

**O/0455/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**APPLICATION NO. 3701742**

**BY IVF PROFESSIONALS LTD**

**TO REGISTER AS A UK TRADE MARK:**



**IN CLASS 44**

**-AND-**

**OPPOSITION NO. 428998 THERETO**

**BY JUNO HEALTHCARE PARTNERS LTD**

## BACKGROUND AND PLEADINGS

1. On 27 September 2021 (“**the relevant date**”) IVF Professionals Ltd (“**the Applicant**”) applied for the UK trade mark shown on the cover of this decision – consisting of a stylised rendering of the word “Aria”. The application was published for opposition on 5 November 2021 in respect of the following services in Class 44:

*Fertility treatment; Human fertility treatment services; In vitro fertilization services; Medical services in the field of in vitro fertilization*

2. The application is opposed by Juno Healthcare Partners Ltd (“**the Opponent**”) based on objections under sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“**the Act**”). The statement of grounds included a relatively detailed account of the circumstances on which the claims are based. It is perhaps sufficient at this stage to note the following central aspects of the parties’ pleaded positions.
3. The Opponent states “Aria is an IVF fertility clinic in London which offers fertility treatments to couples and individuals wishing to have a child. The clinic is owned and operated by the Opponent and ARIA is the Opponent’s trading name. The Opponent was incorporated on 13 January 2020 and the clinic opened to the public on 4 January 2021.”
4. **Section 5(4)(a)** prohibits registration where use of the contested trade mark would be contrary to the law of passing off. The Opponent’s claim under this ground is that it is the owner of the unregistered rights in the indicia “ARIA” and “ARIA FERTILITY”, having used those signs in the UK, since the [ariafertility.com](http://ariafertility.com) website went live to the public (in the final quarter of 2020) and via online marketing and social media, developing, by the relevant date, significant goodwill and reputation by reference to those signs in relation to goods and services that included “*Fertility treatment; Human fertility treatment services; in vitro fertilization services; medical services in the field of in vitro fertilization*” – i.e. the very services specified under the contested application.
5. The Applicant is a minority shareholder in the Opponent. The Applicant is a company owned by Dr Cristina Hickman and her husband Mr Tom Hickman - who are also its only directors. Dr Hickman is also a minority shareholder of the company Juno Healthcare Limited (“**JHL**”), which is a separate company to the Opponent which has taken the lease for the property from which the clinic operates. Dr Hickman was part of the clinic's

management team.

6. Dr and Mr Hickman, as husband and wife, and direct and indirect shareholders in the Opponent, worked collaboratively with the other founders and shareholders to establish the Opponent and the clinic for their mutual benefit.
7. Concerns raised in March and April 2021, led, on 5 July 2021, to the submission of formal grievances against Dr Hickman by two members of staff at the clinic. Relations between the Opponent and Dr Hickman and the Applicant deteriorated rapidly. On 23 July 2021 the Applicant took down the clinic's website. Since July 2021 the Opponent has instead operated its website at the domain name [ariafertility.co.uk](http://ariafertility.co.uk). On 25 October 2021, the Applicant disabled the *ariafertility.com* domain, creating significant business interruption as staff no longer received automatically redirected emails from the *ariafertility.com* e-mail address.
8. The Opponent's claim under **section 3(6)** of the Act is that the Applicant acted in bad faith in filing the contested trade mark application. The Opponent claims that as at the relevant date (nor since) the Applicant had no intention to use the contested mark in the course of trade itself. Rather, the Applicant applied for the trade mark after its relationship with the Opponent broke down:
  - (i) to disrupt the Opponent's business;
  - (ii) to prevent the Opponent from registering the name "ARIA" itself; and/or
  - (iii) to provide leverage in the ongoing disputes between the Applicant, the Opponent and Dr Hickman.
9. The Opponent claims that the Applicant's behaviour in applying for the contested mark falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced people.
10. The Applicant filed a notice of defence including a **counterstatement**. The counterstatement admits no wrongdoing or bad faith. The Applicant claims to have acted in good faith and denies that use of the Contested Mark would be passing off.
11. The counterstatement claims include that:

- (i) “Mr Hickman devised the Aria name and brand on 28 June 2020. The contested mark, the unregistered trade marks incorporating the sign Aria, the domain names and the website content, together with the generation of social media promoting the brand, were devised by Mr Hickman on behalf of the Applicant for the Applicant's ultimate independent use as another provider of fertility services and treatments.
- (ii) All aspects of the Aria branding were shared and discussed with the Opponent on 8 July 2020, when the Applicant and Dr Hickman were minority shareholders.” The iteration of the Aria brand as per the Contested mark “was finalised by 4 January 2021.”
- (iii) Further to the discussions and dealings between the shareholders, the Opponent had enjoyed the benefit of a revocable, sole or non-exclusive licence, to use the contested mark in connection with the operation of the Clinic (“**the Licence**”)” but that the Licence has since been terminated.
- (iv) The Applicant was entitled to apply for the trade marks “in pursuance of its purposes as an independent entity operating or intending to operate in the fertility services and treatment field and or as a licensor of the ARIA and ARIA Fertility signs (or any registrations incorporating them) to other fertility care providers, inclusive of the Opponent.”

12. The attorneys for the Opponent are Stevens & Bolton LLP; the attorneys for the Applicant are TWM Solicitors LLP.<sup>1</sup> During the evidence rounds both parties filed evidence and submissions in chief, as I indicate below and the Opponent filed evidence in reply. A hearing was held before me by video conference on 23 February 2023. Nick Zweck of counsel attended on behalf of the Applicant; Alaina Newnes of counsel represented the Opponent. Both counsel provided helpful skeleton arguments in advance of the hearing. I have read all the papers filed and refer to their contents to the extent I consider it warranted to do so.

## **EVIDENCE AND SUBMISSIONS FILED**

### **Evidence and submissions filed for the Opponent**

13. Witness statement of **Robert Smith**, dated 23 May 2022, with **Exhibits RS1 – RS34**: Mr

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1 The Applicant appears to have been initially represented by Dutton Gregory LLP.

Smith is a registered embryologist and clinical scientist. He is a shareholder and employee of the Opponent and clinic director of the Aria fertility clinic operated by the Opponent (the Clinic). He states that he co-founded the Opponent with Anna Carby, Cristina Hickman, Stuart Lavery and Amanda Tozer (“**the Board**”). Most of the Opponent’s evidence comes from Robert Smith, and I refer to his evidence in greater detail in due course, much of which focuses on the Board’s discussion of the clinic’s brand and the nature and basis of the work undertaken by Tom Hickman.

14. Witness statement of **Gabrielle Wickham**, dated 23 May 2022: Gabrielle Wickham is a friend of Robert Smith, described as an experienced branding consultant, who provided her expertise as a favour, without professional fee, in the task of branding the Opponent.
15. Witness statement of **Stuart Lavery**, dated 20 May 2022. Stuart Lavery is one of the co-founders and the director of the Opponent. Stuart Lavery is a consultant in gynaecology, reproductive medicine, and surgery at University College Hospital in London, a lecturer at Imperial College London, and was a founding partner of The Fertility Partnership, one of the largest providers of fertility care in Europe. He also serves on the Committee of the British Fertility Society. His evidence is fully consistent with that provided by Robert Smith and Gabrielle Wickham. A central point in Mr Lavery’s evidence, and indeed across the Opponent’s evidence, is that over the summer of 2020 the branding exercise was a collaborative process. He believed everyone understood that the brand was being created exclusively for the Opponent’s use and that it was owned by the Opponent. He states: “No other arrangement would have made sense and I certainly did not consider that it belonged to Cristina or IVF Professionals Limited. Neither were there any discussions about us somehow licensing the brand from IVF professionals.”
16. During the evidence rounds, the Opponent also filed written **submissions** dated 23 May 2022.

### **Evidence and submissions filed for the Applicant**

17. **Witness statement of Cristina Fontes Lindemann Hickman** dated 22 July 2022, with **Exhibits CFLH1 – CLFH2**. As previously noted, Dr Hickman is the wife of Tom Hickman, and is an owner/director of the Applicant and a co-founder and shareholder of the Opponent. She was Scientific Director of the Opponent, as well as its Human Fertilisation and Embryology Authority Person Responsible, Data Protection Officer and Risk Officer.

Dr Hickman has roles elsewhere, including a lecturer at Imperial College, London and Chief Scientific Officer at Apricity. Dr Hickman was also a director of JHL (incorporated on 8 October 2019) which company handles the lease and acts as the property manager for the fertility clinic in London.

18. Dr Hickman states that she wrote the business plan for the clinic, designed the layout for the laboratory and project managed the entire clinical fit-out and build process on behalf of the Board of Directors of JHL. Dr Hickman states that before the composition of the Board on 5 December 2019, she had already completed the clinic design, the business plan, financial projections, everything acquired to make the clinic viable, feasible and investable business proposition. She states that her efforts began in early 2017, and that even before the registration of JHL in October 2019, she had conducted a feasibility study on the building where the clinic is located.
19. Witness statement **Thomas Alexander Hickman** dated 23 July 2022 with **Exhibits TAH1 - TAH4**. As previously noted, Mr Hickman is the husband of Dr Hickman who are both directors and shareholders of the Applicant. His evidence focuses on his contribution to the brand name and the logo and his work on the aria website and social media and the circumstances that he claims generated the Licence.
20. Mr Hickman's evidence includes an account of his professional experience. He states that he has worked in an administrative and marketing capacity for the Applicant since it was incorporated on 25 April 2016. He states that it was he who devised the name "IVF Professionals" and is responsible for the look of the Applicant's website ("ivfprofessionals.com") using range of design tools, such as Photoshop, WordPress and Adobe Illustrator.
21. He states that between April 2018 and March 2020 he was employed by Yellapro Limited, an Amazon-based kitchenware supply company, completing an apprenticeship there as a digital marketer in October 2019 before staying on as head of customer relations and continuing to manage its digital marketing.
22. He states that he also developed "digital media presences... for the Applicant's legitimate purposes". This included, in preparation for a conference on artificial intelligence and fertility to be held in September 2022, registering the domain name "aifertility.org" in July 2021 and building its website. He states that he has also built other websites such as

myova.co.uk.

23. The Applicant also filed written submissions dated 25 July 2022.

### **Opponent's evidence in reply**

24. **Second Witness statement of Robert Smith** dated 17 October 2022: this primarily introduces **Exhibit RS35**, which is a copy of the WIPO administrative panel decision regarding the beneficial ownership of the registered aria-based domain names, and whether they were filed by Tom Hickman/the Applicant in bad faith.

### **THE SECTION 5(4)(a) CLAIM**

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

“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 or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

[...]

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.”

26. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark ...”

### **Relevant legal principles**

27. The essential requirements that a claimant must establish to sustain a passing off claim are:<sup>2</sup>

- (a) a protectable goodwill in the UK owned by the claimant at the relevant date;

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2 The “classical trinity” per Lord Oliver in *Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341 HL, the “Jif Lemon” case.

(b) a misrepresentation made by the defendant which is liable to deceive the public; and  
(c) damage to the claimant's goodwill caused by the misrepresentation.

28. At the hearing, Ms Newnes noted that the skeleton argument filed by Mr Zweck stated that the Applicant submits that the Opponent has (a) failed to adduce evidence which shows a substantial reputation or goodwill in the ARIA or ARIA FERTILITY trade marks; and (b) further and in any event failed to adduce prima facie evidence to show that its reputation or goodwill extends to all of the services comprised in the application.

29. Ms Newnes argued that it was not open to the Applicant to take that position since it appeared from the pleadings the Applicant had not contested the existence or extent of goodwill, rather that the counterstatement claimed that the goodwill did not belong to the Opponent, since the rights in the brand belonged the Applicant, and that the Opponent used the aria sign under the Licence. Paragraph 16 of the Applicant's counterstatement reads

*"It is denied by the Applicant that the Opponent has any or any significant goodwill or reputation in the Earlier Unregistered Trade Marks. It is not however in dispute that the Opponent made use of the Earlier Unregistered Trade Marks before the date on which the contested mark was applied for, but such use was shared with the Opponent pursuant to the Licence. The Applicant had prior title to all unregistered marks containing the sign ARIA with respect fertility services and treatments."*

30. Mr Zweck responded by emphasising the denial in the opening line from paragraph 16 of the counterstatement, quoted above; he argued that it did not follow that, merely because it was not disputed that the Opponent had used the sign, it was therefore inconsistent to say that there was no *significant* goodwill or reputation. Mr Zweck submitted that use of the marks may be trivial and fail to give rise to "reputational goodwill".

31. Ms. Newnes also referred to paragraph 13 of the written submissions of the Applicant that states: "At the time the contested mark was applied for and since there was no passing off as all goodwill had arisen and vested in the Applicant". Mr Zweck argued that this said no more than 'if and to the extent there was any goodwill, it vests in the Applicant'.



32. In my view, the emphasis of the Applicant's defence appears to be its essentially laying claim to ownership of the brand by virtue of the domain registrations in the name of Mr Hickman, the work he carried in thinking of brand names, fashioning the logo, designing the Aria website and managing the social media accounts. The Applicant made no clear challenge to the Opponent's claims in its statement of grounds as to the use of the sign in relation to the offer of fertility services, the promotion of those services or to the business generated. The lack of sharp notice on this point may reasonably account for the comparatively brief account of the Opponent's reputation and goodwill set out in paragraphs 50 – 55 of Robert Smith's witness statement. Nonetheless, I accept that there is not a unambiguous concession by the Applicant as to the existence of relevant goodwill. I accept too that the Opponent's claim under section 5(4)(a) requires evidence that, at least prima facie, the Opponent's reputation/goodwill extends to the services comprised in the Applicant's specification.<sup>3</sup> I will therefore consider the sufficiency of the evidence of goodwill, associated with the name ARIA or ARIA FERTILITY, and generated in respect of what goods or services.
33. Goodwill must be shown to have existed at the relevant date, which is, at least in the first instance, the date of application, 27 September 2021. The concept of goodwill has been described as "*the benefit and advantages of the good name, reputation and connection of a business*" and "*the attractive force which brings in custom.*" The same case law commented that "*it is the one thing which distinguishes an old-established business from a new business at its first start*".<sup>4</sup> Mr Zweck highlighted that the clinic had not been in operation for very long by the time that the Applicant applied for the contested trade mark.
34. In *Hart v Relentless Records*, Jacob J. (as he then was) stated his view that "the law of passing off does not protect a goodwill of trivial extent. .... one is looking for more than a minimal reputation."<sup>5</sup> This does not mean that a small business is incapable of establishing goodwill - even though its goodwill may be modest, a business can protect signs which are distinctive of that business under the law of passing off.<sup>16</sup> Thus in *Lumos Skincare Ltd v Sweet Squared Ltd*<sup>18</sup>, the Court of Appeal upheld a claim for passing off

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3 Mr Zweck referred in this regard to Floyd J. (as he then was) in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat).

4 House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217

5 *Hart & Anor v Relentless Records* [2002] EWHC 1984 (Ch) [62]

based on the claimant's use of the mark "LUMOS" for around three years before the defendant's use of the same mark, even though sales volumes and turnover were modest. In that case, the Claimant sold skincare products under the name LUMOS and alleged passing off by the Defendants' sale of nail care products under the same name. Both parties sold their products to beauty salons whose technicians used the products on their customers. The claimant's products sold for between £40 and £100 each and between early 2008 and September 2009, the claimant had achieved a turnover of around £2,000 for quarter. From the latter date up until the relevant date in October 2010, the claimant's turnover increased to around £10k per quarter and had repeat custom from over 25 retail clients. Even so, the claimant remained a very small business with a modest number of sales, yet the court was prepared to protect the goodwill in that business under the law of passing off. It is also the case that a relatively short period of time may sometimes be sufficient to build up goodwill.<sup>6</sup> Each case turns on the individual facts found in the evidence.

35. In the present case, the Opponent's statement of grounds set out a number of clear and explicit claims relevant to the question of goodwill. These included:
- i. Aria is an IVF fertility clinic in London offering fertility treatments;
  - ii. The clinic is owned and operated by the Opponent and ARIA is the Opponent's trading name;
  - iii. The Opponent was incorporated on 13 January 2020 and the clinic opened to the public on 4 January 2021;
  - iv. By October 2021, the Opponent's total revenue was £1,396,484;
  - v. The aria website went live to the public in the final quarter of 2020;
  - vi. The Opponent's Google Adwords analytics as at 29 November 2021 were 118,000 impressions and 4300 clicks, at a cost of £3480. From September to November 2021 there were 21,100 views of the Opponent's business on Google (between the search and maps functions). During this period, Google Analytics logged the most common actions that customers took on the Opponent's Google listing as: 907 visits to the

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6 *Stannard v Reay* [1967] F.S.R. 140, 144 may illustrate the extreme of that possibility.

Opponent's website; 949 requests for directions via Google; and 282 calls to the Opponent. The Opponent has 13 Google reviews by customers, all giving the maximum five stars, the earliest being eight months ago." (I note that the statement of grounds is dated 10 December 2021);

36. The Applicant does not appear to have taken specific issue with any of the points above, and anyway those points appear to be supported by the evidence. For instance, Dr Hickman states at paragraph 7 of her witness statement that "JHL handles the lease and acts as the property manager for the clinic and the Opponent handles the day-to-day operation of the clinic business. Together, these two demerged entities are operating a fertility clinic and are using the brand Aria Fertility." She states that "meetings of the Board did not differentiate between JHL or the Opponent, with any decisions affecting either JHL or the Opponent made as if they were the same entity." Tom Hickman gives the date of the public launch of the aria.com website as 14 October 2020.<sup>7</sup>
37. Robert Smith states at paragraph 51 of his witness statement that "despite the difficulties with Dr and Tom Hickman and the Applicant, and despite some limitations caused by the COVID pandemic, the business was going very well already and the clinic was receiving lots of inquiries some great reviews from patients and the cofounders were pleased with the financial performance of the clinic." He refers to the graph at **Exhibit RS29** as showing that the number of consultations were growing each month from January to November 2021 (the clinic being closed over the Christmas period in December 2021).
38. The Applicant's response to these points, is the claim by Tom Hickman at paragraph 54 of his witness statement that "this is in part testament to the strength of the Aria fertility branding concept that I have created and licensed to the Opponent." Mr Hickman states that between 1 March and 1 July 2021 he posted almost daily on platforms such as Twitter, Facebook, Pinterest and Instagram (by reference to, for instance #Ariafertility and @ariafertility).<sup>8</sup>
39. The Applicant does not therefore seem to be contesting that the clinic offers fertility treatments, that this is done through the trading name ARIA, and that this had generated

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7 Page 30 of Exhibit TAH2.

8 Paragraphs 38 and 43 of his witness statement. The clinic's Facebook page went live @AriaFertilityClinic went live on 8 February 2021.

business.

40. Mr Zweck made a number of submissions in challenge to the claimed goodwill:
- i. that although revenue totals over £1 million, there were also significant costs;
  - ii. that the evidence does not show what signage went up at the clinic, inside or out, and that patients may not have been exposed to the Aria sign;
  - iii. that the sum of £3480 spent on Google AdWords is a tiny amount over the period of six months or so and that the click rate was “trifling” and picked up only just before the relevant date.<sup>9</sup>
41. With regard to Mr Zweck’s point (i) above, the clinic was in its first year and would of course incur start-up costs, but I anyway do not consider the balance of profit or loss to be relevant. I note that the Opponent’s total revenue figure of £1,396,484 is recorded in October 2021, whereas the relevant date is the end of September, but the income by the relevant date is still substantial, despite the challenges mentioned by Robert Smith.
42. With regard to Mr Zweck’s point (ii) above, I note that **Exhibit CFLH1** shows a WhatsApp group discussion, over a period of months, in which the Board members discuss a range of clinic-related matters. Line 676 shows Robert Smith highlighting that the points for discussion at the Board’s meeting on 19 January 2021 included “marketing and signage.” Line 982 shows the Board to have arranged a “marketing meeting” to take place on 26 January 2021. **Exhibit RS16** shows a quotation, dated 27 January 2021 for the provision of interior and exterior signage, addressed to “Tom” at Juno Healthcare Ltd – i.e. JHL – at the clinic’s London address. It also includes various images of the signage envisaged at places inside and outside the clinic. Line 1032 of **Exhibit CFLH1** shows “the signage guys” going to the clinic on 10 March 2021 “to grab the signage and sort the acrylic boards outside the building”, which at that date appear to have been “too shiny” and in need of a coating. Line 1068 indicates that signage for the entrance appears to have been agreed by 19 March 2021. Robert Smith at paragraph 28 of his witness statement states that the signage quote “was approved by the founders and the work carried out.”
43. I accept that the evidence in relation to signage at the clinic is not entirely clear, as to

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9 Exhibit 32

what signs went up exactly when, but it seems that the work was carried out before the application was made. I see no reason to believe that the patients attending would not have known the identity of the provider as Aria. Aria is the sign used on the website, in social media and in email names. Line 460 of **Exhibit CFLH1** records Dr Hickman notifying Stuart Lavery on 7 December 2020 that a first patient had emailed Aria, which she (Dr Hickman) had forwarded to stuart@ariafertility.com so that he (Dr Lavery) could respond. Line 510 and 514 of the exhibit shows the clinic to have 8 patients by 17 December 2020 (still ahead of the clinic opening its doors). Line 1010 shows the Board agreeing, on 9 March 2021, their choice of the address name for the clinic's patient portal (myariafertility.com).

44. Moreover, **Exhibit RS31** shows that the clinic is named on several third-party directories or websites: for instance, page 2 of the exhibit lists Aria Fertility (including the kallisha font of the contested sign), to be a clinic regulated (as at June 14 2021) by the Human Fertilisation and Embryology Authority (HFEA). **Exhibit RS31** at page 4 shows that in May 2021 a third-party website - altrui.co.uk - states it is working with Aria fertility (giving the clinic's London address) and describing Aria as "a new and independent fertility centre purpose designed and equipped to provide a complete range of treatment services for all aspects of infertility diagnosis." Other websites promoting the services of Aria include [www.eggdonation-uk.com/clinics](http://www.eggdonation-uk.com/clinics) and [www.totalfertility.co.uk/fertilityclinics](http://www.totalfertility.co.uk/fertilityclinics).
45. With regard to Mr Zweck's point (iii) above, criticising the Google AdWords data, Mr Zweck referred at the hearing to paragraphs 42 and 43 of **Exhibit TAH2**, which shows Robert Smith linking up Tom Hickman and someone called Sean at searchbutlers, who appears to be a website optimisation consultant. The exchanges date from early April 2021, where the goal appears to get aria to page 1 on Google search results, up from page 4 (as of 5 April 2021). It is difficult to gauge how significant are the click rate or amounts paid for AdWords, but I find that the evidence in the round at least shows a serious attempt to publicise the brand.
46. Mr Zweck also criticised the number of consultations as being low. Ms Newnes responded that **Exhibit RS29** lists the initial consultations, then follow-up consultations with a third column giving a grand total. It shows initial consultations and follow-up consultations increasing in the months closer to and ahead of the application, totalling around 500 consultations between January – September 2021. I also accept the point

made by Ms Newnes that one consultation may lead to the purchase of multiple fertility services. The evidence remains that the aria clinic generated over a million pounds of revenue to the Opponent. I am satisfied that by the time that the Applicant filed the contested application, there was actionable goodwill associated with the signs aria / aria fertility.

47. I do not accept Mr Zweck's contention that the evidence is insufficient to show that the goodwill extends to all of the services comprised in the application. The Applicant makes no denial of the nature of the services provided by the clinic - they are clearly fertility services. This is borne out too in various aspects of the evidence, such as the third-party websites at **Exhibit RS31** that I referred to earlier. Fertility treatment is one of the services for which registration is sought in the contested application, along *human fertility treatment services, in vitro fertilisation services, medical services in the field of in vitro fertilisation*. I accept the submission by Ms Newnes that these are essentially subsets of, and identical to, fertility treatment.<sup>10</sup>
48. Having found there to have been actionable goodwill at the relevant date, associated with the aria sign and in relation to fertility services, I need to determine whether the Opponent may properly lay claim to that goodwill, or whether the goodwill flowed to the Applicant by virtue of the claimed licence.
49. It is my view that the evidence is that the goodwill belongs to the clinic business. As I have noted, Dr Hickman acknowledges that the day-to-day operation of the clinic business is handled by the Opponent, and that the Opponent and JHL operate the fertility clinic as two demerged entities using the Aria fertility brand.
50. The Opponent and JHL have shareholders and a board of directors. The Board comprised the co-founders, which in both cases appears to be: Anna Carby, Cristina Hickman, Stuart Lavery, Robert Smith and Amanda Tozer. Dr Hickman takes issue with the characterisation of Robert Smith as a co-founder, stating that he first became aware of plans for the clinic in December 2019 when he signed a non-disclosure agreement and did not become fully operationally involved until his resignation from CARE in October

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10 This analysis would align with the inclusive principle set out at paragraph 29 of *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05.

2020.<sup>11</sup> Still, he appears to have been a director of the Opponent and of JHL and is shown to have taken a lead role in the WhatsApp discussions.

51. It was not clear to me from the evidence who are the shareholders in total, but the shareholders of the Opponent company include the Applicant (which is the private company of Dr Hickman and her husband Tom).<sup>12</sup> Other shareholders appear to include Dr Hickman and Robert Smith. It also appears from the pleadings that the Applicant and Dr Hickman were *minority* shareholders. Tom Hickman also states at paragraph 10 of his witness statement that funding for the clinic came from Stuart Lavery, Robert Smith and Amanda Tozer.
52. Page 30 of **Exhibit TAH2** shows an image from the [ariafertility.com](http://ariafertility.com) website, which Mr Hickman states to have been live since October 2020, wherein the text shown includes the following description of Aria as a "... specialist provider of private IVF treatment and genetic fertility services in the UK, our hand picked, knowledgeable and diverse team of leading fertility specialists includes world-renowned expert Mr Stuart Lavery, Dr Anna Carby, Dr Amanda Tozer and Dr Cristina Hickman." The public therefore appears to have been alerted to the existence of key individuals comprising the team that make up the clinic that offered the fertility services under the aria name.
53. Robert Smith states that each of the co-founders brought their medical and scientific backgrounds and experiences of working at other fertility clinics, and that as clinic director his role is to oversee the smooth operation of all aspects of the clinic. He states that all decisions about the clinic were made collaboratively between the co-founders; decisions were reached by consensus or majority vote if necessary, but that all had an equal say, regardless of their shareholding in the clinic.
54. In the circumstances, the prima facie position surely appears to be that the goodwill would belong to the Opponent as the operator of the clinic.
55. The Applicant contends that the Opponent only used the Aria name and branding on licence from the Applicant. There is no written licence. Nor is there any narrative evidence of any discussion or even mention of a licence. There was no oral agreement. The Opponent's witnesses have given evidence to the effect there was no such licence

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11 At paragraph 26 of her witness statement.

12 Dr Hickman states that this is partly because the Applicant made a loan to the clinic at its build stage.

in place. The Applicant submits at paragraph 4 of its written submissions that it owns unregistered trade mark rights in the sign “ARIA” and owns the copyright in all aspects of the Aria brand “... by operation of law since Mr Hickman was at the time of its creation a director of the Applicant.”

56. The Applicant’s position is that there was an implied licence between it and the Opponent for the Opponent to use the sign with the goodwill thereby generated belonging to the Applicant. The onus is on the Applicant to establish its existence and extent.<sup>13</sup> I find that the evidence fails to show any such licence. Ms Newnes put forward the following points in her skeleton argument:

- i. there was no pre-existing relevant contractual relationship between the Applicant and the Opponent;
- ii. Neither the Applicant nor Mr Hickman was instructed in a branding role for the Opponent and neither has a business of licensing trade marks or brands;
- iii. There is no evidence of anyone ever suggesting that there were restrictions on the Opponent using the Sign, “ARIA FERTILITY” or “ARIA” solus or that it required a licence to do so.
- iv. As would have been apparent to the Applicant, Mr Hickman, Dr Hickman and the Opponent it would have made no commercial sense and have been quite extraordinary for the Opponent to choose a name for its business that it could not own and to have entered into the alleged licence. In line with my earlier extract from Mr Lavery’s witness statement, such an arrangement would make no sense.

57. I accept all of those points.

58. I do not overlook the evidence from Tom Hickman that his wife, Dr Hickman, had for some years been interested in setting up a fertility clinic (Dr Hickman refers to early 2017), but only when funding was made available through the other board members did it begin to come to fruition. Nor do I doubt that Dr Hickman was a driving force in the establishment of the clinic and made a range of substantial individual contributions to it becoming a viable reality. I find too that Tom Hickman evidently has at least some limited experience

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13 In this regard Ms Newnes referred me to Copinger 18th Edition, para 5-259.



of setting up websites and operating social media, and appears to have given advance consideration to potential names for the clinic such as ova or IVF fertility. Mr Hickman states at paragraph 8 of his witness statement that he created the Aria / Aria Fertility brand in all of its aspects (words and logos) and the website content on behalf of the Applicant “for Cristina's clinic”. I find that while Dr Hickman clearly had a significant interest in the clinic, there is nothing to suggest that the clinic business goodwill should flow to Dr Hickman (or to the Applicant), alone and separate from the Opponent company in which she was a shareholder.

59. In my view, the evidence supports the statement of Robert Smith that developing the brand name was a collaborative process. Even by the beginning of July 2020, the clinic had no name. **Exhibit RS1** shows an e-mail dated 7 July 2020 from Gabby Wickham to Stuart Lavery, Robert Smith, Amanda Tozer and Christina Hickman entitled “branding meeting”. Ms Wickham met with those board members on 8 July 2020 to discuss the branding of the business proposing a choice of name for the clinic that is “something feminine like Allegra, Aurora, starting with “A” to be top of alphabetical listings, and suggested a golden, undulating font to showcase the luxury element.” Ms Wickham suggested to those e-mail recipients that it would be good to get an idea of key customer profile, USPs, competitors and role models for the clinic.
60. The day after the initial branding meeting with Ms Wickham, Robert Smith set up a WhatsApp group for the cofounders so they could carry on discussions about agreeing a branding name that reflects the clinic’s core values.
61. I remind myself that the Applicant’s claims in its counterstatement include:
- i. that “Mr Hickman devised the Aria name and brand on 28 June 2020”;
  - ii. that “all aspects of the Aria branding were shared and discussed with the Opponent on 8 July 2020”;
  - iii. that “Further to the discussions and dealings between the shareholders, the Opponent had enjoyed the benefit of a revocable, sole or non-exclusive licence, to use the contested mark in connection with the operation of the clinic.”
  - iv. That Mr Hickman’s work (on the aria website etc) was on behalf of the Applicant, for

the Applicant's ultimate independent use as another provider of fertility services and treatments.

62. The meeting referred to in the Applicant's counterstatement appears to be the WhatsApp group discussion set up by Robert Smith on 8 July 2020. A transcript of messages exchanged within that group is shown at **Exhibit RS2**, from which I note the following details from that chat transcript:
- i. Robert Smith is shown to be introducing the WhatsApp group for the purposes of devising "our new brand name" (my underlining).
  - ii. Various suggested names are shown to have been offered by those in the WhatsApp group including: "Ki Fertility", suggested by Mandy Tozer's son (where "ki" is life in Japanese); Ai Fertility (where "ai" means love); Robert Smith offers "Kibo Fertility (meaning 'hope')".
  - iii. The suggestion of "Aria fertility" is shown to come from Dr Cristina Hickman, which she says means "of high value".
  - iv. Stuart Lavery comments that they're all good and that he likes "Aria".
  - v. On 10 July 2020 Dr Hickman that tells the chat that she had jotted down a few ideas around Aria fertility" (my underlining).
  - vi. On 11 July Dr Hickman says: "Tom, my husband, suggested the tagline "an inspiring fertility experience", plus a draft paragraph to capture clinic's concept.
  - vii. Dr Hickman asks Robert Smith to add Anna Carby to the group, which he does on 11 July 2020.
  - viii. The WhatsApp exchanges show the group's intention to continue to engage Gabby to keep up the momentum on the branding, while acknowledging that "Cris has made such a cracking start to the brand guidelines" (my underlining).
  - ix. On 14 July 2020 Dr Hickman shares "Aria logo design pack PDF "with the group and on 15 July 2020 suggests adding Gabby Wickham to the group and to call the group "branding". Dr Hickman shares a few other potential tag lines.

- x. The group subject is changed to “Aria fertility branding” on 15 July 2020 and Ms Wickham is added to the group as of that date. Ms Wickham’s first contribution to the chat is “great meeting yesterday”, so it appears that there was some sort of meeting on 14 July 2020, including Gabby Wickham.
  - xi. On 15 July 2020 Ms Wickham also provides a capture of action points from the previous day’s meeting including: each contributor to identify up to 3 websites they like the look of to inform website vision the vision for the website and to identify a budget for the website; agreeing keywords for inclusion in strap line mission statement; agreed a logo is needed and a budget to be defined for a branding expert and external brand development support for website logo in digital marketing.
  - xii. Positive acknowledgement is given to the logo put forward by Tom, which the WhatsApp group has seen or received.
  - xiii. On 9 July 2020, Anna Carby, addressing Robert Smith and Ms Wickham, offers up some possible brand values and slogans.
  - xiv. Page 6 of the exhibit shows Dr Hickman sharing a link for the domains on 20 July 2020, stating that all participants can edit.
  - xv. On 29 July 2020 Dr Hickman shares with the group a link to “Rob’s Aria fertility brand identity document” (my underlining).
  - xvi. On 30 July 2020 Dr Hickman is shown to announce that “ariafertility.com domain is officially ours!” (my underlining).
63. Clearly there is nothing at all in this chat, stemming from the 8 July meeting, to suggest an IP or licence arrangement with Tom Hickman or the Applicant. Tom Hickman states that it was he who essentially created the document described as Rob’s Aria fertility brand identity document, but even if that is the case this was not conveyed by Dr Hickman to the other co-founders when she sent it and invited them to contribute to it. Mr Smith explains that he then built upon the contents of this document to create a brand identity document that he circulated on 14 July 2020.<sup>14</sup>
64. The transcript does not bear out either of the claims by on behalf of the Applicant that I

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14 Witness statement of Robert Smith at paragraph 13.

set out in my paragraph 61(ii) and (iii) above. Dr Hickman confirms at paragraph 17 of her witness statement that prior to 1 July 2020, the Clinic had no brand name, though Tom Hickman had given consideration to options such as “MyOva” and “Ova”. She states that “determining the brand name of the clinic was prioritised from 1 July 2020 when we officially signed the lease for the building. We as the board did not have any discussions around branding the clinic until this point.”

65. Tom Hickman was not part of the initial meeting with Ms Wickham to discuss branding, and was not part of the Aria Fertility Branding WhatsApp group, nor did Dr Hickman suggest he should be; only later, on 26 August 2020, did he become part of a separate WhatsApp discussion group focused on website discussion.<sup>15</sup> The contemporaneous transcript evidence solidly supports the statements from Stuart Lavery and Robert Smith that developing the brand name was a collaborative process, with ideas bounced off friends and family, who variously offered suggestions for names. Dr Hickman offers “Aria”, which proves to be the favoured option, but it was one among various other contenders put forward by others. Dr Hickman makes no mention to the group that her suggestion of Aria, made in the WhatsApp chat, had any connection with Tom Hickman or the Applicant.
66. Tom Hickman states that when the funding was agreed with the other co-founders, he started revisiting his original work on fertility clinic branding, and between April – June 2020 discussed with his wife alternative names to “ova”, including LFC (London Fertility Clinic), NGF (New generation fertility) “Novae” and “Emergis”. By 28 June 2020 he states that worked further on his old “Ova” logo design, trying to incorporate names such as ARIA and Laina.<sup>16</sup>
67. Page 13 of **Exhibit TAH2** shows an adobe illustrator artboard dated 28 June 2020 which is said to be the first use of Aria as a potential logo name. The image is very tiny, but the name aria is shown to be one of several others seemingly in contention, such as ‘aquera’.
68. Robert Smith clearly played a significant co-ordinative role in the branding exercise, but acknowledges that the brand identity document at **Exhibit RS3** that Dr Hickman circulated to the WhatsApp group on 11 July 2020 reflected Tom Hickman’s ideas (e.g.

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15 Exhibit RS9 shows that the website WhatsApp group also included at least Anna Carby, Cristina Hickman, and Gabby Wickham and Mandy Tozer.

16 Paragraphs 10 and 11 of his witness statement.

on tag lines and resonating words). Robert Smith also acknowledges that Tom Hickman undertook work on options for the logo, captured in a document shown at **Exhibit RS4** and circulated by Dr Hickman to the WhatsApp group.

69. Tom Hickman undertook the task of securing the domain name, for which he states he set up a new GoDaddy account to buy the ariafertility.com domain name as it was listed cheaper there than through a domain provider he'd previously used. Page 29 of Exhibit TAH2 is a screenshot from GoDaddy showing IVF Professionals Limited as the administrator and owner of ariafertility.com domain name purchased on 9 August 2020. However, it is also clear that the GoDaddy cost (billed to Tom Hickman) along with all image licences purchased on the clinic's behalf, was paid for by the Opponent.<sup>17</sup> Dr Hickman's celebratory announcement to the WhatsApp chat group, comprising the Board (and not including Tom Hickman) that the aria domain name was officially "ours" surely refers to the addressed recipients.
70. Page 34 of **Exhibit TAH2** shows an email from February 2021 from Robert Smith (rob@ariafertility.com) informing a third-party service provider (copied to Stuart Lavery and to tom@iivfprofessionals.com) that Tom Hickman designed the Aria fertility website. It is clear that Tom Hickman took very much the lead role in designing the website, though the evidence shows the Board members making various suggestions and contributions e.g. there is reference to Tom Hickman "working with Anna to build the content and finalise the website structure." Tom Hickman worked on the website, initially without payment then later on an invoiced basis of around £1000 per month (plus VAT). The Opponent's position is the Tom Hickman's reasons for his work appear to be to develop his skills and experience, as well as having a personal interest in the matter to assist his wife Dr Hickman with her business endeavours or for the indirect benefit of the Applicant as a shareholder. Robert Smith also acknowledged the welcome advantage of reducing costs as the clinic business started up. This all seems to me entirely plausible and consistent with the evidence.
71. At paragraph 37 of his witness statement Mr Hickman says "it was always the intention for me to invoice for my services and the licence to use my Aria brand when the clinic became more financially stable". This seems implausible on the evidence, including

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17 Exhibit RS7 and Exhibit RS8.

**Exhibit RS19** and **RS34** that I mention in the following paragraphs. At paragraph 29 of his statement Mr Hickman states that he “did all this work with the intention of invoicing for use of my brand and this would include the website and social media work at a time when the clinic was more financially stable ... this is what led to the Applicant’s invoices.” However, there is no evidence establishing that the Opponent owed any branding development fee or licence in respect of the aria marks.

72. **Exhibit RS19** is a proposal provided by The Social Services (part of the Applicant). The covering email is dated 28 March 2021 and is from Tom Hickman to Robert Smith, and reads:

*“thanks for your time today and the opportunity to discuss the ongoing development for the website, social media and other aspects of digital marketing for Aria. The attached proposal outlines the full scope of services that I am offering to Aria and that this is all-inclusive [my underlining]. I reiterate that I am willing to accept a delay of payment for the first four months to July with the first invoice in July backdating to April for the purposes of easing the cash flow at this stage.”*

Mr Hickman’s proposal document does not refer to or suggest any sums or licence fee owed for the input to that point or going forward.

73. **Exhibit RS34** is an invoice dated 5 May 2021 from The Social Services to the Opponent for the attention of Robert Smith invoicing in the amount of 1000 pounds plus VAT in respect of April 2021 and in respect of “digital media marketing website and social media management”. **Exhibit RS24** is another similar invoice, dated 29 June 2021 this time from IVF Professionals Limited in respect of the same description of work done in June 2021.

74. **Exhibit RS21** is an email dated 7 April 2021 sent to Tom at ivfprofessionals.com identifying that the Board wished to improve the image of the website and intended to seek quotes from developers for a redesign. Robert Smith invites Tom Hickman to provide a quote for his ongoing efforts while the Board organises a digital marketing strategy going forward; he also indicates that the Board would be happy to consider a proposal from Tom Hickman for the website revamp should he wish to submit one.

75. **Exhibit RS22** is an email of 12 April 2021 from Robert Smith to Tom Hickman. The email

acknowledges that Tom Hickman has enabled the clinic to have an online presence, “with very little input from the team” and expresses the team’s gratitude. Mr. Smith appreciates that Tom would want to be paid for his ongoing efforts. (my underlining) The email conveys the Board’s desire for a more professional offering as the website “is lacking a premium feel and that social media posts need to be more factual and informative for patients.”

76. **Exhibit RS24** is an e-mail of 2 July 2021 from Robert Smith to Tom Hickman indicating the Board’s intention to go with a digital marketing agency, and that while they complete the review of the website they asked Mr Hickman to stop working on the Aria account.
77. **Exhibit RS26** is an e-mail from Tom Hickman dated 23 July 2021 informing that the clinic website content had been deleted in view of the Board’s request for Mr Hickman to cease his digital media marketing services. The email asserts that the Applicant had created the website(s) “for Aria Fertility in good faith but they remained the property of IVF Professionals Limited and Aria Fertility had no permission to use the content or structure free of charge.” Mr Hickman included an invoice (number 137) for use of the content and structure of the website during July 2021 and claimed that £1000 plus VAT would be payable each month until they were removed. I note that in his second witness statement Robert Smith provides the update that on 7 October 2022 the county court judge dismissed the applicant's claim in respect of invoice number 137.
78. **Exhibit RS28** shows an email response of 30 July 2021 from Robert Smith to Tom Hickman, confirming the understanding of the team that the website was created by the applicant for the clinic, it is registered in the Opponent’s company name and the team had no recollection of any evidence to suggest that the website was the property of the applicant.
79. **Exhibit RS12** shows a copyright notice 2020 on the website, presumably inserted by Tom Hickman, in favour of “Aria Fertility” and shows “website by IVF Professionals Limited”. I have already found that the clinic has the goodwill in the signs Aria / Aria Fertility; the copyright is publicly attributed to Aria Fertility. Since there is no legal entity called Aria Fertility, the attribution is not wholly conclusive, but a natural understanding may be that whoever may lay claim to unregistered trade mark rights based on that sign, may also be the one here credited as owning the copyright. The copyright is not attributed to the

Opponent, but nor, clearly, is it attributed to the Applicant. Aria is the fertility clinic owned and operated by the Opponent, as Dr Hickman acknowledges.

80. Mr Hickman states at paragraph 51 of his statement that WIPO has determined that ariafertility.com domain is rightfully owned and operated by the Applicant. **Exhibit RS35** is a copy of the WIPO decision. The decision declined to uphold the complaint made by the Opponent, noting that the registration of the contested aria domain name was not a typical example of cybersquatting of the kind which the Uniform Domain Name Dispute Resolution Policy was designed to address. The decision states that “the Panel takes no position on the merits of the various disputes that exist and are ongoing between the Parties and this decision should not be taken as condoning or endorsing the Respondent’s actions in the use of the disputed domain names after the wider dispute between the Parties emerged.” I duly draw no adverse conclusion from the Opponent’s not having succeeded in recovering the domain names held by the Applicant.
81. In light of the above evidential points, I find there is no basis on which to imply the existence of the Licence that is claimed by the Applicant. I also note that for a contract to be implied its terms would anyway need to be sufficiently clear, for instance as to the fee, duration etc. – and clearly the evidence establishes nothing of that sort.
82. The Opponent had relevant goodwill, the services and signs are identical, such that misrepresentation inevitably arises were the Applicant to use the contested trade mark, confusing potential and actual consumers thereby leading to damage to the Opponent’s goodwill.

**OUTCOME:** The section 5(4)(a) ground succeeds.

### **THE SECTION 3(6) CLAIM**

83. Section 3(6) of the Act states that a trade mark shall not be registered if or to the extent that the application is made in bad faith. Both parties included in their claims and submissions established case law on bad faith and the principles are not in dispute. I bear in mind all of the points arising from case law referenced, including:
- i. The relevant time for determining whether there was bad faith on the part of an



applicant is the time of filing the application for registration.<sup>18</sup>

- ii. The standard of proof in relation to an allegation of bad faith is on the balance of probabilities: cogent evidence is required to the seriousness of the allegation.<sup>19</sup>
  - iii. “[A] claim of bad faith is not avoided by making an application in the name of an entity that is owned or otherwise controlled by the person behind the application.”<sup>20</sup> Dr Hickman and Tom Hickman are the sole directors of, and control, the Applicant and so their motives can be attributed to the Applicant in my assessment of bad faith.
84. The relevant factors to an assessment of bad faith, were recently considered by the Court of Appeal in the Skykick case.<sup>21</sup> . Relevantly, these include the following:
- i. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law, namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin;
  - ii. the concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices;
  - iii. it is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proven. However, where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application; and

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18 Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd [2009] RPC 9 at [167]; Red Bull GMBH v Sun Mark Ltd, Sea Air & Land Forwarding Ltd [2013] ETMR 52 at [132].

19 Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd [2009] RPC 9 at [177].

20 As Professor Ruth Annand sitting as the Appointed Person in Joseph Yu v Liaoning Light Industrial Products Import and Export Corporation BL O-013-05 at [22]

21 In Sky Ltd (formerly Sky Plc) v Skykick UK Ltd [2021] EWCA Civ 1121 at [67]

- iv. whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case. For that purpose, it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case.
85. In *Alpha-Tek Associates Ltd v University of Durham*, Iain Purvis QC sitting as the Appointed Person stated at [40]: "...Unless and until a cogent and compelling case is put forward by the party alleging bad faith which amounts to a prima facie case that there was no intention to use, there is no reason why the proprietor should be expected to advance positive evidence of such an intention. Having signed the TM3 with its accompanying declaration, the proprietor has stated its intention and the tribunal will presume in the first that this was done bona fide.
86. I note Mr Zweck's submission at the hearing, that it cannot be the case that if somebody is mistaken in their belief but has an earnest belief, that one then just concludes that they are acting in bad faith because they were not right about it. In determining whether an application is one made in bad faith, I must determine what was the Applicant's intention, drawing reasonable inferences based on the facts.
87. Mr Zweck submitted that Mr Hickman was a man obviously vexed at the prospect that he and therefore the Applicant were being potentially deprived of rights in the contested mark, which they earnestly believe to be theirs because of Mr. Hickman's endeavours in conceiving of the mark and then working on the branding. Mr Zweck submitted that Mr Hickman was earnest in his belief that he understood that he /the Applicant was providing services for which payment would later come. However, the evidence shows that at the end of March 2021 Mr Hickman put forward an all-inclusive proposal for development for the website, social media and other aspects of digital marketing for Aria.<sup>22</sup> The few monthly invoices that followed, whether in the name of the Applicant or of The Social Services are in respect of management of digital media and the website.<sup>23</sup> There is no reference in those documents to a fee for the Licence now claimed in defence of this opposition (nor any claim of brand initiation or copyright).

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22 Exhibit RS19  
23 Exhibits RS24 and RS34

88. The evidence shows that the brand name was the option settled on by collaborative discussions of the Board (along with Ms Wickham). The word was then presented in various fonts and configurations in a document circulated to the Board by Dr Hickman on 14 July 2020.<sup>24</sup> That document appears to be the work of Tom Hickman, though the design of the logo was a process that, as Mr Lavery explains, was “constantly evolving” with all those in the WhatsApp group (which does not include Mr Hickman) sharing ideas throughout July 2020.<sup>25</sup> I accept that it was in fact Mr Hickman making the changes to reflect the input from the Board, such as favouring the kallisha font, and I note that Mr Hickman states that he has added a subtle manipulation of the final “a” to represent a sperm swimming with its elongated tail.
89. However, none of this in my view furnishes the Applicant with any of the claimed rights. I have rejected the argued existence of an implied licence. The brand was being developed and discussed by the Board at large; while Mr Hickman may have been of significant practical and creative assistance in that task, it is in my view only reasonable to consider him to have done that as an interested party as husband of Dr Hickman and co-director of the Applicant. There is nothing to indicate that a belief on the part of the Applicant that it was entitled to lay claim to the trade name by which the Opponent company operated the clinic and in which the Applicant and Dr Hickman were minority shareholders. Mr Hickman’s work on the website and social media began only after the Board had decided upon the name. I also note that case law does not rule out a finding of bad faith even in a case where an applicant sees nothing wrong with its own behaviour.
90. I agree with Ms Newnes that the evidence raises a rebuttable presumption of a lack of good faith, given the circumstances where the Opponent has, to the knowledge of the Applicant, been using the sign ARIA prior to the application, the Applicant has a close connection with the Opponent and where relations between the parties had become disharmonious, in view of the staffing dispute and the preferment of an alternative website management option over that provided initially by Tom Hickman. The deletion of website content and the demand for ongoing payment (which the deputy judge in the county court has dismissed) suggest a degree of petulance on the part of the Applicant and a desire to inconvenience the Opponent. I remind myself that the counterstatement states that

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24 Exhibit RS4 and paragraph 14 of Robert Smith’s witness statement.

25 Paragraphs 9 – 10 of his witness statement.

the Aria name and brand was devised by Mr Hickman on 28 June 2020 and that: "All aspects of the ARIA branding were shared and discussed with the Opponent on 8 July" and that Opponent raised no objection around ownership of the brand and did not at any time request assignment of the ARIA brand by the Applicant or the right to be granted by the Applicant or Mr. Hickman to file the contested mark." As I have earlier discussed, there is nothing in the WhatsApp discussion from 8 July 2020, nor in the later proposal and invoice evidence, to suggest that at any time Mr. Hickman, or the Applicant, can have thought that there was a licence in place or that anyone else can have thought that there was licence in place. The suggestion that there was such a licence is simply not credible and was claimed only after the parties' relationship had broken down.

91. I accept the submission by Ms Newnes that the application was made to block the Opponent from using the sign without due cause and / or to disrupt the Opponent's business as part of an ongoing and broader dispute between the Applicant, the Opponent and Dr Hickman. I consider the application to have been made in bad faith since it falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced people operating a business of the sort at issue.

**OUTCOME:** The Opponent's claim under section 3(6) succeeds.

### **COSTS**

92. In its statement of grounds in the Form TM7, the Opponent requested an order of costs in its favour. In the skeleton argument of Ms Newnes, the Opponent requested that the award of costs should be on an off-scale basis, and on the day of the hearing the Opponent filed a schedule of its legal costs totalling over £40,000.
93. Ms Newnes referred to section 68 of the Act and rule 67 of the Trade Mark Rules 2008 giving the Tribunal a wide discretion to award reasonable costs. She referred too to the guidance of the tribunal practice notices TPN 7/2016, TPN 4/2007, and TPN 2/2002, that off-scale costs may be awarded where there has been unreasonable behaviour. Ms Newnes acknowledged that while a finding of bad faith is not in and of itself sufficient to require off-scale costs, she submitted that in this case "the conduct of the Applicant is sufficient to warrant an off-scale award of costs. The Applicant can have had no bona fide belief that its Application was soundly based and its position taken in this opposition that there was a licence between the parties was not credible. It has proceeded without

regard to the costs that the Opponent has been required to expend in order to protect its IP, or perhaps with the hope that those costs would mount up. Either way, the making of this Application and defence of this Opposition was wholly unreasonable and warrants an award of costs off-scale.”

94. Mr Zweck resisted the request for off-scale costs, arguing that this is not a case in which the conduct of the proceedings or the application for the mark has been to justify an off-scale costs award. I agree with Mr Zweck. While I reject the Applicant’s case as set out in its counterstatement, I am not aware of unreasonable behaviour in these proceedings such as repeated breaches of procedural rules or behaviour designed to frustrate, delay, or unreasonably increase the costs of the other party. I accept the Opponent felt bound to oppose the contested application and I have found in favour of the Opponent. However, despite the expense to which the Opponent has been put, through no fault of its own, I do not consider that this justifies an award of costs off-scale, simply because the Applicant defended its application, even if I consider its argued position untenable.
95. The Opponent is, however, entitled to a contribution towards its costs in bringing the opposition. In line with the scale published in the annex to Tribunal Practice Notice (2/2016), I award the following costs:

Preparing a statement of grounds and considering the Applicant’s counterstatement	<b>£650</b>
Preparing evidence and submissions and considering and commenting on the other side’s evidence and submissions during the evidence rounds	<b>£2200</b>
Preparing for and attending the hearing	<b>£1600</b>
Official fee for Form TM7	<b>£200</b>
TOTAL	<b>£4650</b>

96. I order IVF Professionals Ltd to pay Juno Healthcare Partners Ltd the sum of £4650 (four thousand six hundred and fifty pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

**Dated this 16th day of May 2023**

*Matthew Williams*

**For the Registrar**

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