names under section 3(6) of the Act is to be reconciled with: (1) the existence or absence of a **relative** right to object under section 5 of the Act compliantly with the legal principles and requirements referred to in paragraphs [50] and [51] above; and (2) the prohibition contained in Article 2 of The Trade Marks (Relative Grounds) Order 2007 which restricts the Registrar’s power to act pre-grant for the protection of section 5 rights in opposition proceedings: “**The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right**” and the prohibition to the same substantive effect contained in Articles 5(1) and (2) of the Order which restricts the Registrar’s power to act post-grant for the protection of such rights in invalidity proceedings.

53. In Decision BL O/629/21 the Hearing Officer made the following assessment in relation to the trade mark put forward for registration in Application No. 3595047 (RONALDINHO):

[17] ... As one of the clubs that 'Ronaldinho' famously played for was F.C. Barcelona, [the badge] will reinforce the message that the mark refers to the well-known footballer, 'Ronaldinho', who is often considered one of the best players of his generation and regarded by many as one of the greatest of all time. I would further add that the silhouette image of the player himself includes his characteristic long flowing hair at the back. There is no doubt in my mind that the mark as a whole references, as far as the relevant consumer is concerned, the famous ex-player for F.C. Barcelona, known in the UK most usually and commonly by his nickname Ronaldinho. I should perhaps note that 'Ronaldinho' is in fact a nickname, his real name being Ronaldo de Assis Moreira. Nothing turns on this point as there is no doubt in my mind that it is by the name 'Ronaldinho' that most people in the UK will refer to and recognise this ex-player. As far as the UK consumers are concerned the name 'Ronaldinho' is, furthermore, distinctive in a broad sense, as a name alone and on the basis of inherent characteristics.

...

[19] As I have previously stated, well known personalities are known to endorse products and I consider it more than likely that anyone seeing this mark on the goods applied for would expect 'Ronaldinho' to have endorsed or otherwise had some control over them, and in view of his fame, consumers would be encouraged to buy those goods. ... there have been a number of cases concerning a famous person's goodwill under the common law action of passing off. A trade mark registration held by someone completely unconnected to Ronaldinho himself would, in my opinion, not just free ride in relation to his reputation but potentially impede Ronaldinho's legitimate use of his own name in the course of trade or, for example, in respect of which Ronaldinho himself would have no wish to be associated. ...

54. In Decision BL O/630/21 the Hearing Officer made the following assessment in relation to the trade mark put forward for registration in Application No. 3587268 (HENRY):

[17] ... Thierry Henry is considered an iconic striker and one of the greatest players in the history of the Premier League. He signed for Arsenal in 1999 and became Arsenal's all-time leading scorer and spent his final two seasons with Arsenal as club captain. There is no doubt in my mind that the mark, as a whole, references as far as the relevant consumer is concerned the well known player Thierry Henry.

...

[19] As I have previously stated, well known personalities are known to endorse products and I consider it more than likely that anyone seeing this mark on the goods applied for would expect Thierry Henry to have endorsed or otherwise had some control over them, and in view of his fame, consumers would be encouraged to buy those goods ... there have been a number of cases concerning a famous person's goodwill under the common law action of passing off. A trade mark registration held by someone completely unconnected to Henry himself would, in my opinion, not just free ride in relation to his reputation but potentially impede Henry's legitimate use of his own name in the course of trade or, for example, in respect of which Henry himself would have no wish to be associated. ...

55. These were to all intents and purposes findings that the trade mark applications in issue conflicted with earlier unregistered rights which Ronaldinho and Henry could successfully have asserted against the applications for registration on relative grounds under section 5(4)(a) of the Act: ***“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 ...”***
56. The assessments proceeded by way of assertion without (or, at least, without reference to) any evidence or specified sources of information. They did not allow

for the proposition that *“there should be no a priori assumption that only a celebrity or his successors may ever market (or licence the marketing of his own character”* (see paragraph [50] above and see further the discussion in Kerly’s Law of Trade Marks and Trade Names (16th Edition, 2018) at paragraphs 10-336 to 10-344). To the contrary, they proceeded on the premise that the Registrar’s objection was reinforced by a *“rebuttable presumption of bad faith”*. The Registrar’s absolute objection under section 3(6) of the Act could not be assimilated with or to an objection on relative grounds under section 5(4)(a) of the Act without requiring him to consider the scope and effect of the prohibition contained in Articles 2 and 5 of the 2007 Regulations. However, it is not apparent from the Decisions under appeal that any consideration was given to the implications of that (“am I permissibly sidestepping that prohibition?”).

57. For the reasons I gave in MR MIYAGI’S Trade Mark BL O/171/22 (2 March 2022), I consider that bad faith filing is a free standing basis of objection on absolute grounds under section 3(6) which is neither governed nor exhausted by the operation of the relative rights provisions of section 5 of the Act. I see no reason to suppose that the free standing objection under section 3(6) is intended to operate as a substitute for other substantive grounds of objection. It provides a basis of objection to registration which must be fully and fairly assessed in accordance with the legal considerations and requirements noted in paragraphs [22], [23], [28] and [33] to [42] above. The assessment should, in my view, be made without predilection of the kind envisaged for the protection of famous names in the Registrar’s practice statement and without resorting to a rebuttable presumption of bad faith. I note that in Case C-529/07 Chocoladefabriken Lindt & Sprungli AG EU:C:2009:361 at paragraph [53] the Court of Justice referred to *“the degree of legal protection enjoyed by the third party’s sign”* as a relevant factor for consideration in the context of a claim for bad faith filing. I do not, at the moment, see how the presumption of innocence can be rebutted by pretending that the law of England is not what it actually is with regard to the absence of any general ‘right to a name’ or general ‘right of personal

portrayal'. However, it is not necessary for me to come to a conclusion on that particular point in order to resolve the appeals before me and I do not do so.

58. Section 47(4) of the Act provides that: ***“In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.”*** The Registrar is not permitted to determine whether the bad faith filing objection which he himself has raised is well-founded: he is required to bring the matter before the court for independent and impartial determination with all appropriate procedural safeguards in place for the protection of the rights of the proprietor of the contested trade mark registration. This operates in situations where the relevant trade mark application has been published for the purposes of opposition under section 38(1) and then proceeded to registration either without being opposed or after surviving any opposition which may have been filed under section 38(2). I make two observations at this point. First, when the Registrar is deliberating on whether to apply to the court under section 47(4), he is in a position to take full account of the fact that no one else has (successfully) objected to the trade mark application using the inter partes procedure for opposition under section 38. Second, the Registrar is able by means of an application to the court under section 47(4) (which can, in principle, be made as soon as the trade mark in question has been registered) to exercise vigilance and control in relation to matters of the kind referred to by Henry Carr J in Trump International and do so adversarially without embarking on any departure from the basic principles and safeguards applicable to independent and impartial judicial determination.
59. The pre-grant procedure for opposition under section 38 is designed to operate adversarially, with the Registrar being the independent and impartial tribunal entrusted with the task of adjudicating on any bad faith filing objection which the parties to the opposition may have raised for determination under section 3(6). I say **“the”** independent and impartial tribunal because oppositions to registration must and can only be brought and pursued to a determination in the first instance by means of proceedings commenced in the Trade Marks Registry under section 38 as part of the registration procedure laid down in sections 37 to 41 of the Act. It is not

possible to initiate applications for registration or commence opposition proceedings before the court. Moreover, the Registrar has no power to refer pending applications for registration or pending opposition proceedings to the court for determination (c.f. the power of referral to the court conferred on the Registrar by section 46(4)(b) in relation to pending registry proceedings for revocation and by section 47(3)(b) in relation to pending registry proceedings for invalidity).

60. I think it is procedurally asymmetrical to suggest that the Registrar's practice statement stands as a platform for protecting famous names on the basis of which he may of his own volition raise and determine a bad faith filing objection to an application for registration before it has been published for the purposes of opposition under section 38(1). By acting in that way, the Registrar becomes an adversary of the applicant for registration outside the scope of the power to act adversarially which section 47(4) of the Act expressly confers upon him. Moreover, he does so at a time when he ought not to be compromising his ability to act as an independent and impartial tribunal in any opposition proceedings which might be brought under section 38(2) on the basis of bad faith filing after the application for registration has been published under section 38(1).
61. An application for registration is an object of property under sections 22 and 27(1) of the Act and protected as a possession for the purposes of Article 1, Protocol 1 of the European Convention on Human Rights: Anheuser-Busch Inc. v Portugal (2007) 45 EHRR 36; CE:ECHR:2007:0111; paragraphs [73] to [78].
62. On orthodox principles, a decision of the Registrar determining the legal status of an application for registration in the exercise of his powers and duties under the Act falls to be regarded as a quasi-judicial decision. He is required by section 6 of the Human Rights Act 1998 and Article 6(1) ECHR to act so far as possible as an independent and impartial decision taker in that regard. I do not accept that paragraphs [54] and [85] of Trump International can or should be interpreted as permitting or requiring the Registrar to depart from that fundamental principle of judicial decision taking. His duty to carry out what the Court of Justice has

emphasised should be a stringent and full examination of trade mark applications for registrability also provides no justification for departing from that fundamental principle.

63. There has never (so far as I am aware) been a time in the history of trade mark registration in this country, from enactment of the first trade mark registration statute in 1875 down to the present day, when the Registrar has carried out *ex officio* investigations for the purpose of examining trade mark applications for conflict with **earlier unregistered rights**. The Registrar's duty of *ex officio* examination for conflict with **earlier registered trade mark rights** existed in one form or another in successive statutory provisions running forward from section 6 of The Trade Marks Registration Act 1875 to section 37(2) of the Trade Marks Act 1994. However, section 37(2) of the 1994 Act ceased to have effect on 1 October 2007 by virtue of Article 3 of The Trade Marks (Relative Grounds) Order 2007. The Registrar has not since then been under any statutory duty or obligation to object to applications for registration for the protection of earlier registered trade mark rights. Pursuant to Article 4 of the 2007 Order and Rule 14 of the 2008 Rules, he gives notice to persons affected by what he would or might previously have objected to as conflicts with earlier registered trade mark rights and leaves it to the persons concerned to decide what (if anything) they wish to do about that.
64. In the present case, the Registrar's objections to the Applicant's trade mark applications No. 3587268 (HENRY), No. 3591582 (CLARK), No. 3591586 (WALLACE) and No. 3595047 (RONALDINHO) involved *ex officio* examination with a view to establishing whether these were the names of famous individuals who might themselves have made a claim for bad faith filing based on the Registrar's practice statement. This was what I would describe as a targeted examination procedure: the investigations were, in substance, directed to examination of the trade mark applications for conflict with **unregistered rights** and they were, in substance, undertaken with a view to rebutting the presumption of innocence or (as the Registrar maintains) establishing a rebuttable presumption of bad faith. This is not,

according to my understanding, a process of *ex officio* examination to which trade mark applications in general are subjected.

65. I am well aware that the examiners in the Trade Marks Registry carry out searches for the purpose of enabling them to assess whether signs are eligible for registration as trade marks in accordance with the absolute requirements of the Act. Nothing I say in this Decision is intended to question their processes and procedures for assessing the registrability of signs as such. The point at issue in these appeals is not the registrability of the signs as such: there is no suggestion that they are, in themselves, unregistrable. The issue before me relates to the *ex officio* examination of the Applicant's behaviour for the purpose of deciding whether it was acting with ***“a dishonest intention or other sinister motive involving conduct which departs from accepted principles of ethical conduct or honest commercial and business practices”***. Metaphorically speaking, the Registrar acted as “investigator-prosecutor-judge-jury-executioner” in relation to a serious accusation which he himself had raised against a person entitled to the benefit of a rebuttable presumption of innocence.
66. For the reasons I have given, I consider that in the cases before me a legally deficient practice statement was enforced by the Registry in a procedurally unacceptable manner.
67. To be clear: I am intentionally saying nothing about what the outcome would or might be if any objections to registration were to be raised by Henry or Ronaldinho (or any economic operators connected with either of them) in relation to the trade mark applications in issue on these appeals; and by the same token I am intentionally saying nothing about the significance or otherwise of Mr Dear's statements at the hearing before me (Transcript p.50, line 20 to p.53, line 18) to the effect that the trade mark applications in issue were filed along with other trade mark applications for the purposes of a project which would as well as being a commercial enterprise, involve providing financial support for football players from the past and their families.

68. My determination is as follows:

- (1) the Applicant's appeals are allowed.
- (2) the Hearing Officer's Decisions issued under reference numbers BL O/629/21 (RONALDINHO) and BL O/630/21 (HENRY) are set aside.
- (3) Trade Mark Applications No. 3587268 (HENRY) and No. 3595047 (RONALDINHO) are remitted to the Registrar for further processing under the Trade Marks Act 1994 and the Trade Marks Rules 2008.

In accordance with the usual practice of this Tribunal on appeals against the rejection of applications for registration under section 37 of the Act and as confirmed at the hearing before me, I make no order as to costs.

Geoffrey Hobbs QC

30 March 2022

Mr Jim Dear (Company Director) appeared and also provided written submissions on behalf of the Applicant.

Ms Bridget Rees (Examination Practice Manager, Trade Marks and Designs) appeared and also provided written submissions on behalf of the Registrar.