

O/084/19

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003245783
IN THE NAME OF OGIO INTERNATIONAL, INC.
FOR THE FOLLOWING TRADE MARK (SERIES OF TWO):

OGIO SAVAGE

AND

Ogio Savage

IN CLASS 18

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 501879 BY KAVEH SAVAGE

BACKGROUND AND PLEADINGS

1. Ogio International, Inc. (“the proprietor”) is the owner of the trade mark (series of two) shown on the cover page of this decision (“the contested mark”) which was filed on 24 July 2017. It was registered on 27 October 2017 for the following goods:

Class 18 Bags; luggage; cases; backpacks

2. On 20 November 2017, Kaveh Savage (“the applicant”) applied to have the contested mark declared invalid under s.47 of the Trade Marks Act 1994 (“the Act”). The application is based on sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Act. The invalidity is directed against all of the goods for which the contested mark is registered.

3. For its application based on sections 5(2)(b) and 5(3) of the Act, the applicant relies upon the UK trade mark **SAVAGE** (registration no. 2244426). The earlier mark was filed on 4 September 2000 and was registered on 5 October 2001. It is registered for the following goods:

Class 18 Bags, wallets, purses, briefcases, articles made of leather and artificial leather, belts.

Class 25 Clothing; headgear; footwear.

4. The applicant claims that the contested mark is similar to its own mark and is registered for identical or similar goods and there is a likelihood of confusion. The applicant also claims that the earlier mark has a reputation in respect of all of the goods for which it is registered in class 18 and that use of the applicant’s mark would, without due cause, take unfair advantage of, or be detrimental to, the repute of the earlier mark.

5. For his application based on section 5(4)(a) of the Act, the applicant relies on the sign **SAVAGE** and claims that the sign has been used throughout the UK since 5 October 2001. The applicant states that the sign has been used in relation to “class 18 & class 25”, although no more specific details are provided. As the applicant has

described his use of the sign by reference to its earlier mark, I will proceed on the basis that the applicant relies on the same goods for which the earlier mark is registered for its opposition under section 5(4)(a).

6. In respect of its application based on section 3(6) of the Act, the applicant argues as follows:

“The proprietor is an established US registered Company, selling bags by the name of Ogio Golf bags. The recent application to register Ogio Savage, was undertaken by the UK IP lawyers, who would have, without doubt advised their client of the existence of my earlier trademark, in the same class. The proprietor then proceeded, with legal advice at hand, and still registered the very similar mark. In the real world of marketing and commerce I am absolutely convinced that the name Ogio Savage will be abbreviated and market and sold as Savage. This is where I believe the bad intent lies. Indeed it falls way below the normal standards of commercial behaviour. To compound my point, I have already received a without prejudice, save as to cost letter from the proprietors IP lawyers. It is clear that they see me as small independent trader and will use whatever is necessary to ensure they retain their mark as it stands and follow the bigger marketing plans for future. I submit that on balance of probability, given that full legal advice was provided to register the mark, that the application was made in bad faith. IP lawyers, as mine did when registering, always advise the client of other similar names within the territory and worldwide. This, I will further submit, to be industry standard. They could have approach me direct with their intentions but chose not to. I believe there is definitely an case of bad faith and absolutely falls below normal commercial standards.”

7. The proprietor's predecessor in title, Callway Golf Company, filed a counterstatement denying the grounds of invalidity (and requested that the applicant provide proof of use of its earlier trade mark relied upon). The proprietor has confirmed that it has had sight of all forms and evidence filed by its predecessor in title, stands by the statements made in the counterstatement and accepts the liability for costs for the whole proceedings in the event that the application is successful. The proprietor

also confirms that where its predecessor in title is referenced in the pleadings, this should be read as though it is the proprietor's name.

8. The proprietor was originally represented by Mathys & Squire LLP and is now represented by Kempner & Partners LLP. The applicant is unrepresented. The applicant filed evidence in the form of a witness statement by himself dated 31 July 2018. The proprietor filed evidence in the form of the witness statement of Sonia Lari dated 15 November 2018. This was accompanied by written submissions dated 16 November 2018. The applicant filed submissions in reply dated 17 December 2018. No hearing was requested and only the proprietor filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

Applicant's Evidence in Chief

9. As noted above, the applicant's evidence in chief takes the form of a witness statement dated 31 July 2018 prepared by himself, with 6 exhibits. The applicant confirms that he is the owner and chief designer of an independent clothing brand in London, and has been since 1999. He has been a designer and a business man for over 3 decades and has previously been the chief designer and owner of 2 other brands.

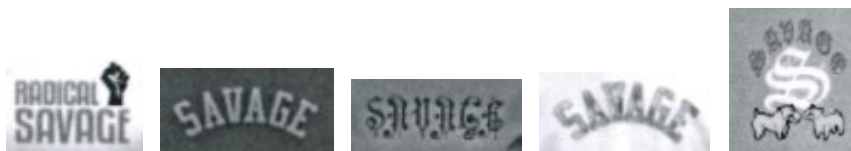
10. The applicant has previously operated his retail business from a number of high profile locations including Portobello Road, Carnaby Street and Covent Garden Piazza, London. However, it has been run from a store on Cricklewood Broadway, London for the last 5 years which the applicant acknowledges has a lower profile than its other previous locations. The applicant confirms that it operates a standard retail outlet from this location, as well as its online sales, with sales being made from around the world (although sales are predominantly from the United Kingdom).

11. The applicant has referred to various domain names that he owns and has provided a list of these¹. The applicant has referred to articles available on his website savagelondon.com which he claims show that the brand has enjoyed “tremendous²” media and press coverage. The applicant has provided a selection of print outs to demonstrate this at Exhibit KS2. The first of these is a picture displaying a man wearing a T-shirt which is captioned “Top £20, s-xl, Savage”. This article is undated. The second is a print out of the cover page of “Northern NW Woman” dated September 2001. The applicant’s mark is not referred to on the cover. This is accompanied by an undated page from a magazine (it is not clear whether this is from the same magazine as the cover provided) which refers to SAVAGE LONDON and displays the following mark:



12. The fourth of these print outs displays the same mark as shown above next to two tops. The caption states that these tops have been in demand and references fashion company SAVAGE. It also refers to the website www.savagelondon.com. However, the print out is undated.

13. The applicant has provided a print out from his website which shows jumpers and tops. The page is entitled “SAVAGE T-SHIRTS, HOODIES AND SWEATSHIRTS”³. SAVAGE is used in the description for the products and the mark appears in the following forms:



¹ Exhibit KS1

² Witness Statement of Kaveh Savage, para. 11

³ Exhibit KS3

14. The applicant has also provided two photographs of a selection of bags which display the following marks⁴:



15. The applicant confirms that both the print out and photograph were dated 30 July 2018.

16. Exhibit KS5 to the applicant's statement consists of what he refers to as submissions that were previously filed by the applicant incorrectly. These are actually evidence of fact. The 'submissions' are accompanied by an email dated 5 December 2017 from the applicant to the proprietor's previous representatives (attaching a screenshot from the website ogio.com) and an email dated 27 November 2017 from the proprietor's previous representatives to the applicant (which is marked as being without prejudice, save as to costs). The most relevant part of the 'submissions' provided by the applicant is as follows:

"2.2 It is unfortunate that they suggest zero reputation. For the record, I have been operating for many years. Quite possibly longer than they have. I have supplied and designed goods and provided services to the Fashion, TV, Film and media companies as well as the general public. They all refer to me as Savage, they know my brand Savage London and when wearing a t shirt or using our bags they call it Savage top/bag etc.... Please feel free to type Savage in Google and you will see our website Savage London on the first page, normally top or half way down the page. The website is full of various products utilising our mark. These products are being ordered and sold, dispatched and worn by our clients daily. The Mark Savage is being promoted and marketed within the Savage London Brand and this has been so for many years.

⁴ Exhibit KS4

2.3 My reputation is that of high quality and design content as well as ethics of the name and brand across all products as & when we choose to produce, sell & market them. As no one knows of the intentions of the owners of Ogio Savage in the future development of their products then it is a reasonable to assume that usage is likely to be to my detriment, damage my reputation and confuse the public.”

17. The applicant invites the Tribunal to undertake its own search for “Savage T-shirts”. I will come back to this point later in my decision.

18. The applicant has provided a report showing the number of searches for the word SAVAGE on the internet⁵. This appears to show the results for the word SAVAGE generally (as at 30 July 2018) and not specifically relating to the applicant’s business. The report appears to show the results for 30 July 2018. Beneath the results, there is an “Interest by region” section which lists Ghana, Zambia, Zimbabwe and Nigeria. The second page shows that there have been 201,000 searches for the word SAVAGE but, again, this doesn’t show whether the search related to the applicant’s business or the location of the people undertaking the searches. This page is undated.

The Proprietor’s Evidence

19. The proprietor’s evidence consists of the witness statement of Sonia Lari dated 15 November 2018. Ms Lari is the Senior Corporate Counsel for the proprietor; a position she has held since July 2017. Prior to that, she held the position of Corporate Counsel since November 2009. Ms Lari confirms that the proprietor and their predecessor in title, Callaway Golf Company, are part of the same group of companies.

20. Ms Lari states that the contested mark had already started being used in the UK prior to the filing of the application for registration and was an extension of the existing business in the US. The applicant’s mark was identified by the Intellectual Property Office search report and the proprietor took the view that there was no conflict with the contested mark because the marks were sufficiently different, the proprietor is

⁵ Exhibit KS6

predominantly in the golf sector so a commercial conflict was unlikely and there were already a number of other marks containing SAVAGE on the register for goods in class 18 and 25 that had been co-existing with the earlier mark. Ms Lari lists three of these marks.

21. Ms Lari's evidence was accompanied by written submissions dated 16 November 2018. The proprietor also filed written submissions in lieu of a hearing. Whilst I do not propose to summarise these here, I have taken them into consideration and will refer to them below as appropriate.

The Applicant's Evidence in Reply

22. The applicant's evidence in reply took the form of written submissions dated 17 December 2018. Whilst I do not propose to summarise these here, I have taken them into consideration and will refer to them below as appropriate.

PRELIMINARY ISSUES

23. In his evidence, the applicant has made reference to (and included as an exhibit), without prejudice correspondence between the parties. Such statements made during the course of genuine negotiations are inadmissible. In any event, this correspondence does not appear relevant to the decision I must make and will not affect the outcome of these proceedings.

24. The applicant has also included various webpage links in his evidence and has invited the Tribunal to undertake its own searches. I have neither looked at the links nor undertaken my own searches, as it is not the responsibility of the Tribunal to investigate internet evidence; only content put before the Tribunal can be considered. Internet links may have become inaccessible or their content changed. They are not durable, reliable evidence⁶.

⁶ *Kustom Musical Amplification, Inc. v Office for Harmonisation in the Internal Market (OHIM)*, Case T-317/05

DECISION

25. Section 47 of the Act states as follows:

“47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5 (4) is satisfied

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

Section 5(2)(b) and section 5(3)

26. Sections 5(2)(b) and 5(3) of the Act have application in invalidation proceedings because of the provisions set out in section 47(2)(a) of the Act. By virtue of this section, a registered trade mark may be declared invalid if there is an earlier trade mark which satisfies the conditions under section 5(1), (2) or (3) of the Act and the owner of the earlier mark has not consented to the registration. In circumstances in which the earlier mark completed its registration process more than five years before the date of the application for invalidity, the use conditions must be met.

27. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

28. Section 5(3) of the Act reads as follows:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

29. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, an international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

30. The applicant’s mark qualifies as an earlier trade mark under the above provisions. It does not fall within section 6(1)(c) of the Act. The applicant’s mark completed its registration process on 5 October 2001; more than five years before the date of the application for invalidity (which was made on 20 November 2017). The use conditions must, therefore, be satisfied pursuant to section 47(2A) of the Act.

Proof of use

31. The first issue, for the oppositions under section 5(2)(b) and 5(3) of the Act is whether, or to what extent, the applicant has shown genuine use of the earlier mark.

32. The relevant period is the five-year period ending on the date of the application for invalidity. Consequently, the relevant period under these provisions is 21 November 2012 to 20 November 2017. I have lengthy submissions from the proprietor on the evidence provided by the applicant. I also have lengthy submissions from the applicant in response. I do not propose to summarise those submissions here, but I have taken them into consideration and will refer to them below as appropriate. I note that the proprietor has referred to the relevant period for proof of use as being “the five year period preceding the publication date of the Contested Mark i.e. between 18 August 2012 and 17 August 2017”. As noted above, this is incorrect. I will, therefore, bear this in mind regarding the relevance of the proprietor’s written submissions.

33. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01

Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] to [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation

has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not always the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

34. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the mark

35. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“the CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be

fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

36. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character

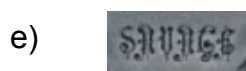
identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

37. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

38. In some circumstances, the mark is used in the same format as it is registered, such as in the product description for the items displayed on the website print outs. Notional and fair use of the applicant’s mark will include use in any standard typeface and so differences created by capitalisation are not relevant. This will be use upon which the applicant can rely. As noted above, the mark also appears in the following variants in the opponent’s evidence:



b) SAVAGE LONDON



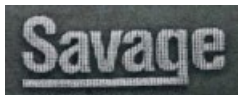
g)



h)



i)



j)



39. Both variants a), d) and f) show the applicant's mark displayed in a curve, presented in a stylised font (albeit on different colour backgrounds). In my view, the stylisation and presentation in these variants do not alter the distinctive character of the mark (as explained in *Nirvana*). This is, therefore, use upon which the applicant may rely.

40. Variant b) shows the applicant's mark used in its word only form combined with the word LONDON. It is clear from the case law in *Colloseum*, cited above, that use in conjunction with other matter falls within the ambit of genuine use. That applies here. The word LONDON is likely to be seen as identifying the geographical origin of the goods or business and will, therefore, be attributed little trade mark significance by the consumer. This is, therefore, use upon which the applicant may rely.

41. Variant c) shows the applicant's mark displayed in a stylised font, preceded by the word RADICAL. There is also a small device to the top right of the applicant's mark, although it is not clear from the image what this device represents. As noted above, use in conjunction with other matter falls within the ambit of genuine use (as per *Colloseum*). This is, therefore, use upon which the applicant may rely.

42. Variant e) shows the applicant's mark displayed in a highly stylised font. The image provided is not of particularly good quality, which makes the word difficult to read. In

my view, although the stylisation is significant, the word is still legible as SAVAGE and the stylisation does not detract from this to such an extent as to alter the distinctive character of the mark. In my view, this is use upon which the applicant may rely.

43. Variant g) is, again, a poor quality image. Although not at all clear, it appears that this includes the word SAVAGE, although the letters have been stylised to such an extent that they appear more like symbols than letters. They appear in conjunction with a large 'S', which itself is highly stylised, and two animal devices. As noted above, use in conjunction with other matter falls within the ambit of genuine use (as per *Colloseum*). However, in my view, the stylisation in this case is so significant that the word SAVAGE is not immediately apparent. I consider that this alters the distinctive character of the mark and this is, therefore, not use upon which the applicant may rely.

44. Variants h) and i) both display the applicant's mark in a stylised font and underlined by an extension of the letter 'G'. The stylisation does not alter the distinctive character of the mark which plainly lies in the word SAVAGE. In my view, this is use upon which the applicant may rely.

45. Variant j) displays the applicant's mark in a stylised font displayed in a curve. This stylisation and presentation does not detract from the use of the word SAVAGE, in which the distinctive character of the mark lies. In my view, this is use upon which the applicant may rely.

Sufficient Use

46. I bear in mind the comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, where he stated:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known

to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

47. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

48. I note that the applicant states that for the last five years (the time falling within the relevant period) he has been operating his business from a store on Cricklewood Broadway, London. The applicant confirms that his sales are generated from this store and online. However, no evidence of any actual sales have been provided by the applicant by way of invoices or financial information. I note that the applicant has various domain names registered (ownership of which is challenged by the proprietor). However, ownership of domain names alone does not prove use of a mark. No information has been provided by the applicant as to how many people have accessed these domain names or whether any sales have been made through them.

49. The examples of media coverage provided by the applicant are, unfortunately, of little use to the issue of use before me. Two are undated and cannot, therefore, assist me in determining whether there has been use during the relevant period. The magazine cover that is dated is dated 2001 but does not itself mention the applicant’s mark. Even assuming that the article following it was taken from that magazine, it falls well before the relevant period. This does not, therefore, demonstrate use during the relevant period. The applicant confirms that the print outs taken from his website, as

well as the photographs of bags displaying the marks, are dated 30 July 2018. This is some 8 months after the end of the relevant period. Again, whilst I recognise that the applicant has provided examples of its mark in use, these examples fall well after the relevant period and cannot, therefore, be of assistance to me in determining whether there as use during the relevant period.

50. The report showing search results for the word SAVAGE on the internet does not assist the applicant in demonstrating use of its mark for a number of reasons. Firstly, the applicant's mark is a UK trade mark and therefore use must be demonstrated in the UK. The report lists various countries as the location in which this word was searched the most, none of which are the UK. No other information is provided as to what proportion of the search results relate to the UK. Secondly, the report shows the results for 30 July 2018. Again, this is well after the relevant period and is therefore not of assistance to the applicant in demonstrating use of its mark during the relevant period. Finally (and most importantly), whilst the word SAVAGE has been adopted by the applicant as its mark, it is also a common dictionary word. There is nothing in this report to suggest that there is any link between the applicant's business and the searches undertaken. In any event, searches for a word on the internet do not demonstrate commercial exploitation of a mark.

51. Consequently, the applicant has failed to show commercial exploitation of the mark which is warranted in the economic sector concerned. The applicant will not, therefore, be able to rely on the goods for which its mark is registered. For the avoidance of doubt, my decision would have been the same even if I had found that variant g) was use upon which the applicant could rely.

52. I note the applicant's submissions regarding the findings of this Tribunal in Case O/595/17, a copy of which was annexed to the proprietor's written submissions in lieu. In that case, a finding of genuine use of the applicant's mark was made in respect of t-shirts because of an admission by the other party to those proceedings. The Hearing Officer expressly stated that the evidence provided by the applicant (in the absence of the admission made) would not have been sufficient to demonstrate genuine use. In any event, each case must be decided on its own merits.

53. Pursuant to section 47(2)(a) and section 47(2A) of the Act, the opposition under section 5(2)(b) and section 5(3) must, therefore, fail.

Section 5(4)(a)

54. Section 5(4)(a) of the Act has application in invalidation proceedings because of the provisions set out in section 47(2)(b) of the Act. By virtue of this section, a registered trade mark may be declared invalid if there is an earlier right which satisfies the conditions under section 5(4) of the Act, provided the owner of the earlier right has not consented to the registration. The proof of use requirements do not apply to the application based on section 5(4)(a) of the Act and therefore the applicant's failure to establish genuine use does not prevent its application on this ground from proceeding.

55. Section 5(4)(a) of the Act reads as follows:

“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 this Act as the proprietor of “an earlier right” in relation to the trade mark”.

56. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely

goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

Relevant date

57. Whether there has been passing off must be judged at a particular point (or points) in time. In her witness statement, Ms Lari states:

"The Contested Mark was already been used by Ogio International, Inc. in the United States so by applying for trade mark protection in the United Kingdom, the business was merely extending its brand protection in one of its core territories in the usual way, when we'd already started using the mark in the UK."

58. However, the proprietor has provided no evidence to show that it was using its mark prior to the date of the application. The relevant date for assessment of the passing off claim is, therefore, the date on which the contested mark was applied for i.e. 24 July 2017.

Goodwill

59. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

"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 customers. It is the one thing

which distinguishes an old-established business from a new business at its first start.”

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

“27. There is one major problem in assessing a passing 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 s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

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

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in

every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

62. Goodwill arises as a result of trading activities. The applicant has referred to sales made under the mark in his statement, but no evidence of any sales has been provided. The applicant has provided a print out from its website, but as this is dated 30 July 2018, this is some 8 months after the relevant date. I have been provided with no turnover figures and no financial information for the applicant's business.

63. Even a small business which has more than trivial goodwill can protect signs which are distinctive of that business under the law of passing off⁷. However, trivial goodwill is not protectable⁸. The evidence provided by the applicant is simply insufficient to establish that he has protectable goodwill in the UK or that its mark is distinctive of that goodwill. The only evidence provided by the applicant which is dated prior to the relevant date is the magazine cover dated 2001. As noted above, the cover itself does not display the applicant's mark. Even if it is assumed that the following article is taken from the same magazine (and is therefore also dated 2001), this is not sufficient to establish any goodwill which is more than trivial. I cannot, therefore, find that the applicant has any protectable goodwill. The applicant's claim for invalidity based upon section 5(4)(a) of the Act must, therefore, fail.

Section 3(6)

64. Section 3(6) of the Act has application in invalidation proceedings because of the provisions set out in section 47(1) of the Act. By virtue of this section, a registered trade mark may be declared invalid if it has been registered in breach of section 3 of the Act. The proof of use requirements do not apply to the application based on section 3(6) of the Act and therefore the applicant's failure to establish genuine use does not prevent its application on this ground from proceeding.

⁷ *Stacey v 2020 Communications* [1991] FSR 49

⁸ *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

65. Section 3(6) of the Act reads as follows:

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

66. The law in relation to section 3(6) of the Act (“bad faith”) 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), [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 Plastics 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)."

67. The relevant date under section 3(6) is the date of the application for the contested mark i.e. 24 July 2017.

68. The applicant submits that the proprietor knew of his earlier mark before filing the application. The proprietor acknowledges that the applicant's mark was listed on the

search report received from the IPO on 31 July 2017 (after the relevant date). No explicit confirmation is given as to whether this was the first time that the proprietor became aware of the applicant's mark, but Ms Lari confirms that they decided there was no conflict between the marks.

69. There is no evidence to support the claim that the proprietor knew either of the applicant's business or his use of the earlier mark at the relevant date. The mere fact that it is usual practice for attorneys to advise their clients on similar marks which fall within the same class as the class in which they seek registration of their applied for mark is not sufficient to prove this knowledge. In any event, mere knowledge of someone else's mark is not enough to make out this ground. Even if the proprietor had had the requisite knowledge, its conclusion (whether correct or not) that there was no conflict between the marks and its subsequent decision to proceed with the filing cannot be said to be either dishonest or to fall below the standards of acceptable commercial behaviour. There is nothing in the evidence to suggest that, at the relevant date, the proprietor was acting in a commercially unacceptable manner by applying for the contested mark. I find that the evidence is wholly insufficient to support an allegation of bad faith and the invalidation under section 3(6) is dismissed accordingly.

CONCLUSION

70. The application for invalidity is unsuccessful and the contested mark will remain registered in its entirety.

COSTS

71. The proprietor has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the proprietor the sum of **£1,150** as a contribution towards the costs of the proceedings. In calculating this sum, I have taken account of the fact that although the proprietor filed two sets of written submissions they accept that the first set of submissions were "subsumed" within the latter, meaning that the first set of submissions did not need to be considered in addition to their written submissions in lieu. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement	£300
Preparing evidence and considering the applicant's evidence	£500
Preparing written submissions	£350
Total	£1,150

72. I therefore order Kaveh Savage to pay Ogio International, Inc. the sum of £1,150. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

13th of February 2019

S WILSON
For the Registrar