

**O-169-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3137514  
BY BRAND PROTECTION LIMITED TO REGISTER THE TRADE MARK**

**Choose Your Weapon**

**IN CLASSES 9, 14, 21 AND 25**

**AND**

**THE OPPOSITION THERETO UNDER NO 406175  
BY ABT MERCHANDISING LIMITED**

## Background and pleadings

1. On 24 November 2015, Brand Protection Limited (“the applicant”) applied for the mark Choose Your Weapon for goods in classes 9, 14, 21 and 25.

2. The application was published for opposition purposes on 4 December 2015. ABT Merchandising Limited (“the opponent”) opposes the application in class 25, claiming that it offends sections 3(1)(a) and (b) and 3(6) of the Trade Marks Act 1994 (“the Act”). The class 25 goods are:

*Clothing, footwear, headgear, casual clothing, hooded sweatshirts, jeans, printed T-shirts, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, long sleeve embroidered T-shirts, printed and embroidered sweatshirts, trousers, fleece pullovers, socks, skirts, shorts, scarves, gloves, underwear, Baseball shirts, Casual shirts, Denim shirts, Formal shirts, Open-necked shirts, Polo shirts, Printed t-shirts, Rugby shirts, Short-sleeve shirts, Sports shirts, T-shirts, Tee-shirts, Woven shirts, Hooded sweatshirts, Sweatshirts, Bandanas (neckerchiefs), Boots for sports, Clothing for sports, Shoes for sports wear, Sports caps, Sports clothing (other than golf gloves), Sports footwear, Sports garments (other than golf gloves), Sports headgear (other than helmets), Sports hosiery, Sports jackets, Sports jerseys, Sports jumpers, Sports shoes, Sports singlets, Sports socks, Sports sweaters, Sports uniforms (other than golf gloves or helmets), Sportswear, Sportswear (other than golf gloves or helmets), Studs for sports footwear, Aprons (clothing), Sun hats, Athletics vests, Babies' vests, Fishing vests, Rash vests, Vest tops, Vests, Wristbands (clothing), Wristbands (sweatbands), Bathing jackets, Jackets (clothing), Jackets for casual wear, Jackets for men, Jackets for women, Quilted jackets, Riding jackets, Shirt jackets, Stuff jackets (clothing), Unlined jackets, Weatherproof jackets, Wind jackets, Windproof jackets, Athletics shorts, Bermuda shorts, Boxer shorts, Denim shorts, Gym shorts, Shorts, Surf shorts, Surfing shorts, Swimming shorts, Trousers shorts, Tracksuits, Babies' pants (clothing), Babygrows, Baby Bibs, Baby Clothes, Bike pants, Long pants, Over pants, Pants (clothing), Short pants, Sweat pants, Track pants, Footless socks, Slipper socks, Socks, Articles of waterproof clothing, Waterproof babies' pants, Waterproof boots, Waterproof clothing, Waterproof headgear, Waterproof suits for motorcyclists, Bibs, not of paper, Clothing for gymnastics, Gym suits, Gymnastic shoes, Gymnastic suits, Gym wear, Articles of water-resistant clothing, Water repellent gloves for use by motor cyclists, Water-resistant clothing.*

3. Sections 3(1)(a) and (b) and 3(6) of the Act state:

“3.— (1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) ....
- (d) ....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

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

4. The claims are expressed as follows:

- 3(1)(a): “The mark applied for is a well recognized slogan that is commonly used on merchandise. The mark is not capable of distinguishing goods or services of one undertaking from those of other undertakings”.
- 3(1)(b): “The mark consists exclusively of three words that, in combination, are used in common language as a tongue-in-cheek fun way to initiate a (play) fight. The mark is commonly used, with or without artwork as a slogan or [sic] merchandising. The three words are not capable of distinguishing the good or services of one undertaking from those of another. A simple Internet image search for “choose your weapon” provides many images of the words being used, with or without graphic work, in various styles on items of merchandise.”
- 3(6): “The Applicant’s core business appears to be clothing and merchandise. A search on the UK register finds 51 pages of registrations and applications

predominantly covering clothing in class 25. The Opponent is aware of the Applicant using its registrations to remove competing clothing companies' listings from online sales platforms such as eBay and Amazon, causing damage to the sales and reputation of that company. The motivation of the Applicant in this case is to prevent any clothing company from being able to apply any statement or slogan (with or without artwork) which includes a well known and well used slogan "Choose Your Weapon" (or anything similar). This is easy to do with a registration because the online sales platforms like eBay and Amazon have very straightforward mechanisms to de-list items which are alleged to infringe a trade mark registration. The Applicant is attempting, and in many cases succeeding, to obtain registrations for simple and/or commonly used statements or slogans, to unlawfully prevent competition in the merchandise and clothing industry to unlawfully cause harm to their competitors and to unlawfully prevent competition."

5. The applicant filed a counterstatement which is signed by Andrew Scott, an officer/employee of the applicant. The content of the counterstatement is reproduced below, verbatim:

As a company we are a builder of brands - not merely a designer and printer of apparel and accessories. Our practices and methods are completely distinct to any other company in the sector, as shown by our 'Sex Weights & Protein Shakes' (SWPS) brand, which is registered not only in the UK but also Australia and the USA. SWPS boasts its own Facebook site and a strong following, dedicated online platform, advertising campaigns but most importantly premium-quality garments that are relabelled and professionally packaged. We do this to stand out and differentiate our products from imitations that appear thereafter. We created our first 'Choose Your Weapon' design several years ago and were dismayed to see that within a few weeks others were simply copying it - some not even creating their own version but merely 'tracing' our existing design. The more we learned and researched trademark law, including discussions with third-party experts as well as the IPO, the more we concluded the best course of action to protect our work would be to invest funds into trademarks and more latterly design registrations. We were the first to produce a 'Choose Your Weapon' design featuring initially guitars and simply extended the concept to other hobbies and past-times such as gaming, cooking, chess, photography, gardening and more. We have reinforced this brand by continuing to use the same fonts throughout the different designs. Our model for the 'Choose Your Weapon' brand will be similar to that of SWPS, in that woven damask labels are being produced for 'branding' purposes, which will be sewn into the neck and hem/sleeve. We do not feel we are doing anything wrong by wanting to protect our work, ideas and IP. We went through the appropriate channels to register our first 'Choose Your Weapon' design in June 2014 (UK00003080327) and received no opposition. We now wish to register 'Choose Your Weapon' to reinforce our brand and protect our other designs, which are quite clearly being copied. It is our belief the opponent in this case, ABT Merchandising, is simply attempting to seek retribution for our company reporting them for infringing another of our brands in 2015. Indeed, they do not even offer a 'Choose Your Weapon' design. This is simply malicious.

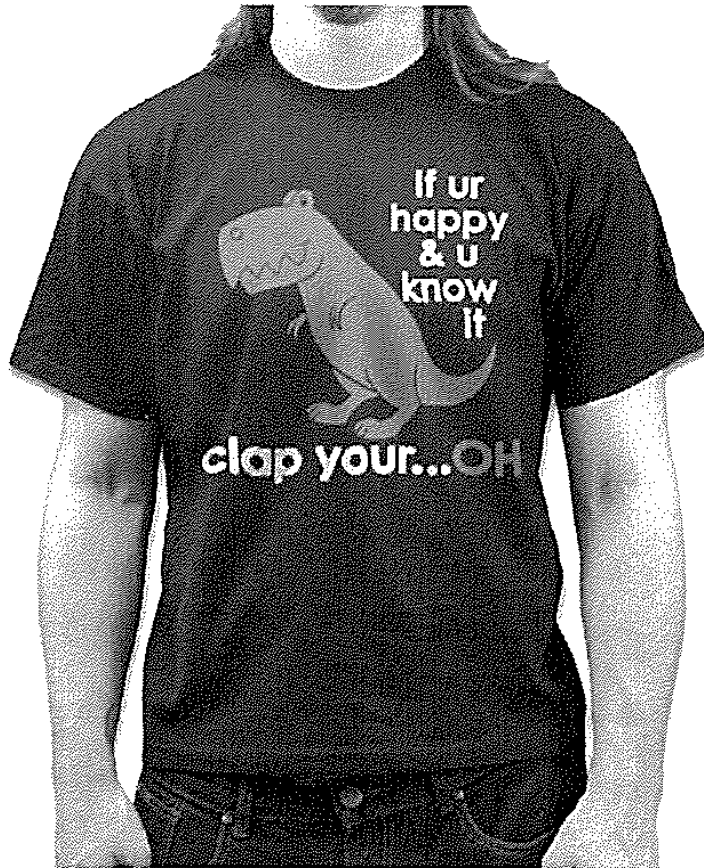
6. Both parties filed evidence. Neither side chose to be heard or to file submissions in lieu of attendance at a hearing. I make this decision on the basis of the law and a careful reading of all the papers filed.

## **Evidence**

7. The opponent's director, Bassam Karam, has filed a witness statement which is undated. Mr Karam states that the opponent sells clothing bearing designs through online channels, such as eBay. The opponent's designs combine current trends, which he states are commonly known in the trade as 'mash-ups'. In 2015, Mr Karam was surprised to find that a number of the opponent's items of clothing had been delisted from eBay. He discovered that the artwork had been "taken and registered" by the applicant. Copies of the clothing and the relevant registrations are exhibited at ABT1. In each case, Mr Karam has provided the date on which the opponent's design was created, the date when it was first sold on eBay, and the dates of filing and registration of the applicant's alleged copy-cat UK trade marks. In each case, the opponent's eBay listing dates precede the applicant's trade mark application filing dates. Some examples are shown below:

ABT Merchandising design:

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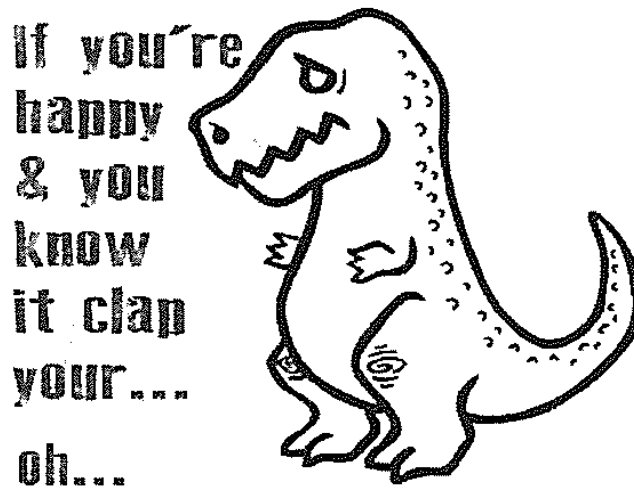
Created: March 18<sup>th</sup> 2014.

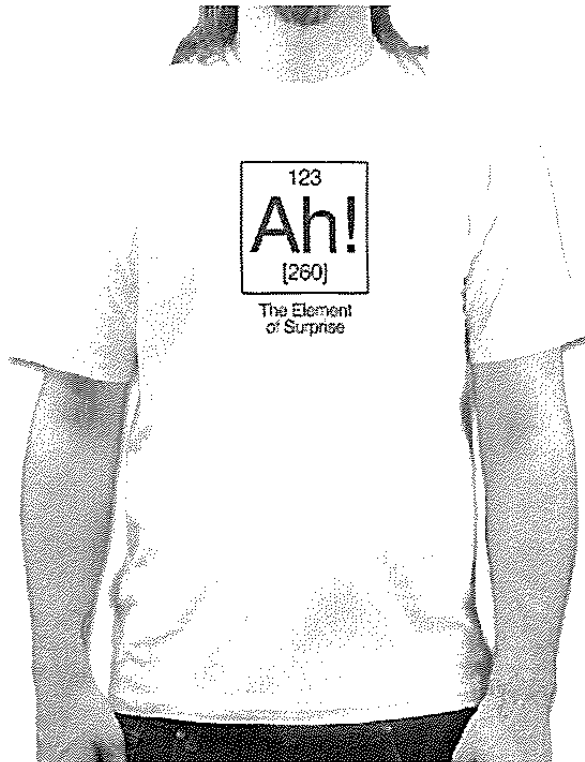
First sold on eBay : March 2014

Brand Protection registration:

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UK00003068962 filed 18 August 2014, registered 21 November 2014





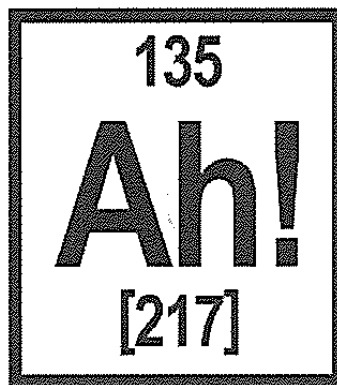
Created: 2<sup>nd</sup> October 2013

First sold on eBay : October 2013

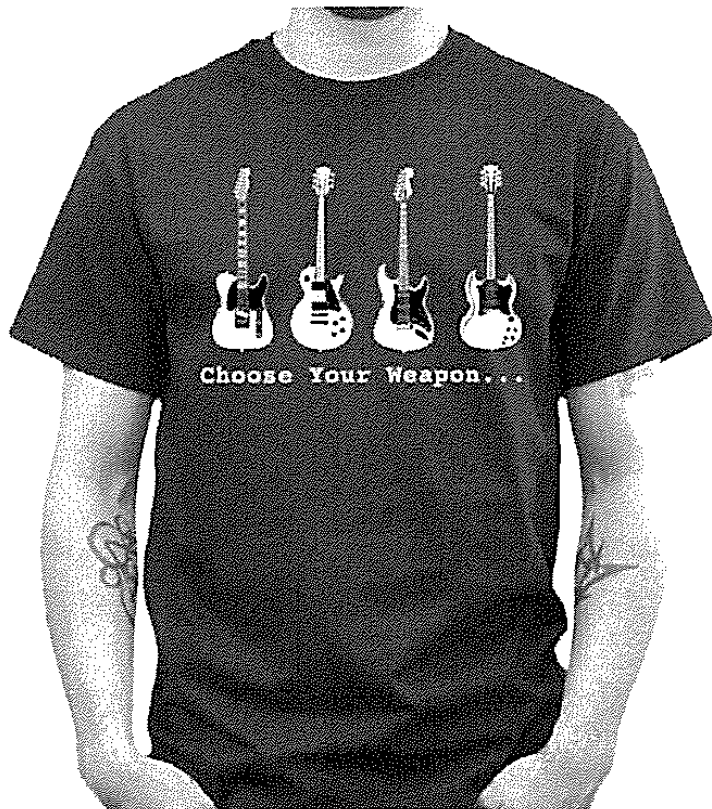
Brand Protection registration:

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UK00003069306 filed 20 August 2014, registered 21 November 2014



**The Element  
of Surprise!**



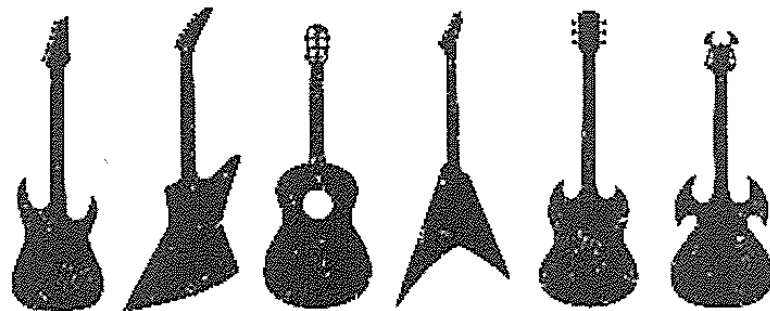
Created: August 14<sup>th</sup> 2012

First sold on eBay : August 2012

Brand Protection registration:

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UK00003137514 filed 6 November 2014, registered 13 March 2015



*Choose Your  
Weapon*



8. Mr Karam states that it was apparent to him that the applicant was deliberately taking the opponent's artwork, registering it as trade marks, and using the trade mark registrations to delist the opponent's goods in a deliberate attempt to cause damage to the opponent's business.

9. The opponent has also filed a witness statement from David Fry, who is a trade mark attorney and partner at Agile IP LLP, the opponent's professional representatives in these proceedings. The witness statement consists mainly of submissions, some of which expand upon the pleadings. I note that Mr Fry refers to section 3(1)(c) of the Act. This was not pleaded as a ground of opposition. I will not include the submissions in my summary of the evidence, but I bear them in mind and will refer to them as necessary.

10. The applicant has filed a witness statement, dated 21 October 2016, from Jason Robertson, who is a director of the applicant. Mr Robertson states that he established the applicant in 2015 to act as a licensing agent for numerous t-shirt designs and brands created over the years by his various other companies. He states that the applicant is also a developer of clothing brands focusing on specific interests, which the applicant licenses to third parties. The goods are sold via online sales channels as well as through 'dedicated brand platforms'. Much of the evidence is not relevant to these proceedings. Mr Robertson states that:

- Some of the applicant's graphic designs are grouped into themes, such as fishing, scuba diving, cycling and gym/bodybuilding, including 'SWPS' (which stands for Sex, Weights & Protein Shakes).
- It is the opponent which is copying the applicant's work. An example from eBay is shown as Exhibits BP003 and BP004, but the text in the prints is too small for me to read.
- The applicant's clothing designs are registered as designs and some are further developed as brands and registered as trade marks.

11. Mr Robertson replies to the allegations of copying of the various t-shirt designs exhibited to Mr Karam's evidence. For reasons which will become clear, I do not

propose to detail the rebuttal of Mr Karam's evidence, but simply note that Mr Robertson denies copying and has provided evidence intended to show that some of the applicant's designs pre-date the opponent's designs. In particular, with reference to the opponent's Choose Your Weapon evidence (shown in paragraph 7 of this decision), Mr Robertson states:

"16. With respect to the Opponent's suggestion we copied their 'Choose Your Weapon' design – which he claims to have created in August 2012 – there are now many, many companies selling t-shirts featuring the words 'Choose Your Weapon' with guitars (in fact a Google search finds 581,000 hits). At the time our figurative trade mark was filed in November 2014 (UK00003080327) there were not. This has long been a good seller for us and we extended the concept to different hobbies and interests, including gardening, gaming, cooking, golf, chess, dice, photography and more, plus we have many more waiting to be unveiled. All of these variants have always been very good sellers and as any platform search will reveal, ours invariably top the list. It is for this reason we decided 'Choose Your Weapon' should be developed as a brand, in the same vein as others, with woven damask labels manufactured and sewn into the neck...The font used for 'Choose Your Weapon' is consistent throughout the various designs and is stylised identically, to reinforce the overall brand image."

12. Mr Robertson states:

"22. With reference to my application to register 'Choose Your Weapon', we do not claim to be the first to sell this design but we were the first to extrapolate the concept to other topics and develop it as a brand in its own right. As a brand, it hones in on the obsessions that people have for certain hobbies and past-times and as you can see from the designs we have created and sold, as well as the woven damask neck labels that we wish to produce, the stylisation and use of typography on the clothing is achieved in a distinctive way, with a graphical representation of the hobby/interest alongside the text which is consistent throughout all designs. There is now exhibited as Exhibit BP015 examples of designs within the Choose Your Weapon brand":



## Decision

### Section 3(1)(a) of the Act

13. Section 1(1) of the Act states:

“1.—(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

14. Strictly speaking, there is no need for me to decide whether this ground succeeds or fails. As Mr Geoffrey Hobbs Q.C., as The Appointed Person pointed out in *AD2000 Trade Mark*<sup>1</sup>, s.3(1)(a) permits registration provided that the mark is ‘capable’ to the limited extent of “*not being incapable*” of distinguishing. Consequently, if I am satisfied that the mark complies with s.3(1)(b) of the Act, the ‘incapable of distinguishing’ objection under section 3(1)(a) is bound to fail. Alternatively, if the ground under section 3(1)(b) succeeds, the outcome under section 3(1)(a) becomes moot. However, for the sake of completeness, I set out here, briefly, why the ground fails, regardless of the ground under section 3(1)(b) of the Act.

15. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), Arnold J said:

“44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4 , the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically.

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<sup>1</sup> [1997] RPC 168.

Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:

"80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those

particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

go47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services."

16. Article 4 of Regulation 207/2009 of 26 February 2009 on the Community trade mark (codified version) is the equivalent to section 1(1) of the Act, set out above. The mark is not incapable of distinguishing any goods. It follows from this authority that the ground of opposition under section 3(1)(a) must fail.

#### **17. The ground under section 3(1)(a) fails.**

#### **Section 3(1)(b) of the Act**

18. Section 3(1)(b) states:

“3.— (1) The following shall not be registered –

(a) .....

(b) trade marks which are devoid of any distinctive character,

(c) ....

(d) .....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

19. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P), as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67).”

20. There are no exhibits to support the pleading. Mr Fry submits that the applicant’s goods are the sort of media used by an undertaking to promote its business and so the mark will be taken as ‘merely descriptive’ of such goods (this is more the language of section 3(1)(c), which is not pleaded). Mr Fry goes on to make submissions about slogans and section 3(1)(b) of the Act. It appears that this is the

crux of the objection: that the average consumer would understand the mark to be a slogan, conveying a reference to a way of initiating a play fight rather than an indicator of trade origin in relation to the goods on which it physically appears.

21. Mr Robertson states that the applicant's neck and sleeve labels will be sewn into the neck, hem and sleeve of the garments. This implies that the mark has not, as yet, been used in relation to the goods as labels; if it has, there is no evidence of such use. There is, therefore, no question as to whether use on labels will have educated the relevant public that the mark is a trade mark. I have only the prima facie case to consider.

22. I must consider the various ways that a trade mark may be used in relation to the goods (notional and fair use of the mark). This would include use on the garment, such as across the front, or on the back, which is, in fact, the type of use which Mr Robertson exhibits, showing the mark as part of a longer set of words across the front of t-shirts; such as:



23. It isn't just a possibility that the mark may be used this way: the applicant's evidence shows that it is used this way, in relation to many different hobbies. Use in the manner shown would not be use in a trade mark sense. Mr Robertson refers to having sold the designs; that the designs have 'long been a good seller'; and it was for this reason the applicant decided to develop the word part of the designs as a



brand. He also states that the applicant was not the first to sell the design (with guitars). If this is the case, then it is unlikely that the average consumer, having become accustomed to seeing the words together with various hobby-related pictures, will then assume that the words must indicate a single source of trade origin. The average consumer (for these goods, the general public) would perceive Choose Your Weapon, accompanied by pictures of 'tools' used in various hobbies, as a personal statement about the wearer's favoured hobby, not as an indication of trade origin of the goods.

24. In considering the mark applied for, it is my view that the average consumer will perceive it as a modern, jovial invitation to some sort of challenge rather than identifying immediately the goods as originating from a particular undertaking, which is the essential function of a trade mark; see, for example, *Feedback Matters*<sup>2</sup>:

“Where an applicant does not rely on the proviso to section 3(1) concerning acquired distinctiveness, section 3(1)(b) precludes registration of marks that are not inherently distinctive. In other words, to get past the test, the mark must be capable of immediately enabling relevant consumers to distinguish the goods or services bearing the mark from the goods or services of competing undertakings: Case C-136/02 *Mag Instrument* at [50]. This is not about whether the relevant consumers have ever (or never) seen the mark before, or whether they will recognise the mark again, but is about whether they will see the mark as denoting the origin of the goods or services without the need to be educated. (See, for example, *Yakult Honsha KK's Trade Mark Application* [2001] RPC 39, p.756 at pp.758-759.)”

25. The mark is devoid of any distinctive character for goods which are apt to carry phrases, statements or slogans, but is not objectionable in relation to *sports hosiery, studs for sports footwear*.

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<sup>2</sup> BL O/185/12, Ms Anna Carboni, sitting as the Appointed Person.

**26. The ground under section 3(1)(b) fails in relation to *sports hosiery, studs for sports footwear* and succeeds in relation to the following goods:**

*Clothing, footwear, headgear, casual clothing, hooded sweatshirts, jeans, printed T-shirts, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, long sleeve embroidered T-shirts, printed and embroidered sweatshirts, trousers, fleece pullovers, socks, skirts, shorts, scarves, gloves, underwear, Baseball shirts, Casual shirts, Denim shirts, Formal shirts, Open-necked shirts, Polo shirts, Printed t-shirts, Rugby shirts, Short-sleeve shirts, Sports shirts, T-shirts, Tee-shirts, Woven shirts, Hooded sweatshirts, Sweatshirts, Bandanas (neckerchiefs), Boots for sports, Clothing for sports, Shoes for sports wear, Sports caps, Sports clothing (other than golf gloves), Sports footwear, Sports garments (other than golf gloves), Sports headgear (other than helmets), Sports jackets, Sports jerseys, Sports jumpers, Sports shoes, Sports singlets, Sports socks, Sports sweaters, Sports uniforms (other than golf gloves or helmets), Sportswear, Sportswear (other than golf gloves or helmets), Aprons (clothing), Sun hats, Athletics vests, Babies' vests, Fishing vests, Rash vests, Vest tops, Vests, Wristbands (clothing), Wristbands (sweatbands), Bathing jackets, Jackets (clothing), Jackets for casual wear, Jackets for men, Jackets for women, Quilted jackets, Riding jackets, Shirt jackets, Stuff jackets (clothing), Unlined jackets, Weatherproof jackets, Wind jackets, Windproof jackets, Athletics shorts, Bermuda shorts, Boxer shorts, Denim shorts, Gym shorts, Shorts, Surf shorts, Surfing shorts, Swimming shorts, Trousers shorts, Tracksuits, Babies' pants (clothing), Babygrows, Baby Bibs, Baby Clothes, Bike pants, Long pants, Over pants, Pants (clothing), Short pants, Sweat pants, Track pants, Footless socks, Slipper socks, Socks, Articles of waterproof clothing, Waterproof babies' pants, Waterproof boots, Waterproof clothing, Waterproof headgear, Waterproof suits for motorcyclists, Bibs, not of paper, Clothing for gymnastics, Gym suits, Gymnastic shoes, Gymnastic suits, Gym wear, Articles of water-resistant clothing, Water repellent gloves for use by motor cyclists, Water-resistant clothing.*

## Section 3(6): bad faith

27. Section 3(6) of the Act states that:

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

28. In *Red Bull GmbH v Sun Mark Ltd & Anr* [2012] EWHC 1929 and [2012] EWHC 2046 (Ch) (“Sun Mark”) Arnold J summarised the general principles underpinning section 3(6) as follows:

“Bad faith: general principles

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* [2009] EWHC 3032 (Ch), [2009] 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-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see Cipriani at [185].

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], *GERSON 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 that 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).”

29. As stated in the *Sun Mark* case, the relevant date is the date on which the application was made to register the trade mark, which in this case is 24 November 2015.

30. The opponent's claim under section 3(6) appears to be that the applicant obtains registrations to remove competing clothing companies' listings from online sales platforms. The opponent is concerned that the applicant will have a statutory monopoly in a term which is a commonly used statement or slogan, and therefore use its registration to remove from online listings third-party goods which carry the same or similar words. The evidence provided has not substantiated this pleading. Furthermore, it is not a fertile basis for a section 3(6) claim. Otherwise, section 3(6) would be a valid objection against every trade mark application which falls foul of section 3(1)(b) of the Act on the grounds that an applicant seeks a monopoly in a non-distinctive mark.

**31. The ground under section 3(6) fails.**

## **Outcome**

**32. The opposition partially succeeds under section 3(1)(b) of the Act. The mark is refused for the following class 25 goods:**

*Clothing, footwear, headgear, casual clothing, hooded sweatshirts, jeans, printed T-shirts, lined and unlined jackets, short sleeve and long sleeve shirts, baggy shorts, long sleeve embroidered T-shirts, printed and embroidered sweatshirts, trousers, fleece pullovers, socks, skirts, shorts, scarves, gloves, underwear, Baseball shirts, Casual shirts, Denim shirts, Formal shirts, Open-necked shirts, Polo shirts, Printed t-shirts, Rugby shirts, Short-sleeve shirts, Sports shirts, T-shirts, Tee-shirts, Woven shirts, Hooded sweatshirts, Sweatshirts, Bandanas (neckerchiefs), Boots for sports, Clothing for sports, Shoes for sports wear, Sports caps, Sports clothing (other than golf gloves), Sports footwear, Sports garments (other than golf gloves), Sports headgear (other than helmets), Sports jackets, Sports jerseys, Sports jumpers, Sports shoes, Sports singlets, Sports socks, Sports sweaters, Sports uniforms (other than golf gloves or helmets), Sportswear, Sportswear (other than golf gloves or*

*helmets), Aprons (clothing), Sun hats, Athletics vests, Babies' vests, Fishing vests, Rash vests, Vest tops, Vests, Wristbands (clothing), Wristbands (sweatbands), Bathing jackets, Jackets (clothing), Jackets for casual wear, Jackets for men, Jackets for women, Quilted jackets, Riding jackets, Shirt jackets, Stuff jackets (clothing), Unlined jackets, Weatherproof jackets, Wind jackets, Windproof jackets, Athletics shorts, Bermuda shorts, Boxer shorts, Denim shorts, Gym shorts, Shorts, Surf shorts, Surfing shorts, Swimming shorts, Trousers shorts, Tracksuits, Babies' pants (clothing), Babygrows, Baby Bibs, Baby Clothes, Bike pants, Long pants, Over pants, Pants (clothing), Short pants, Sweat pants, Track pants, Footless socks, Slipper socks, Socks, Articles of waterproof clothing, Waterproof babies' pants, Waterproof boots, Waterproof clothing, Waterproof headgear, Waterproof suits for motorcyclists, Bibs, not of paper, Clothing for gymnastics, Gym suits, Gymnastic shoes, Gymnastic suits, Gym wear, Articles of water-resistant clothing, Water repellent gloves for use by motor cyclists, Water-resistant clothing.*

**The mark may proceed to registration for the goods in classes 9, 14 and 21, which were not opposed, and for the following goods in class 25:**

*Sports hosiery, studs for sports footwear.*

### **Costs**

33. The applicant has succeeded in defending only a tiny proportion of the opposed goods. The opponent is entitled to a contribution towards its costs, based upon the scale of costs published in Tribunal Practice Notice 4/2007. I have not made any award for the opponent's evidence and Mr Fry's submissions (filed as evidence) because it did not assist any of its grounds of opposition. The breakdown is as follows:

Official fee	£200
Filing the opposition and considering the counterstatement	£300

Considering the applicant's evidence £200

**Total £700**

34. I order Brand Protection Limited to pay ABT Merchandising Limited the sum of £700 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

**Dated this 6<sup>th</sup> day of April 2017**

**Judi Pike  
For the Registrar,  
the Comptroller-General**