

O-247-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 3248100 AND 3268139 BY
BOOHOO.COM UK LIMITED TO REGISTER THE FOLLOWING TRADE MARK**

A cursive, handwritten-style trade mark consisting of the word "Man" in black ink.

AND THE FOLLOWING SERIES OF THREE TRADE MARKS

A cursive, handwritten-style trade mark consisting of the word "Woman" in black ink.



AND



IN CLASSES 18, 25 AND 35

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER
NOS. 411562 AND 411751
BY MENNACE LIMITED**

Background and pleadings

1) Boohoo.com UK Limited (hereafter “the applicant”) applied for two UK trade mark registrations on 3 August 2017 and 3 November 2017, respectively. They were accepted and published in the Trade Marks Journal on 3 November 2017 and 24 November 2017, respectively. The marks are shown on the front cover of this decision and they are in respect of the following lists of goods and services:

Application 3248100

Class 18: *Luggage; bags; wash bags; wallets; card cases; luggage label holders; luggage tags; luggage straps; umbrellas.*

Class 25: *Clothing; footwear; headgear; menswear; articles of outer clothing; trousers; shorts; jeans; denims; tops; shirts; t-shirts; vests; knitwear; sweaters; tank tops; pullovers; sweatshirts; jumpers; jerseys; cardigans; hooded tops; jackets; coats; overcoats; blazers; waistcoats; suits; ties; underwear; undergarments; socks; nightwear; sleepwear; loungewear; dressing gowns; belts; braces; scarves; snoods; bandanas; gloves; leisurewear; casualwear; sportswear; sweatpants; track suits; rainwear; waterproof clothing; swimwear; ready-made clothes linings; boots; shoes; sports shoes; training shoes; headwear; hats; caps.*

Class 35: *Retail services, electronic shopping retail services, mail order retail services and shop retail services, all connected with the sale of toiletries, eyewear, spectacles and sunglasses, frames for spectacles and sunglasses, cases for eyewear, covers and cases for computers, computer software and programs, software applications, electronic publications, covers and cases for mobile phones, audio and/or visual recordings, electronic storage media, jewellery, cufflinks, tie pins and tie clips, watches and clocks and parts and fittings therefor, key rings, key chains, key fobs, key covers, printed publications, luggage, bags, wash bags, wallets, card cases, luggage label holders, luggage tags, luggage straps, umbrellas, drinking vessels, mugs, clothing, footwear, headgear, menswear, articles of outer clothing, trousers,*

shorts, jeans, denims, tops, shirts, t-shirts, vests, knitwear, sweaters, tank tops, pullovers, sweatshirts, jumpers, jerseys, cardigans, hooded tops, jackets, coats, overcoats, blazers, waistcoats, suits, ties, underwear, undergarments, socks, nightwear, sleepwear, loungewear, dressing gowns, belts, braces, scarves, snoods, bandanas, gloves, leisurewear, casualwear, sportswear, sweatpants, track suits, rainwear, waterproof clothing, swimwear, ready-made clothes linings, boots, shoes, sports shoes, training shoes, headwear, hats, caps, badges, belt clasps, games, toys and playthings and parts and fittings therefor; organisation, operation and supervision of loyalty programmes and of sales and promotional incentive schemes; advertising; marketing; promotional services; trade fairs; organisation of fashion shows for commercial or promotional purposes; information, advisory and consultancy services in relation to all of the aforesaid.

Application 3268139

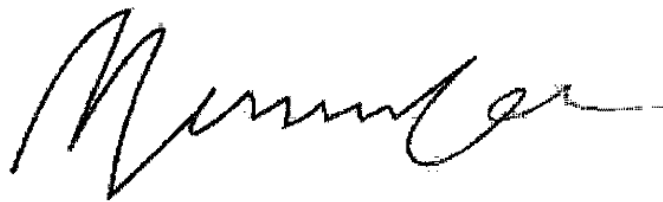
Class 18: *Luggage; bags; purses; wallets; card cases; wash bags; cosmetic bags; luggage label holders; luggage tags; luggage straps; umbrellas; parts and fittings for all of the aforesaid goods.*

Class 25: *Clothing; footwear; headgear*

Class 35: *Retail services, electronic shopping retail services, mail order retail services and shop retail services, all connected with the sale of toiletries, hair care products, beauty care products, cosmetics, fragrances, candles, eyewear, spectacles and sunglasses, frames for spectacles and sunglasses, cases for eyewear, covers and cases for computers and tablets, computer software and programs, software applications, electronic publications, covers and cases for mobile phones, audio and/or visual recordings, electronic storage media, jewellery, watches and clocks, watch straps, key rings, key chains, key fobs, key covers, printed matter, printed publications, stationery, cards, photographs, pictures, wrapping and packing materials, luggage, bags, purses, wallets, card cases, wash bags, cosmetic bags, luggage label holders, luggage tags, luggage straps, umbrellas, drinking vessels, mugs,*

water bottles, household textile articles, household linens, towels, clothing, footwear, headgear, clothing accessories, badges, belt clasps, hair ornaments, games, toys and playthings and parts and fittings therefor, gymnastic and sporting articles and parts and fittings therefor; organisation, operation and supervision of loyalty programmes and of sales and promotional incentive schemes; advertising; marketing; promotional services; trade fairs; organisation of fashion shows for commercial or promotional purposes; information, advisory and consultancy services in relation to all of the aforesaid.

2) Mennace Limited (hereafter “the opponent”) oppose the applications on the basis of section 3(6), section 5(4) (a) and section 5(4)(b) of the Trade Marks Act 1994 (“the Act”). The section 5(4)(a) ground is on the basis of its alleged earlier rights in the following sign:

A handwritten signature in black ink, appearing to read 'Mennace', with a long horizontal flourish extending to the right.

3) It claims to be the owner of goodwill through extensive use of this sign (as well as the word mark MENNACE, but I don't understand the reference to this sign to be a statement that the opponent relies upon it for the purposes of these proceedings) in the UK in respect of the following goods and services:

Bags, clothing, footwear, headgear, menswear, outerwear, shirts, t-shirts, shorts, trousers, tracksuits and accessories and retail and online retail of the same

4) It claims that the sign was designed in October 2016 and that it has been used extensively on its own website www.mennace.com, through the online fashion retailer www.asos.com as well as a physical retail store in London. The opponent claims that the applicant's marks and its sign are highly similar and that the first letter

of the respective marks and sign is the dominant and distinctive element and that these are highly similar. It also claims conceptual similarity on the basis that its MENNACE sign is a play on the words MEN and MENACE. It concludes that, as a result, use of the applicant's mark would "undoubtedly" result in misrepresentation by deceiving the public into believing that the applicant's goods and services originate from the opponent or that there is some economic connection to the opponent when no such connection exists.

5) The opponent also claims that the applications offend under section 5(4)(b) of the Act because:

(i) it is also the owner of the copyright in its sign that was created in October 2016. It claims the sign was designed by an employee of the opponent and that the copyright is vested in the opponent. It further claims that the applicant's mark constitutes a reproduction or adaptation of the opponent's work and constitutes copyright infringement, and;

(ii) Its sign is protected by unregistered Community design right under Council Regulation (EC) 6/2002, being a design that is new and of individual character. Consequently, use of the applicant's marks would constitute design right infringement.

6) Finally, the opponent also relies upon a ground based upon section 3(6) of the Act, claiming that the applicant and the opponent are competitors both based in Manchester and at least one of the opponent's employees, who had knowledge of its sign, moved to the applicant between October 2016 (the claimed date that the opponent's mark was conceived) and 3 August 2017/3 November 2017 (the respective filing dates of the two contested applications). It is submitted that the applicant has benefitted from knowledge acquired from its ex-employees and acted in ways that fall short of acceptable standards of commercial behaviour by designing marks that is highly similar to its sign and applying to register them.

7) The applicant filed counterstatements denying the claims made. In addition, it challenges the admissibility of the oppositions because they are in a name that is different to the company that filed two Form TM7As (Notice of Threatened

Oppositions) and that there is not sufficient information to satisfy the requirements of Rule 17(3) of the Trade Mark Rules 2008.

8) The two sets of proceedings were subsequently consolidated.

9) Both sides filed evidence and the applicant has also provided written submissions in these proceedings. The evidence will be summarised to the extent that it is considered necessary. The written submissions will not be summarised but will be kept in mind. A Hearing took place on 7 March 2019, with the opponent represented by Jonathan Moss of Counsel, instructed by Marks & Clerk LLP and the applicant by Andrew Norris of Counsel, instructed by Wilson Gunn.

Evidence

10) The opponent's evidence takes the form of two witness statements, the first by Steven McKiernan, Finance Director of the opponent, and the second by Zahiah Alawneh, Design Manager of the opponent.

11) The applicant's evidence is also in the form of two witness statements, the first by Keri Devine, General Counsel and Company Secretary of the applicant, and the second by Shane Chin, Menswear Design Manager of the applicant.

DECISION

Admissibility of the oppositions

12) The applicant challenged the admissibility of the oppositions on the basis that the Form TM7A was filed by a different company to the opponent and was, therefore, contrary to Rule 17(3). The Form TM7A was filed in the name of Debbie Morgan Macao Commercial Offshore Limited ("Debbie Morgan"). It is explained by Mr McKiernan that this company and the opponent are both subsidiaries of the same holding company (called Nakai Investments Limited) described as being the 100%

owner of both Debbie Morgan and the opponent¹ and that, as a consequence, the oppositions meet the requirements set out in Rule 17(3). This was point was not pursued further at the hearing.

Substantive Issues

13) I find it convenient to begin by considering the grounds based upon Section 5(4)(a).

Section 5(4)(a)

14) Section 5(4)(a) states:

“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.”

15) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

¹ Mr McKiernan’s witness statement, para. 4

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

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

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

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

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

16) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

The relevant dates

17) The relevant date for assessing if section 5(4)(a) applies has been discussed by Mr Daniel Alexander QC sitting as the Appointed Person in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11. A summary of the position provided by Allan James, for the Registrar, in *SWORDERS TMO-212-06* was quoted with approval and I reproduce it below:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

18) The relevant dates for the purposes of these proceedings is the filing date of the contested applications, namely 3 August 2017 and 3 November 2017 respectively. The applicant states that its clothing and accessories range sold under its “broken MAN” mark (shown in paragraph 47) and the contested “Man” mark (that was developed in June 2017), “quickly proved popular”² and that this led to the development of its “Woman” mark in October 2017 and the evidence illustrates this new mark was designed on 30 October³ (just three days before the date its contested application was filed). From this, I take two points. Firstly, the applicant’s “Man” mark was conceived a little over a month prior to its filing date, but it is not possible to ascertain to what extent this was the case and I cannot conclude that, at the relevant date, there was any competing goodwill in respect of this mark. Secondly, with the design of the applicant’s “Woman” mark only being completed 3 days before the second relevant date, this points to there being no use prior to the second relevant date and, consequently, there can be no competing goodwill identified by this mark. In the absence of any counterclaim to an earlier or concurrent goodwill on the part of the applicant there are only two relevant dates for assessing

² Mr Chin’s witness statement, para. 7

³ Ditto and Exhibit SC3

the issue of passing off in these proceedings, namely, the filing dates of the contested applications. Even if there was such a claim, the evidence fails to support this.

Goodwill

19) A long-standing definition of goodwill is provided in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

20) In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

21) However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

22) It is the evidence of Mr McKiernan⁴ that the MENNACE brand was launched by the opponent in September 2017. This is relevant to the assessment of goodwill. This launch was after the filing date (the relevant date) of the applicant’s MAN mark and about seven weeks (the precise date of the launch was 14 September 2017⁵) prior to the second relevant date. As a consequence of this the opponent’s reliance upon pre-launch promotion of its mark becomes a pivotal issue, particularly in respect of the case against the applicant’s MAN signature mark.

23) The opponent’s evidence relating to the promotion of its sign prior to its launch can be summarised as follows:

- The opponent’s Instagram account includes posts of photographs of garments on the following dates⁶:
 - No posting date but accessed on 4 July 2018. A sign is visible on one of the garments, but this is the word MENNACE in block capital letters and not the earlier sign relied upon;
 - 24 November 2016 (with the text “COMING SOON”) and 29 November 2016 (with the text “SECRET SNAPSHOTS). Both of these posts partially show a sign appearing on garments and I have no reason not to assume these relate to the sign relied upon;

⁴ Mr McKiernan’s 1st witness statement, para 2

⁵ See Exhibit SM3, page 29

⁶ Exhibit SM3

- Two posts both dated 5 March 2017 (with the text including “MENNACE X @ asos”) and appear to show the earlier sign appearing on the front of sweatshirts;
- 11 April 2017 (providing “first look” at “Mennace Summer 17”) and 15 April 2017, both showing the earlier sign appearing on the front of t-shirts;
- 30 June 2017 (text includes “MENNACE@asos_man” and a customer comment that states “wanna buy y’all grey rose hoodie off ASOS but the shipping is too long. Let me buy it off y’all”). The earlier sign is visible on the sleeve of the garment;
- 20 July 2017 appears to show the earlier sign on track trousers, but the image is too small to be absolutely certain;
- Eight posts in August 2017 including on 11 August 2017 (showing “Mennace Signature T-Shirt available at @asos and on Mennace.com soon”).

24) The opponent also asserts that there have been sales of garments before the relevant dates, through the ASOS website. There is no supporting evidence of this and there are several comments on the opponent’s INTAGRAM account, namely the comment on the post of 30 June 2017 suggesting that the “shipping is too long” of the items offered for sale of the ASOS website, and the 11 August 2017 post stating that “available at @asos soon”. These comments are consistent with the opponent’s garments not being available on the ASOS website, or anywhere else until after the launch in September 2017. Further, as Mr Norris pointed out, the only reference to turnover is made by Mr McKiernan in his first witness statement⁷ and is couched in terms of from “... to the end of April 2018”. Therefore, such sales may all have occurred after the launch date. Consequently, this evidence does not support the assertion that there were pre-launch sales on the ASOS website. When factoring this in with the absence of any sales figures, I find that the evidence fails to demonstrate that there were any pre-launch sales of garments bearing the earlier sign.

⁷ Para 9

25) In respect of the advertising via *Instagram* posts, it is not clear whether an advertising campaign featuring a mark can create a protectable goodwill without any actual sales to UK customers. In *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31, Lord Neuberger (with whom the rest of Supreme Court agreed) stated (at paragraph 66 of the judgment) that:

“Finally, a point which I would leave open is that discussed in the judgment of Sundaresh Menon CJ in *Staywell* (see para 46 above), namely whether a passing off claim can be brought by a claimant who has not yet attracted goodwill in the UK, but has launched a substantial advertising campaign within the UK making it clear that it will imminently be marketing its goods or services in the UK under the mark in question. It may be that such a conclusion would not so much be an exception, as an extension, to the “hard line”, in that public advertising with an actual and publicised imminent intention to market, coupled with a reputation thereby established may be sufficient to generate a protectable goodwill. On any view, the conclusion would involve overruling *Maxwell v Hogg*, and, if it would be an exception rather than an extension to the “hard line”, it would have to be justified by commercial fairness rather than principle. However, it is unnecessary to rule on the point, which, as explained in para 46, has some limited support in this jurisdiction and clear support in Singapore. Modern developments might seem to argue against such an exception (see para 63 above), but it may be said that it would be cheap and easy, particularly for a large competitor, to “spike” a pre-marketing advertising campaign in the age of the internet. It would, I think, be better to decide the point in a case where it arises. Assuming that such an exception exists, I do not consider that the existence of such a limited, pragmatic exception to the “hard line” could begin to justify the major and fundamental departure from the clear, well-established and realistic principles which PCCM's case would involve. In this case, PCCM's plans for extending its service into the UK under the NOW TV mark were apparently pretty well advanced when Sky launched their NOW TV service, but the plans were still not in the public domain, and therefore, even if the exception to the “hard line” is accepted, it would not assist PCCM.

26) Taking these comments into account, it appears that advertising under a mark is not sufficient to create an actionable goodwill where was no imminent prospect of trade commencing at the time: *Bernadin (Alain) et Cie v Pavilion Properties Ltd* [1967] RPC 581. Pre-launch publicity appears to have been accepted as sufficient to create an actionable goodwill in the cases of *Allen v Brown Watson* [1965] RPC 191 and *BBC v Talbot* [1981] FSR 228, but as explained in paragraph 3-071 of Wadlow's 'The Law of Passing Off 5th Ed', the plaintiffs in these cases had long established businesses and goodwills in the UK. The real issue was whether their new marks had become distinctive of those businesses to their UK customers through advertising alone. Until the law is clarified, it is therefore doubtful whether a business with no sales to UK customers can establish a passing off right based solely on advertising.

27) I accept there was some limited promotion on *Instagram* in the 10 months prior to the launch of the opponent's MENNACE brand. However, in line with the above guidance and in the absence of any evidence illustrating that the opponent had a pre-existing goodwill, this very small number of attempts, in one single social medium, to promote the MENNACE brand requires me to conclude that this activity does not demonstrate that any goodwill has accrued prior to the launch date in September 2017. Therefore, I agree with Mr Norris when he submitted that these are not evidence of goodwill and that goodwill has, at best, only been demonstrated from September 2017.

28) Further, there is evidence that the launch was trailed on the opponent's website in August 2017⁸. The extract provided is dated 17 July 2017 providing information about the MENNACE brand and announcing its launch in September 2017. The signature sign relied upon appears several times. Whilst Mr McKiernan has produced figures for the number of user sessions/visits to the opponent's website (I discuss this in more detail later), these figures do not extend back to August and it is reasonable to infer that prior to any launch, the website would have attracted a much lower level of visits than after the launch. Further, later in his witness statement (see

⁸ Mr McKiernan's first witness statement, para 9 and Exhibit SM7

footnote 9), he states that this “website went live in September 2017 to coincide with the official launch” thus casting doubt on when this extract was actually made publicly available. Therefore, as with the Instagram posts, I find that this single extract fails to support a claim that the opponent has the requisite goodwill.

29) There is one further element of the opponent’s pre-launch evidence that requires comment. Mr McKiernan provides two instances of pre-launch media interest⁹. Only one is before the launch date of 14 September 2017. It is dated 21 August 2017 and appeared on the website www.draperonline.com and appears to be an industry website and therefore does not illustrate that goodwill is being generated amongst the opponent’s customers or potential customers. Further, this article does not show the signature MENNACE sign relied upon.

30) In summary, whilst taking due notice of the limited promotion on *Instagram*, one media report and one extract showing pre-launch promotion on the opponent’s website, I find that even when taken together, this does not amount to illustrating the existence of goodwill prior to the launch of the MENNACE brand. In reaching this conclusion, I keep in mind the guidance identified above.

31) As a consequence, the opponent did not have the requisite goodwill at the relevant date of its opposition to the applicant’s MAN signature mark and the section 5(4)(a) grounds fail against this application.

32) Turning to the opposition to the applicant’s WOMAN mark, in light of my finding that no goodwill was developed prior to the launch date, it is necessary that I consider the use of the opponent’s sign since that date (14 September 2017), up to the filing date of the applicant’s WOMAN signature mark of 3 November 2017. The evidence in support of such use can be summarised as follows:

- Numerous posts were made on *Instagram* to promote the launch:
 - Thirteen posts in September 2017 including 14 September 2017 “LAUNCHING TODAY” and “SHOP NOW WWW.MENNACE.COM”,

⁹ Exhibit SM6

and on 30 September 2017 “Find us at [the London store] or shop online at MENNACE.COM”,

- Twelve posts in October 2017,
- Two in the first two days of November 2017.
- The opponent’s website www.mennace.com went live in September 2017 to coincide with the official launch of the MENNACE brand¹⁰. Over 100,000 sessions/visits were received to the website in both September and October 2017¹¹;
- Marketing spend is provided from August 2017 and for the relevant 3 months it was:
 - August 2017: £4,380
 - September 2017: £51,093
 - October 2017: £216,548
- A turnover of £1.5 million is stated between November 2016 and April 2018¹², but it is not possible to ascertain what proportion of these sales occurred prior to the relevant date of 3 November 2017;
- “Shortly after” the launch, the opponent undertook an “out of home” advertising campaign “in prominent areas of the United Kingdom’s major cities”¹³. Copies of photographs are provided showing roadside billboards promoting the brand in locations such as Hammersmith Broadway in London, Manchester One in Manchester and Trinity Leeds.¹⁴. The opponent’s signature mark is visible in some, but not all of these;
- The opponent worked closely with social media “influencers” described as “individuals with a significant social media following” who have featured products bearing its signature mark¹⁵;
- An article that appeared in *Retail Gazette* of 27 September 2017 shows the earlier sign and announces the launch of the Mennace label with an online store and a physical pop-up store in London¹⁶.

¹⁰ Mr McKiernan’s first witness statement, para. 11

¹¹ Ditto

¹² Ditto, para 10

¹³ Ditto, para 13

¹⁴ Exhibit SM8

¹⁵ Mr McKiernan’s first witness statement, para. 14

¹⁶ Ditto, para 9 and Exhibit SM6

33) Mr Norris criticised the evidence of turnover on the basis that it fails to differentiate what proportion relates to sales under the signature version of the sign and because the information straddles use before and after the relevant dates in a way that makes it impossible to ascertain what proportion relates to sales/use before the relevant dates. These are valid criticisms that I agree with. However, I also note that the evidence clearly shows the signature sign in use and a reasonable level of promotion of the brand and its launch. Further, the evidence illustrates that the store in London also opened at the time of the launch in September 2017. In light of the other evidence provided, it is not credible to assume that garments bearing the signature sign were not sold from this store during its first seven weeks of opening i.e. up to the relevant date of 3 November 2017. Taking all of this together, I accept that the opponent has a small goodwill generated as a result of the launch of its brand and the opening of a store in London from which the garments bearing the sign were sold.

34) There is also the question of whether the opponent has the requisite goodwill in respect of retail and online retail. None of the opponent's evidence illustrates use of its signature sign in respect of these services. Where the brand is referred to, it is by way of the word MENNACE in ordinary typeface. I have little hesitation in concluding that the evidence fails to demonstrate that the opponent's signature mark identifies any goodwill in respect of retail services.

35) In summary, I find that the opponent has demonstrated that it has the requisite if goodwill, albeit small, at the relevant date of the second opposition (against the applicant's WOMAN mark). This goodwill exists in respect of garments only.

Misrepresentation and damage

36) In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

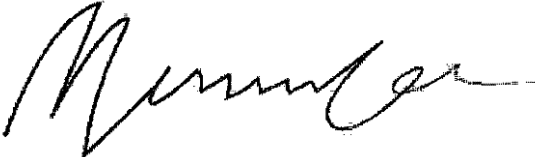

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

37) The respective signs are:

Opponent's sign	Applicant's marks
	

38) Relevant to the considerations regarding misrepresentation is that the goods covered by the applicant's mark are, in part, identical to the goods in which the opponent's goodwill exists.

39) The respective marks/signs have some similarities, namely, they are both presented in a signature style and the first letter of both consists of a double-pointed shape. However, there are also significant differences, namely, the first letters differ, one being a “W”, the other an “M” and the applicant’s mark is likely to be perceived as the handwritten form of the word “Woman” but the opponent’s mark is difficult to read beyond its initial letter and possibly the letter “e” at the end of the word. In its pleadings, the opponent claimed that there was also conceptual similarity because its sign is a play on the words MEN and MENACE. I dismiss this. Even if the mark was legible enough to read it as MENNACE, it is my view that it would merely be seen as a misspelling of the word MENACE.

40) These differences easily outweigh the similarities and even where the identical goods are involved it is not likely that a substantial number of members of the public will be misled into purchasing the applicant’s goods in the belief that they are the opponent’s goods. Even if I am wrong and members of the public will perceive the word “Mennace” in the opponent’s mark, this will merely serve to introduce a further, and significant difference in the conceptual identity of the marks. Consequently, there is no misrepresentation and, by extension, no damage.

41) Even if I am wrong in finding that the opponent’s goodwill did not exist at the relevant date of the applicant’s MAN mark, I would also find that use of this mark would not result in misrepresentation because the differences between the respective sign and mark are pronounced because of the much shorter nature of the applicant’s mark (being only three letters). This difference in length will be instantly obvious to the relevant public. The opponent relies upon the similarity of the common letter “M” at the start of each mark, but beyond creating the impression of a handwritten letter “M” that leans slightly to the right, there are a number of differences, namely, the rounded nature of the peaks and trough of the letter and also of the upswing to join the letter to the letter “a”. In the opponent’s sign, these are all more pointed in nature. Further. The length of the righthand arm is short in the applicant’s letter “M”, but long in the opponent’s sign. Take all of this into account, I find that the differences are such that it is unlikely that use of the applicant’s mark will result in misrepresentation.

42) In summary, the opponent's grounds based upon section 5(4)(a) fail against both of the applicant's marks.

Section 5(4)(b)

43) Section 5(4)(b) states:

“5. –(1) ...

(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) ...

(b) By virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

44) To recap, the relevant dates in these consolidated proceedings are the filing dates of the two contested applications, namely, 3 August 2017 and 3 November 2017 respectively. The earlier right relied upon are copyright and unregistered design right. The opponent must have been in a position to prevent use of the applicant's marks under the law of copyright and the law of unregistered Community designs at these two dates.

The claim to copyright infringement

45) Firstly, I consider the ground insofar as it is based upon an earlier copyright. Section 1 and Section 4(1) of the Copyright Act state:

“(1) Copyright is a property right which subsists in accordance with this Part in the following descriptions of work –

- (a) original literary, dramatic, musical or artistic works,
- (b) sound recordings, films [or broadcasts], and
- (c) the typographical arrangement of published editions.”

and

“4. Artistic works.

(1) In this Part “artistic work” means-

- (a) A graphic work, photograph, sculpture or collage, irrespective of artistic quality,
- (b) ...
- (c) A work of artistic craftsmanship”

46) A helpful summary of the main principles of copyright law and artistic works was given by District Judge Clark in *Suzy Taylor v Alison Maguire* [2013] EWHC 3804 (IPEC):

6. I will set out the law in greater detail than usual to assist the unrepresented Defendant, who did not attend the hearing, in understanding it. Section 1 of the CDPA provides for copyright to subsist in original artistic works. An "original artistic work" is a work in which the author/artist has made an original contribution in creating it – for example by applying intellectual effort in its creation.

7. Artistic works are listed in s.4(1) CDPA and include "a graphic work... irrespective of its artistic quality". Graphic work is defined in 4(2) as including "(a) any painting, drawing, diagram map, chart or plan and (b) any engraving, etching, lithograph, woodcut or similar work...".

8. For an artistic work to be original it must have been produced as the result of independent skill and labour by the artist. The greater the level of originality in the work the higher the effective level of protection is, because it is the originality which is the subject of copyright protection. If the work includes elements which are not original to the artist then copying only those elements will not breach that artist's copyright in the work. It is only where there is copying of the originality of the artist that there can be infringement.

...

11. If something is an exact copy of the whole or a substantial part of an artistic work protected by copyright, it will be an infringement if there is no defence provided by one of the exceptions contained in the CDPA. If something is an inexact copy, for example if it merely resembles an artistic work protected by copyright, it may or may not be infringing. The issue is whether it is a mere idea which has been copied or whether it is the work itself – ie the expression of the author's idea – which has been copied. There is no copyright in an idea per se because a mere idea is not a "work" in which copyright can subsist.

12. The issue was considered by Lord Hoffman in *Designers Guild Ltd v Russell Williams (Textile) Ltd* [2001] FSR11 HL who said:

"Plainly there can be no copyright in an idea which is merely in the head, which has not been expressed in copyrightable form, as a literary, dramatic, musical or artistic work, but the distinction between ideas and expression cannot mean anything so trivial as that. On the other hand, every element in the expression of an artistic work (unless it got there by accident or compulsion) is the expression of an idea on the part of the author. It represents her choice to paint stripes rather than polka dots, flowers rather than tadpoles, use one colour and brush technique rather than another, and so on. The expression of these ideas is protected, both as a cumulative whole and also to the extent to which they form a "substantial part" of the work..."

Ladbroke (Football) Ltd v William Hill (Football) Ltd establishes that substantiality depends on quality rather than quantity... and there are numerous authorities which show that the "part" which is regarded as substantial can be a feature or combinations of features of the work, abstracted from it rather than forming a discrete part. That is what the judge found to be copied in this case...

Generally speaking, in cases of artistic copyright, the more abstract and simple the copied idea, the less likely it is to constitute a substantial part. Originality, in the sense of the contribution of the author's skill and labour, tends to lie in the detail with which the basic idea is presented."

13. Lord Hoffman went on to set out the correct approach for a court concerned with determining an action for infringement of artistic copyright, which is the approach I shall follow:

"The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying...

Once the judge has found that the defendant's design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright

work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the defendants work... The pirated part is considered on its own... and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose.”

47) Therefore, an “artistic work” is one where “the author/artist has made an original contribution in creating it”. The opponent’s evidence in support of its claim includes the following:

- It was created in the course of his employment with the opponent¹⁷;
- Partial images of the earlier sign are shown in the opponent’s Instagram posts from as early as 24 November 2016 and complete images from at least 5 March 2017¹⁸;
- A second post, dated 29 November 2016, illustrates what is described in the post as “secret snap shots” and contains a copy of four polaroid photographs, one of which shows the opponent’s sign on a garment and with the sign also appearing on the part of the print below the photograph itself¹⁹;
- Mr Alawneh provides internal documents in the form of a design sheets he produced when creating garments, dating back to 21 October 2016²⁰. He claims that these documents all show the earlier right appearing on sketches of the garments. I observe the following:
 - Design sheet dated “21/10/16” shows a sketch of a jacket with what is possibly the sign appearing on the back, between the shoulder blades, but the size of the image is too small to say with certainty;
 - Design sheet dated “16/11/16”: The designer is identified as being someone other than Mr Alawneh and it is not possible to identify any reference to the opponent’s sign;
 - Other design sheet clearly show the earlier sign, but are dated after both the relevant dates.

¹⁷ Ditto, para. 3

¹⁸ Exhibit SM3

¹⁹ See the various Instagram posts reproduced at Exhibit SM3

²⁰ Ditto, para. 4 and Exhibit ZA2

48) The role of the actual word included in the copyright work are relatively unimportant because (a) the allegation of copying is based on the logo element of the creation, and (b) viewed as an artistic work, the logo element of the creation is undoubtedly the most important part of the work in qualitative terms.

49) The applicant does not dispute that copyright exists in the opponent's mark from the date claimed and it is clearly from the above evidence that the opponent's mark was created by Mr Alawneh in October 2016²¹ and consists of original features such as the style and presentation of the words. However, that applicant denies that it has copied the sign and that, further, its mark and the opponent's sign are dissimilar and are independent creations.

50) Its evidence is that Mr Chin, its Menswear Design Manager, created its marks in the course of his employment with the applicant²². He explains that the applicant had already experienced "great commercial success" with its range of garments and accessories branded with the following logo²³:



51) The applicant claims that it wished to exploit what it believed to be a clear trend in the industry towards script style lettering such as the long-standing *Ben Sherman* and *Pierre Cardin* brands and claimed that this style was being picked up by more and more brands in 2017. An internal document produced at that time (2017) is provided showing many different "script" brands²⁴. This trend led Mr Chan to create the contested marks. He provides a screen grab of a pdf file entitled "MAN Script" showing the MAN mark he created. The file is dated "Wednesday 21 June 2017

²¹ Mr Alawneh's witness statement, para. 2 and 3

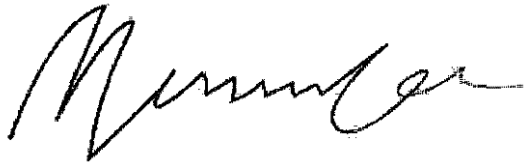


²² Mr Chin's witness statement, para. 3

²³ Ditto, para. 4

²⁴ Exhibit SC1

17:50”²⁵. He developed similar branding for the women’s side of the business and he had completed the design of the applicant’s WOMAN mark by 30 October 2017 and again, he provides a screen grab of a pdf file showing the image he created. It is dated Monday 30 October 2017 17:58”²⁶.

52) I must consider if these creations involved copying of the opponent’s sign. I begin my analysis by undertaking a visual comparison of the respective works to identify the similarities and differences. For convenience, I reproduce them below:

Opponent’s sign	Applicant’s marks
	
	

53) It is convenient that I begin by comparing the opponent’s sign with the applicant’s “Woman” mark. At the hearing, Mr Moss submitted that there is case law that supports a finding of copyright infringement even in circumstances where the signs are quite different. In particular, he referred to *Temple Island Collections Ltd v New English Teas Ltd* [2012] EWPC and *Taylor v Maguire* [2013] EWHC 3804. I note these cases and the potential impact upon my considerations in the current case and I keep in mind, in particular, the following principles highlighted in these cases:

- (i) The greater the level of originality in the work, the higher the effective level of protection,
- (ii) Copyright is infringed by reproducing the whole or a substantial part in a material form. A “substantial part” is a matter of quality not quantity,
- (iii) If the work includes elements which are not original to the artist then copying only those elements will not breach that artist’s copyright in the work,

²⁵ Ditto, para. 6 and Exhibit SC2

²⁶ Ditto, para. 7 and Exhibit SC3

54) Firstly, it is my view that the colour present in the second in the series of the applicant's mark will make no material difference to the comparison and for that reason, I will only consider the similarity with the first mark in the series.

55) Mr Moss identified that both signs comprise signature type text, are a single word, have a first letter leaning to the right and have progressively less readable text. I agree that the signs consist of a single word and they are similar in that they are in a handwritten style, but upon closer analysis, the writing style is quite different. I disagree that both signs are progressively less readable. This may be the case in the opponent's sign, but in the applicant's mark every letter remains legible. Further, the mere fact that the first letter of both signs leans to the right is a common feature of handwriting and is a similarity only at a very general level and, alone, it does not support the contention of copying. The applicant's sign begins with the letter "W" and the opponent's sign with a letter "M". By the very nature of these two letters share some similarities being essentially an inverted image of each other, but beyond the "leaning to the right" point there is nothing in these similarities that may have arisen from copying.

56) Taking all of this together, I find that the visual presentation of the applicant's mark fails to support the assertion that it, or a substantial part of it, resulted from copying of the opponent's sign. Other circumstances such as the parties being in competition, both based in Manchester and that a number of staff have moved from the opponent to the applicant do not impact upon this finding.

57) The section 5(4)(b) based upon infringement of copyright fails in respect of the applicant's "Woman" sign.

58) Next, I turn to consider the applicant's "Man" mark. Mr Moss made the same submissions as detailed in paragraph 55, above, and additionally identified the fact that both signs begin with the letter "M". Mr Norris submitted that Mr Moss' identification of common elements is done at a very general level and many signature-type signs would be caught. Certainly, I am content that the general common elements such as the fact that both signs are in the form of a signature and that both signs consist of a single word are insufficient to demonstrate that a

substantial part of the opponent's sign has been covered. Further, my rejection of the submission that the applicant's "Woman" mark is progressively less readable extends to its "Man" mark. Here, it is easily perceived as either "Man" or possible as "Maw". This is quite unlike the opponent's sign that is essentially illegible after the first letter. Further, there is an added difference when considering the applicant's "Man" sign. It is significantly shorter than the opponent's sign and is an obvious, easily observed difference.

59) Having described the differences identified above, it is my view that if there is a substantial part of the opponent's sign that is copied, the only element of the applicant's mark that is a realistic candidate is the initial letter "M". Mr Norris submitted that "nothing has been taken" from the opponent's sign and that the expression of the letter "M" is different. As I observed earlier, there are differences in the presentation of the letter. The two "peaks" are pointed in the opponent's sign but rounded in the applicant's sign, there is a sharp upturn to join the second letter that creates a dropped "v" type element to the opponent's sign compared to a less dropped and curved aspect to the same part of the applicant's sign. Further, the righthand arm of the letter "M" in the opponent's sign is the letter's longest arm whereas in the applicant's sign it is the shortest. Finally, the lefthand arm of the applicant's letter is slightly curled under, an element that is absent in the opponent's letter. Whilst acknowledging the similarities, these differences are all typical of the kind that occurs from one person's signature to another's and I find that they are sufficient to reach a finding that no substantial part of the opponent's sign has been copied.

60) In light of this finding, the claim to copyright infringement fails. Once again, the movement of employees from the opponent to the applicant or that the parties are competitors both based in Manchester does not disturb such a finding.

61) In summary, the section 5(4)(b) grounds based upon copyright infringement fails in respect of both of the applicant's marks.

The claim to unregistered design infringement

62) Turning now, to the claim that the applicant's mark infringe the opponent's unregistered design right that exists in its "Mennace" sign, the opponent relies upon the same evidence as summarised in respect of its case based upon copyright (see paragraphs 47, above).

63) The Community Designs Regulation 6/2002 has direct effect in the UK. The relevant articles of this Regulation are as follows:

Article 3 Definitions

For the purposes of this Regulation:

(a) "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation;

(b) "product" means any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs;

(c) -.

Article 10 Scope of protection

1. The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression.

2. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration.

Article 19 Rights conferred by the Community design

1. A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

2. An unregistered Community design shall, however, confer on its holder the right to prevent the acts referred to in paragraph 1 only if the contested use results from copying the protected design. The contested use shall not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

64) Mr Moss directed me to *DKH Retail Ltd v H Young Operations Ltd* [2014] EWHC 4034 (IPEC) where Hacon HHJ set out the principles that apply to unregistered designs and cited the following from *Magmatic Ltd v PMS International Ltd* [2014] EWCA Civ 181:

“44. ... As Jacob L.J. observed in *Procter & Gamble* at [2007] EWCA 936 at [3]:

‘The most important things in a case about registered designs are:

- (i) The registered design;
- (ii) The accused object;
- (iii) The prior art.

And the most important thing about each of these is what they look like.’

45. I would add that the two designs must therefore be considered globally and, as one would expect, the informed user will attach less significance to those features which form part of the design corpus and correspondingly greater significance to those features which do not. So also, the informed user will attach particular importance to features in

respect of which the designer had a great deal of design freedom. The analysis is not limited to these considerations, however, for a global assessment also requires the designs to be considered having regard to the way in which the products to which the designs are intended to be applied are used, with some features having greater prominence than others, perhaps because they are more visible.”

65) In respect of the informed user, for the purpose of that analysis, Hacon HHJ states that they will have the characteristics identified by Birss J in his judgment in *Samsung v Apple* [2012] EWHC 1882 (Pat). This, together with the other most relevant parts are re-produced below.

“The informed user

33. The designs are assessed from the perspective of the informed user. The identity and attributes of the informed user have been discussed by the *Court of Justice of the European Union in PepsiCo v Grupo Promer (C-281/10P) [2012] FSR 5* at paragraphs 53 to 59 and also in *Grupo Promer v OHIM [2010] ECDR 7*, (in the General Court from which PepsiCo was an appeal) and in *Shenzhen Taiden v OHIM*, case T-153/08, 22 June 2010.

34. Samsung submitted that the following summary characterises the informed user. I accept it and have added cross-references to the cases mentioned:

i) He (or she) is a user of the product in which the design is intended to be incorporated, not a designer, technical expert, manufacturer or seller (*PepsiCo* paragraph 54 referring to *Grupo Promer* paragraph 62; *Shenzen* paragraph 46).

ii) However, unlike the average consumer of trade mark law, he is particularly observant (*PepsiCo* paragraph 53);

iii) He has knowledge of the design corpus and of the design features normally included in the designs existing in the sector concerned

(*PepsiCo* paragraph 59 and also paragraph 54 referring to *Grupo Promer* paragraph 62);

iv) He is interested in the products concerned and shows a relatively high degree of attention when he uses them (*PepsiCo* paragraph 59);

v) He conducts a direct comparison of the designs in issue unless there are specific circumstances or the devices have certain characteristics which make it impractical or uncommon to do so (*PepsiCo* paragraph 55).

35. I would add that the informed user neither (a) merely perceives the designs as a whole and does not analyse details, nor (b) observes in detail minimal differences which may exist (*PepsiCo* paragraph 59).

Design freedom

40. In *Grupo Promer* the General Court addressed design freedom in paragraphs 67-70. In *Dyson* Arnold J. summarised that passage from *Grupo Promer* as follows:

“design freedom may be constrained by (i) the technical function of the product or an element thereof, (ii) the need to incorporate features common to such products and/or (iii) economic considerations (e. g. the need for the item to be inexpensive).”

Effect of differences between the registered design and the design corpus

51. Apple drew my attention to paragraph 74 of the judgment of the General Court in *Grupo Promer* in which the Court agreed with the ruling of the Board of Appeal that:

“as regards the assessment of the overall impression produced by the designs at issue on the informed user, the latter will automatically

disregard elements 'that are totally banal and common to all examples of the type of product in issue' and will concentrate on features 'that are arbitrary or different from the norm'."

52. Apple submitted that this showed that a design feature need not be unique to be relevant. It is only disregarded if it is totally banal. Thus, Apple submitted, for a feature to be relevant it merely needs to differ from the norm and by logical extension, the greater the difference from the norm, the more weight to be attached to it. The point of this submission is to challenge the manner in which Apple contended Samsung was advancing its case. I do not think Apple's characterisation of Samsung's case was entirely accurate, but in any case I accept Apple's submission on the law at least as follows. The degree to which a feature is common in the design corpus is a relevant consideration. At one extreme will be a unique feature not in the prior art at all, at the other extreme will be a banal feature found in every example of the type. In between there will be features which are fairly common but not ubiquitous or quite rare but not unheard of. These considerations go to the weight to be attached to the feature, always bearing in mind that the issue is all about what the items look like and that the appearance of features falling within a given descriptive phrase may well vary.

The correct approach, overall

57. The point of design protection must be to reward and encourage good product design by protecting the skill, creativity and labour of product designers. This effort is different from the work of artists. The difference between a work of art and a work of design is that design is concerned with both form and function. However design law is not seeking to reward advances in function. That is the sphere of patents. Function imposes constraints on a designer's freedom which do not apply to an artist. Things which look the same because they do the same thing are not examples of infringement of design right.

58. How similar does the alleged infringement have to be to infringe?

Community design rights are not simply concerned with anti-counterfeiting. One could imagine a design registration system which was intended only to allow for protection against counterfeits. In that system only identical or nearly identical products would infringe. The test of “different overall impression” is clearly wider than that. The scope of protection of a Community registered design clearly can include products which can be distinguished to some degree from the registration. On the other hand the fact that the informed user is particularly observant and the fact that designs will often be considered side by side are both clearly intended to narrow the scope of design protection. Although no doubt minute scrutiny by the informed user is not the right approach, attention to detail matters.”

66) Taking all of the above into account, I find that the opponent’s claim based upon an earlier right under EU design law fails for the same reasons as its claim to an earlier right based on copyright; namely, that it has not established that the applicant’s mark was copied from the earlier design. I must automatically disregard elements that are totally banal and common to all examples of the type of product in issue and I must concentrate on features that are arbitrary or different from the norm. The differences between the respective designs are such as to point away from copying.

67) In summary, the section 5(4)(b) ground based upon an earlier unregistered Community Design fails against both of the applicant’s marks.

Section 3(6)

68) Finally, I consider the ground based upon section 3(6). This section of the Act states:

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

69) 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):

“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 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)."

70) The opponent's case is that the applicant and the opponent are competitors both based in Manchester and at least one of the opponent's employees, who had knowledge of its sign, moved to the applicant between October 2016 (the claimed date that the opponent's mark was conceived) and 3 August 2017/3 November 2017 (the respective filing dates of the two contested applications). It is submitted that the applicant has benefitted from knowledge acquired from its ex-employees and acted in ways that fall short of acceptable standards of commercial behaviour by designing marks that are highly similar to its sign and applying to register them.

71) The applicant's defence is threefold. Firstly, it asserts (and provides evidence) that its two marks were independently designed by Shane Chin. Secondly, that the respective marks and sign are not even vaguely similar, particularly taking into account that "signature" brands are common place in the fashion industry. Thirdly, it strenuously denies any wrongdoings. Whilst six ex-employees of the opponent are identified²⁷ as now working for two different companies within the "Boohoo Group companies" (with entirely different brand and design teams from the applicant), these employees do not and have not any involvement with the applicant's "MAN" brands²⁸. A seventh ex-employee of the opponent is identified as working at the applicant (as a menswear buyer who joined the applicant on 26 June 2017). Mr Moss criticised Mr Chin's evidence for its failure to state categorically that he had not received any information about the opponent's sign from these ex-employees, however, Mr Chin does state that the ex-employee was not involved in the inception or design of the contested marks and that, further, the applicant's "man" mark design was completed before she joined the applicant²⁹.

72) I keep in mind my earlier findings together with the guidance that "a person is presumed to have acted in good faith unless the contrary is proved" and that "cogent evidence is required ... it is not enough to prove facts which are also consistent with good faith". The opponent's case builds a picture that identifies a set of circumstances that could have resulted in the applications being made in bad faith with a number of ex-employees moving to the applicant or related companies. Of course, such staff movements do not, in themselves, provide evidence of bad faith. When this is factored in with my findings that the applications do not amount to passing off, copyright infringement or design infringement it is clear that the case of bad faith must also fail.

73) In summary, I find that the grounds based upon section 3(6) fail against both of the applications.

²⁷ Keri Devine's witness statement, para 6

²⁸ Ditto, para. 8

²⁹ ditto

OUTCOME

74) The oppositions against the two applications fail in their entirety and the applications may proceed to registration.

COSTS

75) The applicant has been successful and it is entitled to a contribution towards its costs. Mr Norris claimed that, what he characterised was the opponent's poor case, warrants costs off the scale because it unnecessarily put the applicant to much additional work. I disagree, the bringing of a claim of bad faith was consistent with the belief that the applicant had copied the opponent's sign. The fact that I have found that case not to be made out is not a reason to award costs off scale. It is my view that scale costs are appropriate. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. I award costs as follows:

Preparing counterstatements and considering statements of case	£350
Preparing evidence and considering other side's evidence	£800
Preparing for, and attending hearing	£800
Total:	£1950

76) I order Mennace Limited to pay to Boohoo.com UK Limited the sum of **£1950**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 13 May 2019

Mark Bryant
For the Registrar
The Comptroller-General