

O/0685/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 4023218
IN THE NAME OF KICK AIR MANCHESTER LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:**

KICKair

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 449218
BY MOHAMMED ASIF MANN**

Background and pleadings

1. On 7 March 2024, Kick Air Manchester Limited (“the applicant”) applied to register the trade mark **KICKair** in the United Kingdom, under number 4023218 (“the applicant’s mark”). Details of the application were published for opposition purposes on 24 May 2024, with registration sought for the following goods in class 25:

Clothing for sports; socks; headgear; sweatbands for sports.

2. On 21 August 2024, Mohammed Asif Mann (“the opponent”) opposed the application in its entirety under sections 5(1)/(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of its claim under sections 5(1)/5(2)(b) and 5(3), the opponent relies upon its UK trade mark number 3274683, **KICK AIR** (“the opponent’s mark”). The opponent’s mark was filed on 2 December 2017 and became registered on 9 March 2018. The opponent relies upon all goods for which its mark is registered, namely, *men’s, womens and childrens tee shirts, trousers, jackets, underwear, suits, thermal underwear, long sleeve tops, short sleeve tops, shorts, hoodies, track suits, jogging suits, jogging bottoms, polo shirts, waistcoats, cap, sweatshirts* (class 25).

4. The opponent’s mark qualifies as an earlier trade mark in accordance with section 6 of the Act. As it had been registered for over five years at the filing date of the applicant’s mark, it is subject to the use requirements set out in section 6A of the Act.

5. In pursuing an objection under section 5(1) or 5(2)(b) of the Act, the opponent’s position is that the similarities (or identity) between the parties’ marks and their respective specifications gives rise to a likelihood of confusion, including a likelihood of association.

6. The opponent also claims that its mark enjoys a reputation in respect of the goods listed above. For various reasons, the opponent argues that this reputation is such that use of the applicant’s mark without due cause would take unfair advantage of, and be

detrimental to, the distinctive character and repute of its earlier mark. In light of these claims, the opponent requests that the applicant's mark be refused under section 5(3).

7. As for section 5(4)(a), the opponent claims that it has accrued goodwill in relation to which it has used the sign **KICK AIR** in Manchester since June 2018. The sign is said to have been used in respect of *mens, womens tops, trousers, vests, t shirts, shorts, bottoms, caps and other sportswear and clothing items and childrens track suits*. The opponent submits that use of the applicant's mark would constitute passing off.

8. The applicant filed a counterstatement in which it denies the grounds of opposition and puts the opponent to proof of its earlier mark.

9. The applicant is represented by Mewburn Ellis LLP whilst the opponent is unrepresented. Only the opponent filed evidence during the course of the proceedings. No hearing was requested and only the applicant elected to file written submissions in lieu of attendance. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

10. 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.

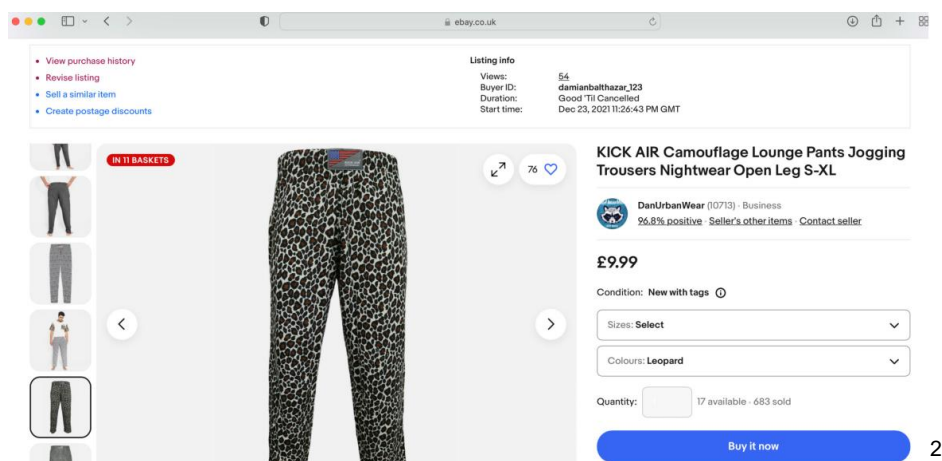
Evidence

11. The opponent's evidence is given in the form of a witness statement from the opponent himself, dated 24 March 2025, together with twenty-four exhibits (EXH1-EXH24). The opponent also provides a signed statement of use. I take the following from its evidence:

- The opponent first used the mark KICK AIR in the UK in 2018, with the mark displayed on external labels and inside tags of the relied upon goods.
- Professional photographs have been taken of such goods, and used on eBay and Amazon platforms, which Mr Mann claims shows “that significant time, money and resources have been invested in the promotion and marketing of the “KICK AIR” brand.”
- A large number of exhibits in evidence (Exhibits 1 to 13) are undated photographs of the opponent’s goods, with KICK AIR displayed on labels or swing tags in the majority of these.¹ I reproduce a sample of the images below:



- Mr Mann directs me to the below ebay listing showing KICK AIR lounge pants for sale. The “Start time” for the listing is recorded as Dec 23, 2021 11:26:43PM GMT. The seller is “DanUrbanWear” and the quantity details indicate that 683 products have been sold.



- As for Exhibits 15 to 20, Mr Mann submits that these show “a small amount of KICK

¹ The mark is not visible on the products shown at Exhibits 2, 4 or 10

² Exhibit 14

AIR listings for sale on eBay showing the amount sold of each item.” I have collated the exhibits below. As shown, the exhibits are absent of any context and simply display an image and description of various goods alongside figures pertaining to the respective goods’ “available quantity” and number “sold”. It is unclear whether the seller identified at the listings set out here was the same as above (“DanUrbanWear”) or otherwise. Only one of the descriptions makes reference to “KICK AIR”.

Picture	Title ↑↓	Available quantity ↑↓	Sold ↓
	<u>Unisex Baggy Gym Pants Jogging Trousers Zebra Jungle Camo Print Open Leg Cotton</u> [49 variations]	912	313
	<u>Men's KICK AIR Mesh Vest Gym Training Breathable Cap Sleeve Muscle Top M-2XL</u> [24 variations]	464	222
	<u>Men's Baggy Camouflage Lounge Pants Jogging Trousers Nightwear Open Leg S-XL</u> [65 variations]	790	683
	<u>Mens Plain Cargo Swim Swimming Shorts Beach Summer Mesh Lined Holiday M L XL</u> [18 variations]	53	208
	<u>Mens Body Warmer Camouflage Gillet Hoodie Casual Summer Hooded Tank Top S-2XL</u> [10 variations]	135	117
	<u>Gym Cotton Baggy Elasticated Camouflage Trousers Lounge Pyjamas Joggers Pants</u> [13 variations]	141	468

- Mr Mann encloses a photograph allegedly taken of the inside of the applicant’s premises, where the words “KICK/AIR” are displayed on the wall. He also provides a screenshot of the applicant’s website *kickair.co.uk*.
- For the last of its exhibits, the opponent encloses the final pages of a UKIPO

³ Exhibit 15

⁴ Exhibit 16

⁵ Exhibit 17

⁶ Exhibit 18

⁷ Exhibit 19

⁸ Exhibit 20

decision dated 8 April 2020, which would appear to have involved the same parties. The decision number is not provided and there is no meaningful explanation as to its significance in the present proceedings.

- Further information is provided in the opponent's statement of use, including approximate sales and promotional figures, from which extracts are shown below:

Exhibit 15 - 20 Shows a few KICK AIR listings for sale on eBay showing the amount sold of each item. This is only a few listing and a small amount compared to the amount of sales done at the warehouse through B2B and B2C. The sales last year at the warehouse alone for just the KICK AIR branded items was in the region of £45000.

If you wish to supplement the information already provided, please state how much was spent promoting the mark in the UK (or in the case of a Community mark, in the Community) during the relevant period. Ideally, this should be broken down by year. Estimates may be provided if exact figures are not readily available.

Estimates

2018 - £1500

2019 - £2000

2020 - £0 (Covid)

2021 - £0 (Covid)

2022 - £1200

2023 - £700

2024 - £700

Q8. Please provide any other information that you consider to be relevant.

Further expenses have been spent on clothing photography, editing and online listing.

Proof of use

12. Section 6A of the Act reads as follows:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(aa) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with

the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. Section 100 of the Act is also relevant. It reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. In *easyGroup Ltd v Nuclei Ltd & Ors*,⁹ Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

⁹ [2023] EWCA Civ 1247

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use

of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there

has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.'

15. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”¹⁰ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

16. Section 6A of the Act (cited above) makes clear that the relevant period for assessment is the five-year period prior to the filing date of the applicant’s mark, in the present case being 7 March 2024. The relevant period is, therefore, 8 March 2019 to 7 March 2024 (“the relevant period”).

Assessment

17. I summarised the content of the opponent’s evidence earlier in my decision. For the purpose of satisfying genuine use, the evidence faces a number of shortcomings.

¹⁰ *Jumpman* BL O/222/16

To begin, the opponent fails to offer any indication as to its turnover throughout the relevant period, nor has it provided any tangible evidence of sales. Whilst such insights are not necessarily fatal, the strength of the remaining evidence is, to my mind, significantly limited. Beginning with the photographs of the opponent's products, not all of them display or make reference to the earlier mark (to my view, at least) and, even if they had, none of the photographs are dated nor do they enjoy any context; they are simply isolated images of the opponent's goods. Whilst the 'Statement of use' template the opponent has completed makes clear that examples should be taken from within the relevant period, and it may be that the photographs were taken during this time, they remain absent of context to support any real signs of *use* insofar as it can be said to constitute an effort to commercially exploit the earlier mark. Of the exhibits said to contain information relating to sales placed via eBay, only two product descriptions incorporate the KICK AIR mark (the lounge pants¹¹ and mesh vest) with the respective sales standing at 683 and 222. I have no means of identifying the dates of these sales (specifically whether they were placed within the relevant period) or any information concerning the buyers. In its statement of use, the opponent submits that "The sales last year at the warehouse alone for just the KICK AIR branded items was in the region of £45000." The statement of use was completed in February of 2025 so, looking at it in literal terms, "last year" likely refers to sales made in 2024, the majority of which falls beyond the relevant period.

18. In terms of its investment into the promotion of the earlier mark, the opponent's statement of use indicates that approximately £2,000 was invested in 2019, no investment was made in 2020 or 2021, £1,200 was invested in 2022 and £700 in 2023. In 2024, £700 was invested though, as above, a proportion of this is likely to fall outside of the relevant period. Mr Mann submits that "further expenses have been spent on clothing photography, editing and online listing". To my mind these figures are not particularly compelling in the context of the relevant market and I must be satisfied that the level of use is justified in the sector concerned. Further, whilst I appreciate the operational impact it is likely to have had at its peak, I give little weight to the justification of "Covid" for the absence of any investment in two consecutive years. Other than taking photographs of the goods and preparing online listings (which appear to have been on eBay), the opponent does not appear to have engaged in any further

¹¹ Shown in the listing enclosed at Exhibit 14

promotional methods in an effort to *create* or *preserve* a place in the market. The opponent's evidence would have benefitted from a greater degree of insight, particularly into the nature of the sales to which it has attested and its engagement with consumers. To my mind, it would have been a fairly straightforward task for the opponent to provide a greater degree of specificity and to supplement its evidence with supporting documentation to enable me to assess, for example, the volume of use. In the present case I find I am unable to establish the scale, frequency or territorial extent, nor can I be confident that the sales, or what proportion of sales, were fulfilled within the relevant period. Whilst I have no reason to disbelieve the figures the opponent has provided, they are not, to my mind, at a significant level and the evidence elsewhere is limited for the reasons identified above. It is clear that the burden of proof lies firmly with the opponent and, whilst it is not strictly necessary to file any particular kind of documentation, it is for the opponent to file its best evidence up front and to provide sufficiently solid evidence which, in this case, has not been done. On reflection of the evidence as a whole, I am not satisfied that it is sufficient to satisfy the requirements of genuine use.

19. The consequence of the above is that the opponent is not able to rely upon its earlier mark for the purpose of the present proceedings and the opponent's objection under section 5(1)/5(2) falls away. Because proof of use is equally as applicable to section 5(3) grounds, the opponent's objection under section 5(3) also falls at this hurdle.

Section 5(4)(a)

Legislation and case law

20. Section 5(4)(a) of the Act states:

“(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.”

21. 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.”

22. In *Discount Outlet v Feel Good UK*,¹² 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).”

¹² [2017] EWHC 1400 IPEC

23. 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”.

Relevant date

22. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,¹³ Mr Daniel Alexander QC, 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.’”

23. There being no evidence that the applicant’s mark was used before its filing date or the earliest claimed use of the opponent’s sign, the relevant date for assessing this ground of opposition is the filing date of the applicant’s mark: 7 March 2024.

Goodwill

24. The first hurdle the opponent must overcome is showing that it had the necessary

¹³ BL O/410/11

goodwill resulting from the trading activity relied upon under its sign at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*¹⁴ 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.”

25. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer* (a partnership),¹⁵ 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 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

¹⁴ [1901] AC 217 (HOL)

¹⁵ [2002] R.P.C. 19 (HC)

occur.”

26. However, in *Minimax GmbH & Co KG v Chubb Fire Limited*,¹⁶ 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.”

23. In *Smart Planet Technologies, Inc. v Rajinda Sharma*,¹⁷ Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*¹⁸, paragraph 52, *Reckitt & Colman Product v Borden*¹⁹, *HL and Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd*²⁰. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

24. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party

¹⁶ [2008] EWHC 1960 (Pat)

¹⁷ [BL O-304-20]

¹⁸ [2015] UKSC 31

¹⁹ [1990] R.P.C. 341

²⁰ [1980] R.P.C. 31

A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi's witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of "reCUP" ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca's Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain

a claim of passing off.”

25. I have discussed the opponent’s evidence above and considered its significance for the purpose of assessing genuine use. In making that assessment, I found there to be a number of flaws. Under the present ground, the opponent claims to have commenced use of the KICK AIR sign in June of 2018 and submits that the sign has been used in respect of *mens, womens tops, trousers, vests, t shirts, shorts, bottoms, caps and other sportswear and clothing items, childrens tracksuits*. In its Notice of Opposition, the opponent submits that the sign has been used in Manchester²¹. At *best*, the evidence shows that the opponent has achieved what I would describe as a modest number of sales of its goods in the years leading up to the relevant date. It is, however, well-established that it is possible for a small business which has more than a trivial goodwill to protect signs which are distinctive of that business under the law of passing off,²² even where such goodwill may be small. Given that the goods at issue are ordinary consumer items, however, to my mind the figures the opponent has provided point toward a very small proportion of engagement from the relevant public. I have nothing by which to gauge the exposure the sign has enjoyed, with the evidence lacking any examples of promotional material, for example. Goodwill arises as a result of trading activities. There is very little in the evidence showing the nature of the opponent’s activities in this regard; invoices or distribution agreements, for example, which presumably would have been readily available to the opponent. As for the monetary amounts the opponent has invested annually into the promotion of the goods, I do not find these particularly significant, at least to an extent sufficient to support a finding of goodwill (absent of any corroborating evidence, at least). I have no invoices before me or ways to identify the consumers of the goods to show, for example, instances of repeat custom. I also have no means of assessing the public’s general perception of the opponent’s business or the goods available under its KICK AIR sign.

26. Determining whether there is goodwill is a multifactorial assessment. I am required to consider the reach of the evidence, the length of time the relevant public has been

²¹ See Question 2 of Form TM7

²² See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

exposed to the sign and how intensive the use has been. The evidence filed is simply not sufficient for this purpose, building a picture that is too incomplete to sustain a claim to goodwill which, as *Inland Revenue* sets out, is an attractive force. To my mind, weighing the above findings and my earlier criticisms of the opponent's evidence, I find it falls far short of establishing that the opponent's business enjoyed a goodwill, even of a trivial level, at the relevant date. There is simply not enough meaningful evidence of the sign in use to reach such a conclusion.

27. The opponent's claim under section 5(4)(a) is therefore dismissed.

Overall outcome

28. The opposition has failed in its entirety. Subject to any successful appeal against this decision, the applicant's mark will proceed to registration in the UK.

Costs

29. The applicant has succeeded and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant a total of **£900**, calculated as follows:

Considering the Notice of Opposition and preparing a counterstatement:	£300
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Considering the opponent's evidence and preparing submissions in lieu of a hearing:	£600
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30. I order Mohammed Asif Mann to pay Kick Air Manchester Limited the sum of £900. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of July 2026

**Laura Stephens
For the Registrar**