

O/0665/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NO. UK0003887812

IN THE NAME OF NANA YAW

FOR THE FOLLOWING TRADE MARK:

D. LOUISE

IN CLASS 14

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 507770 BY DIGITAL GROUP 1 LTD

AND IN THE MATTER OF APPLICATION NO. 4091422

IN THE NAME OF DIGITAL GROUP 1 LTD

FOR THE FOLLOWING SERIES OF TWO TRADE MARKS:

D LOUISE

D. LOUISE

IN CLASS 14

AND OPPOSITION THERETO UNDER NO. 449911

BY NANA YAW

BACKGROUND AND PLEADINGS

1. On 23 August 2024, Digital Group 1 Ltd (“DG Group”) applied to register the series of two trade marks **D Louise** and **D. Louise**, in the UK. The application was given number 4091422 (“the 422 Mark”) and it was published for opposition purposes on 6 September 2024. Protection is sought for the following goods:

Class 14 Jewellery; necklaces; pendants; chains; crosses [jewellery]; bracelets; earrings; ear studs; ear hooped earrings; drop earrings; anklets; wristlets; bangles; lockets; amulets; charms for jewellery; brooches; pins; clips; fashion jewellery; costume jewellery; gold jewellery; silver jewellery; jewellery in semi-precious metals; jewellery in non-precious metals; jewellery incorporating pearls; clasps for jewellery; jewellery boxes; jewellery cases; engravable jewellery; waterproof jewellery; key rings; key chains; watches; jewellery watches.

2. On 30 September 2024, the application for the 422 Mark was opposed by Nana Yaw, based upon sections 5(2)(a) and (b) of the Trade Marks Act 1994 (“the Act”). Nana Yaw relies upon UKTM no. 3887812 (“the 812 Mark”) for the trade mark **D. Louise**, which was filed on 10 March 2023 and registered on 2 June 2023. It stands registered for the goods shown in the Annex to this decision. Nana Yaw claims that the marks are identical or similar, and the goods are identical or similar, with the result that there is a likelihood of confusion.

3. DG Group filed a counterstatement denying the grounds of opposition.

4. Meanwhile, on 5 September 2024, DG Group had applied to invalidate the 812 Mark based upon sections 5(4)(a) and 3(6) of the Act. Under section 5(4)(a), DG Group relies upon the sign **D. Louise**, which it claims to have used throughout the UK since 2021 in relation to the same goods listed at paragraph 1 of this decision. DG Group claims that use of Nana Yaw’s mark would be contrary to the law of passing off.

5. Under section 3(6) of the Act, DG Group claims that Nana Yaw was aware of DG Group's use of the sign **D. Louise** and that the purpose of the registration was to prevent the registration or continued use of DG Group's own mark. DG Group claims that the original owner of the 812 Mark has applied to register various marks owned by third parties for the same purpose. Consequently, it is claimed that the 812 Mark was applied-for in bad faith.

6. Nana Yaw filed a counterstatement denying the grounds of invalidation.

7. Neither party requested a hearing, and only Nana Yaw filed written submissions in lieu. This decision is taken following a careful consideration of the papers on file.

REPRESENTATION

8. Nana Yaw is unrepresented.

9. DG Group is represented by Keltie LLP.

EVIDENCE AND SUBMISSIONS

10. DG Group filed evidence in chief in the form of:

- a. The witness statement of Olivia Jenkins dated 23 January 2025, which is accompanied by 10 exhibits (OJ1 to OJ10). Ms Jenkins is the Director of DG Group, a position she has held since 23 February 2023. She is also the creator of the D. Louise brand used by DG Group.
- b. The witness statement of Charlotte Wilding dated 4 February 2025, which is accompanied by 6 exhibits (CW1 to CW6). Ms Wilding is a partner at DG Group's representative.

11. Nana Yaw filed evidence in chief in the form of their own witness statement dated 31 March 2025, which is accompanied by 4 exhibits (NY1 to NY4).

12. DG Group filed submissions in reply dated 29 May 2025.

13. Nana Yaw filed written submissions in lieu dated 25 July 2025.

RELEVANCE OF EU LAW

14. 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.

DECISION

MY APPROACH

15. As the outcome of the invalidation action filed by DG Group will have a direct impact upon whether the earlier mark in the opposition can be relied upon, I will begin by assessing the invalidation action. I will then return to the impact that the outcome of that action has on the opposition.

THE INVALIDATION

Section 5(4)(a)

16. Section 5(4)(a) of the Act states as follows:

“5(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.”

17. Section 5(4)(a) has application in invalidation proceedings by virtue of section 47 of the Act, which states as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

18. 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).”

Relevant date

19. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (now KC), 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.”

20. The prima facie relevant date is the date of application for the 812 Mark, i.e. 10 March 2023. I note that Nana Yaw claims to have commenced preparations for trade prior to filing the mark. However, the only outward use of the mark that has been provided to support this claim is from 26 March 2024 i.e. after the relevant date. Consequently, I do not need to consider any earlier relevant date.

Goodwill

21. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), goodwill was described 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.”

22. 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 of 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 than 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.”

23. Ms Jenkins explains that she began using the mark D. Louise in 2021 for the purposes of advertising and selling jewellery products. Whilst I note that Ms Jenkins’s evidence appears to refer to her own use of the sign, she does state that “[DG Group] is the legal owner of the D. Louise jewellery brand, created by me in 2021”. This evidence is not challenged by Nana Yaw and, consequently, I will proceed on the basis that DG Group is the owner of any goodwill.

24. Ms Jenkins states that the sign was used on her website from as early as 22 June 2021; a range of rings, necklaces and bracelets can be seen.¹ The sign is also visible on packaging, and Ms Jenkins confirms that such use has been consistent.² Ms Jenkins has provided the following sales figures, which include both sales made through the website and through national retailer Flannels:

FY20/21	£290,167
FY21/22	£1,356,014
FY22/23	£4,310,951
FY23/24	£6,414,695 ³

¹ Exhibit OJ3

² Exhibit OJ5

³ I bear in mind that it is not clear to what extent this figure would have related to the period prior to the prima facie relevant date, if at all.

25. I note Nana Yaw's submission that these figures should be entirely disregarded due to the lack of supporting documentation. Firstly, this evidence is supported by a selection of invoices displaying the D. Louise sign, which show sales of rings, necklaces and earrings prior to the prima facie relevant date.⁴ The fact that only a selection of invoices has been provided is not, in my view, problematic for DG Group (indeed, they would be unable to submit them all due to the Tribunal's limits on filing evidence). Secondly, the allegation about the unreliability of these figures was not raised until written submissions in lieu i.e. after the conclusion of the evidence rounds. This, essentially, deprived DG Group of an opportunity to respond to the criticism which is not acceptable; the criticism should, and could, have been raised during the evidence rounds.⁵

26. The advertising spend is as follows, which relates to advertising with Meta (the owner of Instagram and Facebook) and Google:

2021	£125,600
2022	£950,147
2023	£1,330,499 ⁶

27. To my mind, the evidence plainly shows that there was a reasonable degree of goodwill at the relevant date, of which the sign D. Louise is distinctive in relation to jewellery. This is evident from the growing turnover figures and increased advertising spend leading up to the prima facie relevant date.

Misrepresentation and damage

28. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

⁴ Exhibit OJ7 (For the avoidance of doubt, any invoices that post-date the prima facie relevant date have been discounted).

⁵ O/167/07

⁶ Again, I recognise that most of this spend is likely to have fallen after the prima facie relevant date.

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] *R.P.C.* 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 *R.P.C.* 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 *R.P.C.* 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

29. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small

in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

30. *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 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.”

31. I have found that DG Group benefits from a reasonable degree of goodwill in relation to the sign D. Louise. That sign is identical to the 812 Mark. They are plainly in the same field of activity, both being protected for (or used in relation to) jewellery. Taking these factors into account, there will plainly be misrepresentation and damage arising from diversion of sales.

32. The application for invalidation based upon section 5(4)(a) of the Act succeeds.

Section 3(6)

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

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

34. 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 Ankenaevenet 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 Mağazacılık 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)."

35. According to *Alexander Trade Mark*, BL O/036/18, 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?

36. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). 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).

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

37. In its Form TM26(I), DG Group states as follows:

“9. It is submitted and evidence will be adduced that [Nana Yaw] was aware of [DG Group]’s Unregistered Mark at the time of filing, with [DG Group]’s Unregistered Mark being in use well before the Registration’s filing date.

10. It is submitted and evidence will be adduced that [Nana Yaw] applied for the Registration without intending to use it, and with no rationale for the application to be filed, instead seeking to prevent [DG Group] from registering its own application and/or continuing to use its Unregistered Mark.

11. It is submitted and evidence will be adduced that the original owner, Andrew Odame-Nyadu, is involved in other matters at the UK IPO due to applying to register trade marks to prevent third party brands from registering their own applications and/or continuing to use their marks.

12. It is submitted and evidence will be adduced that Andrew Odame-Nyadu assigned the Registration to [Nana Yaw] in 2023 due to those ongoing matters

at the UK IPO. It is submitted that this took place to hide the original ownership and avoid a claim of bad faith.

13. For these reasons and pending any further information from [Nana Yaw] (or as becomes available to [DG Group]), [DG Group] submits that [Nana Yaw]'s filing of the Registration falls well below the normal standards of acceptable commercial behaviour and honest practices, and is therefore made in bad faith. As a result, it is submitted that registration of the Registration was contrary to Section 3(6) of [the Act].”

38. As such, the claim is that the purpose of the application was to prevent DG Group's registration of the mark that it was already using and/or to hinder the ongoing business carried on under that mark.

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

39. Plainly, that is an objective for the purposes of which the 812 Mark could not be properly filed. Whilst mere knowledge of another party's business is not enough to establish bad faith (see *Lindt, Koton*), to apply for a mark with the intention of hindering another party's business or to prevent it from registering a sign that it was already using, is plainly bad faith.

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

40. Ms Wilding gives evidence regarding the bad faith claim. The current owner of the 812 Mark, Nana Yaw, is alleged to have been assigned the trade mark on 10 November 2021 by Andrew Odame-Nyadu (“the original proprietor”). This assignment was recorded on the Register following the filing of a Form TM16 which was received on 2 December 2023.⁷ Ms Wilding states that the original proprietor has filed a number

⁷ Ms Wilding states that ownership was assigned on 4 September 2024, which Nana Yaw points out is incorrect. The online Register does refer to a change of owner details having taken place on 4 September 2024, but this is a change of owner details and not a change of ownership. The only change of ownership that took place is as recorded on the Register on 7 December 2023 (being the assignment to Nana Yaw). The date given in Ms Wilding's statement is, therefore, incorrect. However, for the sake of completeness, it is not clear to me how

of “fraudulent” trade mark applications (in addition to the present one, which she also lists as an example), as follows:

Trade Mark	Proprietor
Contempee UKTM no. 3886382 Filing date: 8 March 2023 Registration date: 2 June 2023	Originally filed by Andrew Oadme-Nyadu Assigned to CT Interests Ltd on 28 June 2024
MISFITS BOXING UKTM no. 3887822 Filing date: 10 March 2023 (refused)	Originally filed by Andrew Oadme-Nyadu Assigned to An Concrete Ltd on 28 June 2024
Jake Hall UKTM no. 3975054 Filing date: 2 November 2023 (Withdrawn)	Andrew Nyadu

41. The address given for both CT Interests Ltd and An Concrete Ltd is the same as the address given for the original proprietor and he is the only officer of both companies.⁸ Ms Wilding has provided print outs from websites which used the trade marks MISFITS BOXING and Jake Hall (both in stylised forms).⁹ Despite the application for the Jake Hall mark above having been withdrawn, Nana Yaw shortly

Nana Yaw or Mr Oadme-Nyadu could have known about the application for DG Group’s mark being made prior to it being published (so as to enable them to pre-empt it) and so I would have drawn no adverse inferences from this in any event.

⁸ Exhibit CW3

⁹ Exhibit CW4

after filed for the trade mark **Jake Hal** (UKTM no. 4004545).¹⁰ An opposition was filed against the **Misfits Boxing** mark, which was successful.¹¹ In that case, another entity was found to have goodwill in relation to an identical sign. The **Contempee** mark is subject to a cancellation action, which is still ongoing; in that case, another entity claims to have rights in an identical sign.

42. Plainly, the same applicant has applied for a number of trade marks in which third parties have been found to, or claim to, have rights in identical signs. It strikes me that it is somewhat surprising that the same applicant has applied for all of these trade marks in which other people claim to have rights. The fact that the marks are all either invented words or names (which have no connection to the applicant) makes it even more surprising. This makes it less likely to be a coincidence than if, for example, a series of dictionary word marks had been applied for.

43. This is reminiscent of the circumstances in *Trump International Ltd v DTTM Operations LLC* [2019] EWHC 769 (Ch). In that case, the controlling mind behind the applicant was shown to have a history of applying for trade marks without any intention to use them, including famous third-party marks, and of being involved in numerous trade mark proceedings in the UK and elsewhere. The application for the trade mark TRUMP TV was found to have been made in bad faith, and Carr J said, at [42]:

“In relation to allegations of copyright infringement, it is necessary to decide, as a matter of fact, whether copying has occurred. As with claims of bad faith, direct evidence of copying is rarely available. In this context, it is well established that similar fact evidence may be admissible”. The case law is considered in *Copinger and Skone James on Copyright*, Vol 1, 17th Edition at [21-393]:

“... where the issue in a copyright case is whether the similarity between the claimant’s work and the defendant’s work is due to copying or is a coincidence, it is relevant to know that the defendant has produced

¹⁰ Exhibit CW5

¹¹ BL O/0010/26

works which bear a close resemblance to works other than the work in question which are the subject of copyright. Whereas similarity between two works might be mere coincidence in one case, it is unlikely that there could be coincidental similarity in, say, four cases. The probative force of several resemblances together is much better than one alone.”

This reasoning may well apply, depending on the facts, to an allegation that a third-party trade mark has been applied for in bad faith. The probative force of several instances of such applications, by the same or a connected party who has applied to register a third-party trade mark, is obvious. Such instances, if based on solid grounds, are likely to require evidence from the applicant to refuse the inference of bad faith that may otherwise be drawn from them.”

44. I bear in mind that the present case is not concerned with marks that may be considered ‘famous’. However, the fact that the same applicant has applied for multiple marks which are identical to those in which third parties claim to have an interest (or have been found to have an interest in the case of D. Louise and Misfits Boxing), combined with the fact that those marks are either invented or names which have no connection to the applicant creates, in my view, a rebuttable presumption of bad faith.

45. I will now consider the explanation provided by Nana Yaw. Nana Yaw states that they are the founder of a jewellery brand for pet lovers and that the D. Louise mark was “conceived to reflect both emotional and stylistic values”. However, no explanation is provided as to how or why the name D. Louise was chosen. Nana Yaw has referred to communications with Alibaba.com from December 2023 and early 2024 which, it is stated, show intentions to create a jewellery business.¹² However, most of these exhibits do not reference the mark D. Louise. The only document that does reference that mark is a message conversation with a representative from Alibaba.com in which it is stated that the sender is building an e-commerce brand (called D. Louise) and wanted to know how much 40 pieces would cost (presumably this is in relation to jewellery pieces). Whilst the sender name is not visible, Nana Yaw states that they sent the message and this is not disputed by the other side. However, this message

¹² Exhibits NY2 and NY4

was sent in March 2024. There is a second document which displays the mark in issue, which is a Microsoft Word document containing a logo which includes the words D. Louise and a dog device and was created on 24 January 2024.¹³

46. There are a number of issues with Nana Yaw's case. The first is that whatever Nana Yaw's intentions were in respect of use of the 812 Mark after it was assigned to them, that is not the matter in issue; what matters is the intention of the applicant at the time of filing (i.e. Andrew Oadme-Nyadu). Nana Yaw states that Mr Oadme-Nyadu applied for the 812 Mark on their behalf and that he had "no independent commercial interest in the brand or the mark". DG Group submits that this is an admission of no commercial interest i.e. no intention to use. However, I disagree. It is not a statement that there was no commercial interest in the brand, but rather no independent commercial interest. As such, it may be that he was intending to file the mark in order to licence its use to Nana Yaw. That is not a commercial interest that is independent of Nana Yaw, but it is a commercial interest nonetheless. That being said, I bear in mind that no evidence has been filed to support this claim which, presumably, would have been fairly easy to provide (such as in the form of communications between the two individuals regarding the planned licencing arrangement).

47. Secondly, even if the evidence does establish that Nana Yaw had an interest in establishing a jewellery business prior to the relevant date (which I am far from convinced about), what it does not show is any interest in the name D. Louise prior to the relevant date. If Nana Yaw (or, indeed, Mr Oadme-Nyadu) had come up with the name themselves, then I would expect them to be able to provide an explanation as to how that name was landed upon as a brand, particularly as it is not the name of either the original applicant or Nana Yaw (the purported intended user of the mark). There is a complete lack of evidence in this regard. Further, no explanation has been given regarding the other trade marks that have been applied for, either by Mr Oadme-Nyadu or Nana Yaw, or why/how these marks came to be of interest to them.

¹³ Exhibit NY3

48. Taking all of the evidence into account, I find that the evidence filed by Nana Yaw is insufficient to rebut the prima facie case put forward by DG Group. As such, I find that the 812 Mark was filed in bad faith.

49. The application for invalidation based upon section 3(6) of the Act is successful.

THE OPPOSITION

50. As the only earlier mark relied upon in the opposition has been invalidated, the opposition automatically fails.

CONCLUSION

51. The application for invalidation against UKTM no. UK0003887812 is successful and, subject to appeal, the registration is deemed never to have been made.

52. The opposition against UKTM no. 4091422 is dismissed and, subject to appeal, the application may proceed to registration.

COSTS

53. I note that Nana Yaw has requested costs off the usual scale as a result of DG Group's allegedly baseless allegations. However, as I have found in favour of DG Group, I see no reason to justify a departure from the usual principle that costs be paid by the losing party, nor do I consider there to be anything in their conduct that amounts to unreasonable behaviour to warrant such a departure.

54. As DG Group has been successful in both the opposition and the invalidation, 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 DG Group the sum of **£1,950**, calculated as follows:

Preparing TM26(I) and counterstatement and considering the other side's forms	£400
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Preparing evidence and considering the other side's evidence	£1,000
Written submissions	£350
Official fee for invalidation	£200
Total	£1,950

55. I therefore order Nana Yaw to pay Digital Group 1 Ltd the sum of **£1,950**. This sum is to 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 28th day of July 2026

S WILSON

For the Registrar

ANNEX

Class 14

Jewellery; Necklaces [jewellery]; Brooches [jewellery]; Jewellery brooches; Jewellery, including imitation jewellery and plastic jewellery; Pendants [jewellery]; Bracelets [jewellery]; Brooches [jewellery, jewelry (Am.)]; Ornaments [jewellery]; Amulets being jewellery; Amulets [jewellery]; Pearls [jewellery]; Trinkets [jewellery]; Necklaces [jewellery, jewelry (Am.)]; Fashion jewellery; Jewelry; Gold jewellery; Locketts [jewellery]; Jade [jewellery]; Brooches being jewelry; Brooches [jewelry]; Jewelry brooches; Clasps for jewellery; Charms [jewellery]; Charms for jewellery; Jewellery charms; Enamelled jewellery; Costume jewellery; Items of jewellery; Jewellery items; Ornaments [jewellery, jewelry (Am.)]; Pearls [jewellery, jewelry (Am.)]; Decorative brooches [jewellery]; Rings being jewellery; Rings [jewellery]; Trinkets [jewellery, jewelry (Am.)]; Amulets [jewellery, jewelry (Am.)]; Pewter jewellery; Bracelets [jewellery, jewelry (Am.)]; Jewellery stones; Cloisonné jewellery [jewelry (Am.)]; Cloisonné jewellery; Wristlets [jewellery]; Cloisonne jewellery; Charms [jewellery, jewelry (Am.)]; Locketts [jewellery, jewelry (Am.)]; Chains [jewellery, jewelry (Am.)]; Rings [jewellery, jewelry (Am.)]; Jewellery products; Ivory [jewellery, jewelry (Am.)]; Shoe jewellery; Crucifixes as jewellery; Precious jewellery; Necklaces [jewelry]; Agate as jewellery; Pins [jewellery, jewelry (Am.)]; Jewellery chains; Chains [jewellery]; Ivory jewellery; Jewellery chain; Jewellery caskets; Jewellery in semi-precious metals; Medallions [jewellery, jewelry (Am.)]; Gold plated brooches [jewellery]; Paste jewellery [costume jewelry (Am.)]; Paste jewellery [costume jewelry [Am.]]; Pins [jewellery]; Pins being jewellery; Amber pendants being jewellery; Jewellery boxes; Jewellery for personal adornment; Pendants [jewelry]; Imitation jewellery; Cabochons for making jewellery; Jewellery chain of precious metal for necklaces; Body jewellery; Amberoid pendants being jewellery; Paste jewelry [costume jewelry]; Jewelry (Paste -) [costume jewelry]; Beads for making jewellery; Gold thread [jewellery, jewelry (Am.)]; Personal jewellery; Jewellery in non-precious metals; Fake jewellery; Jewellery incorporating diamonds; Silver thread [jewellery, jewelry (Am.)]; Plastic costume jewellery; Imitation jewellery ornaments; Hat jewellery; Clips of silver [jewellery]; Facial jewellery; Jewellery findings; Crosses [jewellery]; Sterling silver jewellery; Jewellery in the form of beads; Paste jewellery; Jewellery (Paste -); Bracelets [jewelry]; Jewellery incorporating pearls; Amulets [jewelry]; Pearls [jewelry]; Articles of jewellery; Jewellery

articles; Diamond jewelry; Jewellery made from gold; Jewellery chain of precious metal for anklets; Wire of precious metal [jewellery, jewelry (Am.)]; Jewellery made from silver; Dress ornaments in the nature of jewellery; Clasps for jewelry; Jewellery chain of precious metal for bracelets; Jewellery of precious metals; Jewellery in precious metals; Jewelry stickpins; Locketts [jewelry]; Jewellery containing gold; Trinkets [jewelry]; Threads of precious metal [jewellery, jewelry (Am.)]; Artificial jewellery; Decorative pins [jewellery]; Jewellery for personal wear; Jewellery fashioned from non-precious metals; Jewellery cases; Body costume jewellery; Jewellery rope chain for necklaces; Charms [jewelry]; Charms for jewelry; Jewelry charms; Jewellery fashioned of semi-precious stones; Jewelry hatpins.