

O-237-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2627536 IN THE NAME OF
SARAH ALEXANDER FOR REGISTRATION OF THE TRADE MARK



Bournemouth BJJ Open

AND

OPPOSITION THERETO UNDER NO 104115
BY DE SOUZA DOJO LIMITED

Background

1. On 6 July 2012, Sarah Alexander (“the applicant”) filed an application seeking registration of the trade mark shown on the front cover of this decision for the following services:

Class 41

Boxing and martial arts education, instruction and training; operating of boxing and martial arts schools and academies; entertainment services involving boxing and martial arts; organisation and provision of entertainment, sporting and cultural activities and events; organisation and provision of?boxing and martial arts competitions; organisation and provision of live entertainment events relating to boxing and martial arts; provision of sports facilities and training; rental of sports equipment; provision of non-downloadable electronic information and publications relating to martial arts; information, advice and consultancy in relation to all the aforesaid services.

2. Following publication of the application in *The Trade Marks Journal* on 17 August 2012, notice of opposition was filed by De Souza Dojo Limited (“the opponent”). The opposition is based on the following grounds under the Trade Marks Act 1994 (“the Act”):

- Under section 3(6) on the ground that the application was made in bad faith;
- Under section 5(4)(a) on the ground of passing off based on use of the following mark since February 2010.



3. The applicant filed a counterstatement in which the objections were denied. It states:

“I am a Director of Phoenix MMA UK Ltd and have the right to apply for a trademark for our company.

The trademark was not dishonestly applied for and was in fact done so after physical threats of violence from Alex Dezousa to enable us to continue trading legally with no hassle. We do not intend to directly or indirectly stop Dezousa dojo trading.

Our company has been registered since Nov 2010. Dezousa Dojo has only been a company since Oct 2012. We have never threatend Alex or Katie or their business and only look to continue what we are doing.”

4. In response to the comments made in the counterstatement, the opponent strongly challenged the claim that threats of violence had made. It also submitted that whilst the opponent company had been formed in October 2012, the business had previously traded as De Souza Dojo (presumably as a sole trader) since 2000 before becoming a partnership in 2009.

5. Only the opponent filed evidence. Neither party sought a hearing in this matter so I make this decision on the basis of all the written material before me.

The evidence

6. The evidence consists of a single witness statement by Katie De Souza dated 11 September 2013. Mrs De Souza states that both she and her husband Alex De Souza are directors of the opponent company. She states that the opponent has run an event in Bournemouth for participants of Brazilian Jiu Jitsu, known by its abbreviation BJJ, called Bournemouth BJJ Open. The first event was held in June 2010. Similar events were held in June 2011, 2012 and 2013 (the latter is after the relevant date in these proceedings). At KDS5, KDS12, KDS14 and KDS16 she exhibits copies of advertising posters for each of these events. Each of them advertises a Brazilian Jiu Jitsu competition taking place at the Littledown Centre in Bournemouth. The words “Bournemouth BJJ Open” appear at the top of each poster. At the bottom of each are what appear to be a number of company logos which includes one comprising a device of what I will refer to as the headdress device with the words De Souza Dojo. At KDS4, KDS14, KDS15 and KDS17 Mrs De Souza exhibits copies of invoices relating to the hire of a room in the Littledown centre on the dates shown in the above posters. The invoices have been redacted to remove the costs of the services provided by the centre and all are addressed to Mr De Souza.

7. At KDS18 a further invoice is exhibited. It is dated 15/06/10 and, whilst not addressed to anyone (it is marked “cash sale”) the customer reference is given as Alex De Souza. The invoice is from a screenprinting company at an address in Bournemouth and relates to some 28 printed/embroidered shirts along with a set up charge and what is described as “De Souza Logo and BBJJO Logo”. Again, the invoice has been redacted to remove the costs of the goods/services provided.

8. Mrs De Souza states that on 24 June 2012, she wrote a letter which is exhibited at KDS1. The exhibit is a single page letter which shows the headdress device and the words De Souza Dojo as its header. It is addressed to Mr Johnstone of Phoenix MMA at an address in Bournemouth. It states:

“We are aware that you are trading using a business name (Bournemouth No Gi Open) that is similar to our trading name of Bournemouth BJJ Open and that this therefore amounts to passing off”

9. The letter goes on to notify him to “stop and desist using your existing business name” and “change your existing business name to a name that is no longer misleading”. Mrs De Souza states that the letter was ignored.

10. Mrs De Souza states that Mr Johnstone and the applicant are both directors of Phoenix MMA Gym which was established in November 2010. At KDS 6 she exhibits a copy of an extract taken from the Companies House website which shows that a company called Phoenix MMA UK Ltd of an address in Fareham was incorporated on 18 November 2010. Whilst this differs from the name of the company Mrs De Souza says Mr Johnstone and the applicant are directors of, I assume this is a typographical error on Mrs De Souza’s part given the applicant’s comments in her counterstatement on the name of her company and as, at KDS3 Mrs De Souza exhibits a letter sent to her from Phoenix MMA UK Ltd dated 20 December 2012. The letter is signed by its directors (J Johnstone and S Alexander) and refers to a threat of opposition against its trade mark application which is the subject of this decision (which, the letter erroneously states, has a filing date of 17 August 2012).

11. The remaining exhibits to Mrs De Souza’s witness statement are as follows:

KDS7: a copy of the PhoenixMMA facebook page which gives an opening date of November 2010. It is not clear to me whether this is the date the page was opened or the date something else (e.g. the gym) opened but nothing rests on this;

KDS8: a copy of the bournemouthopen facebook page. It shows the page owner to be Katie De Souza with a joining date of 04/03/2010 and contains the heading “You are posting, commenting, and liking as Bournemouth Brazilian Jiu Jitsu Open-Change to Katie De Souza”;

KDS9: a copy of a page taken from the webwhois website. It shows that the domain name bournemouthopen.co.uk was registered on 25 February 2010 and the registrant as Katie De Souza;

KDS10: a copy of a page taken from the webshois website. It shows that the domain name bournemouthbjjopen.co.uk website was registered on 8 April 2012 and the registrant as Sarah Alexander;

KDS11: a copy of an extract taken from the bournemouthbjjopen.co.uk website which is said to show the website is not being used. The page shows a download date of 11 September 2013 and contains what is said to be sponsored listings which advertise other apparently unrelated businesses;

KDS19: a copy of an article from the Bournemouth Echo dated Friday June 15 2012. The article refers to a martial arts tournament which was taking place at the Littledown Sports Centre “on Saturday” and reports that “More than 300 Brazilian Jiu Jitsu (BJJ) fighters are set to compete at the fourth Bournemouth BJJ Open”. The article refers to Alex De Souza of De Souza Dojo in Bournemouth and shows a photograph of him and his wife along with other fighters wearing Gi;

KDS20: this consists of two pages. The first is a copy of an article from BJJSTYLE.COM. Entitled “JJS on the road” it is described as an “academy and instructor profile” of Alex De Souza of the De Souza Dojo in Bournemouth. The article is not dated but includes the following:

“Then in 2000 we went to Brazil on holiday and I started to train again. When I came back to the UK I decided to look for a jiu jitsu club, but there was nothing around in Bournemouth.

My wife said to me “why don’t you do your own thing Alex and start a club? so I decided this was a good idea. I hired out a church hall once a week and I only had two students and one of the guys only had one arm.”

The second page shows two undated photographs. There is no indication in the article of when Mr De Souza’s club started or what it may have been called.

12. That completes my summary of the evidence filed.

The objection under section 3(6) of the Act

13. The opponent’s claims under section 3(6) are set out in its pleadings as follows:

“The application 2627536 was only made after we sent the Phoenix Gym a letter requesting they stopped using a similar name to us, as this was already misleading the public. Therefore the application was made in bad faith.”

It goes on to state:

“We have been organising a bjj competition called Bournemouth BJJ Open since the year 2010. We have grown in success over the years by putting a lot of hard work into our events. Our most successful event to date was this year, 2012, where the Daily Echo newspaper interviewed us and published the article with photos in their magazine and the local radio station also interviewed us.

At around the time we were organising and leading up to our latest competition held in June 2012 we started receiving telephone calls from previous competitors asking about our other competition, the No Gi competition. We were a bit confused as we do not run a No Gi competition, all our competitions have been with the Gi on. (a Gi is the name of the jacket and trousers –uniform worn).

We then discovered that the Phoenix Gym (also in Bournemouth) was advertising a competition called Bournemouth No Gi Open, which was causing confusion amongst the public, as proved by the telephone calls we were receiving. We sought legal advice and was informed to write to them requesting they stopped using the name and stopped passing themselves off as us. This letter was dated 24 June 2012, sent recorded delivery and was

signed for at the Phoenix Gym. We did not receive any reply from the Phoenix Gym so we telephoned them a few weeks later to follow up only to be informed that they had received the letter but it was too late they had registered the name.

At first we were unsure what they meant by they had registered the name. After speaking again to a solicitor we decided to look at applying for a trade mark, it was only then that when I searched to see any earlier marks that I saw to my astonishment that the Phoenix Gym had applied to register our trade mark with their logo. They did not even apply for the competition name they were using for their event for which we had written to them asking to stop using (Bournemouth No Gi Open) no, they had actually applied for the name we had been using for years, Bournemouth BJJ Open, of which they have no right.

I also noted from the dates that instead of replying to our letter dated 24 June 2012 requesting they stop passing themselves off as us, instead they applied on the 6 July 2012 to the IPO for our trade mark, our exact name.

I believe I should give you some more back ground history between the two gyms for you to understand why perhaps the Phoenix Gym want to piggy back off our success and why they made an application in bad faith.

In the past (end of 2010, beginning of 2011) the owner of Phoenix Gym James (Jimmy) Johnstone came and trained at our gym under our Master Black belt instructor, Alex De Souza (my husband and also partner of De Souza Dojo). Jimmy was a blue belt when he arrived, after a short few weeks it became apparent he wanted to grade to the next belt up (purple), however it takes years of training to grade up the belts, he was not ready to grade as far as De Souza Dojo were concerned.

Jimmy left training with Alex (Jan 2011) as we believe students need to train, learn and earn their next belts, it take time and practise to improve. We didn't hear from Jimmy after that, we just continued with the running of our gym and focussed on our competitions.

Jimmy then found another instructor which he employed at his gym and within a few weeks became purple belt in May 2011, then a year later in June 2012 he became a brown belt. This was so exceptionally fast that the brazilian jiu jitsu community throughout the UK all questioned his gradings. There is a large bjj community online which involves most of the BJJ academies in the UK where they discuss all martial arts goings on etc. As Jimmy was a new gym owner on the scene having only opened his gym in November 2010, he made quite an impression (the wrong kind) of trying to advance himself as quickly as possible up the belts, I can only assume to try and achieve more students and success as quick as possible. Although if he understood what real bjj was about he would realise that being a good teacher, regularly participating in competitions and developing yourself and leading by example would bring great success rather than wrapping a high ranking belt around your waist.

Jimmy did not like being questioned and discussed by the bjj community and decided that it was us to blame for the other academies asking how he achieved his belts so fast. However we did not start the discussions and were not aware immediately when he received each of his belts as we had kept ourselves distant and got on with our own business and focused on our own success of building the reputation of our competitions.

We were only aware of Jimmy again in 2012 when he decided to put a competition using the name Bournemouth No Gi Open, which was very similar to our name.

At the beginning of the year 2012 we were contacted by the local newspaper, Daily Echo, and asked to do an interview about our competition, we were also contacted by a martial arts fighting magazine and had a three page article written about us including photos.

Our letter was dated 24 June 2012 and I note from IPO records that the application was made on 6 July, They did not ever reply to our letter and after a few weeks we telephoned them, it was during this conversation they had the pleasure in telling us its too late we've applied for the name.

At this point we did assume he referred to the similar name he was using to run his competitions (which would have been bad enough) but to our disbelief and astonishment he had applied for our exact name.

We have used the name Bournemouth BJJ Open for 3 years, 3 competitions in that name and already planning the 4th. We have become more successful, and appeared in a magazine and newspaper earlier in the year promoting our competition as well as on the local radio station.

I believe that the application 2627536 was made dishonestly and is well below the standard regarded as acceptable by the community at large. The Phoenix Gym is another martial arts gym in the same town, primarily targeting the same audience as us and working in the same martial art / bjj community as well as the Bournemouth community as a whole. They therefore are fully aware that we run a gym the same as them and that we already have been running our competitions which they have watched grow more successful over the years. Rather than working hard on gaining their own success under their own merit and name they decided to try and mimic us by initially putting a competition with a similar name 'Bournemouth No Gi Open', which was already a very under hand thing to do and not the type of activity expected by a reputable gym or business. They then went one step beyond trying to pass themselves off as us by practically trying to become us by trying to apply for our exact trade mark. This application was only made after we wrote to them asking them to stop using a similar name of 'Bournemouth No Gi Open.'

It would appear that rather than reply to us about our request they decided to deliberately cause trouble for us by applying to register our exact name trade mark of Bournemouth BJJ Open. Why would a business who put a

competition on in the name of Bournemouth No Gi Open then go within 2 weeks of being challenged about their name to registering another businesses name if it is not to cause deliberate confusion or trouble?

I think it is dishonest to apply for a trade mark which they have not been using and have no right to be using. There is strong evidence that their application is for malicious reasons as proved by the dates of their application. We wrote to them on the 24 June 2012, and instead of replying to us they applied for our trade mark name on 6 July 2012, less than 2 weeks later. This type of behaviour is very dishonest to fill out a declaration on the trade mark application form stating that the mark is theirs and in use, knowing full well that it has already been in use for 3 years by us.”

14. Section 3(6) of the Act reads:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

15. The law in relation to section 3(6) of the Act was summarised by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined”. See *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly’s Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-a-vis the relevant officer, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-a-vis third parties; see *Cipriani* at [1985].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant’s conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant’s own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSHON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant’s intention. As the CJEU stated in *Lindt v Hauswirth*:

“41. ...in order to determine whether there was bad faith, consideration must also be given to the applicant’s intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant’s intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a

Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

16. In accordance with the comments of Arnold J. at paragraph 131, the position is to be judged as of the date on which the application for registration was made. This is 6 July 2012. As stated above, an allegation of bad faith is a serious allegation which must be distinctly proved.

17. Whilst the opponent claims that there is “strong evidence that their application is for malicious reasons as proved by the dates of their application”, I note the application stands in the name of Ms Alexander only and there is, in fact, no evidence at all which shows any reason, malicious or otherwise, as to why she filed the application.

18. Mrs De Souza refers to the applicant’s gym advertising a competition under the name Bournemouth No Gi Open. There is no evidence before me which shows that the applicant or her company has put on a competition under this name but, even if she/it has, whilst it may seem to the opponent to be suspicious for the applicant or her company to have used this name, it seems to me that the name is no more than a natural description that the competition is an open one taking place in Bournemouth and where no Gi is required to be worn. The matter I have to consider, however, is not why the applicant applied for the mark the subject of this application instead of the name it might have used for its competition but rather whether this application itself was made in bad faith.

19. The opponent claims that it has organised a competition known as Bournemouth BJJ Open and alleges that “they decided to deliberately cause trouble for us by applying to register our exact name trade mark of Bournemouth BJJ Open”. Whilst these words appear in the applicant’s mark as applied for, this is not the entirety of the mark which also contains, as its largest and distinctive element, the device of what I take to be a stylised phoenix.

20. The opponent claims “it is dishonest to apply for a trade mark which they have not been using”, however, there is no requirement in law that a trade mark must be used before registration is sought. The opponent also claims it is dishonest to apply for a trade mark which ‘they’ “have no right to be using” but has provided no evidence to show the applicant has no right to use the mark for which she has applied i.e. a composite mark consisting of a device of a phoenix and descriptive words, the device presumably used in view of the name of the applicant’s company’s gym.

21. In written submissions the opponent rejects to claims made in the counterstatement regarding threats of violence and claims that this is “yet another

example of how underhand they run their business”. Whilst I have no reason to doubt that the opponent and the De Souza’s themselves have had dealings with the applicant and/or her co director in the past, a relationship which appears not to have been an entirely happy one, there is no evidence to show what past dealings they may have had nor is there any evidence which shows how the applicant’s business may be undertaken. In short, there is no evidence before me which shows that the mark the subject of this decision was applied for in bad faith.

22. The objection under section 3(6) of the Act fails.

The objection under section 5(4)(a) of the Act

23. Section 5(4)(a) of the Act states:

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

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

(b)

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

24. In deciding whether the applicant’s mark offends against this section, I refer to the guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 which is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously

expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

25. The first hurdle for the opponent is to show that it has goodwill. Goodwill was described by Lord Macnaughten in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

26. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business."

27. Millett LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 stated:

“It is well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property which is protected by an action for passing off is not the plaintiff's proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant's misrepresentation: see *Reddaway v. Banham* [1896] A.C. 199 per Lord Herschell; *Spalding v. Gamage* (1915) 32 R.P.C. 273 at page 284 per Lord Parker; *H.P. Bulmer Ltd. and Showerings Ltd. v. J. Bollinger SA and Champagne Lanson Pere et Fils (the Bollinger case)* [1978] R.P.C. 79 at page 93-4 per Buckley L.J.”

28. Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 commented upon the evidence that is required to establish goodwill (which is often referred to as reputation):

“27. There is one major problem in assessing a passing off 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 Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 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 at 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 possibilities that passing off will occur.”

29. Under this ground, the opponent claims to have an earlier right as shown above at paragraph 3 which consists of a headdress device and the words Bournemouth BJJ Open. It claims to have used it since 25 February 2010 in relation to: *organising competitions and events relating to martial arts; the provision of Brazilian Jiu Jitsu and martial arts education, instruction and training; operating of Brazilian jiu jitsu and martial arts schools and academies; entertainment services involving organising competitions in Brazilian jiu jitsu; organisation and provision of entertainment, sporting and cultural activities and events; organisation and provision of Brazilian jiu jitsu and martial arts competitions; provision of sports facilities and training and seminars in Brazilian jiu jitsu; information, advice and consultancy in relation to all*

the aforesaid services; retail services connected with the sale of clothing, headwear and footwear.

30. As set out above, the opponent's evidence consists of a single witness statement by Katie De Souza, one of its directors. Mrs De Souza's witness statement is not lengthy or complex but introduces a number of exhibits which I have summarised above.

31. Within the exhibits are posters for the years 2010 to 2013 advertising a Brazilian Jiu Jitsu competition. As indicated above, the latter of these dates from after the relevant date at which the matter must be judged. Each of the posters show the words Bournemouth BJJ Open towards the top of them. At the lower edge of the posters are a variety of company logos which includes the headdress device alongside the words De Souza Dojo but does not show the mark relied on under this ground. Whilst I have no doubt the competitions took place and the opponent was involved in them (with Mr De Souza paying for the rental for the hall), given the different companies' logos on these posters, they do not clearly show that any goodwill rests with the opponent. There are also discrepancies within the evidence such that it is not clear what competitions have taken place and under what name: the notice of opposition, which is dated November 2012 states the opponent "is planning" its fourth competition whereas the earlier published newspaper article exhibited at KDS19 states that a fourth competition took place in June 2012. Even putting these issues aside, there is no evidence to show e.g. where, when or how many of the posters may have been advertised or who or how many people may have seen them. Nor is there evidence to show how many people attended the various competitions, whether as competitors or spectators.

32. The opponent claims to have used its mark on a variety of services since February 2010 including retail services. There is evidence in the form of an invoice relating to some 28 polo shirts (whether that is for the purchase of shirts or merely embroidering or printing a logo on them is not explained, though I note that handwritten on the invoice is the word "uniform" which may suggest the shirts were not for onward sale to the public but instead for staff use). There is no evidence which provides any detail of the turnover or promotional spend in relation to all or any of the services relied upon. Neither is there any evidence from any third party or members of the public. Absent such evidence, the opponent has not shown that it has the requisite goodwill and the objection under this ground fails.

Summary

33. The opposition fails on each of the grounds relied upon.

Costs

34. The opposition having failed, the applicant is entitled to an award of costs in her favour. The only material she has filed has been a very short counterstatement. The evidence filed by the opponent was minimal and would not have taken much time or effort to review, even for an unrepresented party. With this in mind, I do not consider it necessary or proportionate to do anything other than award nominal costs to reflect

the time and effort that Ms Alexander is likely to have put into defending the opposition by the filing of her counterstatement.

35. With that in mind, I order De Souza Dojo Limited to pay Sarah Alexander the sum of £200. This sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of May 2014

**Ann Corbett
For the Registrar
The Comptroller-General**