

O/0713/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003807489
BY WISELY VENTURES LTD TO REGISTER:

DEBRA THE GIZEBRA

AS A TRADE MARK IN CLASS 16

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 436742 BY GIZEBRA LIMITED

AND

IN THE MATTER OF APPLICATION NO. UK00003812490
BY GIZEBRA LIMITED TO REGISTER:

Gizebra

GIZEBRA

(SERIES OF TWO)

AS A TRADE MARK IN CLASS 16

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 436836 BY
WISELY VENTURES LTD

BACKGROUND AND PLEADINGS

1. These proceedings involve oppositions brought by Gizebra Limited (“GL”) and Wisely Vetnures Ltd (“Wisely”). I will summarise the relevant proceedings below, beginning with GL’s opposition on the basis that it was brought first.

GL’s opposition

2. On 8 July 2022, Wisely applied to register the trade mark ‘DEBRA THE GIZEBRA’ in the UK for the following goods:

Class 16: Paper; cardboard; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists materials; paint brushes; instructional and teaching material (except apparatus); books; booklets; drawing and colouring books; comic books; magazines; notebooks and pads; calendars; pens, pencils and crayons; paper napkins; paper tablecloths and mats; stickers and transfers; postcards and greetings cards; pen and pencil cases; song books.

3. Wisely’s mark was published for opposition purposes on 12 August 2022 and, on 7 October 2022, it was opposed by GL. GL’s opposition is based on sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).¹
4. Under the section 5(4)(a) ground, GL relies on the unregistered sign ‘GIZEBRA’ that it claims to have been using throughout the UK since 2018. In respect of the goods and services relied upon, it is noted that rather than list the goods and services expressly, GL has offered the following explanation:

“The earlier mark has been used in relation to a book published in hard copy in August 2018 titled 'The Gizebra'. The author of the book is Ms G. Harris, a

¹ It is noted that Gizebra previously sought to rely on section 3(1)(c) grounds, however, these were subsequently withdrawn.

shareholder and director of the Opponent. The book was subsequently posted online as a flip book in 2018 through digital publishing platform Anyflip before being edited and re-published in soft copy in October 2019. The updated book was made available to the public for free online as a flip book in March 2020.

The earlier mark has also been used on a website available at www.thegizebra.com since August 2018 (the Gizebra Website). The Gizebra Website contains further information and materials about the books, including cartoons relating to the principal 'Gizebra' character and other related characters, as well as educational and teaching materials and a sound recording of a song."

5. From this explanation, I take GL's case to be reliant upon "books", "downloadable publications", "provision of a website", "educational and teaching materials" and "music recordings".

6. The section 5(4)(a) ground is aimed at only some of Wisely's goods, namely:

Paper; cardboard; printed matters; book binding material; instructional and teaching materials (except apparatus); books; booklets; comic books; magazines; song books.

7. GL's pleaded case is that it has built up goodwill in the unregistered right and that all associated goodwill vests in the company. As a result of this, and Wisely's use of a similar mark on similar or identical products is likely to deceive or confuse the relevant consumer into thinking the goods are related to or connected with GL.

8. GL's section 3(6) ground is aimed at all of the goods for which Wisely seeks to register its mark. I note that GL's pleaded arguments are lengthy but, in short, they can be boiled down to a claim that Wisely was aware of GL's use of its branding and that Wisely filed its mark with the intention of preventing GL from continuing to use its earlier unregistered trade mark. As a result, GL claims that Wisely's conduct

in filing for its mark fell short of the standard of acceptable commercial behaviour and, therefore, was made in bad faith.

9. Wisely filed a counterstatement wherein it denied the claims made against it.

Wisely's opposition

10. On 22 July 2022, GL applied to register a series of word marks, being 'Gizebra' and 'GIZEBRA' (GL's application), in the UK for the following goods:

Class 16: Banners of paper; Booklets; Bookmarks; Book markers; Book marks; Books; Comic books; Fiction books; Drawing books; Birthday books; Book jackets; Activity books; Sticker books; Printed books; Painting books; Scrap books; Poster books; Children's books; Song Books; Children's Song Books; Colouring books; Flip books; Educational books; Note books; Notebooks; Notebook paper; Notebook covers; Baby books; Picture books; Children's activity books; Baby books [storybooks]; Baby books [songbooks]; Covers for books; Books for children; Calendars; Printed calendars; Wall calendars; Desk calendars; Advent calendars; Stationery; Adhesives for stationery purposes; Adhesives for household purposes; Stickers [stationery]; Party stationery; Wrappers [stationery]; Folders [stationery]; Stationery cases; Stencils [stationery]; Writing stationery; Writing materials; Pencil ornaments [stationery]; Pencil ornaments (stationery); Glitter for stationery purposes; Glitter glue for stationery purposes; Glitter pens for stationery purposes; Pens; Colouring pens; Pen sets; Coloured pens; Colour pens; Gel roller pens; Fibre-tip pens; Pen and pencil cases; Pencils; Colour pencils; Colouring pencils; Coloured pencils; Pencil sharpeners; Pencil sets; Pencil erasers; Pencil cases; Pencils for colouring; Paper; Paper badges; Bunting [paper]; Paper tissues; Printed matter; Photographic prints; Printed stationery; Cardboard; Wrapping

paper; Paper gift wrap; Photographs; Printed photographs; Paint brushes; Artists materials; magazines; Cards; Greeting cards; Birthday cards; Christmas cards; Printed cards.

11. GL's application was published for opposition purposes on 12 August 2022 and, on 11 October 2022, it was opposed in its entirety by Wisely. Wisely's opposition is brought under section 5(2)(b) of the Act and relies upon its earlier filed mark (being that under number 3807489) which is the same as the one being opposed under GL's opposition, the details of which are provided at paragraph two above.
12. Wisely argues that the marks at issue are highly similar and both cover identical or similar goods. Therefore, Wisely claims that there exists a likelihood of confusion on the part of the public.
13. GL filed a counterstatement wherein it accepted, at paragraph 10, that the marks are highly similar and that because the applications cover similar goods, there would be a likelihood of confusion on the part of the public. As a result, it follows that if GL's own opposition against Wisely's mark fails then this concession will result in the complete success of Wisely's own opposition.
14. Under the power given to the Tribunal under Rule 62(1)(g) of the Trade Mark Rules 2008, these proceedings were consolidated upon the filing of the counterstatements. This was communicated to the parties by way of written correspondence dated 23 June 2023.
15. Wisely is represented by Agile IP LLP and GL represents itself. Only GL filed evidence in chief with Wisely electing to file submissions during the evidence rounds. Both parties filed evidence in reply, however, there are issues with the manner in which Wisely filed evidence, which I will discuss further below. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

16. 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

17. GL's evidence came in the form of two witness statements from Ms Isobel McEwan dated 23 August 2023 and 30 November 2023, the latter being that which was filed in reply. Ms McEwan is the Director of GL, a role she has held since 15 July 2022. Ms McEwan's first statement is accompanied by 15 appendices, being those labelled Appendix 1 to Appendix 15, and her second statement is accompanied by three exhibits, being those labelled IM1 to IM3.

18. As set out above, Wisely sought to file evidence in reply. This comes in the form of an undated witness statement in the name of Agile IP. While it is common in proceedings before the Tribunal for parties' representatives to file evidence on their behalf, this is usually done by way of a named attorney/solicitor. In the present instance, I note that the statement of truth accompanying this evidence is not signed by a person but is signed simply by *Agile IP*. While it is possible for witness evidence to be given on behalf of a company, I remind myself of Practice Direction 22 of the Civil Procedure Rules which set out the following:

“Who may sign the statement of truth

3.1. Where a document is to be verified on behalf of a company or other corporation, subject to paragraph 3.4 to 3.6 below,² the statement of truth must be signed by a person holding a senior position^[FOOTNOTE OMITTED] in the company or corporation. That person must state the office or position held.

² These are not reproduced here as they are not relevant to the point I wish to make.

3.2. Each of the following persons is a person holding a senior position:

(1) in respect of a registered company or corporation, a director, the treasurer, secretary, chief executive, manager or other officer of the company or corporation, and

(2) in respect of a corporation which is not a registered company, in addition to the people set out in (1), the mayor, chair, president or town clerk or other similar officer of the corporation.

3.3. Where the document is to be verified on behalf of a partnership, those who may sign the statement of truth are:

(1) any of the partners, or

(2) a person having the control or management of the partnership business.”

19. Clearly, where witness evidence is given on behalf of a company, it must be signed by an employee of that company and not under the name of the company itself. Therefore, I am of the view that the evidence of Wisely cannot be treated as evidence of fact. It is my view that such an issue should have been identified upon the filing of the evidence and a correction should have been made. While I have considered the possibility of writing out to Wisely to direct them to regularise the evidence accordingly, I do not consider it necessary in the present case. I say this because the evidence does not particularly assist Wisely’s case.

20. I do not intend to summarise the parties’ evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

21. Given that GL's opposition is aimed at the mark that Wisely relies upon under its own opposition, I will consider GL's opposition first. If GL's opposition succeeds then Wisely's mark will be refused registration meaning that it will not be able to rely on the same as the basis for its own opposition. Alternatively, if GL's opposition fails then the nature of its defence to Wisely's opposition is such that Wisely's opposition will succeed in full.

DECISION

GL's opposition

Section 5(4)(a)

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

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(a) [...]

(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.”

23. 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.”

24. 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).”

25. 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 reputation¹ 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 source² 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

26. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, 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.’ ”

27. Wisely's mark does not have a priority date and neither is there any evidence of use prior to the filing date of the mark that is capable of being considered as the start of the behaviour complained about.³ Therefore, the relevant date for the assessment of GL's claim under section 5(4)(a) of the Act is the filing date of Wisely's mark, being 8 July 2022.

Goodwill

28. The first hurdle for GL is that it needs to show that it had the necessary goodwill in the sign relied upon at the relevant date. Goodwill was described in *Inland Revenue*

³ I appreciate that there is mention in its notice of opposition that GL first became aware of Wisely's potential use in February 2022. However, this is in relation to a pre-order and, further, it is not supported in any of the evidence filed.

Commissioners v Muller & Co's Margarine Ltd [1901] AC 217 (HOL), in the following terms:

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

29. In *South Cone* (cited above), 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 occur.”

30. 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.”

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

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

32. Goodwill arises as a result of trading activities. I remind myself that the applicant claims to have accrued goodwill in its unregistered sign of 'GIZEBRA' in respect of the following goods and services:

Books; downloadable publications; provision of a website; educational and teaching materials; music recordings.

Evidence of trading activities

33. GL's evidence seeks to set out the background to its use of the 'GIZEBRA' sign. This is presented in the form of a timeline of events which discusses its book called, 'The Gizebra'. GL sought the self-publishing services of third-party publishing companies, Blurb and Bookwright, and confirms that it registered for this service on 6 August 2018. Emails confirming the order with Blurb and a subsequent confirmation that the eBook is ready are provided in evidence.⁴ Both of these emails show an order date of 10 August 2018. An eBook and a PDF version of the book was created and images of these are provided in evidence.⁵ The evidence sets out that completed soft copy books, PDFs and eBooks were provided to family, friends and local business as well as focus groups to test the response to the content.

34. After the first run of books discussed above, GL began self-editing the book to prepare for the next edition. It, therefore, created a second version of the book and ordered a PDF version with the intention of sending it to a Scottish book printer for printing. An AnyFlip⁶ version of the book was produced on 17 August 2018 so that GL could check the content of the same before the actual printing began. The AnyFlip version of the book remained in the public domain until October 2019 when GL asked the printer to disable it from public view.⁷ While the availability of this version of the book is noted, there is nothing to suggest how many times it was accessed, downloaded or purchased.

⁴ Appendix 1 and 2

⁵ Appendices 3 and 5

⁶ Presumably, the AnyFlip version of the book is a version that is accessible online.

⁷ Proof of this is provided at Appendix 10

35. The evidence then confirms that GL instructed the printer to produce 25 copies of the book. An invoice confirming this is provided in evidence and I note that it is dated 17 August 2018 and shows a total printing cost of £262.⁸ The narrative evidence confirms that the hard copies of the book were delivered on 19 September 2018 and that they were used as promotional materials. Upon receiving further feedback, GL undertook a further edit of the book.

36. A third version of the book was created and I note that a copy of this is provided in evidence.⁹ The evidence then goes on to speak of efforts during the COVID-19 pandemic but I note that the evidence surrounding this relates to activity in March 2019, presumably being a typographical error on the basis that the COVID-19 pandemic restrictions came in to force in March 2020. This evidence sets out that GL repurposed the aforementioned AnyFlip version of the book to use as a marketing tool to send it prospective publishers and interested parties. It was also made available for free on GL's website. Despite these points, there is nothing to suggest how many prospective publishers or interested parties this version of the book was sent to. Additionally, there is nothing to suggest how many times the book was accessed on the website by UK customers.

37. On 17 December 2021, GL sought to print 100 copies of the book, initially via the Scottish Book Printer but since this went out of business, they sought the services of an undertaking called Mixam. A copy of an invoice confirming this is provided, however, I note that it is dated 17 December 2022, being after the relevant date.¹⁰ Even ignoring the issue with the invoice being dated after the relevant date, there is nothing to suggest whether any of these books were actually sold to customers in the UK or, as was the case with previous versions of the books, whether they were simply given to family and friends or sent to prospective publishers.

⁸ Appendix 6

⁹ Appendix 8

¹⁰ Appendix 12

38. I note that a printout is provided that shows six short promotional descriptions from various people regarding the Gizebra book.¹¹ The comments range in date from November 2018 to June 2022. While noted, the comments are not demonstrative of any actual trading activity and I have nothing to suggest the reach of such comments across the customer base in the UK as they appear to be focused on the potential launch of the book. For example, they include comments such as one wherein the writer thinks that GIZEBRA is “worth launching developing and pursuing and SOON!”. Another simply wishes GL luck and speaks to his intention to do his “best to help promote the story”. These comments are not customer reviews and neither do they indicate that the book is on sale.

39. The evidence then turns to discuss the website, which was created on 8 August 2018. A copy of the website is shown in evidence.¹² The evidence sets out that the website, at one time, had the AnyFlip version of the book available to customers. Further, there is mention of a poem and a song for children. While noted, there is nothing to suggest the amount of UK visitors that the website attracted by the relevant date and neither is there anything to suggest the number of times the books, the poem or song were accessed/downloaded by UK customers.

40. Lastly, while GL’s evidence in reply was filed in respect of its section 3(6) ground, it does state, at page 4 of Ms McEwan’s statement that:

“We may not have promoted or published our book but this in no way reflects a lack of commitment.”

Assessment of the evidence

41. As I have set out above, goodwill accrues as a result of trading activities. The most crucial issue for GL is that it has failed to demonstrate that it has undertaken any trading activities whatsoever. When a party seeks to rely on 5(4)(a) grounds, it would ordinarily be expected to file evidence of sales to UK customers/turnover

¹¹ Appendix 14

¹² Appendix 9

figures, marketing expenditure, advertising efforts or press coverage. In the present case, the evidence summarised above does not demonstrate any such evidence. I appreciate that evidence of this nature is not the absolute requirement for proving goodwill meaning that its absence is not automatically fatal, however, there is nothing further that can be said to be demonstrative of GL undertaking alternative trading activities that would assist its case. This finding is reached primarily for the following reasons:

- a. The only evidence that can be said to even remotely refer to trading activities (or the intention to undertake the same) are the publishing of 125 copies of GL's book. While I appreciate that the first 25 copies printed were used as promotional materials, there is nothing to suggest who this was sent to or the level of reach/exposure that the 'GIZEBRA' brand achieved as a result. As for the next set of 100 copies, these were not published until after the relevant date. Even ignoring the publication date of the 100 books, there is nothing to suggest that the books were actually sold to UK customers or that they were even made available for sale;
- b. There is nothing to suggest that any digital copies of the book mentioned in the evidence, be that the eBook, the AnyFlip version or the PDF copy, were sold or accessed by UK customers prior to the relevant date (or at all for that matter). As such, this evidence is not sufficient to support a claim of goodwill;
- c. The evidence of testimonials do not indicate reviews from customers that actually bought the book but are, instead, speculative comments regarding the potential for the book to be published in the future. In my view, such comments are not representative of any level of use and neither are they sufficient promotional activity as it is unclear whether such comments were circulated to any degree; and
- d. GL, by its own admission in evidence, has not published its book and neither has it attempted to promote the same. While I appreciate that this does not necessarily reflect a lack of commitment to do so, I remind myself that goodwill

stems from trading activities. Clearly, GL had not undertaken any activities that could be considered trading activities.

42. As for the website evidence, the mere existence of a website is not the same as GL providing evidence of the actual provision of websites as a service. Even if it did, its mere existence is not sufficient to give rise to a finding that GL owns any protectable level of goodwill in the provision of the same. On this point, there is nothing before me to suggest how many customers visited the website by the relevant date. As for the music on the website (and the poem, for that matter), the same issue applies here in that there is nothing to suggest that this has been downloaded or accessed by any customers whatsoever.

43. While even small businesses with a low level of use can obtain a protectable level of goodwill,¹³ the issue with GL's case is that there is no evidence of trading activities whatsoever. As such, it cannot even be said to enjoy a low level of goodwill. Therefore, I find that GL's reliance upon the section 5(4)(a) ground must fail at this stage.

Section 3(6)

44. 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.”

45. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19,

¹³ See, for example, the case of *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, 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 the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from

accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]".

46. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

47. GL's claim under this ground is that Wisely's application was made in bad faith because it was filed in order to prevent or impede GL from making use of its earlier right. GL claims that Wisely was aware of GL's unregistered right from at least as early as 5 July 2022. The claim also sets out the Wisely was also aware that GL planned for the publication of the second edition of its book and that it was prepared to initiate legal proceedings. It is submitted that Wisely filed its application in response of communications between Ms Isobel McEwan, Whitefox Publishing and the author of Wisely's book between 5 and 8 July 2022.

48. 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?

49. In considering the present case in light of the first two questions set out in *Alexander*, I note that the claimed objective is that Wisely, by filing an application for its mark, sought to block GL from making an application for its own 'GIZEBRA' mark. In the case of *Copernicus-Trademarks v EUIPO (LUCEO)* Case T-82/14, the General Court found that the filing of EU trade marks for the purposes of blocking applications by third parties, and without an intention to use the mark, was an act of bad faith. As this principle applies equally to UK trade marks, it follows that the claimed objective is one for which Wisely's application could not be properly filed. Therefore, if it is established that Wisely's mark was filed in pursuit of this claimed objective, GL's case will succeed. The burden of proving this falls on GL and I will now proceed to consider the evidence before me.

50. In support of its claim, a detailed chronology of events has been provided. I do not intend to repeat the chronology in full but note that GL first became aware of Wisely's book in February 2022 when it noticed that it was listed for pre-order on Amazon, Waterstones, The Book Depository and Goodreads (amongst others). On 13 February 2022, Ms McEwan attempted to contact the author of the book via Wisely's Instagram account. No reply was forthcoming and, in that same month, Ms McEwan also sought to contact the illustrator of the book who advised Ms McEwan that she had contacted the author directly.¹⁴ In March 2022, Ms McEwan reported the 'Debra the Gizebra' book to Amazon for copyright infringement and while it was removed from Amazon in April 2022, it remained listed for pre-sale on other websites such as WH Smith.¹⁵ Ms McEwan sought to contact Wisely again on 4 April 2022 but received no reply.

51. Ms McEwan became aware of a new advertisement for the 'Debra the Gizebra' book in July 2022 which set out that it would be available in hard copy and a Kindle

¹⁴ Copies of these communications are provided in evidence at IM1. As the illustrator does not appear to operate on behalf of Wisely, I do not consider it necessary to discuss these communications further.

¹⁵ For the avoidance of doubt, I do not consider that the removal of the pre-order by Amazon is an indicator that GL's claim was a valid one.

soft copy on 6 October 2022. On 5 July 2022, Ms McEwan sought to contact Wisely via Instagram again. There is no mention of any response so it can be assumed that there was none. Following this, on 6 July 2022, Ms McEwan contacted Wisely's publisher (being Whitefox) by way of an email direct to its CEO wherein she confirmed that she was seeking legal advice and sought confirmation that it would not publish the book. A response was received on 8 July 2022 wherein a representative for Whitefox set out that he had passed the email on to the author.¹⁶

52. On 8 July 2022, Ms McEwan responded to Whitefox's email stating that, on that day, she would write to the author directly. On this point, the pleadings refer to a Ms Khanyi Dhlomo who GL believes to be the author of the book. No copy of any correspondence directly to Ms Dhlomo is included in the evidence and there is nothing to suggest that it was actually sent. On that same day, GL noted that Wisely applied for the mark at issue here.

53. In respect of the correspondence and the lack of response from the author, Wisely's submissions set out that she is a world-renowned journalist based in South Africa. Therefore, it claims that the attempts to contact her on Instagram would not have filtered through to her verified account. I have no evidence as to whether this is something that occurs for verified Instagram accounts (in that they filter out direct messages). That being said, even if she was aware of GL's correspondence, her lack of response is not an act of bad faith. In my view, it is reasonable to suggest that an author of a book would not look to engage in direct messages via social media when made aware of a potential legal dispute.

54. My primary issue with GL's case under the present ground is that there is nothing to suggest the actual intention of Wisely in filing for its mark. The evidence speaks to the actions of the book's author and relates to correspondence between the illustrator of the book and the book's publisher. Bad faith grounds are to be focused on the actions of the applicant of the mark. On this point, I remind myself that bad faith is not avoided by an application being made in the name of an entity that is

¹⁶ IM2

owned or otherwise controlled by the person behind the application.¹⁷ For example, if an individual was acting in bad faith but made an application in the name of a company it was a director of (or they were a person in control of said company), then bad faith could still exist. In the present case, there is simply nothing to suggest that the author of the book (or the illustrator or the person involved with the book's publication, for that matter) is a director or a person with control of the applicant company. In short, the evidence is just too vague as to any connection between the parties GL claims to have acted in bad faith. Even if it was proven that the author, the illustrator or the individuals within the publishing company were directors or were capable of being those in control of the applicant company, the evidence falls far short of proving that the applicant acted in bad faith. I will explain why below.¹⁸

55. From the evidence, it appears that GL became aware of Wisely's use of 'DEBRA THE GIZEBRA' in February 2022 by way of pre-order adverts on Amazon and Waterstones, amongst others. At this point, it is clear that Wisely had already created a book, obtained publishing services, secured a number of well-known distributors (being Amazon and Waterstones, both of which are popular book sellers in the UK) and listed it for pre-sale. It is reasonable to infer from this that preparations to sell a book entitled 'DEBRA THE GIZEBRA' were in place long before February 2022. Further, even if it was the case that the 'Gizebra' book was in production first, there is nothing in the evidence before me to suggest that Wisely would have been aware of GL's plans at any point prior to the initial contact. On this point, I remind myself that the evidence of GL's use or promotion of its book (being that discussed under the section 5(4)(a) ground above) is far from sufficient to demonstrate that GL's use of its 'GIZEBRA' sign was something that was so widespread that it could reasonably be said to give rise to a finding that Wisely must, or ought to have, been aware of the same.¹⁹ On this point, I note that Wisely has submitted, in its defence, that 'GIZEBRA' is a portmanteau word made up of a

¹⁷ See *Joseph Yu v Liaoning Light Industrial Products Import and Export Corporation*, BL O/013/05

¹⁸ In this scenario, for the sake of completeness and because it represents GL's best case, I will deem any reference to Wisely as a reference to the author or any other party involved in the process of creating the book.

¹⁹ I note that GL's own evidence in reply confirms that it has not published or advertised the book. How then, could Wisely have been aware of GL's intentions?

combination of giraffe and zebra. I do not consider the concept of a portmanteau word combining the names of two animals is something that is so novel that Wisely also coming up with the term independently (and without the knowledge of GL's book) is implausible. Based on the evidence before me, I find that GL has failed to prove that Wisely was aware of GL's intentions before beginning the process for creating its own book. In my view, it is reasonable to suggest that Wisely only became aware of this after February 2022 when GL sought to contact Wisely regarding potential infringement. Again, it is likely that the 'Debra The Gizebra' book was deep into its publication process at this time.

56. I move now to consider the actual intention of Wisely at the date of filing its application in the UK. Wisely's submissions set out that the filing date for its mark falling on the same day it became aware of the claim was a coincidence. On this point, I am not particularly convinced. In my view, applying for a mark on the same day as becoming aware of someone else's use is heavily indicative of the fact that Wisely's application was a reaction to GL's correspondence. While that may be the case, this is not an act of bad faith. I say this because having knowledge of another undertaking's use of a mark is not, in itself, indicative of bad faith.²⁰ In my view, upon noticing GL's alleged claims against it (and the reference in said claims to GL intending to publish its own book with the similar title 'GIZEBRA'), Wisely was entitled to seek to protect its position by filing a trade mark application for the title of said book, especially in light of the various threats of legal action from GL. On this point, I remind myself again that Wisely was, at this stage, already in the full throes of preparing for the release of the 'DEBRA THE GIZEBRA' book so plainly had the intention to use the mark in the near future (arguably it was actually using the mark as at the date of the application by way making the book available for pre-order). As a result, I do not consider that Wisely's application was made without an intention to use its mark. As set out in the case of *Copernicus* (cited above), an intention to block a third party from making an application may only be deemed as being bad faith if it was made without an intention to use it. This is not the case

²⁰ See paragraph 40 of *Lindt* (cited above)

here meaning that Wisely's application was made with the good faith intention of using its mark for the publication of its own book.

57. Taking all of the above into account and also reminding myself that a claim of bad faith is a serious allegation that must be distinctly proved, I find that that GL has fallen far short in proving that Wisely acted in bad faith in filing its application.

Conclusion in respect of GL's opposition

58. GL's opposition fails in its entirety. Therefore, subject to any successful appeal of my decision, Wisely's mark will proceed to registration for all goods applied for. Further, Wisely may proceed to rely on its mark as the basis for its opposition against GL's application.

Wisely's opposition

Section 5(2)(b): legislation and case law

59. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because-

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark.”

60. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

61. While the opposition against Wisely’s mark failed, meaning that it may proceed to registration, it is still technically a pending mark. Regardless, it still qualifies as an “earlier trade mark” for the purposes of this decision since it was applied for at an earlier date than the filing date of GL’s application.²¹ In the present circumstances, clearly it has yet to complete its registration process more than five years prior to the filing date for GL’s application’s, meaning that it is not subject to proof of use pursuant to section 6A of the Act. This means that Wisely can rely upon all of the goods for which its mark is protected.

62. As I have set out above, the basis for GL’s defence of Wisely’s opposition was on the basis that Wisely’s own mark should be refused registration because it contravenes sections 5(4)(a) and 3(6) of the Act.²² I have found that the GL’s opposition under these grounds has failed meaning that this is not a valid defence. In respect of confusion, I note that GL’s defence was as follows:

“8. The Applicant agrees with paragraph 8 of the Opponent’s Statement of Grounds of Opposition that the identified goods in the both the Opponent’s and the Applicant’s trade mark applications are similar and, in some instances, identical.

9. The Applicant agrees with paragraph 9 of the Opponent’s Statement of Grounds of Opposition.²³

²¹ See Section 6(1)(a) of the Act.

²² See paragraphs 12 to 15 of GL’s counterstatement.

²³ It is noted that paragraph 9 of Wisely’s statement of grounds set out that the level of attention paid would not be high and that the goods would be placed close to each other and that consumers would believe that came from the same undertaking, thus causing confusion.

10. The Applicant agrees with paragraph 10 of the Opponent's Statement of Grounds of Opposition that the Applicant's application for the 'Gizebra' trade mark is highly similar to that of the Opponent's application for the 'Debra the Gizebra' trade mark and that, as the applications cover similar goods, there would be a likelihood of confusion on the part of the public."

63. Plainly, GL concedes the existence of a likelihood of confusion in respect of all goods applied for. In light of this concession, it is not necessary for me to proceed to consider the opposition in full. Therefore, I hereby find that Wisely's opposition succeeds in full and GL's application is hereby refused registration for all goods applied for.

CONCLUSION

64. The outcome of these consolidated proceedings is that GL's opposition has failed in its entirety meaning that, subject to any appeal of my decision, Wisely's mark may proceed to registration for all of the goods for which protection was sought. As for Wisely's opposition, this has succeeded in full and, again, subject to any successful appeal of my decision, GL's application is refused registration in its entirety.

COSTS

65. As Wisely has succeeded in its defence of GL's opposition and in bringing its own opposition. Therefore, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award Wisely the sum of £1,300 as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement of GL:	£300
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Considering GL's notice of opposition

and preparing a counterstatement: £300

Considering GL's evidence in chief and in reply
and preparing its own written submissions:²⁴ £600

Official fees: £100

Total: £1,300

90.I hereby order Gizebra Limited to pay Wisely Ventures Ltd the sum of £1,300.

The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 29th day of July 2024

A COOPER

For the Registrar

²⁴ For the avoidance of doubt, the costs associated with the evidence in reply that I discussed at paragraphs 18 to 20 above are not included in these costs.