O/0516/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001762131 IN THE NAME OF MICHAEL WARD FOR THE FOLLOWING TRADE MARK:

Wemby

IN CLASS 25

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 447295 BY VICTOR WEMBANYAMA

BACKGROUND AND PLEADINGS

1. Michael Ward ("the applicant") is the holder of the International Registration shown on the cover page of this decision ("the IR"). The IR was registered on 23 October 2023 and, with effect from the same date, the applicant designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR is derived from the applicant's US trade mark, being that numbered 2263652, and enjoys a priority date of 13 June 2023. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 2 February 2024 in respect of the following goods:

   Class 25: Athletic clothing, namely, shirts, pants, jackets, footwear, hats, caps, socks, shorts, hoodies, sweatshirts, athletic uniforms.

2. On 2 May 2024, the applicant's mark was opposed by Victor Wembanyama ("the opponent"). The opposition is based on sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 ("the Act").

3. Under the section 5(4)(a) ground, the opponent relies on the unregistered signs "WEMBY" and "WEMBANYAMA". He claims to have used these signs throughout the UK since at least December 2019. It is claimed that the opponent has used his signs in respect of the following goods and services:

   "Clothing; endorsement of luxury goods; services relating to the promotion of goods and services for others; sponsorship services; sports personality sponsorship and endorsement services."

4. The opponent claims that by virtue of his use of the signs, he has accrued substantial goodwill in them. As a result, it is claimed that use of the IR will amount to a false endorsement, thereby misleading consumers into believing that use of the IR is by the opponent or otherwise connected with or endorsed by him. The opponent's position is that this will cause damage to his goodwill.

5. Under the 3(6) ground, the opponent claims that the designation of the IR in the UK was either an attempt to prevent the opponent from marketing the contested goods or an attempt to deceive the public. As such, it is claimed that any use of the IR is intentionally misleading. Further, the opponent argues that the IR would take advantage of the opponent's significant reputation and would deceive the public into believing the goods at issue are somehow authorised or associated with the opponent. The opponent's position is that this falls far short of honest and acceptable commercial practices observed by reasonable persons within the relevant industry.

6. The applicant filed a counterstatement wherein he denied the claims against him.

7. The opponent is represented by DLA Piper UK LLP and the applicant is represented by Carpmaels & Ransford LLP. Both parties filed evidence in chief during these proceedings. In addition, the opponent filed evidence in reply. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

9. The opponent's evidence in chief came in the form of a witness statement in his own name dated 22 October 2024. This statement was accompanied by one exhibit, being VW1, and was adduced in order to demonstrate that the opponent enjoys goodwill in his signs and that the designation of the IR in the UK was done in bad faith.

10. The applicant's evidence came via two witness statements. The first being the witness statement of the applicant himself dated 24 January 2025. This statement is accompanied by six exhibits (being MW1 to MW6) and was adduced in order to demonstrate the reasoning behind his choice of the name 'WEMBY'. The second witness statement filed on behalf of the applicant was that of Roger Lush dated 27 January 2025. Mr Lush is a partner at the applicant's representative firm and his evidence is accompanied by nine exhibits (being RCL1 to RCL9). His evidence was adduced for a number of reasons and while I will not discuss each of those here, they were all made in support of the applicant's defence.

11. In reply, the opponent filed the witness statement of Ruth Hoy dated 27 March 2025. Ms Hoy is a partner at the opponent's representative firm. Her evidence is accompanied by nine exhibits (being RPH1 to RPH9) and was adduced to demonstrate the recognition of the opponent as 'Wemby' and to provide information regarding the popularity of basketball in the UK.

12. I will refer to points from the evidence or submissions where necessary.

DECISION

Section 5(4)(a)

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

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) …..

(b) …..

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

14. 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 or date of the priority claimed for that application."

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

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

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

16. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

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

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

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

Relevant Date

17. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

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

18. The IR enjoys a priority date of 13 June 2023. While there are examples of the applicant's initial attempts to launch his brand,[1] there is no customer facing use in the UK that could be said to be the start of the behaviour complained about. Therefore, the relevant date for the present ground is the priority date of the IR which, as above, is 13 June 2023.

[1] See, for example, MW4 and MW5

Goodwill

19. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

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

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

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing

officer that it is not shown on the balance of probabilities that passing off will occur."

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

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

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

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

23. Goodwill results from trading activities in the UK. The opponent's evidence begins with an explanation that he is a professional basketball player currently playing for the San Antionio Spurs in the National Basketball Association ("NBA") in the United States. He was drafted with the number one pick in the 2023 NBA draft. Before this, his professional career began in 2019 in France, where he played for three different teams in the French Ligue de Nationale de Basketball ("LNB"), before moving to the USA to play the NBA. He also explains that he recently represented Team France in the 2024 Olympics.

24. The opponent discusses the fact that he is sponsored and endorsed by various brands including, but not limited to, Nike and Louis Vuitton. There is no supporting evidence that can be linked to this claim but I do note that there are images of him throughout the evidence wearing Nike and Louis Vuitton clothing.[2]

25. He goes on to explain that the number one pick in the NBA draft is typically considered the most promising talent available at that time. In respect of the 2023 NBA Draft, the opponent explains that he was commonly predicted in the media and across basketball to be the number one pick for that year. On this point, it is noted that articles from UK publications The Times (dated 4 October 2022) and The Guardian (dated 6 October and 8 December 2022) provided in support of the opponent's prospects.[3] In the Times article, for example, the opponent is tipped to be the number one pick in the 2023 NBA Draft.

26. The opponent goes on to discuss the NBA in the UK. He explains that the information provided in respect of this point was given to him by his attorneys. I note, for example, that he refers to an article from hoopsfix.com dated 4 May 2019 which states that the NBA League Pass (the subscription based broadcast service for the NBA) has seen a 30% year-on-year increase of subscribers in the UK and that the UK ranked fifth in total number of league pass subscriptions among

[2] See pages 74 and 132 of VW1, for example.
[3] See page 35 of VW1 for The Times article and pages 60 to 64 and 66 to 68 of VW1 for the Guardian articles.

markets outside the US and China.[4] Further evidence includes a printout from June 2022 which reports that the NBA achieved record viewership in the UK for the 2021 to 2022 season, with Sky reporting an average viewership growth of 58%.[5] This evidence is noted but it does not give me information as to actual viewership figures so there is nothing to compare the stated growth of 30% and 58% to. That being said, it clearly indicates a growth in popularity of the NBA in the UK.

27. In respect of the popularity of basketball in the UK, the applicant sought to argue that it was not popular given that it does not crack the top ten most watched or played sports in the UK.[6] Further, the applicant refers to the fact that a 'Harris Interactive' report from October 2019 lists basketball as the 14th most popular sport in the UK.[7] I appreciate that the evidence does not point to the fact that basketball is a particularly popular sport in the UK. However, the relevant consideration is the popularity of the NBA as a sports league. In short, the applicant's evidence does not mean that the NBA is not popular amongst at least a significant part of the relevant public in the UK. Despite my issues with the opponent's evidence regarding actual UK viewership of the NBA, there is just enough to demonstrate that the NBA was a somewhat popular league in the UK prior to the relevant date thanks to its increase in viewership from 2019 onwards.

28. Turning back to the opponent and his association with the name 'Wemby', it is noted that press coverage is provided demonstrating the use of the same. This evidence comes not only from the opponent's own evidence but various exhibits filed by Ms Hoy.[8] I do not intend to discuss each and every article provided as, for the most part, they are articles from US-based publications and there is nothing to suggest their reach within the UK so they are, therefore, of no assistance to the present ground.[9] Further, some articles are from after the relevant date so are also

[4] Pages 1 and 2 of VW1
[5] Pages 3 to 5 of VW1
[6] RCL2
[7] RCL3
[8] See RPH1 to RPH5
[9] See, for example pages 6 to 17, page 23 and pages 91 to 94 of VW1

not relevant to the present ground.[10] Of those that are relevant here, I note the following:

a. An article from the BBC dated 22 April 2023 but this makes no reference to the name 'Wemby'.[11]
b. An article from dailymail.co.uk dated 20 October 2022 which discusses the opponent scoring 36 points in 37 minutes in a game between his LNB team and an NBA G-League team.[12] This article makes one reference to the nickname 'Wemby'.

29. In addition to the above, there are articles from The Times and The Guardian, being those I have discussed briefly at paragraph 25 above. In respect of this point, I also note that there are additional articles from international publications, namely:

a. An article from the official Olympics' '.com' website dated 17 October 2022[13] makes reference to the opponent's Instagram account, which is titled 'Wemby'. Further, this article also discusses the opponent as being the one name on every basketball fan's lips at that time.
b. The opponent was featured on the cover of the international magazine 'SLAM 240' in October 2022.[14]

30. While noted, there is nothing to demonstrate the reach of the above international article or publication across the UK. For example, 'SLAM 240' is said to be an international basketball magazine but I have no indication of the reach of this magazine in the UK which I would ordinarily expect to come via readership/sales figures or at least some form of indication of how it reaches the UK market.

31. Even if I were to accept that the international publications were relevant to the UK customer, I do not consider that the above evidence is representative of an

[10] See, for example, pages 42 to 50 of VW1
[11] See pages 79 and 80 of VW1
[12] RPH3
[13] Pages 26 to 34 of VW1
[14] See pages 55 to 59 of VW1

extensive level of press coverage across the UK. On the contrary, it reflects a very limited range of coverage.

32. The evidence proceeds to discuss merchandising. In short, the opponent makes two points in respect of the merchandising surrounding his name. I will deal with these in turn.

33. The first point relates to the opponent's San Antionio Spurs jersey which is listed for sale in British pounds on printouts from the EU NBA Store.[15] The jerseys appear to be emblazoned with the 'SPURS' logo as well as an alternative 'SATX' logo. Given that the NBA draft took place on 22 June 2023 (as per paragraph 12 of the opponent's witness statement), it is reasonable to suggest that any official sales of this jersey would not have begun until after that date. This means that the printout is of no assistance here because it comes from after the relevant date. In respect of this point, it is noted that one article makes reference to fans already wearing Spurs jerseys with 'Wembanyama' printed on the back when he arrived in Newark Airport (in New Jersey, USA) the week before the NBA Draft.[16] However, it is my understanding that this would have been custom ordered jerseys as opposed to those offered on the NBA Store in the same way as shown in the evidence. I say this because, as far as I am aware, the nature of the NBA Draft is such that it was not officially confirmed that the opponent was going to be drafted to San Antionio (who held the number one pick) until the draft pick was made on the night of the draft.[17] In any event, these fans were situated in America and there is nothing to suggest any pre-draft sales of jerseys in the UK. Further, there is no evidence showing the level of sales associated with these jerseys (whether custom or not) from prior to the actual NBA Draft.

34. The second point stems from a collection of screenshots from the opponent's '@Wemby' Instagram account.[18] These show him playing in basketball games

[15] Pages 125 to 130 of VW1
[16] See page 118 of VW1
[17] I appreciate that press evidence sets out that the opponent was clearly expected to be drafted number one overall but this is not as official confirmation.
[18] Pages 131 to 133 of VW1

wearing different jerseys with his name on them. The opponent argues that because the jerseys show his name then they are sufficient to demonstrate that he has accrued goodwill. While noted, this argument is misconceived. I say this because the images, whilst from prior to the relevant date, do not show any attempt to sell any goods or offer any services.

35. Before moving on, I wish to discuss the evidence of the opponent's Instagram account. There is a Forbes article provided which, whilst dated after the relevant date (and being a US-based publication) confirms that in October 2022, the opponent had 200,000 followers.[19] This increased to 2.2 million right after the 2023 NBA Draft. While the lattermost figure is of no assistance here because it comes from after the relevant date, the former figure is of no real assistance either. I say this because even though this demonstrates that his social media following prior to the relevant date was in the hundreds of thousands, there is nothing to suggest the proportion of the opponent's followers that are from the UK. Therefore, I do not consider that the social media evidence carries any probative value in these proceedings.

36. The opponent turns to discuss the awards he has received during his playing career. There are three different awards discussed, being the LNB Pro's most valuable player ("MVP"), the LNB Pro's best young player and the NBA Rookie of the year award. He won the LNB's MVP award once and the best young player award three times, all being prior to the relevant date. As for the NBA's Rookie of the Year award, this was given to him in 2024 so is, therefore, after the relevant date. The presence of these awards is noted but they do not necessarily indicate a level of knowledge of the opponent prior to the relevant date in the UK. I have nothing before me to suggest the popularity of the LNB in the UK and, in any event, the awards do not actually point to any actual trading activities under the signs relied upon.

[19] Pages 91 to 94 of VW1

Assessment of the evidence

37. Taking all of the evidence into account, I am of the view that it is insufficient to demonstrate that the opponent was known to a sufficient amount of members of the relevant public in the UK prior to the relevant date, whether as Victor Wembanyama or as 'Wemby'. I say this because while there is UK-specific evidence regarding the opponent potentially being drafted number one overall in the 2023 NBA Draft, it is very limited and covers just a handful of press articles. Further, even though the NBA viewership in the UK was on the rise prior to the relevant date, this does not mean that a significant number of the relevant public would have automatically known of him. In short, the opponent was not an NBA player until after the relevant date and, again, the evidence prior to this is simply insufficient.

38. In any event, even if he was known to a significant proportion of consumers in the UK as at the relevant date, his evidence entirely lacks any actual examples of him conducting trading activities in the UK. I remind myself that, under the present ground, he claims to have used his signs in respect of the following goods and services:

> "Clothing; endorsement of luxury goods; services relating to the promotion of goods and services for others; sponsorship services; sports personality sponsorship and endorsement services."

39. The opponent has attempted to show use on clothing by way of the Spurs jerseys with his name on them. The jerseys are shown as being available via NBA Store EU but there are no sales figures and the screenshot is undated and, as above, it is likely that the screenshot was taken after the NBA Draft in 2023 which is after the relevant date. As such, the evidence on this point falls far short of demonstrating the existence of any goodwill in favour of the opponent. In any event, I am not convinced that his name appearing on the back of jerseys sold by the NBA would be viewed as the sale of goods under the opponent's signs. If anything, any use of such goods is likely to be attributed to the NBA and associated

with the signs ‘SPURS’ or ‘SATX’. Therefore, regardless of whether any sales prior to the relevant date were made in the UK or not, I do not consider that the appearance of his name on a jersey is of any assistance to the present ground.

40. Further, despite briefly mentioning being endorsed and sponsored by Nike and Louis Vuitton, there is nothing before me to suggest that the opponent actually engaged in any of the sponsorship or endorsement services he seeks to rely on. As set out above, there are images of him wearing clothes from these brands but this alone is not enough to suggest that he offers any such services.

41. While I appreciate the evidence confirms that the opponent went on to be successful in the NBA (by winning the Rookie of the Year award in his first season), the assessment I must make here is whether, at the relevant date, his trading activities in the UK gave rise to a finding that he enjoys a protectable level of goodwill in respect of the goods and services relied upon. In short, the opponent has not provided any evidence as to actual trading activities in the UK. All he has attempted to do is demonstrate that he was a well-known basketball player with the nickname ‘Wemby’. Even then, he fell short of demonstrating that this applies to the UK. As a result, I find that upon taking all of the evidence into account, it falls far short of demonstrating that the opponent enjoys any protectable goodwill in the UK. The present ground, therefore, fails.

42. I will now proceed to consider the section 3(6) ground of the opposition.

Section 3(6)

43. Section 3(6) of the Act states:

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

44. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

"(i) […]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*"), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a 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 consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes

other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc* v *EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 ("*Hasbro*")], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the

application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

45. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

46. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull* (cited above). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

47. The relevant date for the present assessment is not the priority date of the IR but the date upon which the applicant sought to designate it for protection in the UK, being 23 October 2023. This is because it is this date that the applicant technically *applied* to register the IR in the UK.[20]

48. In considering claims under the present ground, I remind myself of the case of *Alexander Trade Mark*, BL O/036/18, wherein the key questions for determination in a claim of bad faith were set out as being:

> (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
>
> (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
>
> (c) Was it established that the contested application was filed in pursuit of that objective?

[20] In support of this approach, see the cases of *FSS Trade Mark* [2001] RPC 40 and *HYBRID* (BL O/308/20)

49. Dealing with the above questions in turn, I note that, under the present ground, the opponent claims that in applying to designate the IR for protection in the UK, the applicant was attempting to prevent the opponent from marketing the contested goods or attempting to deceive the public. As such, it is claimed that any use of the IR is intentionally misleading, that it would take advantage of the opponent's significant reputation and would deceive the public into believing the goods at issue are somehow authorised or associated with the opponent. The opponent's position is that these all fall far short of honest and acceptable commercial practices observed by reasonable persons within the relevant industry.

50. In support of the above claims, the opponent refers to a range of other trade marks that the applicant, through his companies Wemby Corporation and Wemby Inc, has sought to protect in the USA and other jurisdictions. Six of these marks are for the word 'WEMBY' whereas one other is for the word 'EIFEL POWER'. It is confirmed that the USA based trade mark applications have been refused by the USPTO on the basis of a likelihood of false association with the opponent.[21] In respect of the 'EIFEL POWER' mark, the opponent claims that this is another nickname associated with him. On this point, I note that only one article is provided confirming this. It is dated 4 October 2022 and is from the website 'WSUM.org'.[22]

51. The nature of the opponent's evidence suggests that these filings demonstrate a pattern of behaviour by the applicant (and companies associated with him) to apply for trade marks associated with the opponent during the height of the media attention in the lead up to the NBA Draft 2023. To me, this argument appears to be in line with the opponent's pleaded claim that by filing numerous marks associated with the opponent, the applicant was attempting to deceive the public into believing that the IR was authorised by or associated with the opponent, or to take advantage of the opponent's significant reputation.

52. In considering the second question set out in *Alexander*, I am satisfied that the claimed objectives of the applicant are such that, if proven, would mean that the IR

[21] While noted, I will say for the avoidance of doubt that the outcomes of any USPTO decisions are not binding on me and, as such, are not relevant to the present decision.
[22] Pages 203 and 204 of VW1

could not have been properly filed. As a result, I must now move to consider whether it has been established in evidence that the IR was filed in pursuit of that objective.

53. In defence of the present ground, the applicant has sought to provide an explanation as to the reasoning behind his 'WEMBY' brand, details as to the steps he took before applying for his trade marks and the searches he undertook at that time. Further, he claims that he did not know of the opponent when he coined the term 'WEMBY'. Lastly, he sought to directly respond to the issue raised regarding the 'EIFEL POWER' mark. Each of these points were directly responded to by the opponent either in evidence in reply or in his submissions in lieu of a hearing. In order to address these issues, I will deal with these points in turn.

The applicant's intentions behind his 'WEMBY' brand and subsequent steps.

54. The applicant's evidence discusses the concept behind the IR and the reasons why he sought to protect both it and the other marks referred to by the opponent. He begins by explaining that the name 'WEMBY' was conceived in August 2022 as an acronym for the phrase 'With Every Moment Be Yourself'. He states that the first and only time he had seen the term 'WEMBY' at that time was in relation to an online mental wellness therapy company, being Wemby Therapy.

55. In November 2022, after conceiving of the brand in August 2022, he sought the commission of a WEMBY logo. A copy of an email dated 17 November 2022 from a design company called 'designhill' regarding the finalisation of his 'WEMBY' logo is provided.[23] A screenshot dated 26 January 2023 is provided from AMG Digital Agency's website that appears to be a mock-up of a potential 'WEMBY' website.[24]

56. An additional photograph is provided of a different mock-up of the applicant's website, being 'getwemby.com'.[25] This photograph is one of a physical printout of

[23] MW4
[24] Also MW4
[25] MW5

the mock-up. The print-out date is shown as 27 April 2023 and includes the WEMBY branding alongside an image of a female wearing gym clothing. There are handwritten notes on the printout, and it is not clear when these were added. In this same exhibit are a range of further screenshots taken from AMG Digital Agency's website as well as a screenshot of 'getwemby.com' which shows the listing of a range of t-shirts and tank tops bearing the WEMBY branding. While noted, these printouts are undated.

57. The applicant explains that he planned to launch his brand in March 2023 by utilising Amazon for global distribution. He was approved for brand protection to use WEMBY on Amazon in March 2023. In discussing this point, he explains his belief that the brand protection via Amazon is far more extensive than the USPTO due to the fact that it is the second largest retailer in the world and because more infringement activity takes place online. While these points are noted, I am not convinced that they have any relevance here.

58. In his submissions in lieu of a hearing, the opponent put forward that the claim of 'WEMBY' being an acronym for 'With Every Moment Be Yourself' appears to have been coined later (in mid-2023) in an attempt to legitimise his application *ex post facto*.[26] This argument is based on the fact that the applicant did not file contemporaneous documentation in his evidence pre-dating his alleged coining of the term in August 2022. In essence, this is a submission inviting me to disbelieve the applicant's narrative evidence that he independently coined the term 'WEMBY – With Every Moment Be Yourself' at that time. While noted, there is nothing before me to suggest that the applicant is being untruthful and I remind myself that the applicant's statement is accompanied by a sworn statement of truth. Further, it was open to the opponent to apply to cross-examine the applicant on this point but he elected not to, reserving this argument until his submissions in lieu of a hearing which, in the circumstances, is inappropriate.

[26] It is noted that a US trade mark application was made for 'With Every Moment Be Yourself – WEMBY' on 17 May 2023 which is before the opponent was drafted to the NBA.

The searches undertaken

59. Around the time of creating his brand, the applicant's evidence sets out that he hired the company 'Trademark Engine' to initiate trade mark searches on 15 November 2022 to identify any potential conflicts with existing trade mark rights, including registered marks, US state registrations and common law usage. A screenshot is provided, seemingly of his account portal for Trademark Engine, that shows a number of actions for the mark 'WEMBY', the first of which being a federal direct hit search on 24 November 2022.[27] It is not clear what this direct hit means but the narrative evidence does state that "the searches located no earlier conflicting rights in the name 'WEMBY'".[28] Therefore, it is reasonable to conclude that the 'direct hit' did not flag up a conflicting right.

60. It was at this point that the applicant decided to proceed with filing a number of trade marks in the USA (with Canadian priority dates). The evidence runs throughout the details associated with these marks and while I will not reproduce that information here, it is noted that some of the marks were applied for in the name of Wemby Inc and Wemby Corporation, as well as in the applicant's own name. As such, it does not appear as though the applicant is contesting his association with these other companies who applied for the marks.[29] Included in the evidence are printouts from the USPTO and Canadian IPO websites showing the status of the marks discussed in his evidence.[30]

61. The applicant goes on to state that he abandoned some of the filings of the WEMBY trade marks that he applied for in the USA because of manufacturing and distribution issues as well as trade mark redundancy and a change in strategic focus. Those marks he abandoned were in respect of NFT related goods, trading cards and clothing. Where clothing was applied for in respect of these marks, I note

[27] MW1
[28] Paragraph 6 of the applicant's witness statement
[29] I mention this here because, as above, the alleged pattern of behaviour covers applications by the applicant as well as these other companies.
[30] MW3

that the marks were for ‘With Every Moment Be Yourself – WEMBY’ and ‘WEMBY Wear’.

62. In respect of the applicant’s searches, the opponent argues that it was inconceivable that these searches did not flag up the use of ‘WEMBY’ by the opponent or in connection with the opponent. The submissions of the opponent claim that it is very telling that the results of the searches were not disclosed in evidence by the applicant. While he did not disclose the results, he was under no obligation to. Further, as noted above, the applicant confirms the nature of the results by saying that no earlier conflicting rights in the name WEMBY were returned. Essentially, the opponent is inviting me to disbelieve this statement (which is accompanied by a sworn statement of truth) and, without anything further, I am not willing to do so. On this point, I will repeat what I have above in that it was open for the applicant to request to cross-examine the applicant on the truthfulness of his statement, a step that was not taken.

The applicant’s claim to not know of the opponent

63. The applicant’s witness statement states that when he first came up with the brand in August 2022, he had no knowledge of the opponent and that he had (and still has) no interest in basketball. In support of the latter point, he claims that the designs of his prototype products (being American footballs) support the fact that he does not seek to align himself or his brand with basketball.[31]

64. In response, the opponent’s position is that the applicant must have known of him on the basis that he was a well-known figure in basketball as at the relevant date. In respect of this argument, I appreciate that there may be circumstances where a public figure is so well-known that it is implausible to suggest that they were not known to someone making a trade mark application. In the context of basketball, I am of the view that a finding (based on judicial notice) could be said to apply to someone like Michael Jordan, Kobe Bryant or LeBron James. However, I do not consider that the opponent is at this level of fame for such a finding to apply here.

[31] Photos of the American Footballs branded ‘WEMBY’ can be found at MW2

Further, the evidence does not demonstrate that he is so widely known that it can be said that the applicant ought to have known of him.

65. In further support of the argument that the applicant must have known of the opponent, the evidence in reply of Ms Hoy refers to the fact that the applicant's stated address in a separate trade mark application in the USA was listed as being in Texas, USA.[32] It is not clear whether the applicant actually resides at this address as the address at issue in the present proceedings is one in Canada.[33] In any event, a screenshot is provided of a Google Maps route showing the driving distance between the applicant's Texas address and San Antonio.[34] The distance is shown as being 156km (being around 100 miles). Ms Hoy argues that the applicant must have known about the opponent and his Wemby nickname because it was widely recognised that he would be selected by the San Antonio Spurs and such a point was subject to headlines in the local press, which is demonstrated via a printout of mysanantonio.com dated 3 July 2022.[35]

66. This argument is a mere supposition based on the fact that there was speculation amongst the basketball community that the opponent would go to San Antonio. In short, I see no merit in this argument. Firstly, there is nothing to suggest that the applicant ought to have been aware of this speculation. Secondly, to suggest a proximity to the team automatically means the applicant must have known of the speculation that the opponent was going to be drafted to San Antonio is entirely misguided. If this was the case then, to use an analogy, it would mean that anyone who has an address within 100 miles of say, Manchester United, could be said to be aware of that team potentially signing a high profile football prospect, regardless of their interest in the sport or not. This is entirely unsupportable and, in the present case, it is not a finding I am willing to make. As a result, I do not consider it inconceivable for a Canadian individual who confirms that he has no interest in basketball and who may or may not have ties to Texas (by way of a filing address)

[32] RPH6
[33] As this issue was raised in reply, the applicant had no opportunity to respond to this claim by way of his own evidence.
[34] RPH7
[35] RPH5

to suggest that he did not know of the opponent. In short, there is nothing before me that contradicts the applicant's stated lack of knowledge regarding the opponent.

EIFEL POWER

67. The last point the applicant seeks to discuss is the EIFEL POWER brand. He explains that this was filed in the name of Vivico, LLC on 21 December 2022. There is no information of this company's connection to the applicant but he does go on to explain the rationale in making this application, thereby indicating that he was responsible for it. His rationale for this application and its subsequent abandonment is explained in his narrative evidence. The applicant confirms that he is a proud Canadian with a strong Anglo-French heritage. He states that he was attracted by the idea of a strong message combined with a globally recognised landmark like the Eifel Tower, which he visited whilst on his honeymoon in 2016. He states that he became aware of a coffee brand in the US using the name 'Eifel Power' as well as a song and band by that same name based in Seattle, USA. It was his desire to avoid litigation with these parties that led to him withdrawing the application for this mark. Further, he argues that the presence of these other users of the mark shows that the name is not unique to the opponent. Lastly in respect of this point, he disputes that the opponent was known by this name in North America at the time of filing on 21 December 2022.

68. As I have explained above, there is just one article regarding the nickname 'The Eifel Power'. This article is from the publication WSUM.org and I have no evidence to suggest the readership of such a publication and, as it is not one I am familiar with, I consider it reasonable to conclude that it is not a well-known publication. In short, it was for the opponent to direct me to evidence confirming that he is known by this nickname and one article is simply insufficient for me to conclude that the opponent was widely known by this nickname at that time. As such, I am unwilling to find that the applicant was aware of this. Taking this into account alongside the explanation given by the applicant, I do not consider it indicative of a pattern to deceive the public or take advantage of the opponent.

Conclusion of section 3(6) ground

69. Taking all of the above into account, I am of the view that even if it could be said that the opponent's evidence gave rise to a *prima facie* case that the applicant had acted in bad faith,[36] the applicant has duly rebutted it by confirming the basis behind his branding. Such an explanation, to me, appears legitimate and save for some unsupported allegations, I have nothing sufficiently solid before me to suggest otherwise. In considering bad faith, I remind myself that I am to focus on the applicant's intention as at the relevant date. While the evidence regarding his intentions is focused on August to November 2022, I consider it reasonable to infer that his intentions in seeking protection in the UK in October 2023 are simply in furtherance of his initial legitimate intentions surrounding the brand. As such, there is nothing before me to suggest he sought wider protection in different jurisdictions in bad faith so as to misrepresent himself as being associated with the opponent.

70. I do appreciate that the applicant applied for two marks that can be said to be associated with the opponent (being 'WEMBY' and 'EIFEL POWER'). However, the fact it covers just two different marks is such that I am content to conclude that this is purely coincidental. Of course, if it were the case that the evidence covered other trade mark applications for a range of additional names associated with the opponent then I agree that there would likely be no alternative but to find it indicative of a pattern aimed at associating himself with the opponent. However, that is not the case here and, as such, I do not consider that the applicant is engaging in a dishonest pattern of behaviour.

71. As a result of the above, I find that the present ground fails.

[36] My primary view is that it does not because there is not enough to suggest that the applicant could have reasonably been aware of the opponent in order for there to be a finding that he had any dishonest intentions.

CONCLUSION

72. The opposition has failed in its entirety and the IR may, therefore, proceed to be granted registration in the UK.

COSTS

73. The applicant has succeeded and is, therefore, entitled to a contribution towards his costs. In the circumstances, I award the applicant the sum of £1,500 as a contribution towards his costs. The sum is calculated as follows:

Considering a notice of opposition and preparing a counterstatement	£300
Preparing evidence and considering the evidence of the opponent:	£800
Written submissions in lieu of a hearing:	£400
Total:	**£1,500**

74. I hereby order Victor Wembanyama to pay Michael Ward the sum of £1,500. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 19th day of June 2026

A COOPER
For the Registrar