

1 **BL O/0376/24**

2 ON APPEAL FROM THE UK INTELLECTUAL PROPERTY OFFICE

3

Tuesday, 23rd April 2024

3

Before:

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THE APPOINTED PERSON
(Mr. Geoffrey Hobbs KC)

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In the matter of the Trade Marks Act 1994

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- and -

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TRADE MARK REGISTRATION No. 3490021 for the mark BE THE
REAL in Class 25 in the name of BeReal SAS (RESPONDENT)

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- and -

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INVALIDITY APPLICATION No.506674 in the name of BeReal
Wear Limited (APPELLANT)

12

13

- and -

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In the Matter of an Appeal to the Appointed Person

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Computer-aided transcript of the Stenograph notes of
Marten Walsh Cherer Ltd.

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2nd Floor, Quality House, 6-9 Quality Court, Chancery Lane,
London WC2A 1HP.

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Telephone No: 020 7067 2900. Fax No: 020 7831 6864

19

E-mail: info@martenwalshcherer.com

Website: www.martenwalshcherer.com

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MS. BATOOL ZAIDI appeared in person for the Appellant.

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MR. CRAIG BEAUMONT and MS. CATHERINE WISEMAN (of Barker
Brettell LLP) appeared for the Respondent.

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APPROVED DECISION

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1 DECISION

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3 THE APPOINTED PERSON: On 30th November 2020, BeReal Wear Limited
4 ("BRW") applied under No. 3562154 to register the designation
5 **BeReal** as a trade mark for use in relation to clothing in
6 Class 25. The application proceeded to registration on 18th
7 June 2021.

8 There was, at the filing date of BRW's application for
9 registration, an earlier registration of **BE THE REAL** as a
10 trade mark for clothing in Class 25 standing in the name of
11 Joseph Andrews, who appears to have been based at an address
12 in Lowestoft. The earlier trade mark had been registered
13 under No. 3490021 on 14th August 2020, with a filing date of
14 14th May 2020.

15 I pause at this point to make a number of observations
16 relative to the matters I am asked to determine on this
17 appeal. First, I must emphasise that it was not possible at
18 the filing date of BRW's trade mark application, and it is
19 still not yet possible, for BRW to apply for revocation of the
20 earlier trade mark registration for lack of use under
21 section 46 of the Trade Marks Act 1994.

22 Second, I must emphasise that there is no evidence or
23 material before me on the basis of which it could possibly be
24 suggested that the earlier trade mark was invalidly registered
25 under section 3(6) of the 1994 Act, for having been registered

1 pursuant to an application for registration filed in bad
2 faith.

3 Third, I must emphasise that there is no evidence or
4 material before me on the basis of which it could possibly be
5 suggested that BRW was, on 14th May 2020, the proprietor of
6 any registered or unregistered right capable of supporting a
7 claim for invalidity of the earlier registered trade mark on
8 relative grounds under section 5 of the 1994 Act.

9 Fourth, I should record that there is no evidence or
10 material before me which sheds any light on whether BRW did or
11 did not consciously file or continue with its application for
12 registration with knowledge of the existence of the earlier
13 trade mark registration for **BE THE REAL**.

14 It appears from the register entries relating to the
15 earlier trade mark that on 28th July 2023, Joseph Andrews
16 assigned and transferred it in full to Paul Chung, who, on the
17 same day, assigned and transferred it in full to BeReal SAS
18 ("BRS"). I understand that Mr. Chung acted as a middleman for
19 BRS in the acquisition of the trade mark from Mr. Andrews.

20 BRS then proceeded, as proprietor of the earlier trade
21 mark registration for **BE THE REAL**, to assert it in
22 Invalidity Application No. 506416, claiming that BRW's trade
23 mark registration for **BeReal** was invalidly registered under
24 section 5(2)(b) of the 1994 Act.

25 BRW reacted to that by filing a form TM26(I) on 6th

1 November 2023, claiming that the earlier trade mark
2 registration should be declared invalid under section 3(6) of
3 the Act on the following basis: "The purchase of this trade
4 mark is directly connected to our opposition OP000434629,
5 seeing their losing position BeReal SAS France purchased this
6 trademark BE THE REAL No. UK00003490021 from a third party
7 with sole intention to cause harm to our business and brand
8 BeReal (trademark UK00003562154) using this trademark. The
9 effective date of the assignment is 28 July 2023. It is
10 clear, that the purchase of trademark UK00003490021 was made,
11 not as part of the usual course of business, but exclusively
12 with the bad intentions of sabotaging our brand. This social
13 media app has no connection with clothing. BeReal France had
14 tried threatening us to close our business (letter sent by
15 French lawyer), tried putting false allegations on us by
16 placing ill intent order from Paris (which we did not ship,
17 the order was successfully cancelled by our team), tried
18 putting cancellation action based on prior use and seeing
19 their losing position purchased this trademark BE THE REAL
20 (this trademark has zero use in commerce) with bad intentions
21 of using this trademark and cause damage/harm to our business.
22 Our business websites, social media was stalked by Founders,
23 French Lawyer of BeReal SAS France. The purchase of this
24 trademark is purely in bad faith and with a clear intention to
25 cause harm to BeReal Wear Limited, the company director,

1 employees, partners and customers. We request that the
2 relevant authorities consider the circumstances presented
3 herein and remove this trademark BE THE REAL from the register
4 as if it had never been registered."

5 That resulted in an official letter, dated 22nd November
6 2023, in which the Trade Marks Registry wrote to BRW, stating
7 as follows with reference to the form TM26(I) it had filed on
8 6th November 2023: "It is noted the cancellation has been
9 filed for a Section 3(6) ground. Your pleadings refer to the
10 purchase of the attacked trade mark being in bad faith.
11 Section 3(6) is only about whether a trade mark was filed in
12 bad faith and the date of assessment is the date on which the
13 trade mark was filed, not when it was purchased or assigned.

14 "In view of the above, it is the Registry's preliminary
15 view to strike out the cancellation application."

16 BRW requested a hearing at which to contest the
17 Registrar's preliminary view. The hearing took place on 12th
18 December 2023, before Ms. Laura Nicholas, acting as Hearing
19 Officer for the Registrar of Trade Marks. In her decision
20 letter dated 15th December 2023, the Hearing Officer noted
21 that BRW had expressly recognised and accepted in its letter
22 of 22nd November 2023, requesting the hearing that: "This
23 trade mark was definitely not filed in bad faith by the
24 original owner on 14th May 2020."

25 She determined that section 3(6) could only be invoked

1 as a ground for cancelling a trade mark registration in
2 circumstances where the relevant application for registration
3 was shown to have been filed in bad faith. Since that was
4 conceded not to have been the position here, she struck out
5 BRW's cancellation application and ordered it to pay £100 to
6 BRS in respect of its costs of the struck-out proceedings.

7 BRW now appeals under section 76 of the 1994 Act,
8 contending that the Hearing Officer's decision should be set
9 aside and the invalidity application allowed to proceed for
10 the reasons set out in Box 6 of its form TM55P Notice of
11 Appeal filed on 31st January 2024 in the following terms:

12 "The joint hearing was held on 12th December 2023 and we
13 received the decision. We feel there is a need to appeal in
14 order to clarify this case in details, and for Bereal France
15 SAS to provide details leading to the purchase of BE THE REAL
16 trademark in detail. The hearing lasted 7-9 minutes, where
17 Bereal France SAS representatives just said one sentence that
18 they feel that BE THE REAL was not purchased in bad faith,
19 there was no other explanation no other comments after that.
20 The main reason is after seeing their losing position in
21 Opposition OP000434629, Bereal France SAS applied for 1st
22 Cancellation Action application CA000506174. (This
23 application was filed on 7th June, 2023 and was withdrawn on
24 6th November without submission of any evidences by Bereal
25 France SAS as they had no evidences to prove their claims).

1 "Throughout opposition hearings and 1st Cancellation
2 Application Bereal France SAS has repeatedly confirmed BeReal
3 as their trademark not BE THE REAL, there was massive delay
4 caused in opposition as well by this company as their strategy
5 was to delay and confuse matters, the 1st cancellation
6 application was withdrawn after almost six months when it was
7 clear that it would not be successful, and their purchase of
8 the trademark BE THE REAL is only for the purpose of starting
9 a new Cancellation Application CA000506416.

10 "I mentioned during the hearing that for this purchase
11 of trademark BE THE REAL there is a back story of different
12 cases with IPO and why trademark is purchased 3 years later
13 but there was no comment on that either. We strongly believe
14 that this trademark is purchased only to base cancellation
15 application on it and as a retaliation to our original
16 opposition. Dishonest intentions are a factor in this case as
17 the other party's only motive was to attempt a 2nd
18 cancellation application using this trademark, after a failed
19 first attempt CA000506174."

20 BRS filed a Respondent's Notice on 16th February 2024,
21 maintaining that the Hearing Officer's decision was correct
22 and should be upheld for the reasons she gave.

23 BRW filed a response to that on 12th March 2024,
24 stating: "We have multiple ongoing cases with this app
25 company bereal SAS France in UKIPO. The filed Respondent's

1 Notice by bereal SAS France is not a reflection of the actual
2 reality, which is that the purchase of this trademark is
3 solely for the purpose of cancellation action against our
4 trademark (Cancellation No: CA0000506416 Trade Mark No:
5 UK00003562154) and bereal SAS France is taking advantage of
6 the fact that the law covers registration of trademark in bad
7 faith not purchase in bad faith by another party after a
8 trademark is fully registered. This case is unique and
9 requires review in the light of the strategies this company
10 has adopted against us. The TM8 filed by bereal SAS France
11 for Opposition No. 444843 explains the entire strategy
12 (counterstatement by bereal SAS France attached below) where
13 this company has based the entire application on BE THE REAL
14 Trademark."

15 I should refer also to the latest summation of BRW's
16 position which I received by email yesterday, in which it is
17 stated: "This app company is clearly using the gap in the
18 current law that does not prevent the purchase of bad faith
19 trademarks, which has happened in this case. We want to close
20 this gap so no other company can use this gap and set it as an
21 example to prevent bad faith registered trademark purchases,
22 this is not the first time this app company has used such
23 loopholes, from their French lawyer sending us a threatening
24 letter, them placing fake order from France on our website,
25 stalking our social media, using Twitter campaigns to spam us,

1 we have proofs of all their patterns and the proofs only lead
2 to the fact that BE THE REAL trade mark purchase is the
3 continuation of this app company's intention to cause damages
4 and it should be removed immediately from the register. We
5 look forward to the opportunity to close the gap in current
6 trademark law so no other company with ill intentions can use
7 this gap to cause damages to any other business."

8 In its oral submissions, BRW has reiterated its position
9 to the effect that BRS is, in Invalidity Application No.
10 506416 filed against BRW's **BeReal** registered trade mark No.
11 3562154, improperly and abusively relying on the earlier trade
12 mark **BE THE REAL** registered under No. 3490021, by taking
13 advantage of the fact that the law covers registration of
14 trade marks in bad faith, not purchases in bad faith by
15 another party after a trade mark is fully registered.

16 I must now explain why this appeal cannot succeed and
17 must be rejected. It is settled law that the grounds on which
18 the registration of a trade mark can be declared invalid are
19 exhaustively stated in the Trade Marks Act 1994, in conformity
20 with the Trade Marks Directive (Directive (EU)2015/2436 of 16
21 December 2015): see Case C-371/18 Sky Plc v SkyKick (UK)Ltd at
22 paragraphs [56] to [58].

23 BRW's claim for invalidity specifically relies on the
24 ground for invalidity in section 3(6) of the 1994 Act, which
25 can only succeed if the original application for registration

1 is shown to have been made in bad faith. That is concededly
2 not the case here and the grounds for invalidity, exhaustively
3 stated in the Act do not include any other grounds on which
4 invalidity can be claimed on the basis of allegations of
5 improper and abusive reliance on the rights conferred by
6 registration of a trade mark as asserted in support of BRW's
7 application for invalidity filed on 6th November 2023. The
8 form TM26(I) must therefore be struck out as determined in the
9 Hearing Officer's decision issued on 15th December 2023.

10 More generally, I do not doubt that the Registrar has an
11 inherent power to strike out Registry proceedings, in whole or
12 in part, on the basis that they involve or amount to an
13 improper and abusive assertion of the rights conferred by
14 registration of a trade mark. Any application for an order to
15 that effect would clearly need to have been made by BRW in
16 answer to Invalidity Application No. 506416.

17 The caselaw relating to the operation of Civil Procedure
18 Rule 3.4(2)(b) (which enables a Statement of Case in court
19 proceedings to be struck out on the basis that it is an abuse
20 of the Court's process, or is otherwise likely to obstruct the
21 just disposal of the proceedings) shows that there is little
22 scope for a well-founded claim to be struck out on that
23 ground.

24 The same can be said of the caselaw relating to Article
25 3(2) of the Enforcement Directive (Directive 2004/48/EC) which

1 specifies that measures, procedures and remedies for the
2 enforcement of intellectual property rights, which of course
3 includes registered trade mark rights, shall be applied in
4 such a manner as to avoid the creation of barriers to
5 legitimate trade and to provide for safeguards against their
6 abuse. And likewise in relation to claims for liability for
7 malicious prosecution and abusive use of process, as discussed
8 at length in chapter 15 of the current (24th) edition of Clerk
9 & Lindsell on Torts.

10 On the limited information presently available to me,
11 the claim for invalidity made by BRS against BRW's trade mark
12 Registration No. 3562154 appears to be no less lawful and
13 legitimate for BRS to pursue after 28th July 2023 than it
14 would have been for Joseph Andrews to pursue if he had wished
15 to do so prior to that date. However, that is as far as I am
16 prepared to go in relation to the arguments addressed to me on
17 that subject in the context of the present appeal. And I must
18 emphasise that nothing I have said in this decision is to be
19 taken as determinative, one way or the other, of any
20 application which BRW might hereafter decide to make to the
21 Registrar, for Invalidity Application No. 506416 to be
22 struck out.

23 For the reasons I have given, the appeal is dismissed.

24 Does anybody want to address me on any other question?

25 MR. BEAUMONT: No, thank you, Sir.

1 THE APPOINTED PERSON: You have nothing further?

2 MS. ZAIDI: No, thank you.

3 THE APPOINTED PERSON: You have nothing to further to say?

4 MR. BEAUMONT: No.

5 THE APPOINTED PERSON: Fine. In the absence of any submissions
6 relating to costs, the result will be that the appeal is
7 dismissed with no order for costs. (Pause) Continuing
8 silence. In those circumstances, that concludes today's
9 hearing.

10 MS. ZAIDI: Thank you so much for taking the time out.

11 THE APPOINTED PERSON: Thank you. Thank you all for your
12 submissions.

13 MS. ZAIDI: Thank you.

14 MR. BEAUMONT: Thank you, Sir.

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