

**ON APPEAL FROM
THE UK INTELLECTUAL PROPERTY OFFICE**

Monday, 22nd April 2024

Before:

**MR. GEOFFREY HOBBS KC
(Sitting as the Appointed Person)
(VIA MS TEAMS)**

In the Matter of the Trade Mark Act 1994 (as amended)

- and -

**In the Matter of UK Trade Mark Registration No. 3343574 in the names of
Gurpreet Singh Nagpal and Ragbeer Singh
(Appellants)**

- and -

**In the Matter of an Application for Invalidation No. 503944 by Alyce Designs Inc
(Respondent)**

In the Matter of an Appeal to the Appointed Person Mr. Geoffrey Hobbs KC

*(Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd.,
2nd Floor, Quality House, 6-9 Quality Court,
Chancery Lane, London WC2A 1HP
Telephone No: 020 7067 2900. Fax No: 020 7831 6864
e-mail: info@martenwalshcherer.com)*

MR. GURPREET SINGH NAGPAL appeared in person for the Appellants

MS. ANNELIESE MONDSCHIEIN (instructed by Birketts LLP) for the Respondent

APPROVED DECISION

Transcript of the Stenograph Notes Marten Walsh Cherer Ltd.,
2nd Floor, Quality House, 6-9 Quality Court, Chancery Lane, London WC2A 1HP.
Telephone No: 020 7067 2900. Fax No: 020 7831 6864 DX 410 LDE
Email: info@martenwalshcherer.com
Web: www.martenwalshcherer.com

THE APPOINTED PERSON:

1. Trade mark number 3343574 ALYCE PARIS was registered on 21 September 2018, with a filing date of 5 October 2018 in the names of Gurpreet Singh Nagpal and Ragbeer Singh for use in relation to articles of clothing listed in Class 25, including:

“Ball gowns; Bridal gowns; Bridesmaid dresses; Bridesmaids wear; Dresses for evening wear; Evening dresses; Evening gowns; Evening suits; Evening wear; Formal evening wear; Formal wear; Women’s ceremonial dresses”.
2. They had previously been actively engaged in carrying on business in the United Kingdom as distributors of such clothing designed and supplied by Alyce Designs Inc under the name and mark ALYCE PARIS.
3. The distributorship had been terminated by Alyce Designs Inc on 5 September 2018 in a manner and circumstances which left Mr. Nagpal and Mr. Singh feeling aggrieved about what they regarded as the unfair way in which they and their business had been treated.
4. They applied to register ALYCE PARIS as their trade mark on 5 October 2018 as a way of obtaining leverage and putting commercial pressure on Alyce Designs Inc in relation to the distribution of its clothing in the United Kingdom. By doing, so they acquired a registered right to object to others, including Alyce Designs Inc’s subsequent distributors of choice, from using the trade mark ALYCE PARIS for articles of clothing marketed in this country.
5. I can see no basis in the evidence for the suggestion made in submissions that the registered proprietors were prevented by termination of the distributorship from selling

off existing stock or fulfilling pre-existing orders. Whatever the rights and wrongs of the termination of the distributorship arrangement which had been brought to an end on 5 September 2018 (as to which I say nothing) that was an application for registration made for an improper purpose.

6. Alyce Paris Inc applied to the Registrar of Trade Marks on 22 June 2021 for a declaration to the effect that the trade mark was invalidly registered on absolute grounds, under section 3(6) of the Trade Marks Act 1994, for bad faith filing, and on relative grounds under section 5(4)(a) of the Act, for conflict with the invalidity applicant's right by virtue of the law of passing off to prevent independent and autonomous use of it by the registered proprietors for Class 25 goods of the kind covered by the contested registration.
7. Both objections to registration were upheld in a carefully considered decision issued by Ms. Charlotte Champion on behalf of the Registrar of Trade Marks under reference BL O/0688/23 on 19 July 2023. The registered proprietors were ordered to pay £1,800 to the invalidity applicant in respect of its costs of the Registry proceedings.
8. The registered proprietors now appeal to this Tribunal under section 76 of the 1994 Act maintaining in their form TM 55P Reasons for Appeal filed on August 2023 and in oral submissions before me that they did not apply for the registration of the trade mark ALYCE PARIS in bad faith, but did so basically with a view to securing financial redress for the cost of the stock they say they have been left with and trade expenses that they say were wasted as a result of the termination of the distributorship in September 2018.

9. In the reasons for appeal put forward by Mr. Nagpal, it is stated:

“I’m not at all interested to be associated with Alyce Paris name or trade mark. We never used it or will use it in future”.

And also:

“Once again I have no interest in their brand name or trade mark. I’m happy to accept the decision to return the trade mark back but on a condition they get all their stock back plus pay for the trade show.”

10. The reasons for appeal do not refer to the objection under section 5(4)(a) of the Act on which the invalidity applicant also succeeded in the decision under appeal. The Form 55P did not fulfil the basic procedural requirement under Rule 71(1A) of the Trade Marks Rules 2008 for a succinct but complete statement of grounds of appeal and statement of case which specifically identifies the alleged errors in the decision under appeal by itemising what the Hearing Officer decided but according to the appellant should not have decided, and what the Hearing Officer did not decide but according to the appellant should have decided: see paragraphs [15] to [20] of the recent decision of Dr Brian Whitehead sitting as the Appointed Person in ONE FOR Trade Marks BL O/1211/23 (22 December 2023).
11. I can see from the Hearing Officer’s decision that she directed herself correctly as to the law she was required to apply for the purpose of determining the objections to validity which had been raised under section 3(6) and section 5(4)(a).
12. Her determination in relation to the objection under section 3(6) is set out in paragraphs [31] to [34] of her decision, as follows:

“31. Applying the key questions from *Alexander Trade Mark* (set out at my paragraph 21):

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

32. The Proprietors have been accused of (i) seeking to prevent the Applicant from legitimately registering its trade mark in the UK, and (ii) of seeking to hinder the Applicant's business in the UK.

(b) Was that an objective for the purposes of which the contested application could not be properly filed?

33. It appears that the objectives under (a) were for purposes for which the application could not properly be filed. This is because the Proprietors acted as distributor of the Applicant's products, with there being no evidence to show that rights to the Applicant's trade mark passed to the Proprietors under the distribution agreement. The business relationship ended before the Proprietors filed the contested mark.

(c) Was it established that the contested application was filed in pursuit of that objective?

34. I consider the evidence to show that Proprietors filed the contested mark in pursuit of the claimed objectives. Under objective (i), though it is not shown that the Applicant has been prevented from filing its trade mark in the UK, the effect of the Proprietors owning the UK trade mark "ALYCE PARIS" would be that it could rely on it to prevent the Applicant from filing its mark in the UK. Objective (ii), of hindering the Applicant's business in the UK is evidenced through the emails sent by the Proprietors to the Applicant's customers. The email sent to the Applicant's new distributor states "...if this (use of the name Alyce Paris) continues we will be sending letters to stores to take this name off their websites and garments off their rails." Removal of the Applicant's products from UK retailer's shops and websites would clearly have the effect of hindering the Applicant's business. The Proprietor's defence that it needed to register the contested mark to enable it to sell its remaining stock is not supported through evidence."

13. Her determination in relation to the objection under section 5(4)(a), which, as I have already indicated is not challenged in the proprietors Form TM55P, is set out in paragraphs [55] to [69] of her decision, where she found that the invalidity applicant had the right by the virtue the law of passing off to prevent the proprietors from making independent and autonomous use of the trade mark ALYCE PARIS for clothing in Class 25 in the United Kingdom.

14. The question for this tribunal on appeal is whether it was open to the Hearing Officer on the evidence and materials before her to come to the conclusions she did for the reasons she gave. I am satisfied that it was. I reach that conclusion having reviewed the evidence and materials on file and considered her reasoning in relation to them. That is to say my decision is not based simply on the failure of the Form TM55P to fulfil the basic requirements of Rule 71(1A) of the 2008 Rules.
15. For the reasons I have given, the appeal is dismissed.

(Proceedings continued, please see separate transcript)

16. I am not going to make an award by reference to off-scale considerations. I am going to adopt the normal approach which applies to assessing a contribution towards the costs of the successful party on appeal. I am referring in this connection to the reasoning, which I regularly follow, in my earlier decision as the Appointed Person in the AMARO GAYO COFFEE Trade Mark case. That is the basis on which I am proceeding.
17. I think it would be right and reasonable in the circumstances, looking at the figures and using my own assessment of the nature of the work required, to require the registered proprietors, as the unsuccessful appellants, to pay £2,000 to the respondent in respect of its costs of this appeal, that amount to be paid within 21 days of the date of today's decision. That of course will be additional to the sum of £1,800 awarded by the Hearing Officer in the Tribunal below.

(Proceedings continued)

18. On that basis, my order will be £2,000 in respect of the costs of this appeal, to be paid within 28 days of today's date.

(Proceedings continued)