O/0690/25

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003937694
IN THE NAME OF SHENZHEN LOVECASA KITCHENWARE CO., LTD
FOR THE FOLLOWING TRADE MARK:

Selamica

IN CLASS 21

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 506931 BY CHAOZHOU G&D CERAMIC CO., LTD

BACKGROUND AND PLEADINGS

1. The trade mark shown on the cover page of this decision ("the contested mark") is owned by Shenzhen Lovecasa Kitchenware Co., Ltd ("the proprietor"). The contested mark was filed on 25 July 2023 and registered on 20 October 2023. It stands registered for the following goods:

Class 21	Ceramics for household purposes; Porcelain; Crockery; Ceramic ornaments; Drinking vessels; Toilet and bathroom cleaning utensils; Kitchen utensils; Glassware; Crystal [glassware]; Flowerpots; Roasting pans; Plastic bowls [household containers]; Fitted picnic baskets, including dishes; Cooking pot sets; Cooking pots for use in microwave ovens.

2. On 23 January 2024, Chaozhou G&D Ceramic Co., Ltd ("the applicant") applied to invalidate the contested mark pursuant to section 47 of the Trade Marks Act 1994 ("the Act"). The applicant relies upon sections 5(4)(a) and 3(6) of the Act.

3. Under section 5(4)(a) of the Act, the applicant relies upon the sign **Selamica** which it claims to have been using throughout the UK since 2019 in relation to "ceramics for household purposes and the retailing of the same". The applicant claims that use of the contested mark would be contrary to the law of passing off.

4. Under section 3(6) of the Act, the applicant claims that the proprietor was or should have been aware of its activities under the sign either in this country or elsewhere, that the contested mark was filed for the purpose of profiting from the sale of the registration or otherwise to disrupt the business activities of the applicant and that the proprietor had no intention to use it. As a result, the applicant claims that the contested mark was filed in bad faith.

5. The proprietor filed a counterstatement denying the grounds of invalidation.

6. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful consideration of all the papers on file.

REPRESENTATION

7. The proprietor is represented by Pablo Albert Catala.

8. The applicant is represented by Isabelle Bertaux of IBE Avocat.

EVIDENCE

9. Only the applicant filed evidence. This took the form of the witness statement of Lu Bingyang dated 14 June 2024. Mr Lu is the President of the applicant, a position he has held since 2006. His evidence is accompanied by six exhibits (Annexes 01 to 06).

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.

DECISION

11. The relevant parts of section 47 state:

> "47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has

been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(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."

Section 5(4)(a)

12. 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."

13. 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

14. There is no evidence before me that the proprietor has used the contested mark prior to the filing date. Consequently, I have only the prima facie relevant date to consider, which is the date of application for the contested mark i.e. 25 July 2023.

Goodwill

15. 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."

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

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

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

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

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

18. Mr Lu gives evidence that his business was started in China and that it engages in the production, processing and sale of ceramic dishes. However, it is important to note that only use in the UK is relevant to my assessment of goodwill. In this regard, Mr Lu states that use was first made of the sign in the UK in 2019 via Amazon. Four screen shots taken from Amazon UK have been provided, which show ceramic pasta bowls, cereal bowls, and a mug offered for sale under the sign Selamica.[1] The dates upon which these listings were first made available are recorded as 24 August 2019, 9 June 2019 and 3 September 2019.

19. Mr Lu has provided what he describes as "the sales order we sent to British consumers".[2] I note that all of these sales are described as having been made through Amazon.com (with an American flag alongside it). The screenshots show the following:

a. An order dated 27 May 2022 for one set of ceramic cereal bowls priced at $29.99 with a shipping address in London.

[1] Annex 04
[2] Annex 05

b. An order dated 20 May 2022 for two sets of large bowls with a total sale price of $85.98 (excluding postage and VAT) with a shipping address in Weymouth.

c. An order dated 3 June 2023 for one set of porcelain mugs priced at $45.99 with a shipping address in Reigate.

d. An order dated 5 January 2022 for one set of porcelain bowls priced at $39.99 with a shipping address in Ashford.

e. An order dated 14 April 2023 for one set of porcelain dinner plates priced at $38.53 with a shipping address in Longforgan (which I understand to be in Scotland).

f. An order dated 3 January 2023 for one set of dinner plates priced at $35.99 with a shipping address in London.

g. An order dated 18 March 2023 for one set of cereal bowls priced at $35.99 with a shipping address in Devon.

h. An order dated 29 November 2022 for two sets of cups priced at $21.99 and $19.99 respectively, with a shipping address in Gloucestershire.

i. An order dated 22 June 2023 for one set of baking dishes priced at $27.89 with a shipping address in Thornton-Cleveleys (which I understand to be in Lancashire).

j. An order dated 3 June 2023 for one set of cups priced at $23.99 with a shipping address in Nottingham.

20. The evidence filed by the applicant is clearly very thin. Whilst it appears that goods have been available for sale via Amazon UK since 2019, I have no evidence of sales taking place until 2022. I have evidence of 10 sales made prior to the relevant date which were associated with UK-based shipping addresses, amounting to a total of just

over $400. There is nothing in Mr Lu's evidence to suggest that this is only a selection or sample of sales made; as noted above, he states that this document is "the sales order we sent to British consumers". It appears to me, therefore, that this represents the entirety of the applicant's sales made to UK customers. Further, whilst I note that the shipment addresses are located in the UK it is not clear to me that all of these goods were purchased by people located in the UK (as opposed to them being only the recipients of the goods); it seems possible to me that the purchases could have been purchased by US-based customers for shipment elsewhere, particularly given that they were made through the Amazon.com website (the US version) and the charges were in US dollars.

21. However, even if I take all of these sales as validly made to UK customers prior to the relevant date, this is an incredibly small number of sales in what is undoubtedly a significant market. There is no evidence before me as to what steps the applicant has taken to promote its sign in the UK (if at all), beyond merely listing its goods on Amazon.

22. I bear in mind that small businesses may still be protected by the law of passing off. However, the law of passing off does not protect a goodwill of trivial extent.[3] As Mr Thomas Mitcheson KC, sitting as the Appointed Person, concluded in *Smart Planet Technologies, Inc. v Rajinda Sharma:*[4]

> "…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."

23. The burden of proving a protectable goodwill is on the applicant. In my view, taking the evidence as a whole into account, it falls a long way short of demonstrating that the applicant had a protectable goodwill in the UK at the relevant date, or that the sign relied upon had become distinctive of any such goodwill.

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[3] *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

[4] BL O/304/20

24. The application based upon section 5(4)(a) of the Act is dismissed.

Section 3(6)

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

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

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

> "(i) […]
>
> (ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).
>
> (iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation […], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 ("*Malaysia Dairy*")], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 ("*Sky CJEU*")], para 73).
>
> (iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the […] law of trade marks, namely the establishment and functioning of […] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which

enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacilik Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*")], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

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

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

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

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

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

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

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

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

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

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

27. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are (with amendments made to reflect that this is an invalidation, rather than an opposition):

(a) What, in concrete terms, was the objective that the [proprietor] has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested [mark] could not be properly filed? and

(c) Was it established that the contested [mark] was filed in pursuit of that objective?

28. 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 proprietor has been accused of pursuing?

29. The applicant claims that the proprietor knew (or should have known) about the applicant's activities under the sign for identical or similar goods and services. This is on the basis of the applicant's alleged use of the sign in the UK and abroad. The applicant claims that the contested mark was filed with the intention of preventing the applicant from using its brand or to profit from the trade mark registration by selling it to the applicant for a fee significantly higher than the cost of registering it. As a result, the applicant claims that the proprietor had no intention to use the contested mark.

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

30. The mere knowledge of another party using the contested mark in another territory (or, indeed, the UK) does not, of itself, establish bad faith.[5] However, if the contested mark was filed to block the applicant's entry into the UK market or to obtain an illegitimate financial benefit (rather than having a legitimate business interest in using the mark), then this would amount to bad faith.

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

31. In my view, the applicant has failed to prove its case in this regard. In order for the proprietor to have registered the contested mark with the intention of gaining some financial or other benefit from the applicant, I would need to be satisfied that it had knowledge (actual or inferred) of the applicant's business activities under the sign (either in the UK or elsewhere).

32. There is certainly no evidence before me that the proprietor knew of the applicant's use (or intention to use) the sign in the UK. Whilst I note that there is some evidence of the applicant using the sign in the UK prior to the relevant date, it is on such a small scale that it cannot be said that the proprietor should have known of their activities.

[5] *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12

The only evidence that I have before me of the applicant's activities outside of the UK are a Chinese business licence, a United States trade mark registration certificate, a Chinese trade mark registration certificate and a European Union trade mark registration certificate.[6] None of these inform me about the scale or extent of the use of the sign by the applicant in these jurisdictions prior to the relevant date. In the absence of any such evidence, I am unable to infer any knowledge of the applicant's activities in other jurisdictions on the proprietor. Consequently, I see no basis for finding that the proprietor knew, or should have known, that the applicant was using the mark (or, indeed, that the proprietor had any motivations for filing the contested mark other than those consistent with the essential function of a trade mark).

33. An allegation of bad faith is a serious one, and the burden of proof is on the applicant. The applicant has failed to establish a prima facie case of bad faith. As such, the application based upon section 3(6) of the Act is dismissed.

CONCLUSION

34. The application for invalidation is unsuccessful and, subject to any successful appeal, the contested mark may remain registered.

COSTS

35. The proprietor has been successful 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 proprietor the sum of **£950**, calculated as follows:

Considering the Notice of invalidation and preparing a counterstatement	£350
Considering the applicant's evidence	£600
Total	**£950**

[6] Annexes 01, 02 and 03

36. I therefore order Chaozhou G&D Ceramic Co., Ltd to pay Shenzhen Lovecasa Kitchenware Co., Ltd the sum of **£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 24th day of July 2025

S WILSON
For the Registrar