O/0521/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4048231
IN THE NAME OF VISHAL MADHU
TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASS 30

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 448863
BY GENERAL MILLS, INC.

Background and pleadings

1. On 7 May 2024, Vishal Madhu ("the applicant") applied to register the trade mark shown above in the UK, under number 4048231 ("the applicant's mark"). It was published for opposition purposes on 19 July 2024 in respect of the following goods in class 30:

Milk chocolates; Chocolate beverages with milk; Coffee beverages with milk; Chocolate for confectionery and bread; Chocolate beverages containing milk.

2. On 30 July 2024, General Mills, Inc. ("the opponent") filed a Notice of Opposition. The opponent opposes the mark in its entirety, with its opposition based upon section 3(6) of the Trade Marks Act 1994 ("the Act")[1].

3. The opponent's pleaded case is that, by seeking to register a "well-known stylised mark", the applicant acted dishonestly and in such a manner which falls below the standards of acceptable commercial behaviour. It claims that the applicant seeks to take advantage of the opponent's reputation. The opponent also directs me to two further sets of proceedings involving the same parties, which the opponent alleges goes to "a pattern of bad faith conduct". As for the applicant's intentions, the opponent submits that he "cannot have any genuine intention to use the mark… other than for the purpose of blocking, tarnishing or otherwise disrupting the business of the opponent." For these reasons, the opponent claims that the application was filed in bad faith.

4. The applicant filed a counterstatement denying the grounds of opposition. Whilst he acknowledges that the parties' goods are cereal, he submits that the opponent's sign and the applied-for mark are "very different" and, as for the separate proceedings, the applicant claims that these are "not related" and do not "bear any relevance". The applicant submits that this indicates that the opponent is acting maliciously or "using their power and harassing applicants."

[1] The opponent originally filed its opposition under sections 5(4)(a) and 3(6) of the Act. However, in its submissions filed in lieu of a hearing it confirmed that it wished to rely upon section 3(6) only.

5. The opponent is represented by Bird & Bird LLP, whilst the applicant is represented by Shipleys LLP. Only the opponent filed evidence during the course of the proceedings. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

Relevance of EU law

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

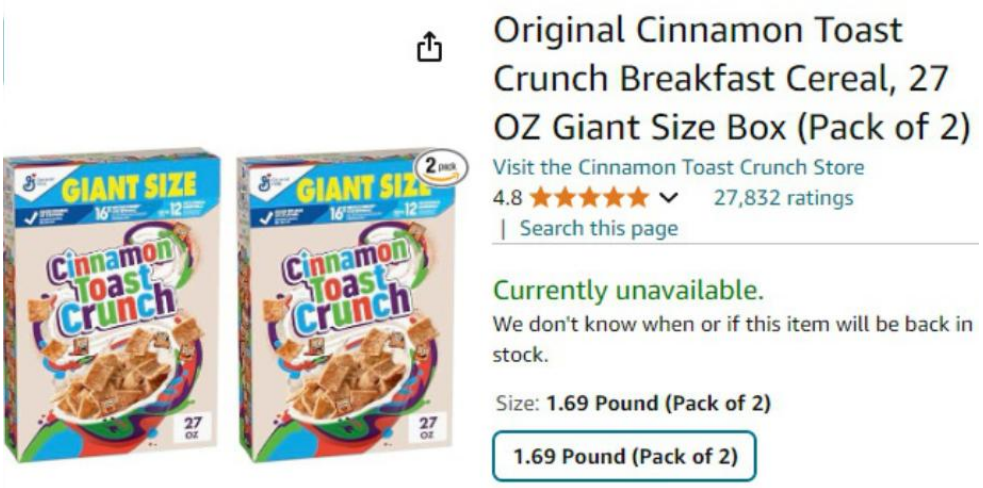
Evidence and submissions

7. The opponent's evidence is given in the witness statement of Mr C. Michael Geise, Chief Intellectual Property Counsel for the opponent. Mr Geise has held this position since September 2023 and his statement is accompanied by four exhibits (XX-1 to XX-4). I take the following from the opponent's evidence:

- The opponent is a "major US manufacturer of consumer food products", owning over 100 brands worldwide. A variety of these are listed on its website and include Cinnamon Toast Crunch, Cheerios, Haagen-Dazs and Lucky Charms.
- The opponent has a long-standing partnership with Nestle via Cereal Partners Worldwide S.A.[2], through which it has built up considerable goodwill in cereal brands, including in the UK. The CPW website details the opponent's focus on creating cereal products, stating that it was the "first major global cereal company to commit to having whole grain as a main ingredient in our cereals."

[2] "CPW": its vision is set out in its website https://www.nestle-cereals.com/uk/our-promises/about-cpw

- The opponent's Cinnamon Toast Crunch brand was launched in 1984, a fact which is unchallenged by the applicant. It uses the brand in respect of a range of cereals including, for example, Cinnamon Toast Crunch Waffles and Cinnamon Toast Crunch Minis.[3] An Amazon listing[4] shows the goods' packaging, including some information from the manufacturer. I enclose extracts from the listing below:



- The remaining parts of Mr Geise's witness statement, and remaining exhibits, go

[3] https://www.cinnamontoastcrunch.com/
[4] The goods are described as "currently unavailable".

to the history of proceedings before the parties, which I will address later in my decision.

The law

8. An objection to a trade mark on the grounds of bad faith is provided for at s. 3(6) of the Act, which reads:

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

9. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)*,[5] Lord Kitchin SCJ considered the question of what amounts to bad faith. He underlined that the categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

> "152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.
>
> 153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart

[5] [2024] UKSC 36

from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 […]."

10. Later in his judgement (at paragraph 240), Lord Kitchin summarised the general principles applicable to bad faith 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 EUIP*O, *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)."

11. According to *Alexander Trade Mark*[6], the key questions for determination in a claim of bad faith are:

(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?

12. It is necessary to ascertain what the applicant knew at the relevant date.[7] In these proceedings, that is the filing date of the applicant's mark, i.e. 7 May 2024. Evidence about subsequent events may be relevant if it casts light backwards on the position at the relevant date.[8]

13. As per the case law cited above, it is for the party alleging bad faith to prove it. The initial evidential burden falls upon the opponent: it must present evidence from which a rebuttable presumption of bad faith can be drawn. If it does that, then the burden shifts to the applicant to rebut the allegation.

14. An allegation of bad faith is a serious allegation 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 they are bad faith.[9]

What, in concrete terms, was the objective that the applicant has been accused of

[6] BL O/036/18
[7] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)
[8] *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).
[9] *Red Bull*

pursuing?

15. The opponent's pleaded case can be summarised as follows:

The applicant has elected to use the same stylisation in the applied-for mark as that which the opponent adopts in its highly similar CINNAMON TOAST CRUNCH sign, such that the opponent submits that the applicant seeks to take advantage of the opponent's reputation. Further, the opponent alleges that the applicant "cannot have any genuine intention" to use the mark, other than for the purpose of "blocking, tarnishing or otherwise disrupting the business of the opponent".[10]

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

16. If proven, this is an objective for the purpose of which the applicant's mark could not be properly filed.[11]

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

17. The applicant does not appear to have denied that he was aware of the opponent's Cinnamon Toast Crunch brand at the time of applying for his trade mark. The opponent claims that, as the applicant would have undertaken market research before designing its own cereal product, it is likely that the applicant would have become aware of the opponent (and its brands). Whilst this may seem a reasonable expectation, it is not substantiated to any degree by the evidence. That said, the opponent has filed evidence documenting past proceedings involving the same parties which is more persuasive.

18. That brings me to consider the opponent's point concerning the parties' history. In this regard, the opponent alleges that there has been a pattern of bad faith. The opponent submits that the applicant applied for a figurative "Cinnamon Toast Crunch"

[10] See Section D of the Notice of Opposition
[11] See, for example, *Copernicus-Trademarks v EUIPO (LUCEO)* Case T-82/14, where the General Court found that the filing of EU trade marks for the purposes of blocking applications by third parties, and without an intention to use the mark, was an act of bad faith.

mark in February 2024 which was subsequently withdrawn after the opponent filed an opposition.[12] The opponent contends that this further corroborates its claim that the present application was filed with an intention to misappropriate its well-established brand. The opponent also refers to a further application made by the applicant in July 2020 for the word mark "LUCKY CHARMS FROSTED TOASTED OAT CEREAL WITH MARSHMALLOWS". This application was also withdrawn following an opposition from the opponent brought on the basis of its "major cereal brand", LUCKY CHARMS.[13] Both oppositions were filed under sections 5(4)(a) and 3(6) of the Act.

19. In his counterstatement, the applicant submits that these cases are "not related to this applications and does not bear any relevance" (sic).

20. Whilst these proceedings are admittedly unrelated to the present opposition, the evidence showing that the applicant has previously applied for other trade marks which are highly similar to those owned by the opponent supports the opponent's claim that the applicant had prior knowledge of the opponent's business. I keep in mind, however, that even if I were to be satisfied that the applicant had knowledge of the opponent's use of the Cinnamon Toast Crunch sign at the time of filing (be that in the UK or otherwise), this does not, in itself, point toward a finding that the application must have been made in bad faith.[14] There must be something more. The opponent has filed no evidence as to the actual motivations of the applicant in filing either of these applications, though naturally it would be wrong to expect the party bringing the claim to give direct evidence of the motivation of someone else, in this case the applicant.[15] Whilst I note that the earlier applications were not defended (and so no substantive decision on the merits has been issued), to my mind the repeated act of filing marks similar to those owned by the opponent suggests a pattern of behaviour on the part of the applicant of deliberately seeking to associate itself with the opponent. The present application is consistent with that pattern.

21. For ease, I present examples of use of the opponent's sign and the applied-for mark in the table below:

[12] A copy of the application details (no. 4019211) and Notice of Opposition are enclosed at Exhibit XX-3.
[13] A copy of the application details (no. 3512240) and Notice of Opposition are enclosed at Exhibit XX-4.
[14] See the cases of *Lindt* and *Koton* (cited above) and *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12.
[15] *Maya Appliances Pvt. Ltd v Prapaharan Sivaratnam*, BL O/0052/25, paragraph 27

The opponent's sign as shown in evidence	Applicant's mark
 	

22. Whilst the screenshots of the opponent's website and the Amazon listing (see summary above) appear to have been retrieved at the time of drafting (rather than prior to the relevant date), it is well-established that evidence from after the relevant date can be relevant if it casts light backwards on the position as at that time and I find it reasonable to conclude that these exhibits are capable of pointing to that position.

23. It is clear that two of the three words in the representations shown above are identical, both beginning "Cinnamon Toast". To my view, the typeface and stylisation adopted in the respective sign/mark appears to be identical (or at the very least highly similar). The diamond-shaped tittle above the 'i' in Cinnamon is identical and, whilst the applicant's mark is applied for in grayscale, the variation in contrast appears to coincide with the opponent's sign. By way of example, the first and sixth letters in the first word, the third letter in the second word and the second and sixth letters in the third word are all presented in a colour (or shade) which is notably darker than the words' remaining letters. The opponent's sign and the applicant's mark also apply the same border to the perimeter of the words the mark comprises, with both positioned at an upward angle which (again, to my view) appears to be at exactly the same orientation. Whilst I acknowledge that the term "Cinnamon Toast Crunch" is unlikely to enjoy a high degree of inherent distinctiveness, and that the stylisation or alternation

in letter colours, for example, are not particularly elaborate details, I find it highly coincidental that the applicant would have elected to use such similar (if not identical) aesthetic embellishments. Coupled with the history between the parties which I have found will at least go to the opponent's claim that the applicant was familiar with the opponent and its activities, the pattern of behaviour on the part of the applicant, and the length of time the opponent's sign has been in use (which, as noted above, is not challenged by the applicant), I am satisfied that, on the balance of probabilities, the evidence gives rise to a *prima facie* case of bad faith.

24. The evidential burden now shifts to the applicant to explain its intentions at the time of making the application. Failure to rebut the case means that the proceedings in respect of the present ground must succeed. Given that the applicant has filed only a counterstatement, I will reproduce it in full here:

> "I deny the claim made by the claimant, that we are trying to potential pass off on their un regsitered (sic) trade mark rights.
>
> We do confirm that the products are cereal, but our produt (sic) is in development and the finished product is not yet procuced (sic), so for the claimant to oppose our trademark is not a valid activity, as they are just to block us.
>
> The Trademark is very different to what the opponent has (the (sic) are claiming as cinnamon toast crunch, where as our trademark for cinnamon toast squares, not cinnamon toast crunch as per TM7 filed by claimant.
>
> Further more claimant has added previous application, which are not related to this applications (sic) and does not bear any relevance.
>
> This clearly highlights their malicious mature (sic) or using their power and harassing applicants. They claim also that the application was filed for no intension (sic) of use, which is not sustainable and cannot be proven.
>
> The claimant needs to withdraw this application of opposition, as it is done is bad fate (sic) and a case of harassment and also their assumption of various alleged

misconception is discarded not not valid (sic).

In simple terms we deny their opposition and do not accept their claims against our registeration (sic) filed on on (sic) UK trademark Registration services."

25. As seen, the applicant claims that the product for which the mark is intended to be used in relation to (which it admits is cereal) is "in development". As for the opponent's submission regarding a lack of intention to use, the applicant submits that this "cannot be proven". What the counterstatement is lacking is an explanation of why (for example) the parties' respective stylisation is so similar, and of how such coincidences may have arisen. The applicant also declined to file evidence to show, for example, that it had a real commercial interest in making use of the mark applied for which, even in respect of a product in development, I expect would have been readily available. At the very least the applicant could have explained narratively how it came to construct the device he has applied for and/or what steps it has taken to develop its product. It has also failed to explain why there have been previous applications made which also correspond to marks owned by the opponent. If this was a coincidence, then I would expect this to have been explained by the applicant. Instead, there is no real rebuttal of the circumstances as put forward by the opponent. There are multiple authorities which highlight the importance of doing so.[16] For instance, in *Rui Qu (Shanghai) Enterprise Management Consulting Company Limited v Accessible Labs Ltd*,[17] Mr Daniel Alexander KC, sitting as the Appointed Person, explained that:

"47. […] the case law from the Court of Appeal prior to *SkyKick* suggests that where, in principle, evidence from those with knowledge of intention is available, it is reasonable to expect it to be adduced to rebut a prima facie case of bad faith. That proposition is supported by *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where Arnold LJ said at [180] of one of the grounds of appeal (namely that it was not realistic for the judge to expect that either witness testimony or documentary evidence would be available to explain Lidl's intentions) that despite the passage of time, the applicants for registration

[16] See, for example, *Metro-Goldwyn-Mayer Studios Inc v Meteoric Games Ltd*, BL O/791/21, *Maya Appliances Pvt. Ltd v Prapaharan Sivaratnam*, BL O/0052/25, *Rui Qu (Shanghai) Enterprise Management Consulting Company Limited v Accessible Labs Ltd*, BL O/0534/25, *SkyKick* (cited above), and *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor* (Rev1) [2024] EWCA Civ 262.
[17] BL O/0534/25

were best placed to explain their intentions. The court expected a proper explanation.

48. In the light of these authorities, where there is evidence from which it is proper to infer that an application for registration has been made in bad faith (on the basis that it was not applied for to protect one or more of the legitimate functions of a trade mark) an applicant can reasonably be expected to provide a sufficiently coherent explanation for the application specifically in the UK including as to its scope. An applicant may be able to justify the application (including its scope) on the basis of credible evidence as to its purposes in making it, for example by reference to the width of the underlying business, actual or reasonably contemplated, which the trade mark is intended to protect. If no adequate or sufficiently credible explanation is provided or one which justifies the UK application, there may be a proper basis for a finding of bad faith in whole or in part."

26. In my view, should the applicant have sought to deny the opponent's objection, it could have elected to provide an explanation as to how it came to adopt the same figurative details as in the opponent's Cinnamon Toast Crunch sign. It could have attested to not having any knowledge of the opponent's brand (if this was the case) or filed evidence to support its claim concerning product development. These are merely examples and the applicant could have gone beyond them in order to defend its position. Instead, the applicant filed no evidence or reasonable explanation in response to the opponent's pleading. The matters were clearly set out in the Notice of Opposition and the applicant, for some reason, has declined the opportunity to substantiate his denial or provide a sufficient explanation for the likeness between the opponent's sign and the application at issue. As the applicant has failed to rebut the opponent's prima facie claim of bad faith, I accept that the opponent's case is likely to reflect the correct position. I am not satisfied that the applicant has shown that he filed his application with a genuine intention to use the mark but, instead, for the reasons given above I find it more likely that the application was filed to potentially block the opponent's use of its sign in the UK or otherwise disrupt its activities, or to take advantage of the opponent's reputation. In short, I find the application was made in bad faith.

27. The opponent's claim under section 3(6) is successful.

Conclusion

28. The opposition has succeeded. Subject to any appeal against this decision, registration of the applicant's mark will be refused.

Costs

29. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1400, which is calculated as follows:

Preparing a statement and considering the applicant's counterstatement:	£250
Preparing evidence:	£600
Filing written submissions in lieu of a hearing:	£350
Official fee:	£200

30. I order Vishal Madhu to pay General Mills, Inc. the sum of £1400. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 22nd day of June 2026

Laura Stephens
For the Registrar